

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CYANOTECH CORPORATION  
Petitioner

v.

THE BOARD OF TRUSTEES OF THE UNIVERSITY OF ILLINOIS  
Patent Owner

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Case IPR2013-00401  
Patent 5,527,533

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Before SCOTT E. KAMHOLZ, SHERIDAN K. SNEDDEN, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

DECISION

On Patent Owner's Motion to Submit Supplemental Information  
*37 C.F.R. §§ 42.123(b)*

We authorized Patent Owner to file a motion to submit supplemental information, and we authorized Petitioner to file an opposition. Paper 38. Patent Owner has filed its motion (Paper 39), and Petitioner has filed its opposition (Paper 40). For the reasons given below, Patent Owner's motion is *granted*.

Under 37 C.F.R. § 42.123(b), a motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests of justice. As stated in 37 C.F.R. § 42.1(b), trial rules are construed to secure the just, speedy, and inexpensive resolution of every proceeding.

Patent Owner seeks to submit two supplemental documents—a pair of emails with attachments containing statements by Petitioner related to the reliability of spectrophotometric analysis for determining the presence of astaxanthin. Paper 39, 2–3. Patent Owner directs our attention to the following statements made in the email attachments:

- (1) “The problem with the Spectrophotometric assay method is that, in addition to astaxanthin, other carotenoids such as lutein, canthaxanthin, and beta carotene are falsely included as astaxanthin in the results. Of even greater concern, chlorophyll and degradation products of astaxanthin without health benefits (such as astacene) will also be falsely included as asxatanthin in the results. . . . Purchasing astaxanthin from a supplier that uses Spectrophotometric analysis means that you can't be sure if your astaxanthin is really astaxanthin.” *Id.*, Ex. A at RA015049–49.
- (2) “The only valid way to accurately measure astaxanthin is the HPLC method used by Cyanotech.” *Id.*, Ex. A at RA015049–49.
- (3) “[A] UV spectrophotometric analysis [ ] can falsely include other

carotenoids and even chlorophyll and astacene (a breakdown bi-product of astaxanthin that has no health benefits) as astaxanthin.” *Id.*, Ex. B at RA023192–95.

Patent Owner contends that the information could not have been reasonably obtained earlier because the two documents at issue were part of a production consisting of over 100,000 pages. *Id.*, 3–4. Patent Owner further contends that consideration of the supplemental information would be in the interests of justice, because the information includes Petitioner’s own statements concerning issues under consideration in this *inter partes* review. *Id.*, 1.

Petitioner argues that the documents in question had been produced to Patent Owner several months before Patent Owner filed its Response, and that Patent Owner’s failure to submit them with the Response is no more than attorney negligence. Paper 40, 1–3. Petitioner argues it will suffer prejudice in that Petitioner’s time to prepare for the deposition of Patent Owner’s witness was reduced by two-thirds and its time to locate a rebuttal expert and to prepare its Reply have been reduced by half. *Id.*, 3. Petitioner also argues that Patent Owner’s scientific argument is baseless. *Id.*, 3–4.

Upon consideration of the documents and the parties’ arguments, we conclude that the interests of justice are served by permitting entry of the supplemental information. The documents are Petitioner’s own statements and relate directly to an argument Patent Owner has advanced in its Response: whether Grangaud correctly identified the substance he administered as being astaxanthin. Paper 32, 2. We deem any prejudice to Petitioner to be negligible. Petitioner will have an opportunity to cross-examine Patent Owner’s witnesses about the supplemental documents and may introduce direct testimonial evidence with its Reply that is responsive to the supplemental documents.

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For these reasons, it is

ORDERED that Patent Owner's motion to submit supplemental information is *granted*; and

FURTHER ORDERED that Patent Owner shall file the two supplemental documents as separate, numbered exhibits.

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