

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CQV CO., LTD.,
Petitioner,

v.

MERCK PATENT GMBH,
Patent Owner.

PGR2021-00054
Patent 10,647,861 B2

Before ERICA A. FRANKLIN, JO-ANNE M. KOKOSKI, and
JON B. TORNQUIST, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.223(a)

I. INTRODUCTION

With our authorization, CQV Co., Ltd. (“Petitioner”) filed a motion to submit supplemental information in the form of a test report characterizing an additional property of previously tested Xirallic[®] product samples, and two declarations, wherein one addresses those results, and the other attests to the chain of custody for the samples tested. Paper 11 (“Mot.”). Merck Patent GMBH (“Patent Owner”) filed an opposition to the motion. Paper 12 (“Mot. Opp.”).

II. DISCUSSION

Under 37 C.F.R. § 42.223(a), a party may file a motion to submit supplemental information if: (1) the request for authorization to file the 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. As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief in its motion. 37 C.F.R. § 42.20(c).

Based upon our review, we find that Petitioner’s request for authorization to file the motion was timely, as it was submitted within one month of the institution decision.

Additionally, we find that the supplemental information which Petitioner seeks to submit is relevant to a claim for which trial has been instituted. Petitioner explains that it seeks to submit three documents. Mot. 1. The first submission would be a test report authored by Professor Kyeong Youl Jung detailing the results of the x-ray powder diffraction tests on the commercially available Xirallic[®] product samples, identified as samples A, B, D, and H in the Petition and in the Declaration and Experimental Report of Seunghoon Mo, submitted with the Petition. *Id.* Petitioner explains that because those samples were not subjected to acid

treatment to remove the metal oxide layers from the alumina flakes, they are “in the condition as sold by Merck KGaA.” *Id.* at 1–2. Petitioner asserts that the results of the x-ray powder diffraction tests will be relevant to the α - Al_2O_3 structure of the Xirallic[®] product samples. *Id.* at 2. The second submission would be a declaration from Professor Jung addressing the authenticity and reliability of his test report. *Id.* The third submission would be a declaration from Mr. Byung-Ki Choi of CQV addressing only the chain of custody of the tested samples from CQV to Professor Jung. *Id.* Because the supplemental information may confirm the α -alumina structure of the Xirallic[®] flakes previously characterized and relied upon by Petitioner, and such structure is required by the challenged claims, we find that the requested supplemental information is relevant to a claim for which institution has been granted.

Thus, Petitioner has met the timing and relevancy requirements for its motion to submit supplemental information under 37 C.F.R. § 42.223(a).

Next, we consider whether Petitioner has met its burden under 37 C.F.R. § 42.20(c) to show that the motion should be granted. In doing so, we consider whether the request is in line with the principle that guides our determination, i.e., “to ensure the efficient administration of the Office and the ability of the Office to complete . . . proceedings in a timely manner,” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015); *see also* 35 U.S.C. §316(b); 37 C.F.R. §42.1(b).

Petitioner asserts that “the proposed supplemental evidence does not change any of the evidence initially presented in the Petition. Rather, the proposed supplemental information is additional evidence that Xirallic[®] that was publicly available prior to the effective filing date comprised α - Al_2O_3 .”
Mot. 5.

Petitioner asserts also that the supplemental information will not prejudice Patent Owner or delay the proceedings. In support of that assertion, Petitioner explains that Professor Jung's test report is limited to "a single type of test (x-ray powder diffraction) to evaluate a single feature of the Xirallic[®] samples (α -Al₂O₃ structure)." *Id.* at 6. Petitioner asserts that any deposition of Professor Jung will, therefore, be limited to the narrow scope of his test report and declaration. *Id.* Additionally, Petitioner asserts that Mr. Choi has already submitted a declaration in this proceeding and has not yet been deposed, so his supplemental declaration will not require an additional deposition. *Id.*

Finally, Petitioner contends that Dr. Jung's test results are appropriate under the circumstances because Petitioner could not have reasonably expected Patent Owner to dispute the evidence that Petitioner relies upon in the Petition to demonstrate that Xirallic[®] pigments are based on α -Al₂O₃ flakes, i.e., a disclosure in the '861 patent and a disclosure in the cited prior art, Pfaff. *Id.* at 6–7 (citing Pet. 42; Ex. 1001, 1:10–12; Ex. 1034, 72). Petitioner asserts that, although not required to support its timely motion, "the proposed supplemental information is in the interest of justice because the information is intended to confirm an admission in the disclosure of the '861 patent, on which the public is entitled to rely." *Id.* at 7.

Patent Owner asserts that Petitioner's motion should be denied because it is allegedly based on improper gamesmanship as it seeks to bolster deficiencies in the Petition identified by Patent Owner, and exemplifies a "wait-and-see" opportunity to supplement the Petition after such arguments have been made by Patent Owner. Mot. Opp. 5–6. In particular, Patent Owner asserts also that although Petitioner "obtained and tested many properties of the Xirallic[®] samples prior to filing its petition, . . .

Petitioner has not explained why it failed to test whether the samples included ‘ α -alumina flakes,’ nor provided any reason such testing could not have been performed and submitted with the Petition.” *Id.* at 6.

Additionally, Patent Owner asserts that the proposed supplemental information “would substantially, and improperly, change the evidence relied on by Petitioner.” *Id.* at 7. According to Patent Owner, “[u]nlike information to shore up publication of a document . . . the new evidence [here] bears no relation to the ’861 patent or the Pfaff article[s] themselves.” *Id.* According to Patent Owner, “neither the ’861 patent nor the Pfaff article discuss the specific pigment products (T50-10, F60-50SW, and F60-51SW) within the Xirallic[®] product line that Petitioner now proposes testing.” *Id.* Further, Patent Owner asserts that the proposed supplemental information is a different type of evidence than what the Petition relied upon. *Id.*

Patent Owner contends also that Petitioner’s motion should be denied because “receiving such new, complex, and potentially voluminous testing and declarations on a central issue of the proceeding within weeks of Merck’s Response deadline is highly burdensome and prejudicial to Merck.” *Id.* at 9. Additionally, Patent Owner asserts that “Petitioner’s requests runs counter to the PTAB’s goal of securing the just, speedy, and inexpensive resolution of this proceeding, and should be denied.” *Id.* at 10.

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. Specifically, as discussed in our Institution Decision, Petitioner has shown, sufficiently for institution, that “a person of ordinary skill in the art would have understood that, prior to the

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