

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PROLLENIUM US INC.,  
Petitioner,

v.

ALLERGAN INDUSTRIE, SAS,  
Patent Owner.

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IPR2020-00901, Patent 10,485,896 B2  
IPR2020-00902, Patent 10,391,202 B2<sup>1</sup>

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*Before* JOHN G. NEW, SHERIDAN K. SNEDDEN, and  
ROBERT A. POLLOCK, *Administrative Patent Judges.*

NEW, *Administrative Patent Judge.*

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

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<sup>1</sup> This Order applies to both cases. We exercise our discretion to issue one Order to be docketed in each case. The parties may only use this caption when authorized by Board. The parties are instructed to use this heading for the consolidated filings authorized in this Order.

IPR2020-00901, Patent 10,485,896 B2  
IPR2020-00902, Patent 10,391,202 B2

On January 11, 2021, Petitioner Prolenium US Inc. (“Petitioner”) timely requested, *via* email, authorization to file a motion to submit supplemental information (“Motion”) for each of the captioned proceedings. Ex. 3002. The Board granted authorization to file the Motion on January 15, 2021. Paper 18. Petitioner filed its motion on January 22 2021. Paper 19. Patent Owner Allergan Industrie SAS (“Patent Owner”) filed an opposition to the Motion on January 29, 2021 (“Opposition” or “Opp.”). Paper 20.

In its Motion, Petitioner, pursuant to 37 C.F.R. § 42.123(a), seeks to file supplemental information consisting of Declaration testimony from Dr. Glenn Prestwich (the “Prestwich Declaration, proposed Exhibit 1106), as well as accompanying documentary exhibits supporting the Declaration (proposed Exhibits 1102, 1103, 1111–1117, 1210, 1216, and 1301–1303). Motion 1.

According to Petitioner, the Prestwich Declaration is substantially the same as the testimony offered in the copending related IPRs<sup>2</sup>, although some testimony has been revised and added to conform the testimony to the procedural posture and issues presented in the Grounds in the present IPRs. Motion 5. Petitioner also states that some additional testimony also addresses disputes about the evidence between the parties in the related IPRs that are likely to recur here. *Id.* Petitioner also provides a redline comparison between the earlier declaration and the one presently submitted as supplemental information. *Id.* (citing IPR2019-01505 et al. Ex. 1304).

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<sup>2</sup> The “copending related IPRs” are IPR2019-01505, -01506, -01508, -01509, -01617, -01632, and IPR2020-00084.

IPR2020-00901, Patent 10,485,896 B2  
IPR2020-00902, Patent 10,391,202 B2

Patent Owner opposes Petitioner’s motion, pointing to the Board’s prior motion decision in *ClearOne, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683 (PTAB Nov. 6, 2019). Opp. 6. In *ClearOne*, the Board considered a number of factors in deciding whether to allow filing of supplemental information, including whether the supplemental information:

- (1) “change[s] the grounds of unpatentability” or “the evidence initially presented in the Petition to support those grounds”;
- (2) constitutes evidence that could have been submitted with the petition rather than as supplemental information;
- (3) interferes with the Board’s mandate to secure the “just, speedy, and inexpensive resolution” of the; or
- (4) would otherwise prejudice the non-moving party.

*Id.* (citing *ClearOne*, Paper 32 at 5–6; see also *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 446–447 (Fed. Cir. 2015); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3–5 (PTAB Feb. 5, 2014); *B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, IPR2014-01510, Paper 37 at 3) (PTAB May 26, 2015)). Consideration of the above factors is discretionary, and not required. See, e.g., *Redline Detection*, 811 F.3d at 446–447.

Patent Owner contends that Petitioner seeks to add nearly double the amount of expert testimony (72 pages) and 13 new exhibits, to “change its evidence and patch over gaps in its obviousness arguments ... such as the POSA being motivated to combine certain references with a reasonable expectation of success. Opp. 8. Patent Owner points to *Yamaha Golf Car Company v. Club Car, LLC*, IPR2017-02142, (PTAB Dec. 7, 2018), in which the Board denied a motion to file supplemental information because

IPR2020-00901, Patent 10,485,896 B2  
IPR2020-00902, Patent 10,391,202 B2

the new evidence “amount[ed] to a substantial change in [Petitioner’s] original showing” on those issues in the petition, adding that “the sheer volume of new evidence that [the petitioner] proposes to submit renders the request immediately suspect” and “gives rise to a presumption of a change in the basis of the expert’s opinions, effectively amounting to a change in the evidence and perhaps even a change in the grounds of the petition.” *Id.* at 8 (quoting *Yamaha Golf Car*, Paper 43 at 5–6).

Patent Owner argues that Petitioner makes no effort to justify the submission of each proposed exhibit, but rather asserts that the exhibits as a whole are “focused” on issues of motivation to combine and reasonable expectation of success, issues that Patent Owner asserts “go to the very core of [Petitioner’s] challenge.” *Opp.* (citing Motion 5–6, and quoting *Yamaha Golf Car*, Paper 43 at 6). Patent Owner similarly argues that Petitioner’s Motion: (1) “does not even try to explain why it could not have submitted this evidence with its petitions”; and (2) “conflicts with the PTAB’s statutory mandate to ensure efficient administration of the Office.” *Opp.* 10–11.

Finally, Patent Owner asserts that it is unfairly prejudiced by Petitioner’s Motion because Petitioner would receive an opportunity to amend its Petition before Patent Owner submits its Response to the Petition. *Opp.* 14. Patent Owner contends that, contrary to Petitioner’s argument, advancing its submission of new evidence before Patent Owner’s Responses are due is not “efficient.” *Id.* (citing Motion 8). According to Patent Owner, even if the supplemental information were proper rebuttal evidence, accepting it now effectively gives Petitioner two opportunities to submit rebuttal evidence without a corresponding expansion of proceedings for

IPR2020-00901, Patent 10,485,896 B2  
IPR2020-00902, Patent 10,391,202 B2

Patent Owner. *Id.* (citing *Sling TV L.L.C. v. Realtime Adaptive Streaming, LLC*, IPR2018-01342, Paper 17 at 3–4 (PTAB May 7, 2019)). Patent Owner further argues that permitting Petitioner to essentially double its Petition would require Patent Owner to address both the Petition and the Prestwich Declaration as though it were, *in toto*, part of the Petition, prejudicing Patent Owner’s ability to fully respond. *Id.*

Section 42.123 states that:

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

As noted above, Petitioner has timely filed its request for authorization to file a motion to submit supplemental information. Furthermore, the requested supplemental information is clearly relevant as it relates to a skilled artisan’s motivation to combine, with a reasonable expectation of success, the prior art references cited in Petitioner’s Grounds. Petitioner’s Motion thus satisfies the requirements of 37 C.F.R. § 42.123(a).

Furthermore, the supplemental information Petitioner seeks to add to the record has largely been produced as exhibits in the prior related IPRs. *See, e.g.*, IPR2019-01617, Exs. 1102, 1103, 1105, 1111–1117, 1210, 1216. Proposed supplemental Exhibits 1302 and 1303 are excerpts from standard textbooks in the field of endeavor, and do not appear to alter or expand the

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