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Paper 17
Entered: June 17, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMAN, LLC,
Petitioner,

v.

KARYA PROPERTY MANAGEMENT, LLC,
Patent Owner.

CBM2020-00020
Patent 7,636,687 B2

Before MEREDITH C. PETRAVICK, SUSAN L. C. MITCHELL, and FRANCES L. IPPOLITO, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

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

On March 17, 2021, we instituted a covered business method patent review of claims 1–21 of U.S. Patent No. 7,636,687 B2 ("the '687 patent). *Resman, LLC v. Karya Prop. Mgmt., LLC*, CBM2020-00020, Paper 9, 35 (PTAB March 17, 2021). In our decision, we noted the following about an asserted reference, Broerman.[1]

> Patent Owner correctly notes that a reference that qualifies as prior art under 35 U.S.C. § 102(e) may not be used to support a challenge in a covered business method patent review. *See, e.g.*, *Meridianlink, Inc. v. DH Holdings, LLC*, CBM2013-00008, Paper 24, 2 (PTAB Sept. 12, 2013); *eBay, Inc. v. Advanced Auctions LLC*, CBM 2014-00047, Paper 15, 12 (PTAB June 25, 2014). It appears that Broerman is not available as a prior art reference to be asserted against the claims of the '687 patent. We invite the parties to address further this issue during trial.

Resman, Paper 9, 34.

Petitioner sought authorization for a motion to file supplemental information to provide support for the public accessibility and commercial availability of the subject matter that Broerman discloses. On April 20, 2021, we convened a conference call with the parties and Judges Mitchell, Petravick, and Ippolito to determine if such authorization would be appropriate.

During the call, Petitioner described the supplemental information as web pages, newspaper articles, and declaratory evidence to establish that the substance of Broerman's disclosure was known to the public and commercially available in a time frame to attempt to establish Broerman as section 102(a) art.

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[11] Vincent S. Broerman, U.S. Patent No. 6,594,633 B1, issued Jul. 15, 2003 (Ex. 1011, "Broerman").

Petitioner has the initial burden of production to establish that there is prior art that renders the claims unpatentable. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, No. 2015-01214, 2015 WL 5166366, at *4 (Fed. Cir. Sept. 4, 2015). To satisfy this initial burden, we often have required Petitioner to come forward with sufficient evidence to make a threshold showing, at the institution stage, that the reference relied upon is available prior art. *See, e.g.*, *Coalition For Affordable Drugs (ADROCA) LLC v. Acorda Therapeutics, Inc.*, IPR2015-00720, slip op. at 3–5 (PTAB Aug. 24, 2015) (Paper 15); *Symantec Corp. v. Trs. of Columbia Univ.*, IPR2015-00371, slip op. at 5–9 (PTAB June 17, 2015); *Temporal Power, Ltd. v. Beacon Power, LLC*, IPR2015-00146, slip op. at 8–11 (PTAB Apr. 27, 2015) (Paper 10); *Dell, Inc. v. Selene Comm'n Techs., LLC*, IPR2014-01411, slip op. at 21–22 (PTAB Feb. 26, 2015) (Paper 23). As set forth above, we stated in our institution decision that Petitioner had shown only that Broerman qualifies as section 102(e) art. *See Resman*, Paper 9, 34. We understand Petitioner's argument concerning its request to submit supplemental evidence not to show that the Broerman patent itself was available and qualifies as section 102(a) art, but that the *disclosure* in the Broerman patent was so available to the interested public.

As Patent Owner noted, however, in the ground involving Broerman, a United States patent, Petitioner made no mention or any assertion as to the additional evidence that Petitioner now seeks to present as supplemental evidence. To the extent that Petitioner is seeking to have the Broerman patent itself serve as a section 102(a) reference, the supplemental information that Petitioner seeks to file is irrelevant to Broerman's prior art status under section 102. The additional web pages, newspaper articles, and

declaratory evidence would be additional pieces of art that are not part of any ground presented in the Petition, and would do nothing to support the Broerman reference itself as qualifying for any publication date for public availability other than publication dates that are set forth on the Broerman reference itself. *Compare* 35 U.S.C. § 102(e) (referring to publication date of patent application or patent grant), *with* 35 U.S.C. § 102(a) (stating "invention was known or used by others in this country").

The key inquiry to determining under which statutory section under 35 U.S.C. § 102 Broerman fits, however, is whether the *reference* was made "sufficiently accessible to the public interested in the art" before the critical date. *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989). "A given reference is 'publicly accessible' upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it." *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)). Petitioner is not requesting authorization to submit supplemental evidence that supports earlier public availability of the Broerman patent, but only its disclosed subject matter. As discussed above, this we find is not an appropriate use of supplemental evidence.

As we have stated, "[t]he opportunity to submit additional evidence does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 15 (PTAB Dec. 20, 2019) (Precedential) (citing *Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016)). In its Petition, Petitioner states

that the Broerman patent, "filed July 7, 1999, issued July 15, 2003, is prior art under at least § 102(e) (pre-AIA)." Pet. 27. Petitioner does not seek to offer evidence to support any public accessibility of the patent before these dates, but seeks to establish that the subject matter of the Broerman patent was publicly available prior to these dates using other independent references such as web pages, newspaper articles, and a declaration showing the public availability of a commercial embodiment of the subject matter of the Broerman patent. This constitutes a new theory of unpatentability based on these additional references that Petitioner seeks to offer, which is not an appropriate use of supplemental information.

It is

ORDERED that Petitioner's request for authorization to file a motion for supplemental information is *denied*.

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