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Paper 14
Entered: November 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00343
Patent 9,300,432 B2

Before SHARON FENICK, STEVEN M. AMUNDSON, and STEPHEN E. BELISLE, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER

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

Apple Inc. ("Petitioner") filed a petition for *inter partes* review challenging claims 1–18 ("challenged claims") of U.S. Patent 9,300,432 B2 (Ex. 1001 ("'432 patent")). Paper 2 ("Pet." or "Petition"). Petitioner relied on a declaration of Dr. R. Michael Buehrer (Ex. 1003). *See, e.g.*, Pet. 11 (citing Ex. 1003 ¶¶ 63–68), 14–16 (citing Ex. 1003 ¶¶ 76–84). Telefonaktiebolaget LM Ericsson ("Patent Owner") did not file a preliminary response.

In our Institution Decision, we identified an ambiguity relating to the claim term "radio channel," and noted that "the parties are encouraged to examine this issue and determine whether to submit evidence and argument regarding this term." Paper 6 (Institution Decision or "Dec. on Inst."), 14, 17–18.

Petitioner requested and was granted authorization to file a motion to submit supplemental information in the form of a supplemental declaration of Dr. Buehrer which "would offer discussion of the term 'radio channel' and an explanation of how channels such as CPICH [common pilot channel] and HS-DSCH [high speed downlink shared channel], which are referenced in the petition . . . are interrelated." Ex. 3001 (Oct. 13, 2022 email from Petitioner); Paper 8 (granting authorization). Patent Owner opposed Petitioner's request and was granted authorization to file an opposition. Paper 8. Petitioner filed its Motion to Submit Supplemental Information, Paper 9 ("Motion" or "Mot."), along with the supplemental information it desires to submit: a supplemental declaration of Dr. Buehrer (Exhibit 1020) and materials cited therein (Exhibits 1021–1028). Patent Owner filed a

Response in Opposition to Petitioner's Motion. Paper 12 ("Opposition" or "Opp.").

The supplemental information, submitted as Ex. 1020, purports to "include[] supplemental testimony regarding how certain features recited in claims 1, 11, and 15 of the '432 patent would be understood by a POSITA in view of the '432 patent and in the context of the prior art combinations relied upon in the Petition and in Dr. Buehrer's original declaration." Mot. 1.

Upon consideration of the documents and the parties' arguments, and for the reasons stated below, Petitioner's motion is granted.

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 is 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 September 13, 2022. Petitioner requested authorization to file a motion to submit supplemental information on October 13, 2022, and thus, 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), the supplemental information Petitioner seeks to admit appears to be relevant to the grounds of unpatentability it asserted for claims 1–5 and

11–18. While we preliminarily noted an issue with respect to Petitioner's arguments with respect to these claims (*see, e.g.*, Dec. on Inst. 17) we instituted trial on the basis of claims 6–10. Dec. on Inst. 15–26; *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting 35 U.S.C. § 314 as requiring "a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition").

Petitioner argues that its supplemental information does not change the grounds of unpatentability authorized in the proceeding or seek to rely on new prior art or uncited portions of relied-on prior art, but only "clarifies how a POSITA would have understood the term 'radio channel' and how the recitation of this term is rendered obvious by the description of and reference to the interrelated logical channels, CPICH and HS-DSCH, in the Petition and in [Dr. Buehrer's original declaration]." Mot. 4–5. Petitioner further argues that "Patent Owner stands to benefit in being able to address the testimony provided" in its Patent Owner Response. *Id.*

Patent Owner argues that Petitioner is attempting to cure inconsistencies in its prior art mapping. Opp. 1. Patent Owner further argues that merely meeting the requirements of § 42.123(a) could not justify a grant of leave to supplement, because were we to grant all supplements, word constraints would be meaningless, as parties could freely supplement with any relevant information. *Id.* at 2. Patent Owner argues that Petitioner could file this supplemental declaration with the Reply, and that the declaration exceeds the issue we identified in our Institution Decision and attempts to cure deficiencies in the Petition. *Id.* at 1–5. Patent Owner argues that the supplemental information unfairly prejudices Patent Owner's

ability to prepare a responsive filing because of its volume, and because Patent Owner must respond within the word constraints for its responsive filing. *Id.* at 4–5.

Patent Owner's arguments are not persuasive. Petitioner does not, in this supplement, circumvent page limits for the Petition and Reply; our rules prohibit incorporation by reference, so if the evidence submitted is not explained in the Reply, it may not be considered. 37 C.F.R. § 42.6(a)(3); *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 10 (PTAB Aug. 29, 2014) (informative). Additionally, we do not at present discern where a new rationale has been raised or evidence provided which would only support such a new rationale in the submission. To the extent that this supplemental information is used to raise a new issue in Reply, Patent Owner can move to strike the brief or the improper parts of it. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide, 80–81 (Nov. 2019) ("CTPG") (available at www.uspto.gov/TrialPracticeGuideConsolidated).

Patent Owner argues that the motion should be denied because Petitioner "does not even attempt to explain its failure to include this [supplemental] information in its Petition." Opp. 1 (citing *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015). In *Redline Detection*, however, the Federal Circuit ruled that whether supplemental information reasonably could not have been submitted with the petition is a factor that may be considered in evaluating a motion to submit the supplemental information; this does not stand for the proposition that a petitioner filing a motion under § 42.123(a) must demonstrate the supplemental information could not have been submitted with the petition as

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