

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC., and
AXIS COMMUNICATIONS AB,
Petitioner,

v.

AVIGILON FORTRESS CORPORATION,
Patent Owner.

Case IPR2019-00311
Patent 7,923,923 B2 & C1

Before GEORGIANNA W. BRADEN, KIMBERLY McGRAW, and
JESSICA C. KAISER, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

ORDER

Granting Motion to Submit Supplemental Information
37 C.F.R. § 42.5
37 C.F.R. § 42.123

I. INTRODUCTION

Canon Inc., Canon U.S.A., Inc., and Axis Communications AB (“Petitioner”) filed an authorized motion to submit supplemental information (Paper 19, “Mot.”), to which Avigilon Fortress Corporation (“Patent Owner”) filed an opposition (Paper 21, “Opp. to Mot.”).

Petitioner states the supplemental information consists of evidence relating to the publication status of two references asserted in this proceeding (i.e., Kellogg and Brill), namely:

1. the declaration of Guang-Yu Zhu (Exhibit 1041);
2. webpages from the Library of Congress regarding the standard MARC format (Exhibits 1042 and 1043);
3. a copy of the Flinchbaugh reference obtained from the Library of Congress (Exhibit 1045);
4. a copy of the Brill reference obtained from the University of Virginia Libraries (Exhibit 1046) and a declaration from the University of Virginia (“UVA”) Library concerning the cataloging, shelving and public accessibility of Brill (Exhibit 1049);
5. declarations from other IPR proceedings concerning MIT Libraries’ shelving and indexing policies (Exhibits 1047 and 1048);
6. a copy of the Brill reference from the University of Wisconsin-Madison Memorial Library (“UW”)(Exhibit 1051) and a forthcoming declaration from the University of Wisconsin – Madison Memorial Library concerning the public cataloging, shelving and public accessibility of Brill (Exhibit 1053¹).

Mot. 1.

For the reasons stated below we grant Petitioner’s motion.

¹ In its motion, Petitioner explains it is unable to submit Exhibit 1053 with its motion because the librarian who prepares the declarations for the UW

Analysis

As the moving party, Petitioner 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.

Petitioner's request for authorization to submit supplemental information was made on August 2, 2019, which is within one month after July 8, 2019, the date that trial was instituted. Thus, Petitioner has satisfied the first requirement of § 42.123(a).

Patent Owner argues Petitioner did not sufficiently identify Exhibits 1049, 1051, and 1053 within one month of the date trial was instituted because Petitioner only requested authorization to submit the documents that Petitioner intended to serve on Patent Owner in response to Patent Owner's objections to evidence and that these documents did not include Exhibits 1049, 1051, and 1053. *See* Opp. to Mot. 3–6. We disagree. Petitioner's email requesting authorization to file supplemental evidence also requested authorization to subpoena certain libraries and compel testimony and/or production of documents *and to file any testimony or documents produced by any of these entities with the Board*. Ex. 3002. During the conference call, Petitioner explained that the “supplemental information that we're

library is unavailable to execute the declaration until after August 22, 2019. Mot. 6–7 n.2. Exhibit 1053 was served on Patent Owner on August 23, 2019.

looking to submit includes additional stamped copies of the references from various libraries showing that the references were actually disseminated.” Ex. 1050, 7:6–10. During the call Petitioner further explained that it is attempting to obtain testimony from somebody with personal knowledge as to the shelving status of each of the asserted references in order to address Patent Owner’s argument that a declaration from somebody with personal knowledge is necessary. *See* Ex. 1050, 11:3–19. Under these circumstances, we determine Petitioner sufficiently identified the information that it sought to submit as supplemental information.

With respect to the second requirement of § 42.123(a), the supplemental information Petitioner seeks to admit generally relates to the publication status of Kellogg and Brill, which is a basis for the ground of unpatentability in this proceeding, and is therefore relevant to the challenges to the claims of the ’923 patent for which this trial was instituted.

We are unpersuaded by Patent Owner’s argument that the information Petitioner seeks to submit is supplemental evidence, not supplemental information, and therefore submission of the information is untimely as Patent Owner has not yet filed a motion to exclude. Patent Owner does not persuasively explain, and we do not see, why evidence that may constitute supplemental information as well as supplemental evidence may not be submitted as supplemental information.

We also are unpersuaded by Patent Owner’s arguments that Petitioner has not shown the supplemental information could not have been obtained earlier and that admitting the information now would allow Petitioner to bolster its position in a way that is not in the interest of justice. *See* Opp. to Mot. 5–8. As stated in our Decision to Institute, Petitioner provided

sufficient argument and evidence in its Petition that the asserted references constitute printed publications. *See* Paper 13. Patent Owner challenged the publication status of the asserted reference in its Preliminary Response. The supplemental information is being provided in anticipation Patent Owner may maintain its argument that the asserted references are not prior art. *See* Mot. 2.

Nor do we agree with Patent Owner that admitting these documents, including Ex. 1053, will unfairly prejudice Patent Owner. *See* Opp. to Mot. 4. Rather, entry of the exhibits will allow Patent Owner to review and address the exhibits in its response, in the event Patent Owner chooses to maintain its position that Kellogg and Brill are not prior art.

Patent Owner also argues that Petitioner's motion should be denied because the Petitioner inadequately authenticates the exhibits sought to be filed. Opp. to Mot. 9. We disagree. Issues relating to the authentication of exhibits are properly addressed by objections to evidence and motions to exclude.

ORDER

For the foregoing reasons, it is ORDERED:

Petitioner's motion to submit Exhibits 1041–1043, 1045–1049, 1051, and 1053 as supplemental information is granted.

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