

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFIC BIOSCIENCES OF CALIFORNIA, INC.,
Petitioner,

v.

PERSONAL GENOMICS TAIWAN, INC.,
Patent Owner.

IPR2020-01163
IPR2020-01200
Patent 7,767,411 B2

Before SUSAN L. C. MITCHELL and MICHAEL VALEK,
Administrative Patent Judges.

MITCHELL, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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Pacific Biosciences of California, Inc., (“Petitioner”) sought authorization for a motion to file supplemental information pursuant to 37 C.F.R. 42.123(b) to submit a translation of a recent decision from a tribunal in China “that invalidated the claims of the Chinese counterpart to the patent at issue in these IPRs [IPR2020-01163 and IPR2020-01200] in view of the same prior art presented here by Petition.” Ex. 3003. Patent Owner opposed the request. *See id.*

We convened a call to discuss the request with the parties. Petitioner explained that although the date for the decision from the Chinese tribunal was August 17, 2021, the decision was not issued until September 2, 2021. Petitioner asserts that it promptly translated the decision and requested authorization to file a motion for supplemental information from the Board on October 6, 2021. Petitioner asserts that the decision from the Chinese tribunal addresses similar claims to those presented in the two cases before us here.

Patent Owner responds that Petitioner’s request to file a motion for supplemental information is untimely. Patent Owner asserts that this request comes late in the proceeding after the record has been fully developed, and Petitioner unduly delayed in requesting authorization to file supplemental information after the Chinese tribunal issued its decision.

Neither party believes that any briefing concerning the relevance of the supplemental information is necessary.

The parties presented sufficient argument during the conference call to apprise us of their respective positions concerning the appropriateness of the filing of supplemental information requested by Petitioner. We decided on the conference call to grant Petitioner’s request to file supplemental

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information constituting the Chinese tribunal's decision without further formal briefing. This Order sets forth our reasoning for granting Petitioner's request.

A motion for the late submission of supplemental information is governed by 37 C.F.R. § 42.123(b), which requires the movant to show why the supplemental information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests-of-justice.

We find from Petitioner's explanation set forth above that it was sufficiently diligent in getting the translation of the Chinese tribunal's decision after issuance and requesting authorization to file it as supplemental information. On the facts here, the delay from the issuance of the decision on September 2, 2021 until October 6, 2021, when Petitioner requested authorization, is not so lengthy as to constitute undue delay.

We also find that Petitioner has sufficiently shown that it could not have obtained the supplemental information earlier as the decision by the Chinese tribunal was not issued until September 2, 2021. *See* 35 U.S.C. § 42.123(b) (requiring a showing as to why the supplemental information could not have been obtained earlier); *see also Curt G. Joa, Inc. v. Fameccanica.data S.P.A.*, IPR2016-00906, Paper 62, 3 (PTAB June 21, 2017) (agreeing that the decision from a court in the United Kingdom could not have been obtained prior to the date upon which it became publicly available).

We also find that our consideration of the supplemental information would be in the interests-of-justice as required by section 42.123(b) as the Chinese tribunal's decision apparently involves a counterpart patent to the

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one at issue in the *inter partes* reviews before us here. *See Id.* at 3–4 (determining consideration of UK decision on patent involving a common specification to that at issue in the *inter partes* review was in the interests-of-justice). We do note, however, that any factual or legal findings set forth in the Chinese tribunal’s decision do not have any preclusive effect in these *inter partes* proceedings. *See id.* at 4 (citing *cf. Novartis AG v. Noven Pharms. Inc.*, 853 F.3d 1289, 1293–94 (Fed. Cir. 2017) (determining that the Board was not bound by prior judicial opinions relating to the challenged patent)).

Accordingly, it is:

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *granted*, subject to the qualifications set forth herein; and

FURTHER ORDERED Petitioner shall submit a copy of the Chinese tribunal’s decision as an exhibit no later than December 22, 2021.

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