

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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OCADO GROUP PLC,  
Petitioner,

v.

AUTOSTORE TECHNOLOGY AS,  
Patent Owner.

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IPR2021-00274  
Patent 10,294,025 B2

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Before FRANCES L. IPPOLITO, SCOTT B. HOWARD, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motion to File Supplemental Information  
*37 C.F.R. §§ 42.5(a), 42.123(a)*

## I. INTRODUCTION

Petitioner requested authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) within one month of our institution of trial. On July 2, 2021, by email correspondence, we authorized Petitioner to file the motion. Petitioner filed a Motion to Submit Supplemental Information (Paper 14, “Mot.”) on July 9, 2021. Patent Owner filed an Opposition (Paper 17, “Opp.”) on July 16, 2021.

## II. DISCUSSION

Section 42.123(a) requires (1) that any party filing a motion to request supplemental information do so “within one month from the date the trial is instituted;” and (2) that “[t]he supplemental information must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a).

Section 42.123(a) “does not connote the PTAB must accept supplemental information so long as it is timely and relevant.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (citation omitted). Our guiding principle in evaluating a motion to submit supplemental information is “to ensure the efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.” *Id.* (citations and internal quotations omitted).

In its Motion, Petitioner provides a table, reproduced below, which lists the exhibits that Petitioner seeks to submit as supplemental information. Mot. iv.

Employment Agreement of Sverker Lindbo	EX1017
Employment Agreement of Robert Stadie	EX1018
Employment Agreement of Matthew Whelan	EX1019
Employment Agreement of Christopher Brett	EX1020
Combined Declaration and Assignment filed in connection with U.S. Patent Appl. No. 15/905,294	EX1021
Business Purchase Agreement	EX1022
Confirmatory Assignment Agreement	EX1023

The table from Petitioner’s Motion identifies, by number and a brief description, the exhibits which Petitioner seeks to enter as supplemental information. Mot. iv. Petitioner contends that on March 8, 2021, months after the Petition was filed in this proceeding, Patent Owner served contentions in the related ITC matter alleging that Lindbo ’178<sup>1</sup>, is not entitled to claim priority to Lindbo ’313<sup>2</sup> under 35 U.S.C. § 119(a) “because they were filed by two different affiliated entities—Lindbo ’178 was filed by Ocado Innovation Limited and GB ’313 was filed by Ocado Limited—and the latter was not a ‘legal representative[] or assign[]’ of the former as the ITC Complainants contend is required by § 119(a).” *Id.* at 2–3. Because the priority of Lindbo ’178 is also an issue in this *inter partes* review, Petitioner seeks to submit Exhibits 1017–1023 as supplemental information relevant to the claims challenged under instituted grounds based on Lindbo ’178. *See id.* at 4 (“[T]he supplemental information is ‘relevant to a claim for which the trial has been instituted’ because it pertains to the priority status of a prior art reference—Lindbo ’178—on which the Petition and the Board’s institution decision rely.”).

Petitioner adds that it could not have reasonably anticipated this argument prior to filing the Petition because Patent Owner did not raise this

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<sup>1</sup> US 10,577,178 B2, issued Mar. 3, 2020. Ex. 1003.

<sup>2</sup> GB 1314313.6, published Feb. 12, 2015. Ex. 1004.

argument at the ITC until after the Petition was filed. Mot. 5. Further, Petitioner contends that Patent Owner will not be prejudiced by the admission of the supplemental information because Petitioner produced the same information contained in Exhibits 1017–1023 to the Patent Owner at the ITC on May 2, 2021. *Id.*

In response, Patent Owner contends that the information in Exhibits 1017–1023 changes the evidence presented in the Petition and that there is no presumption Lindbo '178 is entitled to priority to Lindbo '313. Opp. 2–4.

Based on our consideration of the arguments and evidence, we determine that Petitioner's proposed supplemental information would efficiently and expeditiously serve to supplement evidence that has already been presented by Petitioner and may prove beneficial to the Board in reaching a decision with respect to the trial. In particular, the supplemental information Petitioner seeks to submit in Exhibits 1017–1023 relates to the priority of Lindbo '178, which is relied upon by Petitioner for grounds of unpatentability in this instituted proceeding. *See* Paper 12, 8. The priority date of Lindbo '178 was raised at the pre-institution stage and continues to be an issue that the panel has invited the parties to address during trial. *Id.* at 25–26. That being the case, we disagree with Patent Owner that Exhibit 1017–1023 changes or alters the evidence presented in the Petition. Rather, the supplemental information does not change the grounds of unpatentability based on Lindbo '178 that have been authorized in this proceeding, but rather develops the record on an issue we have asked the parties to address. *Id.*

We further note that Patent Owner will have sufficient time to address the supplemental information before filing the deadline of its Patent Owner

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Sur-Reply, due January 3, 2022. Paper 13, 10. Indeed, Petitioner has previously presented to Patent Owner the information contained in Exhibits 1017–1023, along with its arguments regarding the same. *See* Paper 29, 2–5; Mot. 5. Nonetheless, the parties are reminded that either may request authorization to submit additional briefing on particular issues (e.g., priority) for the panel’s consideration.

Accordingly, Petitioner’s Motion is GRANTED.

### III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion is granted and the supplemental information at Exhibits 1017–1023 are entered.

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