

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INGENICO INC.,
Petitioner,

v.

IOENGINE, LLC,
Patent Owner.

Case IPR2019-00416
Patent 8,539,047 B2

Before ELIZABETH M. ROESEL, SHEILA F. McSHANE, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. §§ 42.5(a), 42.123(a)

On August 16, 2019, the Board authorized Ingenico Inc. (“Petitioner”) to file a Motion to Submit Supplemental Information Pursuant to 37 CFR § 42.123(a). Paper 25. Petitioner filed its Motion and Patent Owner filed an Opposition. Paper 27 (“Mot.” or “Motion”); Paper 30 (“Opp.”). After considering the Parties’ papers and the evidence of record, Petitioner’s motion is granted.

Under 37 CFR § 42.123(a), a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

Petitioner requested authorization to file the motion in an email dated August 13, 2019, within one month of the date the trial was instituted (i.e., July 15, 2019). *See* Paper 25. Patent Owner does not dispute that Petitioner’s request is timely. *See generally* Opp. Accordingly, Petitioner’s motion meets the requirement of 37 C.F.R. § 42.123(a)(1).

Petitioner asserts that the proffered supplemental information (i.e., Exhibits 1031–1035) is relevant to challenged claims 1–21, 23–25, 27, and 28 of US Patent No. 8,539,047 B2 for the which the trial has been instituted. Mot. 2–5. Patent Owner disagrees. Opp. 2–5. For the reasons discussed below, we determine Petitioner’s motion meets the requirement of § 42.123(a)(2).

In the Decision on Institution (Paper 20), we indicated that “the parties may wish to address during the trial whether the use of [graphical

user interfaces (“GUIs”)] were ubiquitous for portable phones, PDAs, and personal computers in 2004. *See* Ex. 1003 ¶ 14 (describing various portable devices that can be used in Iida).” Paper 20, 46.

Petitioner states that “Patent Owner had posited that just because accommodating a graphical user interface (“GUI”) on a cellphone today would have been obvious because of the current ubiquity of the iPhone and the like, that did not mean one would have accommodated a GUI back on March 23, 2004.” Mot. 2. Petitioner argue that the evidence submitted with the Petition “supports the conclusion that a POSITA would have been motivated by Iida’s interest in accommodating existing user devices to therefore accommodate devices with a GUI, such as disclosed by Genske.” *Id.* More specifically, Petitioner argues that the supplemental information “show the widespread use of GUIs in laptop computers and PDAs and their growing use in cellphones well prior to the critical date” and should “dispel” “Patent Owner’s argument that it would take hindsight to see a benefit in putting a GUI on a wide variety of electronic devices.” *Id.* at 5.

Petitioner further argues that “[b]ecause the challenged claims only refer to the broader terminology ‘interactive user interface’ rather than just a GUI, the exhibits are not limited to GUIs.” *Id.* at 3.

Patent Owner argues that “Ingenico is using this issue as a backdoor to introduce new prior art that Ingenico failed to include in its Petition.” Opp. 2; *see also id.* at 2–3. According to Patent Owner, “Ingenico admits that the purpose of its submission is not to show the ubiquity of GUIs, but to show ‘the widespread availability and use of *interactive user interfaces* in

portable apparatus prior to 2004.” Opp. 3 (quoting Ex. 2094¹) (emphasis added in Opp.). Patent Owner further argues that the motion should be denied because “Ingenico does not even attempt to explain why its new information could not have been presented with its Petition.” *Id.* (citation omitted).

Patent Owner also argues that the cited exhibits are not responsive to either the Institution Decision or Patent Owner’s Preliminary Response. *Id.* at 4–5. Specifically, Patent Owner argues that Petitioner’s “strategy is to proffer descriptions and advertisements of dozens of devices that it admits did not have GUIs, and then cite several isolated examples of alleged GUI-based products, implying that those are representative of the numerous non-GUI devices in Ingenico’s submissions.” *Id.* at 4 (citation omitted).

Based on the present record, we determine that the evidence of record sufficiently demonstrates that Petitioner’s supplement information, Exhibits 1031–1035, is relevant to the claims for which the trial has been instituted, as required by § 42.123(a)(2). That is, based on Petitioner’s assertions in its motion, the supplemental information may be useful in determining the patentability or unpatentability of the challenged claims. Permitting admission of the supplemental information at this time also will allow Patent Owner the opportunity to address this information in its Response, if it chooses to do so, and will ensure an efficient deposition of Petitioner’s expert witness, Mr. Geier. *See* Paper 29 (Notice of Deposition).

At this stage of the proceeding, and for purposes of deciding Petitioner’s motion, we do not reach a determination of whether the

¹ Exhibit 2094 is an August 2019 email from Robert Asher (counsel for Petitioner) to, *inter alia*, Derek Brader (counsel for Patent Owner).

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supplemental information constitutes evidence that supports a reason to combine Iida and Genske or whether any arguments based on the supplemental information exceed the scope of a proper reply. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016) (determining the reply brief exceeded the scope of a reply under 37 C.F.R. § 42.23(b)). The parties may present any arguments regarding these issues in Patent Owner’s Response, Petitioner’s Reply, and Patent Owner’s Sur-Reply.

ORDER

Accordingly, it is:

ORDERED that Petitioner’s Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.123(a) is *granted*.

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