

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
Case IPR2019-00314¹
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 Authorization to File Motion to Submit Supplemental Information
and Motion to Compel Testimony and/or Production of Documents

37 C.F.R. § 42.5

37 C.F.R. § 42.52

37 C.F.R. § 42.123(a)

¹ This order addresses issues that pertain to both cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style caption in subsequent papers.

IPR2019-00311 (Patent 7,932,923 B2 & C1)

IPR2019-00314 (Patent 7,932,923 B2 & C1)

I. INTRODUCTION

A conference call in the above proceedings was held on August 9, 2019 among respective counsel for Canon Inc., Canon U.S.A., Inc., and Axis Communications AB (“Petitioner”) and Avigilon Fortress Corporation (“Patent Owner”) and Judges Braden, McGraw, and Kaiser. Petitioner arranged for a court reporter. A copy of the transcript has been filed as Exhibit 1050. The purpose of the call was to discuss Petitioner’s requests (1) for authorization to file a motion to file supplemental information under 37 C.F.R. § 42.123(a) and (2) for authorization to file a motion to compel testimony and/or production of documents pursuant to 37 C.F.R. § 42.52(a). *See Ex. 3002.*

For the reasons stated below we authorize Petitioner to file the requested motions and authorize Patent Owner to file oppositions thereto.

1. Background

In IPR2019-00311, Petitioner filed a petition asserting certain claims of U.S. Patent No. 7,932,923 B2 & C1 (“the ’923 patent”) are unpatentable over certain references (i.e., “Kellogg” and “Brill”). IPR2019-00311, Paper 1. In IPR2019-00314, Petitioner filed a petition asserting that certain claims of the ’923 patent are unpatentable over Brill in combination with another reference (i.e., “Dimitrova”). IPR2019-00314, Paper 1. In support of each petition, Petitioner also filed declarations by Emily R. Florio (Ex. 1007²) to support its allegations that the asserted references qualify as prior art. In IPR2019-00311, Ms. Florio asserts that the citation of Kellogg in another reference (i.e., “Flinchbaugh”) is further evidence of the public

² A different declaration by Ms. Florio was submitted in each proceeding as Exhibit 1007.

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availability of Kellogg. *See* IPR2019-00311, Ex. 1007 ¶ 28. Patent Owner filed a Preliminary Response in each proceeding disputing, *inter alia*, the prior art status of the asserted references. IPR2019-00311, Paper 9; IPR2019-00314, Paper 9. Petitioner then filed an authorized Reply to address Patent Owner’s arguments that the asserted references in each proceeding are not printed publications (IPR2019-00311, Paper 11; IPR2019-00314, Paper 11), to which Patent Owner filed an authorized sur-reply (IPR2019-00311, Paper 12; IPR2019-00314, Paper 12).

On July 8, 2019, we instituted a trial in each proceeding. IPR2019-00311, Paper 13; IPR2019-00314, Paper 13. Based on the evidence submitted with each petition, we determined Petitioner made a sufficient showing that the asserted references in each proceeding qualify as printed publications, for purposes of instituting a trial.

Subsequently, Patent Owner served Petitioner objections to evidence in each proceeding under 37 C.F.R. § 42.64(b)(1), objecting to the Florio declarations under, *inter alia*, Federal Rules of Evidence 602 and 901 and alleging Petitioner has not “provided sufficient evidence to support a finding that [its] librarian declarant [Ms. Florio] has personal knowledge of the library shelving practices at MIT Libraries, University of Michigan Media Union, University of Virginia Library, North Carolina State University Library, University of California Los Angeles Science & Engineering Library, or the Library of Congress.” IPR2019-00311, Paper 15, 2; IPR2019-00314, 2. Petitioner states it served Patent Owner with evidence responsive to Patent Owner’s objections, as supplemental evidence. Ex. 3002.

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2. Request for Authorization to Submit Supplemental Information

Petitioner requests authorization to file the evidence that it had served on Patent Owner as supplemental evidence into the record as supplemental information under 37 C.F.R. § 42.123(a). *See* Ex. 3002. Petitioner states the information it seeks to submit relates to the publication status of the asserted references, an issue relevant to the proceeding, and includes an MIT Library copy of the Dimitrova reference, a Library of Congress copy of the Flinchbaugh reference, a University of Virginia Library copy of the Brill reference, MIT declarations from other proceedings discussing MIT's shelving and indexing policies, and copies of webpages from the Library of Congress regarding the standard MARC format. *Id.* Petitioner contends submitting this information now will allow Patent Owner the opportunity to address this information in its Patent Owner Response, if Patent Owner chooses to continue its challenge to the publication status of the asserted references.

Patent Owner opposes Petitioner's request on the basis that the information sought to be submitted is not responsive to its objections as the information does not go to Ms. Florio's personal knowledge. Patent Owner also states that Petitioner's request is untimely because Patent Owner has not yet moved to exclude the references. Patent Owner also contends Petitioner has failed to show why the supplemental information could not have been obtained earlier.

Analysis

37 C.F.R § 42.123(a) provides that once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements. First, the request for the authorization to

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file a motion to submit supplemental information must be made within one month of the date the trial is instituted, and second, the supplemental information must be relevant to a claim for which the trial has been instituted. *See* 37 C.F.R. §§ 42.123(a)(1), 42.123(a)(2).

Here, Petitioner provides sufficient argument that the motion it seeks to file in each proceeding will satisfy both of these requirements.

Petitioner's request for authorization was made on August 2, 2019, which is within one month after July 8, 2019, the date that each trial was instituted.

Also, Petitioner stated during the call that the supplemental information relates to the publication status of the asserted references, which is relevant to a claim for which trial has been instituted in each proceeding.

We are unpersuaded by Patent Owner's arguments that the information Petitioner seeks to submit is not responsive to Patent Owner's objections or that submission of the information is untimely as Patent Owner has not yet filed a motion to exclude. Although the information that Petitioner seeks to submit was served on Patent Owner in response to Patent Owner's Objections to Evidence, Petitioner is seeking to submit the material as supplemental information under 37 C.F.R. § 42.123(a) and is not seeking to submit the information to support the admissibility of previously filed evidence.

We also are unpersuaded by Patent Owner's argument that Petitioner has not shown that the supplemental information could not have been obtained earlier. Petitioner's request for authorization was made within one month of the trial institution date, and therefore, Petitioner does not need to show that the why the supplemental information could not have been obtained earlier. *See* 37 C.F.R. § 42.123(b) (stating that if a party seeks to

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