

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY INTERACTIVE ENTERTAINMENT LLC,  
Petitioner,

v.

INTELLECTUAL PIXELS LIMITED,  
Patent Owner.

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IPR2020-01248  
Patent 8,667,093 B2

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Before JENNIFER S. BISK, JENNIFER MEYER CHAGNON, and  
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

ORDER  
Granting Patent Owner's Motion to  
Submit Supplemental Information  
*37 C.F.R. § 42.123*

## DISCUSSION

On August 9, 2021, we authorized Patent Owner to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 24; *see also* Ex. 3001. On August 11, 2021, Patent Owner filed its Motion to Submit Supplemental Information. Paper 25 (“Motion” or “Mot.”). Petitioner filed an Opposition to the Motion on August 13, 2021. Paper 27 (“Opposition” or “Opp.”). For the reasons set forth below, we grant the Motion.

### *A. Patent Owner’s Argument*

Patent Owner seeks to submit as supplemental information Exhibits 2021 and 2022 (collectively, the “New Exhibits”). Mot. 1. Patent Owner argues that the New Exhibits “are in direct response to Petitioner’s reliance on Exhibit 1034,” which Patent Owner contends supports Petitioner’s attempt “to fill the evidentiary gap left by the Petition” as to the version of the Ethernet standard employed by Schmidt, Petitioner’s primary reference.<sup>1</sup> Mot. 1–2 (citing Paper 3 (“Pet.”), 70–71; Paper 19 (“PO Resp.”), 59–63; Paper 21 (“Pet. Reply”), 23 n.7; Ex. 1006; Ex. 1034). Specifically, Patent Owner contends that the Petition “asserted that the IEEE 802.3-1985 Standard was ‘Ethernet’ used by Schmidt,” while Petitioner’s Reply “relies on newly-submitted Exhibit 1034, which is a 1,262-page, 1998 version of the IEEE 802.3 Standard for Fast Ethernet.” *Id.* Patent Owner contends that Petitioner’s Reply argument as to Ethernet specifically “relies on Exhibit 1034’s disclosure of CSMA/CD’s interFrameSpacing used in a particular mode (half duplex) in Fast Ethernet.” *Id.* at 2–3 (citing Ex. 1034, 53–54).

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<sup>1</sup> Petitioner challenges claims 4, 13, and 19 as obvious over the combination of Schmidt (Ex. 1004) and the IEEE 802.3 Standard (Ex. 1006). Pet. 68–72.

According to Patent Owner, its New Exhibits are responsive to Petitioner's Reply argument and reasonably could not have been obtained or submitted earlier. *Id.* at 3.

Patent Owner further argues that granting its request is in the interests of justice because Patent Owner was entitled to rely upon Petitioner's case-in-chief and "because the supplemental information would provide a more complete record of the use of CSMA/CD's interFrameSpacing relied upon by Petitioner." *Id.* at 4–5

### *B. Petitioner's Argument*

Petitioner responds that its reliance on Exhibit 1034 in its Reply does not constitute a "new theory of invalidity." Opp. 1. Instead, Petitioner contends, Exhibit 1034 "is the full version of Exhibit 2004 cited by Patent Owner" in the Patent Owner Response, and is intended to "correct Patent Owner's suggestion that Fast Ethernet lacked 'interframe spacing.'" *Id.* at 2 (citing Pet. Reply 24). Petitioner asserts that "Exhibit 1034 was thus in direct response to the incomplete evidence that Patent Owner itself raised in its POR as Exhibit 2004, and to corroborate the knowledge a [person of ordinary skill in the art] would bring to bear when reading Schmidt." *Id.* Petitioner argues that it has "always relied on 'interframe spacing' as being claim 4's 'specified elapsed time,' and interframe spacing is undisputedly used in all versions of Ethernet used in Schmidt." *Id.* (citing Pet. Reply 22–25). Petitioner asserts that Patent Owner, having introduced the Fast Ethernet standard in its papers, "cannot now claim surprise that Petitioner included the body of the Fast Ethernet CSMA/CD standard in Exhibit 1034." *Id.* at 4. Petitioner also argues that granting Patent Owner's request is not in the interests of justice because Patent Owner's reliance on the New Exhibits

is misplaced and also because Patent Owner had full notice of Petitioner's argument but waited till the Sur-reply to address it. *Id.* at 4–5 (citing Paper 12, 35). Petitioner therefore asks that the Motion be denied, or in the alternative, Petitioner be granted a two-page response to address the New Exhibits and any related arguments made in Patent Owner's Sur-reply. *Id.* at 5; Ex. 3001.

*C. Analysis*

Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Because Patent Owner seeks to submit supplemental information more than one-month after institution of trial, the following Rule also governs:

(b) Late submission of supplemental information. A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must 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.

37 C.F.R. § 42.123(b).

Accordingly, Patent Owner bears the burden of showing (1) “why the supplemental information reasonably could not have been obtained earlier” and (2) “that consideration of the supplemental information would be in the interests-of-justice.” *Id.* On this record and in the particular circumstances of this proceeding, we determine that Patent Owner has met its burden.

Patent Owner persuasively argues that even though the Petition asserts that a person of ordinary skill in the art reading Schmidt would have understood that Schmidt's transmissions were sent in accordance with the Ethernet protocol described by the IEEE 802.3 standard (Ex. 1006), the

Petition does not expressly address the Fast Ethernet standard. Mot. 1; Pet. 69–72. As Petitioner acknowledges, Petitioner’s Reply does rely on Exhibit 1034 and expressly addresses the Fast Ethernet standard.<sup>2</sup> Opp. 2; Pet. Reply 24–25. We are therefore persuaded that Petitioner’s complete argument as to what a person of ordinary skill in the art would have understood from the earlier IEEE 802.3 standard about the later Fast Ethernet standard may not have been entirely clear prior to Petitioner’s Reply. Although we agree with Petitioner that Patent Owner could have been aware of Petitioner’s position as to the Fast Ethernet standard earlier, we do not find it unreasonable that Patent Owner did not submit evidence relating to Fast Ethernet with its Patent Owner Response. *See General Elec. Co. v. United Techs. Corp.*, IPR2018-01442, Paper 33, 6 (PTAB. Oct. 10, 2019) (“It is reasonable that Patent Owner should not have to deduce Petitioner’s challenges and all of its supporting arguments before they develop during the course of a proceeding, without a chance to respond in some fashion.”). We also are persuaded that allowing Patent Owner to submit the New Exhibits with its Sur-reply is in the interests of justice as it allow for a more complete record and will not delay the trial schedule. We therefore *grant* Patent Owner’s motion.

We also *grant* Petitioner’s request (Opp. 5) for a two-page response to address the New Exhibits and any related arguments made in Patent Owner’s Sur-Reply.

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<sup>2</sup> We do not address in this Decision Patent Owner’s argument that Petitioner’s reliance on Exhibit 1034 constitutes a new theory of invalidity.

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