

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NEVRO CORP.,  
Petitioner,

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,  
Patent Owner.

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IPR2019-01315  
Patent 7,127,298 B1

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

SMITH, *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 14. Petitioner filed its Motion on March 2, 2020. Paper 15 (“Mot.”). Patent Owner filed an opposition to that motion on March 13, 2020. Paper 19 (“Opp.”).

Petitioner seeks to submit Proposed Exhibits 1024–1044 as supplemental information supporting the public accessibility and prior art status of Hitzelberger (Ex. 1005). *See* Pet. 17–18; Mot. 1. 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 Hitzelberger after institution. Mot. 3 (citing Paper 10, 4–5, 11–17).

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 1024–1044 are “relevant to a claim for which the trial has been instituted” as required under § 42.123(a)(2). Petitioner avers that “the Board instituted trial in this proceeding on several grounds, including grounds relying on Hitzelberger.” Mot. 2 (citing Ex. 1005; Paper 7, 22–23). Petitioner further avers that “[t]he Petition and accompanying declaration of co-author Dr. Manoli explained that Hitzelberger was a printed publication that was publicly accessible prior to the '298 patent's priority date.” *Id.* at 2–3 (citing Pet. 17–18; Ex. 1015 ¶¶ 13–18; Ex. 1005; Ex. 1016; Ex. 1017; Ex. 1018; Ex. 1019; Ex. 1020). Petitioner offers Exhibits 1024–1044 as supplemental information supporting the public accessibility and prior art status of Hitzelberger. *Id.*

In particular, Petitioner asserts that proposed Exhibits 1025–1034 are Internet archive evidence that corroborate and confirm the prior art status of Hitzelberger,<sup>1</sup> that proposed Exhibits 1035–1042 are IEEE evidence that demonstrate the prior art status of Hitzelberger, and that Exhibits 1043 and 1044 further confirm the prior art status of Hitzelberger. *See* Mot. 4–7. Patent Owner does not dispute Petitioner's contentions regarding the relevance of proposed Exhibits 1024–1044. *See generally* Opp. Finding

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<sup>1</sup> Petitioner avers that Exhibit 1024 is a declaration from Samuel A. Dillon that “confirms the hyperlink interrelationship of Exhibits 1028-1034.” Mot. 4 n.2.

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 1024–44 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 the Hetzelberger [sic] reference (Exhibit 1005) was publically accessible before the critical date of the '298 patent.” Opp. 5. 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 6–8. We do not find Patent Owner's argument persuasive.

The '298 patent claims the benefit of provisional application 60/419,684, filed on October 18, 2002. Ex. 1001 (60). While we need not address here whether the challenged claims are entitled to the benefit of that date, this is, nevertheless, the earliest possible priority date for prior art purposes. Petitioner has already provided evidence that Hitzelberger “is a paper that was published and publically disseminated as part of the 2001 ESSCIRC conference in Villach, Austria.” Pet. 17 (citing Ex. 1015 ¶¶ 11–18). Under the present circumstances, Petitioner has made a threshold showing that Hitzelberger is prior art to the '298 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. The Institution Decision was “[b]ased on the record as a whole at this stage of the proceeding,” and the parties have the opportunity to further develop the factual record during trial. Paper 7, 34. 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 Hitzelberger. Patent Owner’s 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 that granting the Motion as to Exhibits 1024–1044 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 1024–1044 as supplemental information is granted;

FURTHER ORDERED that Petitioner must file Exhibits 1024–1044 within three business days of entry of this Order.

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