

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CIM MAINTENANCE INC.  
Petitioner

v.

P&RO SOLUTIONS GROUP, INC.  
Patent Owner

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Case No. IPR2017-00516  
Patent 8,209,205

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**PETITIONER CIM'S MOTION FOR LEAVE TO FILE SUPPLEMENTAL  
INFORMATION PURSUANT TO 37 C.F.R. 42.123(A)**

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

Pursuant to 37 C.F.R. 42.123(A), and in light of arguments made by Patent Owner P&RO Solutions Group, Inc. (“P&RO”) in its Preliminary Response related to the public availability of certain references, Petitioner CiM Maintenance Inc. (“CiM”) respectfully requests that the Board allow Petitioner to submit the evidence attached in Exhibits 1056-1062 as supplemental information.

## **II. STATEMENT OF FACTS**

This proceedings relates to the *inter partes* review of U.S. Patent No. 8,209,205 (the “’205 Patent”). On December 22, 2016, CiM filed its Petition for *inter partes* review with the Patent Trials and Appeals Board (the “Board”). *See* Paper 1, Petition. In the Petition, Petitioner relied in part on three printed publication references (“the References”): (1) *Best Practice Guideline for Maintenance Planning and Scheduling*, by the Electric Power Research Institute, Inc. (the “Best Practice Guideline”), (2) *Microsoft Excel 2000 Bible*, a book by John Walkenbach, and (3) *Maintenance Planning and Scheduling Handbook*, a book by Doc Palmer (“Palmer”). In its Preliminary response, P&RO argued that CiM had failed to show that each of these references was a printed publication by the time of the earliest priority date of the ’205 Patent. *See* Paper 7 (“Prelim. Resp.”), 23-31, 36-37, 46. The Board instituted review

on June 22, 2017.

### **III. THIS MOTION COMPLIES WITH THE RULES**

CiM's motion complies with the rules. First, the Board instituted review on June 22, 2017, and Petitioner timely submitted its request for authorization on Monday, July 24, 2017. See 37 C.F.R. § 42.123; see also 35 U.S.C. § 21(b); 37 C.F.R. § 1.7. Further, in light of P&RO's challenge to the public availability of the References, and the subsequent institution on the References, the offered evidence relates to the claims at issue in this proceeding. See *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, No. 37 (P.T.A.B. Feb. 5, 2014).

### **IV. THE REQUESTED SUPPLEMENTAL INFORMATION**

Three sets of are submitted with CiM's request. Ex. 1055, the affidavit of Christopher Butler, authenticates the evidence supplied in Exhibit 1056, which are webpage printouts from the Internet Archive's Wayback Machine. Mr. Butler's affidavit explains that the footer of the webpages indicates when they were archived by the Wayback Machine. "[F]ederal Courts have regularly accepted evidence from the Internet Archive." *SDI Technologies, Inc. v. Bose Corp.*, Case IPR2013-00465, Paper 40, 15 (P.T.A.B. Nov. 7, 2014) (Final Written Decision) (denying motion to exclude). Exhibits 1057 is a declaration of Scott Bennett, a librarian and researcher

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with expertise on the dissemination and availability of documents. *See* Ex. 1057, *Bennett Decl.* at ¶¶ 7-24. Mr. Bennett's declaration cites library catalogs and other evidence demonstrating that the Palmer and Walkenbach references were publicly available prior to the priority date of the '205 Patent.

Exhibit 1056 demonstrates that Walkenbach was publicly available for sale on Amazon.com at least as early as November 29, 1999, and there was even a review on Mr. Excel of the books by June 12, 2000. *See* Ex. 1056 at 3-4, 7. Additionally, according to Scott Bennett, there was evidence that Walkenbach was catalogued at public libraries in 1998 and 1999 and that an ordinary research exercising reasonable diligence would have had no difficulty accessing Walkenbach by December 7, 1999. *See* Ex. 1057, *Bennett Decl.* at ¶¶ 32-40; *see also* Ex. 1062, at 7-110. The Internet Archive evidence and Mr. Bennett's declaration demonstrates that Walkenbach is a prior art printed publication in regards to the '205 Patent.

Exhibit 1056 also demonstrates that Palmer was publicly available for sale on Amazon.com by April 22, 2000. *See* Ex. 1056 at 9-10. Additionally, according to Scott Bennett, there was evidence that Walkenbach was catalogued at public libraries in 1998 and 1999 and that an ordinary research exercising reasonable diligence would have had no difficulty accessing Palmer July 1999. *See* Ex. 1057, *Bennett Decl.* at

¶¶ 25-31; *see also* generally, Exs. 1058-1061, Ex. 1062 at 1-6. The Internet Archive evidence and Mr. Bennett’s declaration demonstrate that Palmer is a prior art printed publication in regards to the ’205 Patent.

Finally, Exhibit 1056 provides addition corroboration to statements made in the Petition arguing that that the Best Practice Guideline was known prior to the earliest priority date of the ’205 Patent. First, in its calendar of events in December 2000 and June 2001, epri.com indicated that it was holding a maintenance conference in August 2001, which is when the International Maintenance Conference mentioned in the Petition was purportedly held. *See* Ex. 1056 at 28, 41 (mentioning the EPRI maintenance conference); *see also* Paper 1 at 13. Additionally, in 2001, EPRI began advertising the “Best Practices Guideline for Maintenance Planning and Scheduling” as part of its Option Value Package for Work Process Improvement Guidelines and Techniques. *See id.* at 54. Together with the Swezey Declaration (Ex. 1019) and the International Maintenance Conference proceedings (Ex. 1004), this evidence supports that the Best Practice Guideline was advertised and publicly available before the priority date of the ’205 Patent.

**V. P&RO will not be prejudiced by the supplemental information**

The proposed supplemental information does not change the grounds for

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