

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

NEVRO CORP.,  
Petitioner,

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,  
Patent Owner.

---

IPR2019-01284  
Patent 7,822,480 B2

---

Before ROBERT A. POLLOCK, SCOTT C. MOORE, and  
RICHARD J. SMITH, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER

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

## I. INTRODUCTION

On February 27, 2020, and pursuant to Petitioner’s email of February 21, 2020, the Board granted Petitioner authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a). Paper 13 (“Order”). Petitioner filed its Motion on March 3, 2020. Paper 16 (“Mot.”). Patent Owner filed an opposition to that motion on March 5. Paper 18 (“Opp.”).

Petitioner seeks to submit Proposed Exhibits 1028–1059 as supplemental information supporting the public accessibility and prior art status of Sato (Ex. 1018); Principles of Radiotelegraphy (Ex. 1019); Brenig (Ex. 1020); Oetting (Ex. 1021); Ghassemlooy (Exhibit 1022); and Hitzelberger (Ex. 1025). *See* Pet. 2–3. According to Petitioner, “Patent Owner did not dispute the prior art status of any reference in its preliminary patent owner response,” but served evidentiary objections challenging the prior art status of these references after institution. Mot. 3 (citing Paper 9, 5–13, 16–17).

For the reasons discussed below, Petitioner’s Motion is granted.

## II. LEGAL STANDARD

A party may file a motion to submit supplemental information if the following requirements are met: (1) “[a] request for the authorization to file a motion . . . is made within one month of the date the trial is instituted,” and (2) “[t]he supplemental information must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). The moving party bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

### III. DISCUSSION

#### A. Timeliness of the Motion

We instituted trial in this proceeding on January 21, 2020. Paper 7. Because Petitioner requested authorization to file a motion to submit supplemental information on February 21, 2020, Petitioner's request was made within one month of the date the trial was instituted, and meets the requirements of § 42.123(a)(1).

#### B. Relevance to a Claim for which Trial Has Been Instituted

For reasons set forth below, Petitioner has met its burden to show Proposed Exhibits 1028–1059 are “relevant to a claim for which the trial has been instituted” as required under § 42.123(a)(2). Petitioner avers that the Petition relies on Sato, Principles of Radiotelegraphy; Brenig; Oetting; Ghassemlooy; and Hitzelberger “to explain the background state of the art with respect to the '480 patent,” and “further relies on Hitzelberger . . . to support ground 3.” Mot. 2–3 (citing Pet. 5–8, 11, 27, 28, 52, 57; Ex. 1003 ¶¶ 31–39, 152). Petitioner offers Exhibits 1028–1059 as supplemental information supporting the public accessibility and prior art status of these references. *Id.*

In particular, Petitioner asserts that Proposed Exhibit 1029 is relevant to Sato; Proposed Exhibit 1020 to Principles of Radiotelegraphy; proposed exhibit 1031 to Brenig; Proposed Exhibit 1032 to Oetting; Proposed Exhibit 1032 to Ghassemlooy; and Proposed Exhibit 1028, and Proposed Exhibits 1034–1059 to Hitzelberger. *See* Pet. 4–9. Patent Owner does not dispute the above contentions regarding the relevance of Proposed Exhibits 1028–1059. Finding Petitioner's arguments reasonable, Petitioner has satisfied the requirements of § 42.123(a)(2).

C. Entitlement to the Requested Relief

Patent Owner seeks to persuade us that Petitioner is not entitled to the relief requested under 37 C.F.R. § 42.20(c) because it “offers Exhibits 1028–59 as a belated attempt to supplement its *prima facie* case and attempts to remedy the deficiencies present in the petition with respect to the issue of whether Exhibits 1018–22 and 1025 were publically accessible before the critical date of the ’480 Patent.” *See* Opp. 4. More particularly, Patent Owner contends that “Petitioner intends to rely on these exhibits as substantive evidence to support a new theory of public accessibility not set out in its Petition,” and that it would be prejudiced by having to analyze and address them at this stage of the proceeding, particularly because it “does not have the right to submit evidence of its own with a sur-reply.” *Id.* at 5–7. We do not find Patent Owner’s argument persuasive.

The ’480 patent claims the benefit of provisional application 60/392,475, filed on June 28, 2002. Ex. 1001 (60). While we need not address here whether the challenged claims are entitled to that benefit of that date, this is, nevertheless, the earliest possible priority date for prior art purposes. By comparison, each of the references Petitioner seeks to support with its Proposed Exhibits bears on its face, a markedly earlier presumptive date of publication. *See* Ex. 1018 (“Oct. 1978”); Ex. 1019 (“1919”); Ex. 1020 (“Aug. 1978”); Ex. 1021 (“1979”); Ex. 1022 (“March 1996”); Ex. 1025 (“September 2001”). Under the present circumstances, Petitioner has made a threshold showing that Sato; Principles of Radiotelegraphy; Brenig; Oetting; Ghassemlooy; and Hitzelberger are prior art to the ’480 patent.

Having now challenged the prior art status of these references, Patent Owner cannot complain that Petitioner seeks to rebut its assertions with additional evidence. As noted in the Institution Decision, “the parties will

have the opportunity to further develop . . . facts during trial, and the Board will evaluate the fully developed record at the close of the evidence.” Paper 7, 33. Accordingly, will not make a final determination on this particular issue until we have the benefit of a full record developed during the course of trial. Admitting supplemental information will allow for development of the record on the issue of public accessibility and prior art effect of Sato; Principles of Radiotelegraphy, Brenig, Oetting, Ghassemlooy, and Hitzelberger. Patent Owner concerns about prejudice are misplaced and premature. Patent Owner will have a full and fair opportunity to challenge, and respond to, this newly submitted evidence in the Patent Owner Response.

In the circumstances presented here, given the relevancy of the supplemental information to the issue of public accessibility, we determine granting the Motion as to Exhibits 1028–1059 is warranted because it does not change the grounds of unpatentability set forth in the Petition, it will promote the “just, speedy, and inexpensive” resolution of this proceeding, and it will not otherwise prejudice Patent Owner.

#### IV. ORDER

Accordingly, it is

ORDERED that Petitioner’s Motion to submit Exhibits 1028–1059 as supplemental information is granted;

FURTHER ORDERED that Petitioner must file Exhibits 1028–1059 within three business days of entry of this Order.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.