

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UMICORE AG & CO. KG,
Petitioner,

v.

BASF CORPORATION,
Patent Owner.

Cases IPR2015-01121, IPR2015-01123, IPR2015-01124, IPR2015-01125¹
Patents 7,601,662 and 8,404,203

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

DECISION

Patent Owner's Motion for Late Submission of Supplemental Information
37 C.F.R. §§ 42.25(b) and 42.123(b)

¹ This Decision addresses similar motions in four cases. We exercise our discretion to issue a single decision, to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On May 2, 2016, the Board granted Patent Owner's request for authorization to file a motion for late submission of supplemental information pursuant to 37 C.F.R. § 42.123(b).² Paper 34.³ Patent Owner filed its motion on May 13, 2016. Paper 35. In its motion, Patent Owner seeks to submit a copy of U.S. Patent Application Publication No. 2016/0038875 A1 ("the '875 publication"). On May 24, 2016, Petitioner filed its opposition to Patent Owner's motion. Paper 39.

The '875 publication is titled "CuCHA Material for SCR Catalysis," and lists Frank-Walter Schuetze as the inventor and UMICORE AG & Co. KG (Petitioner) as both the applicant and assignee. The '875 publication published in English on February 11, 2016, and is the U.S. national stage application of an earlier international application, published on October 9, 2014 as WO2014/161860 (PCT/EP2014/056537) in German.

Patent Owner states that it first learned of the '875 publication on February 11, 2016, the date it published in English and the day before Patent Owner's Response was due. Paper 35, 2. Patent Owner asserts that statements made by Petitioner in the '875 publication "directly contradict [Petitioner's] contention that the claimed Cu/Al ratio and SAR in the 662 Patent are insignificant and produce expected results." *Id.* at 1–2.

According to Patent Owner, it notified Petitioner of its intention to submit the '875 publication to the Board on April 21, 2016, "[a]fter examining the

² In IPR2015-001121 and 2015-001125, we instituted trial on October 29, 2015, and in IPR2015-001123 and IPR2015-001124, we instituted trial on November 2, 2015.

³ Citations herein are to the record in IPR2015-01121; similar papers may be found in the records of IPR2015-01123, IPR2015-1124, and IPR2015-01125.

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history of the '875 Publication and comparing it to the positions taken by [Petitioner] in this IPR.” *Id.* at 2.

Patent Owner correctly notes that a motion for late submission of supplemental information is governed by 37 C.F.R. § 42.123(b), which requires the movant to 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. This rule’s requirement that the movant show why the supplemental information “could not have been obtained earlier” underscores the importance of avoiding unwarranted delays in introducing such information into the proceeding. Consistent with the idea of avoiding unwarranted delays with respect to not only the late submission of supplemental information, but also to the entire IPR proceeding in general, 37 C.F.R. § 42.25(b) states that “[a] party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.” *See Illumina, Inc. v. The Trustees of Columbia Univ.*, IPR2012-00006, Paper 87, 4–5 (PTAB Oct. 30, 2013).

The record indicates that Patent Owner waited over two months between the time it became aware of the '875 publication (on February 11, 2016), and the time it contacted the Board to seek authorization to file a motion to submit the '875 publication as supplemental information (on April 25, 2016). Petitioner argues that Patent Owner “has not even attempted to explain why the '875 publication could not have been reasonably introduced earlier in the proceeding.” Paper 39, 1. Petitioner argues that Patent Owner should have “immediately raise[d] any purported relevance of the

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publication to this IPR,” but instead Petitioner “delayed more than two months until April 21, 2016.” *Id.* at 1–2. According to Petitioner,

[t]his two month delay occurred during a very critical period. During this time, [Patent Owner] filed its response brief. [Petitioner] assessed [Patent Owner’s] opposition briefing and exhibits, deposed [Patent Owner’s] technical expert witness (who offered opinions on unexpected results), and was heavily engaged in finalizing its own IPR replies. By waiting to raise the ’875 publication, [Patent Owner] deprived [Petitioner] of the ability to cross examine [Patent Owner’s] expert on the publication.

Id. at 2.

The record is consistent with Petitioner’s position, as it shows that Petitioner filed and served its Notice of Cross Examination by Deposition of Dr. Michael Tsapatsis (Patent Owner’s “technical expert witness”) on March 23, 2016, setting April 12, 2016, as the date for the deposition (Paper 28), and that the deposition took place on that date (Ex. 1019). The record also indicates that Patent Owner waited over one week after that deposition before notifying Petitioner of its intention to submit the ’875 publication as supplemental information. Paper 35, 2; Paper 39, 2 n.1.

Patent Owner does not state when, after becoming aware of the ’875 publication, it arrived at its conclusion that Petitioner was taking inconsistent positions. If, as Patent Owner contends, the ’875 publication “plainly contradicts” Petitioner’s position in these proceedings (Paper 35, 3), it is unclear why two months passed between the time Patent Owner allegedly first became aware of the ’875 publication and the time Patent Owner requested authorization to file a motion to submit supplemental information. Thus, in the absence of an explanation for Patent Owner’s delay other than that Patent Owner was “examining the history of the 875 Publication and

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comparing it” to Petitioner’s positions, we determine that Patent Owner failed to promptly seek the relief it requests in the present motion. For this reason, we deny Patent Owner’s motion pursuant to 37 C.F.R. § 42.25(b).

Additionally, in connection with Patent Owner’s Motion for Late Submission of Supplemental Information, Patent Owner filed a copy of the ’875 publication as Exhibit 2036, and a copy of a declaration accompanying the ’875 publication as Exhibit 2037. In view of our decision denying Patent Owner’s motion, these exhibits will be expunged from the record pursuant to 37 C.F.R. § 42.7(a).

Accordingly, it is

ORDERED that Patent Owner’s Motion for Late Submission of Supplemental Information under 37 C.F.R. § 42.123(b) is *denied*; and

FURTHER ORDERED that Exhibits 2036 and 2037 be expunged from the record.

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