

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS DESIGN CORPORATION,
Petitioner,

v.

HOYT AUGUSTUS FLEMING,
Patent Owner.

IPR2019-01566
Patent RE47,474 E

Before JOSIAH C. COCKS, SCOTT C. MOORE, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER

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

1. Introduction

Petitioner, Cirrus Design Corporation, filed a “Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a).” Paper 24 (“Motion” or “Mot.”).¹ The Motion indicates that Patent Owner, Hoyt Augustus Fleming, does not oppose the Motion (Mot. 8, n.2), and no opposition has been filed.² For the reasons set forth below, we grant the Motion.

2. Discussion

In its Motion, Petitioner seeks to have entered proposed Exhibits 1038–1042 as supplemental information. According to Petitioner those exhibits constitute “Declaration of Robert Haig” (Ex. 1038), a “Declaration of Rachel J. Watters” (Ex. 1039), a “Declaration of Frank Hoffmann” (Ex. 1040), a “Declaration of Shirley Katherine Johnson,” and a “Declaration of Sunshine Carter” (Ex. 1042). Mot. 3–5. Petitioner explains that those Declarations had been served on Patent Owner on February 6, 2020, to address objections that Patent Owner had raised with Petitioner in connection with various exhibits currently in the record. *Id.* at 1–5. Specifically, those objections pertained to “authenticity and/or date of publication” of certain exhibits and also to Frank Hoffmann’s testimony referencing “The Cirrus Design, Pilot’s Operation Handbook, SR22, Revision A8” that was stated to not be of record. *Id.* at 3. Petitioner further

¹ The Motion was previously authorized by the panel. Paper 23.

² During a conference call in which the Motion was authorized, Patent Owner indicated to the panel that it did not object to the Motion, and would not file an opposition. *See* Paper 23, 3.

explains that the proposed Exhibits 1038–1042 address issues of public accessibility of certain exhibits and also that Mr. Hoffman’s reference in one paragraph of his Declaration to “Revision A8” instead of “Revision A7” was a typographical error. *Id.* at 2–5.

Supplemental “evidence” and supplemental “information” are different. Supplemental information arises under 37 C.F.R. § 42.123 and is additional information that potentially may be filed after institution of a trial and “must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a)(2). Supplemental evidence, on the other hand, is evidence that may be served on an opposing party in response to an objection. 37 C.F.R. § 42.64(b)(2). The intent of supplemental evidence is to alleviate the need for the Board to have to consider whether the initial evidence needs to be excluded in the event that such evidence becomes the subject of a motion to exclude. Supplemental information and supplemental evidence, thus, have distinct roles as a part of an *inter partes* review proceeding. Here, however, Petitioner contends that the Exhibits 1038–1042 that it had served on Patent Owner as supplemental evidence would also benefit the record to be entered as supplemental information. *See* Mot. 5–10.

37 C.F.R. § 42.123 states, in part, the following:

§ 42.123 Filing of supplemental information.

(a) *Motion to submit supplemental information.* Once a trial has been instituted, 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 for which the trial has been instituted.

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

Petitioner's request for authorization to file the Motion was timely, and Petitioner contends that the supplemental information is relevant to a claim for which trial has been instituted. Mot. 5–6. Petitioner also contends that the supplemental information: (1) “does not change the ground of unpatentability authorized in this proceeding or the evidence initially presented in the Petition to support that ground of unpatentability”; (2) “would not interfere with the just, speedy, and inexpensive resolution of this proceeding”; (3) “Patent Owner will not be prejudiced by submission of the supplemental information”; and (4) “provides additional evidence of public accessibility, in addition to the indicia of public accessibility already evidence from the exhibits and Mr. Hoffmann's testimony included with the Petition.” *Id.* at 7–9.

Although, as noted above, supplemental evidence and supplemental information are different, there is no prohibition in entering supplemental evidence in a proceeding as supplemental information. With Petitioner's above-noted contentions in mind, and given that Patent Owner does not oppose the Motion, we conclude that, in this case, entry of the supplemental information is warranted. Accordingly, we grant the Motion.

3. Order

It is

ORDERED that “Petitioner's Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a)” (Paper 24) is *granted*.

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