

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION
Petitioner

v.

DESTINATION MATERNITY CORPORATION
Patent Owner

Case No. IPR2013-00532
(U.S. Patent No. RE43,531)

Dated: May 29, 2014

Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
MITCHELL G. WEATHERLY *Administrative Patent Judges*.

**PATENT OWNER'S MOTION TO FILE SUPPLEMENTAL
INFORMATION UNDER 37 C.F.R. § 42.123(b)**

Pursuant to 37 C.F.R. § 42.123(b) and the Board's May 28, 2014 Order, Patent Owner Destination Maternity Corporation ("Patent Owner") hereby moves to file exhibits related to its Patent Owner's Response to Corrected Petition for *Inter Partes* Review of U.S. Patent No. RE43,531 ("Response").¹ (Paper Nos. 23-24, May 5, 2014). The exhibits were either unintentionally not filed contemporaneously with the Response, or attached to declarations rather than filed as exhibits.

The exhibits that Patent Owner seeks to file are the following: (a) five publicly available patents, three of which were exhibits in the April 24, 2014 deposition of Petitioner Target Corporation's ("Petitioner") expert (Exhibit Nos. 2030-34); (b) five publicly available 10K reports of Patent Owner (Exhibit Nos. 2038-42)²; (c) seven documents produced in the underlying litigation (Exhibit Nos. 2043-49); (d) five publicly available websites (Exhibit Nos. 2050-53, 2083); (e) four confidential Patent Owner spreadsheets not previously produced to

¹ Patent Owner further requests permission to file a motion to seal, should the Board grant this Motion.

² The gaps in exhibit numbers are for exhibits filed only in related proceedings and served exhibits that Patent Owner does not seek to file, such as supplemental expert declarations, which include cites to the new exhibit numbers and some additional language in response to Petitioner's evidentiary objections.

Petitioner also exhibited as redacted (Exhibit Nos. 2056-63); (f) figures, tables, pictures, and exhibits from expert declarations, which were included in Patent Owner's original filing (Exhibit Nos. 2064-73, 2075-80); (g) Patent Owner's publicly available Complaint against Petitioner in the underlying litigation (Exhibit No. 2081); and (h) publicly available MPEP § 2111.01 (Exhibit No. 2084).

The unfiled exhibits reasonably could not have been obtained earlier because of a clerical error of not including the exhibits in the filing and attaching exhibits to declarations rather than filing them separately. And it is in the interests of justice to consider the supplemental information, which was already served on Petitioner on May 23, 2014, was generally either publicly available or already in Petitioner's possession in connection with Patent Owner's Response, or underlying District Court litigation, does not give rise to any new arguments, will avoid future administrative issues, and will not affect the trial schedule or prejudice Petitioner.

I. The supplemental information reasonably could not have been obtained earlier

The unfiled exhibits reasonably could not have been obtained earlier because of a clerical error of not including the exhibits in the filing and attaching exhibits to declarations rather than filing them separately. On May 5, 2014, Patent Owner filed its Response unintentionally excluding certain documents as exhibits.

(Paper Nos. 23-24). On May 12, 2014, Petitioner served objections to evidence pursuant to 37 C.F.R. § 42.64(b)(1). Petitioner's objections included "37 C.F.R. § 42.63 et seq. (not evidence in these proceedings before the PTAB; purported evidence not filed as an exhibit)" for almost 50 paragraphs of Patent Owner's expert declarations, the attachments to Patent Owner's expert declarations, and generally for Patent Owner's Response.

On May 16, 2014, after reviewing Petitioner's objections and attempting to identify the missing exhibits, Patent Owner contacted Petitioner to give notice that Patent Owner would request permission to file the documents as exhibits. Between May 16, 2014 and May 20, 2014, Patent Owner communicated with Petitioner in an attempt to reach agreement on the filing, but the parties came to an impasse. On May 23, 2014, the parties discussed the issue with the Board, which precipitated this filing. That same day, Patent Owner served supplemental information on Petitioner pursuant to 37 C.F.R. § 42.64(b)(2), which included the exhibits at issue.

It has been considered sufficient to submit supplemental information as a result of a prior oversight with a showing that consideration of the supplemental information would be in the interests of justice. *See* IPR2013-00191, Paper No. 39, at 4 (granting a motion to submit supplemental information for an oversight in citing to the wrong patent given "the minor impact on the trial schedule, Patent

Owner's assertion that the two references are similar substantively, as well as Petitioners' expert was not cross-examined yet and Patent Owner has the opportunity to cross-examine on the supplemental information"); IPR2013-00401, Paper No. 41, at 3 (granting motion to submit supplemental information when the movant possessed the information for several months before a filing because "the interests of justice are served by permitting entry of the supplemental information" and prejudice to the respondent was negligible). Here, it is in the interests of justice to consider the supplemental information as shown below.

II. Consideration of the supplemental information would be in the interests of justice

It is in the interests of justice to consider the supplemental information because (1) the supplemental information was already served on Petitioner on May 23, 2014 pursuant to 37 C.F.R. § 42.64(b)(2); (2) almost all of the supplemental information was either publicly available, already produced to Petitioner in connection with Patent Owner's Response, or produced to Petitioner in the underlying District Court litigation; (3) Petitioner never requested copies of the information; (4) the proposed supplemental information does not give rise to any new arguments; to the contrary, it offers support to Patent Owner's already-filed argument; (5) filing the exhibits will avoid potential administrative issues such as any future exhibit numbering, and use of exhibits during depositions and in future filings such as Petitioner's Reply to Patent Owner Response to Petition;

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