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Paper 17
Entered: July 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

ADVANCED MICRO DEVICES, INC.,
Patent Owner.

Case IPR2015-00324
Patent 6,895,520 B1

Before JONI Y. CHANG, BRIAN J. McNAMARA, and RAMA G. ELLURU, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

ORDER
Denying Petitioner's Request for Authorization to File
a Motion to Submit Supplemental Information
37 C.F.R. § 42.123

On June 15, 2015, we instituted the instant *inter partes* review as to claims 16–18 and 20–23 of U.S. Patent No. 6,895,520 B1. Paper 13 ("Dec."). One of the instituted grounds of unpatentability is based, in part, on ACPIS.[1] Dec. 23. On July 17, 2015, more than one month after the institution date, a conference call was held among respective counsel for the parties, and Judges Chang, McNamara, and Elluru. During the conference call, Petitioner requested the authorization to file a motion to submit supplemental information—namely, evidence that purportedly confirms the public accessibility of ACPIS. For the reasons discussed below, Petitioner's request is *denied*.

A request for authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) is required to be made within *one month* of the date for which the trial has been instituted. Petitioner contends that it timely made its request within one month in an e-mail to the Board's administrative staff, requesting a conference call with the Panel. As an initial matter, we do not agree that *a request for a conference call*, itself, constitutes a request for authorization for filing a motion to submit supplemental information under 37 C.F.R. § 42.123(a). *See VTech Telecomm., Ltd. v. Spherix Inc.*, Case IPR2014-01432, slip op. 2 (PTAB Mar. 3, 2015) (Paper 14).

In any event, even if the Petitioner's request was made timely, nothing in 37 C.F.R. § 42.123(a) suggests that a request to submit supplemental

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[1] ADVANCED CONFIGURATION AND POWER INTERFACE SPECIFICATION, INTEL MICROSOFT, TOSHIBA, Rev. 1.0b (Feb. 2, 1999) (Ex. 1006, "ACPIS").

information, if made within one month from institution, automatically would be granted no matter the circumstance. Here, Petitioner did not provide a persuasive explanation as to why submitting evidence that purportedly confirms the public accessibility of ACPIS is warranted at this juncture.

During the conference call, Petitioner alleged that the evidence was obtained in response to an objection made by Patent Owner regarding the *public accessibility* of ACPIS. Petitioner argued that the submission of such evidence, as supplemental information, is appropriate.

Patent Owner countered that it did not make such an objection. More specifically, Patent Owner indicated that it did not challenge the *public accessibility* of ACPIS in its Preliminary Response (Paper 12). Rather, Patent Owner asserted that its Objection[2] (Paper 16) merely challenges the *admissibility* of ACPIS.

Indeed, the present record before us shows that, notwithstanding Petitioner's assertion in its Petition—ACPIS "qualifies as prior art under 35 U.S.C. § 103(a) because [it] was published on February 2, 1999 before the '520 Patent's March 2, 2001 filing date" (Paper 2, 9)—Patent Owner did not contest the prior art status of ACPIS in its Preliminary Response (Paper 12). Notably, Patent Owner's Objection indicates that "Patent Owner objects to

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[2] Patent Owner indicated that it timely *served* its Objection, but inadvertently failed to *file* the Objection within ten business days after institution, as required by 37 C.F.R. § 42.64. *See* Amendment to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,565 (Final Rule) (Effective Date: May 19, 2015). During the conference call, we authorized Patent Owner to file the Objection so that we would have sufficient information to resolve Petitioner's request.

[the] contents [of ACPIS] as inadmissible hearsay" and "objects to this document as not properly authenticated," under the Federal Rules of Evidence (Paper 16, 2–3). Nothing in this record shows that Patent Owner challenges the *public accessibility* of ACPIS, as alleged by Petitioner.

Petitioner's reliance on *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, Case IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 37) is misplaced. In that case, the Patent Owner contested, in the Preliminary Response, the prior art status of the references that served as the basis of the instituted grounds of unpatentability, challenging the *public accessibility* of the references. *Palo Alto Networks*, Case IPR2013-00369, slip op. 7–11, 25–28 (Paper 13). Here, in contrast, Patent Owner has not raised such a challenge in the instant proceeding. Petitioner conflated two different challenges: (1) the *admissibility* of evidence (e.g., authenticity or hearsay), which requires the objecting party to file an objection to evidence under 37 C.F.R. § 42.64(b); and (2) the *sufficiency* of evidence to prove a particular fact (e.g., whether the evidence is sufficient to demonstrate that a reference is a printed publication under § 102(b)). *See Groupon, Inc. v. Blue Calypso, LLC*, Case CBM2013-00033, slip op. 3–4 (PTAB May 12, 2014) (Paper 29); *Bloomberg Inc. v. Markets-Alert Pty. Ltd.*, Case CBM2013-00005, slip op. 5 (PTAB Nov. 15, 2013) (Paper 56); *see also Valeo North America, Inc. v. Magna Electronics, Inc.*, Case IPR2014-00220, slip op. 10–11 (PTAB May 28, 2015) (Paper 59) (Arguing that a reference is not prior art under § 102(b), as it was not publicly accessible, is a challenge to the *sufficiency* or weight to be given to the reference.).

Petitioner also did not explain why the evidence that purportedly confirms the public accessibility of ACPIS could not be filed later as supporting evidence to its reply, should Patent Owner argue, in the response, that ACPIS is not a prior art printed publication under § 102. Furthermore, supplemental evidence is not necessary to be filed at this time because the admissibility objection may be overcome by the evidence. If Patent Owner continues to object to the admissibility of ACPIS and subsequently files a motion to exclude ACPIS, Petitioner may file the previously-served *supplemental evidence* as supporting evidence to its Opposition.

For the foregoing reasons, we do not discern, at this juncture of the proceeding, a sufficient basis for authorizing Petitioner to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a).

Accordingly, it is

ORDERED that Petitioner's request for authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) is *denied*; and

FURTHER ORDERED that Patent Owner is authorized to file the Objection that was served on Petitioner previously regarding ACPIS.

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