

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUP III INTERNATIONAL, INC. and EVERKI USA, INC.,
Petitioner,

v.

TARGUS INTERNATIONAL LLC,
Patent Owner.

IPR2021-00371
Patent 8,567,578 B2

Before JAMES J. MAYBERRY, FREDERICK C. LANEY, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

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

I. INTRODUCTION

On August 12, 2021, we authorized Petitioner to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a). Paper 24. On August 17, 2021, Petitioner filed its Motion to Submit Supplemental Information. Paper 25 (“Motion” or “Mot.”). On August 24, 2021, Patent Owner filed an Opposition to the Motion. Paper 30 (“Opposition” or “Opp.”). For the reasons set forth below, we *grant* the Motion.

II. DISCUSSION

A. Petitioner’s Contentions

Petitioner seeks to submit as supplemental information Exhibits 1015–1019 (collectively, the “New Exhibits”). Mot. 1. Petitioner argues that the New Exhibits “contain evidence relating to the public availability of the contents of the Transportation Security Administration Request for Information (hereinafter ‘TSA RFI’)^[1], which was relied upon in the instituted grounds.” *Id.*; *see also id.* at 6.

Petitioner argues that Exhibits 1015–1017 are Internet Archive affidavits of authenticity regarding articles archived on March 7, 2008, March 6, 2008, and March 9, 2008, respectively, that Petitioner asserts quote TSA RFI. Mot. 6–7. Petitioner argues that Exhibit 1018 is a West Publishing Corporation affidavit of authenticity regarding an article archived on March 7, 2008, that Petitioner asserts quotes TSA RFI. *Id.* at 7. Petitioner argues that Exhibit 1019 is redacted deposition transcript of

¹ “Checkpoint Friendly Laptop Bag,” Transportation Security Administration Request for Information, March 3, 2008 (Ex. 1003).

Mr. Todd Gormick, a named inventor of the '578 patent, taken during the course of district court litigation between Patent Owner and Victorinox Swiss Army, Inc. *Id.* at 8. Petitioner asserts that the deposition transcript “shows Mr. Gormick’s admission that he and Patent Owner were aware that the TSA RFI was published and publicly available prior to the March 13, 2008[,] priority date of the '578 Patent.” *Id.* Petitioner asserts that each of the New Exhibits is “relevant to establishing that the RFI issued by the TSA was published and publicly available well prior to the '578 Patent’s earliest priority date of March 13, 2008,” and, therefore is relevant to this proceeding. *Id.* at 9.

B. Patent Owner’s Contentions

Patent Owner argues that none of the New Exhibits “establish[es] the public accessibility of the TSA RFI reference.” Opp. 1 (citing Paper 24, 2; Ex. 1020, 1). Patent Owner argues that “Exhibit 1003 itself indicates that it was modified over time” and that “[t]he version of the document Petitioner submitted does not support Petitioner’s theory that it was publicly accessible on March 3, 2008.” *Id.* at 3. Patent Owner argues that the New Exhibits likewise fail to show “that the document submitted as Exhibit 1003 was itself publicly accessible on the www.fbo.gov website on March 3, 2008.” *Id.* Patent Owner argues that none of Exhibits 1015–1018 specifically identifies TSA RFI or establishes when the reference was posted on a government website. *Id.* at 4. Patent Owner argues that, in the testimony of Exhibit 1019 cited by Petitioner, Mr. Gormick states that “a ‘document c[a]me out’ on March 4, 2008,” but he “does not indicate what version of the TSA RFI he recalled or establish that the document submitted as

Exhibit 1003 was publicly accessible.” *Id.* at 5 (alteration in original) (citing Ex. 1019, 145–47). Patent Owner argues that Petitioner’s reference in the Motion to the contents of TSA RFI, rather than TSA RFI itself, constitutes a new theory of unpatentability that is not consistent with the arguments set forth in the Petition and instituted in the Institution Decision (Paper 21). *Id.* at 6–7.

C. Analysis

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for authorization to file such motion is made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which trial has been instituted.

With respect to the first requirement of § 42.123(a), trial was instituted in this proceeding on July 9, 2021. Paper 22. Therefore, because Petitioner requested authorization to file a motion to submit supplemental information on August 4, 2021 (*see* Ex. 1020), Petitioner’s request was made within one month of the date the trial was instituted.

With respect to the second requirement of § 42.123(a), information is relevant if “it has any tendency to make a fact more or less probable than it would be without the evidence” and “the fact is of consequence in determining the action.” Fed. R. Evid. 401; *see also* 37 C.F.R. § 42.62 (“Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.”). Exhibits 1015 and 1016 appear to

reference or quote from TSA RFI, and thus appear to be relevant to the public availability of TSA RFI. *See, e.g.*, Ex. 1015, 5 (summarizing the performance criteria and high-level design concepts set forth in TSA RFI); Ex. 1016, 4 (summarizing the performance criteria and high-level design concepts set forth in TSA RFI). Exhibits 1017 and 1018 also appear to reference TSA RFI, and thus appear to be relevant to its public availability. *See, e.g.*, Ex. 1017, 5 (referencing a “‘checkpoint-friendly’ case,” a design that “unfolds like a book, with a laptop on one side and gear on the other side,” and the solicitation of prototypes; quoting TSA Technology Chief Mike Golden); Ex. 1018, 2 (same). In Exhibit 1019, Mr. Gormick discusses a “Transportation Security Administration[] RFI” that he saw on “March 4th, 2008.” Ex. 1019, 145, 147. Thus, Exhibit 1019 appears to be relevant to the public availability of TSA RFI. In the Institution Decision, we determined that Petitioner had set forth a reasonable likelihood of prevailing on its assertion that independent claims 17, 21, 22, 28, 42, 50, and 57 would have been obvious based on the combination of TSA RFI, Moor, Hollingsworth, and Miller. Paper 21, 33–41. Thus, the public availability of TSA RFI, and how such availability affects its qualification as a prior art reference, is relevant to a claim for which trial has been instituted.

We do not agree that Petitioner’s reference to the contents of TSA RFI changes the grounds of unpatentability asserted in the Petition. *See* Opp. 6–7. As explained above, the New Exhibits appear to reference TSA RFI, and thus appear to establish that TSA RFI was publicly available on a website that was well known to the community interested in the subject matter of the reference.

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