

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.
(TSMC),
Petitioner,

v.

DSS TECHNOLOGY MANAGEMENT, INC.,
Patent Owner.

Case IPR2014-01030
Patent 5,652,084

Before ERICA A. FRANKLIN, JACQUELINE WRIGHT BONILLA, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION
Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

On February 2, 2015, a conference call was conducted among counsel for Petitioner Taiwan Semiconductor Manufacturing Company, Ltd. (“TSMC”), counsel for Patent Owner DSS Technology Management, Inc. (“Patent Owner”), counsel for Samsung Electronics Co., Ltd., i.e., Petitioner in IPR2014-01493 (having a joinder motion pending), and Judges Franklin, Bonilla, and Kalan. The purpose of the call was to address TSMC’s request to file a motion to submit supplemental information under 37 C.F.R. § 123(a).

During the call, TSMC explained that its motion would relate to supplemental information it wishes to submit in relation to Exhibit 1004, which is an English translation of Japanese Patent App. No. H04-71222, published March 5, 1992 (“Jinbo”) (Ex. 1011). Specifically, TSMC indicated that the supplemental information would be a declaration, as required under 37 C.F.R. § 1.68 and § 42.63(b), attesting to the accuracy of the translation of Jinbo.

During the call, Patent Owner did not object to TSMC filing its proposed motion to submit supplemental information. We authorized TSMC to file its motion by the end of the day on February 2, 2015, as discussed during the call. TSMC filed its unopposed motion as authorized, seeking authorization to file Exhibit 1012, which corresponds to a declaration, as discussed above. Paper 10; Ex. 1012.

As the moving party, TSMC bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for authorization to file such motion is made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which trial has been instituted.

TSMC filed its motion on February 2, 2015, which is within one month of the institution date in this proceeding of December 31, 2015, when one takes into account that January 31, 2015, fell on a Saturday. Papers 7 and 10; 37 C.F.R. § 1.7, § 42.1(a). In addition, we instituted trial in relation to three grounds, each involving challenges to claims based on Jinbo, either alone or in combination with other references. Paper 7, 19. Exhibit 1012, evidence that allegedly confirms that Exhibit 1004 is an accurate translation of Exhibit 1011, i.e., references that serve as a basis of grounds of unpatentability authorized in this proceeding, is relevant to claims of the '084 patent for which this trial was instituted. *Cf. Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, slip op. at 2–3 (PTAB Feb. 5, 2014) (Paper 37) (granting a motion to submit supplement information regarding public accessibility of references serving as a basis for instituted grounds). Thus, TSMC meets the two requirements of 37 C.F.R. § 42.123(a).

We also are persuaded that Petitioner has met its burden because the supplemental information Petitioner seeks to submit does not change the grounds of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support those grounds of unpatentability. Instead, such information merely constitutes additional evidence that allegedly confirms the accuracy of the English translation of Jinbo, as presented in Exhibit 1004.

Accordingly, it is

ORDERED that TSMC's motion to submit Exhibit 1012 as supplemental information under 37 C.F.R. § 42.123(a) is granted.

IPR2014-01030
Patent 5,652,084

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