

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

IMMERVISION, INC.,
Patent Owner.

IPR2020-00179 (Patent 6,844,990 B2)
IPR2020-00195 (Patent 6,844,990 B2)¹

Before KRISTINA M. KALAN, WESLEY B. DERRICK, and
KIMBERLY MCGRAW, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123

¹ This Order applies to both listed cases. The parties may not use this style heading unless authorized.

INTRODUCTION

Pursuant to 37 C.F.R. § 42.123(a), and as authorized by the Board in the June 15, 2020, Order (Paper 9 in each proceeding), Petitioner LG Electronics Inc. (“Petitioner”), filed a motion to submit supplemental information (Paper 10 in each proceeding (“Motion”)).² Specifically, Petitioner seeks authorization to file the following:

- 1) Code V Designer’s Manual: System of Optical Design Programs, 2nd ed., Optical Research Associates (1978) (Ex. 1014);
- 2) Excerpts of the Code V Reference Manual, Version 7.60, Optical Research Associates (Feb. 1994) (Ex. 1015);
- 3) “A Technical Overview of CODE V Version 7” by Bruce R. Irving of Optical Research Associates, Proceedings Volume 0766 of the Society of Photo-Optical Instrumentation Engineers (SPIE), Recent Trends in Optical Systems Design and Computer Lens Design Workshop (1987) (Ex. 1016); and
- 4) A supplemental declaration from Petitioner’s expert (Ex. 1017) that authenticates the above three additional pieces of evidence and notes that they corroborate his opinion in his original declaration that the Code V lens design software would render the same results in 2001 as it did at the time of his declaration.

Id. at 1. Petitioner also represents that “Petitioner met and conferred with Patent Owner” and that Patent Owner “indicated that it did not oppose th[e] [M]otion.” *Id.* at 2. No opposition was filed by Immervision, Inc. (“Patent Owner”) within the period of time in which it was authorized to file an opposition. *See* Order 3. Nonetheless, Petitioner bears the burden of proving that it is entitled to the relief requested. 37 C.F.R. § 42.20(c).

² The Board entered a single Order in each proceeding and Petitioner’s Motions are differently captioned, but are otherwise identical. Our citation to Motion is, accordingly, to Paper 10 in IPR2020-00179, as representative of the Motion in both proceedings.

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Having considered the record before us, we *grant* Petitioner’s Motion for the reasons set forth below.

ANALYSIS

A party may file a motion to submit supplemental information, after trial has been instituted, provided that: (1) the request for authorization to file the motion is made within one month of the date the trial is instituted; and (2) the supplemental information is relevant to a claim for which trial has been instituted. 37 C.F.R. § 42.123(a). Section 123(a), however, “does not connote the PTAB must accept supplemental information so long as it is timely and relevant.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (citation omitted). As set forth by our reviewing court, the guiding principle in evaluating a motion to submit supplemental information is “to ensure the efficient administration of the Office and the ability to complete IPR proceedings in a timely manner.” *Id.* (citations and internal quotations omitted). “Requiring admission of supplemental information so long as it was timely submitted and relevant to the IPR proceeding would cut against this mandate and alter the intended purpose of IPR proceedings.” *Id.* That purpose is to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Thus, we consider whether submission of the supplemental information would change the grounds initially presented in the petition or otherwise unfairly change the evidence underlying those grounds.

The requirements of 37 C.F.R. § 42.123(a) are met. Petitioner’s emailed request for authorization to file a motion to submit supplemental information is dated June 11, 2020 (*see* Order 2; Ex. 3001), which is within one month of the decision to institute this proceeding, issued May 13, 2020 (Paper 6). Petitioner’s request also identifies the supplemental information

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to be submitted, *i.e.*, Exhibits 1014–1017, and each appears on its face both to be directed to Code V lens design software and relevant to a claim for which trial has been instituted, as Petitioner relied on the capabilities and availability of that software in its arguments, as explained in our decision to institute *inter partes* review. *See, e.g.*, IPR2020-00179, Paper 6, 14–15; IPR2019-00195, Paper 6, 14–15.

We must further determine whether the supplemental information would change the grounds initially presented in the petition or otherwise unfairly change the evidence underlying those grounds. Petitioner relied on, and continues to rely on, the capabilities of the Code V lens design software that was available circa 2001, as evidenced by the testimony of Dr. Chipman. Petitioner contends that the supplemental information pertains to that software prior to, or at that date, and to corroborating Dr. Chipman’s earlier testimony. Motion 1, 3–4. Patent Owner does not contest Petitioner’s motion to submit the supplemental information. *Id.* at 2. On this record, the supplemental information would not appear to change the grounds initially presented in the petition. Petitioner further contends that it could include this information as exhibits to its Reply rather than submitting it prior to Patent Owner’s Response, but that submitting it earlier as supplemental information affords Patent Owner an opportunity to consider it in preparing Patent Owner’s Response. *Id.* at 5. On this record, with the Motion uncontested by Patent Owner, we discern no unfair change in the evidence underlying the grounds presented in the Petition on which the *inter partes* review proceedings were instituted. In sum, Petitioner has sufficiently shown that allowing Petitioner to submit the supplemental information comports with the guiding principles set forth by our reviewing

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court and the Rules. *See, e.g., Redline Detection*, 811 F.3d at 445; 37 C.F.R. § 42.1(b).

CONCLUSION

Petitioner has sufficiently shown that it is entitled to submit the identified exhibits (Exhibits 1014–1017) as supplemental information in these proceedings. *See* 37 C.F.R. §§ 42.20(c), 42.123(a).

ORDER

Accordingly, it is:

ORDERED that Petitioner’s motion to submit Exhibits 1014–1017 as supplemental information is *granted*.

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