

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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TARGET CORPORATION  
Petitioner

v.

DESTINATION MATERNITY CORPORATION  
Patent Owner

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Case IPR2013-00533  
Patent No. RE43,531

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

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

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## **I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED**

Pursuant to the Board’s May 28, 2014 Order, Petitioner, Target Corporation (“Target” or “Petitioner”), hereby responds to Patent Owner, Destination Maternity Corporation’s (“DMC” or “Patent Owner”), Motion to File Supplemental Information Under 37 C.F.R. § 42.123(b) (the “Motion”).

DMC has not met the standard for late submission of supplemental information under 37 C.F.R. § 42.123(b). DMC fails to show why it reasonably could not have earlier obtained the documents in question, which are listed on pages 2–3 of the Motion (collectively, the “Unfiled Documents”). Indeed, DMC admits that it *had possession* of those documents when they were due to be filed but simply failed to file them due to a purported “clerical error” for which DMC does not provide any evidentiary support. Permitting late submissions of evidence under the circumstances presented here would not be in the interests-of-justice and would set a troublesome precedent in other proceedings before the Board. Accordingly, Target respectfully requests that the Board deny DMC’s Motion.<sup>1</sup>

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<sup>1</sup> Subject to the Board’s approval, pursuant to 37 C.F.R. § 42.6(d), Target does not oppose DMC being permitted to file and serve any exhibits that are merely duplicative of exhibits Target previously filed and served in this proceeding; specifically, DMC’s proposed exhibit numbers 2035, 2036, and 2037. Further,

## II. COUNTER STATEMENT OF MATERIAL FACTS

1. Target disputes DMC’s assertions that the Unfiled Documents: (a) “were either unintentionally not filed [as exhibits] contemporaneously with the [Patent Owner’s] Response, or attached to declarations rather than filed as exhibits,” (Mot. 2), and (b) “reasonably could not have been obtained earlier because of a clerical error,” (*id.* at 3; *see also id.* at 3–5).

2. The Unfiled Documents are “related to . . . Patent Owner’s Response” and should have been “filed contemporaneously with [it].” (*Id.* at 2, 3, 7.)

3. DMC variously cited the Unfiled Documents—though not by exhibit numbers—within its Patent Owner’s Response and other papers filed with it. (*See id.* at 7; *see also* Paper 25 (Response), Ex. 2017 (Brookstein Decl.), Ex. 2022 (Green Decl.).)

4. DMC possessed the Unfiled Documents no later than, and, in view of the previous sentence, likely before, its May 5, 2014 Response deadline.

## III. LEGAL STANDARDS AND APPLICABLE RULES

A motion to submit supplemental information “must show” **both** (1) “why the supplemental information reasonably could not have been obtained earlier,” **and** (2) “that consideration of the supplemental information would be in the

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to the extent that the Board grants any aspect of the Motion, Target does not oppose DMC’s request to file a motion to seal, (*see* Mot. 2 n.1), as appropriate.

interests-of-justice.” 37 C.F.R. § 42.123(b). Rule 42.123(b)’s use of the word “and” to connect its two elements means that meeting the standard under the rule requires a showing of “not one [element] or the other, but both.” *Crooks v. Harrelson*, 282 U.S. 55, 58 (1930) (holding that the word “and” in its “ordinary sense” is a conjunctive word, requiring “not one or the other, but both”); *City of Rome v. United States*, 446 U.S. 156, 172 (1980) (holding that by using “and” to describe “the elements of discriminatory purpose and effect in the conjunctive, Congress plainly intended that a voting practice not be precleared unless *both* discriminatory purpose and effect are absent” (emphasis in original)).

The trial rules are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Nonetheless, “[p]racticitioners involved in *inter partes* review proceedings are expected to know the rules for those proceedings.” *Tasco, Inc. v. Pagnani*, IPR2013-00103, Paper 7, at 2 (P.T.A.B. July 19, 2013).

“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.” 37 C.F.R. § 42.63(a). “Each exhibit must be filed with the first document in which it is cited except as the Board may otherwise order.” *Id.* § 42.6(c). Further, “[e]vidence that is not taken, sought, or filed in accordance with this subpart [subpart A of 37 C.F.R. § 42, which includes §§ 42.1–99] is not admissible.” *Id.* § 42.61(a).

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