

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC., HEWLETT-PACKARD COMPANY, and NETAPP, INC.
Petitioner

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH
INSTITUTE
Patent Owner

Case IPR2013-00635
Patent 6,978,346 B2

Before MIRIAM L. QUINN, and GREGG I. ANDERSON, Administrative Patent
Judges.

QUINN, Administrative Patent Judge.

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

On September 16, 2014, Judges Quinn and Anderson held a conference call requested by Patent Owner seeking authorization for a motion to file supplemental information under 37 C.F.R. § 42.123(b). The supplemental information consists of two documents cited in petitions of different *inter partes* review proceedings (IPRs), all of which are in the preliminary stage. These documents are a prior art reference, referred to as DeKoning, and a declaration of Dr. Katz, a third-party witness. After careful review of the facts and the parties' arguments, we denied Patent Owner's request.

Rule 123(b) addresses late submission of supplemental information. Patent Owner, as the proponent of the supplemental information, has the burden of showing that the "supplemental information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests-of-justice. 37 C.F.R. § 42.123(b).

Patent Owner has had in its possession the proposed supplemental information since its filing, at the latest, on June 13, 2014. Patent Owner responded to the Petition in this proceeding on June 20, almost three months ago. Patent Owner acknowledged the delay, but states it was not until just recently that it was able to review the documents filed with the petitions in the other IPRs and identify the supplemental information. Further, Patent Owner argues that the information involves just a "couple of paragraphs," but that the filings Patent Owner needed to review were large. The Patent Owner's explanation for the delay is not a sufficient showing as to how the interests-of-justice are served.

The information is alleged to be relevant to support Patent Owner's claim construction for the term "RAID." Patent Owner, however, is not seeking to introduce a new argument on claim construction, but instead seeks to make that information available to the record in this proceeding as a housekeeping matter.

Petitioner objected to the introduction of that evidence in this record because it is too late to substantively respond to it. Patent Owner has no further opportunity to brief the relevance of the proposed supplemental information. And Petitioner has no opportunity to cross-examine a third-party declarant over which neither Petitioner nor Patent Owner has control. Petitioner claims prejudice in that its Reply is due on September 22, 2014, in less than a week. Resolution of the issue would not occur before that deadline, and, therefore, Petitioner would not have an opportunity to address the new evidence on claim construction in its Reply or elsewhere.

In our ruling denying the request, we explained that although the proposed supplemental information may be relevant to a claim construction position argued by Patent Owner in its Response, our consideration of that alleged relevance is outweighed by the delay in seeking supplementation of the record and the prejudice to Petitioner, had we allowed the introduction of that information at this stage. Our mandate is to conduct a just, speedy, and inexpensive resolution of the issues. A delay of three months to discover supplemental information with alleged relevance and to seek supplementation so close to a deadline for an opponent's response are contrary to that mandate and heavily weigh against consideration of that information in the interests-of-justice.

As stated during the conference call with the parties, we confirm that it is hereby

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

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