

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SPRINT SPECTRUM L.P.,  
Petitioner,

v.

GENERAL ACCESS SOLUTIONS, LTD.,  
Patent Owner.

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Cases<sup>1</sup>  
IPR2017-01885 (Patent 7,173,916 B2)  
IPR2017-01887 (Patent 6,891,810 B2)

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Before MELISSA A. HAAPALA, *Acting Vice Chief Administrative Patent Judge*, KALYAN K. DESHPANDE and DAVID M. KOHUT, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

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

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<sup>1</sup> This Decision applies to each of the listed cases. The parties are not authorized to use a multiple case caption.

IPR2017-01885 (Patent 7,173,916 B2)

IPR2017-01887 (Patent 6,891,810 B2)

Pursuant to our authorization, Sprint Spectrum L.P. (“Petitioner”) filed a Motion to Submit Supplemental Information (Paper 17,<sup>2</sup> “Mot.”) and General Access Solutions, LTD (“Patent Owner”) filed an Opposition to Petitioner Motion to Submit Supplemental Information (Paper 18, “Opp.”). For the reasons discussed below, we deny Petitioner’s motion.

Petitioner argues that

A party submitting supplemental information under 37 C.F.R. § 42.123(b) must show ‘[1] why the supplemental information reasonably could not have been obtained earlier, and [2] that consideration of the supplemental information would be in the interests-of-justice.’

Mot. 1. Petitioner argues that its request satisfies both prongs of 37 C.F.R. § 42.123(b). Specifically, Petitioner argues that Patent Owner represented that it intended to swear behind the Ahy ’133 patent, and, because of this intervening event, “Petitioner reasonably could not have obtained the Ahy ’384 patent earlier because Patent Owner had not informed Petitioner of its intention to swear behind the Ahy ’133 patent.” *Id.* at 2–4. Petitioner further argues that entry of Ahy ’384 would be in the “‘interest-of-justice’” because it “does not change any instituted grounds in this proceeding” and Petitioner promptly requested authorization to file Ahy ’384 as supplemental information. *Id.* at 4–5.

Patent Owner argues Petitioner was aware of Ahy ’384 at the time of filing the Petition, “Petitioner was aware that there was a risk that the Patent Owner could swear behind that art,” and all of “Petitioner’s arguments rely

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<sup>2</sup> Petitioner and Patent Owner filed similar papers in IPR2017-01885 and IPR2017-01887. Accordingly, citations are to IPR2017-01885 unless otherwise noted.

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on material that was added to the Ahy '133 patent.” Opp. 2–5.

We are not persuaded by Petitioner’s arguments. Rather, we agree with Patent Owner that Petitioner was aware of the existence of Ahy '384 and could have complied with 37 C.F.R. § 42.123(a)(1) in order to file Ahy '384 as supplemental information. Accordingly, we are not persuaded that Patent Owner’s indication of a possible argument is a sufficient reason as to why Petitioner did not request authorization earlier, and Petitioner’s prompt request thereafter does not cure this deficiency. Accordingly, Petitioner’s request to enter Ahy '384 as supplemental information is denied.

We, however, do not require Petitioner to anticipate and predict every argument that may be submitted by Patent Owner at the time of submitting its Petition or within the one month time period specified by 37 C.F.R. § 42.123(a)(1). Rather, Petitioner may review Patent Owner’s Response (Paper 31) and determine whether the entry of Ahy '384 is appropriate as part of its Reply to the Response. That is, while we do not agree with Petitioner that the filing of a motion to submit supplemental information is appropriate in anticipation of a potential argument, we note that it may be appropriate to submit the same evidence in response to an argument that is raised and on record.

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 37 C.F.R. § 42.123, we deny Petitioner’s Motion to file Supplemental Information;

FURTHER ORDERED that Exhibit 1010 is expunged.

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