

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

IMMERVISION, INC.,
Patent Owner.

Case No. IPR2020-00195

U.S. Patent No. 6,844,990

**PETITIONER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION**

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.123(a), and as authorized by the Board in the June 15, 2020 Order of the Board (Paper 9), Petitioner LG Electronics Inc. (“Petitioner” or “LGE”) hereby moves to submit supplemental information consisting of:

- 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.

Petitioner met and conferred with Patent Owner, which indicated that it did not oppose this motion.

II. REASONS FOR THE RELIEF

In its Petition, LGE showed that a prior art reference Tada (Ex. 1007) disclosed a lens that met all of the elements of claim 21 of U.S. Patent No. 6,844,990 (“the ’990 patent”). *See* Pet. at 33-57. In order to show that the lens in Tada had the same characteristics as claimed in the ’990 patent, LGE’s expert, Dr. Russell Chipman, used industry-standard lens design software called Code V to determine certain existing characteristics of the disclosed prior art lens. *See, e.g., id.* at 39; Ex. 1008 at ¶ 51. In its Preliminary Response, Patent Owner ImmerVision, Inc. (“Patent Owner” or “ImmerVision”) argued that Dr. Chipman’s testimony by itself regarding the availability and capability of Code V circa 2001 was insufficient. *See* POPR at 19-22. In its Decision on Institution, the Board noted that Dr. Chipman’s testimony on this point was sufficient at the preliminary stage of the proceeding and that Patent Owner provided no discernable basis for any change in the principles and mathematical calculations necessary to apply those principles in the relevant time period. Paper 6 at 20-21. The Board concluded that Patent Owner’s arguments raise factual disputes that are best resolved upon a full record. *Id.* at 21.

A party may submit supplemental information under 37 C.F.R. § 42.123(a) if: (1) “[a] request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted” and (2) “[t]he supplemental information [is] relevant to a claim for which the trial has been instituted.” In deciding motions under § 42.123(a), the Board has considered whether the information changes “the grounds of unpatentability authorized in [the] proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, Paper 37, slip. op. at 3 (P.T.A.B. Feb. 5, 2014). The Board has also considered whether granting the motion would prevent the just, speedy, and inexpensive resolution of the proceeding, *id.* at 4, or would prejudice the other party. *Unified Patents Inc., v. Dragon Intellectual Property, LLC*, Case IPR2014-01252, Paper 43, slip. op. at 3 (P.T.A.B. Apr. 14, 2015).

Here, Petitioner made the request to submit supplemental information on June 11, 2020, which is within 30 days of the date of institution (May 13, 2020). Accordingly, the first requirement is met. 37 C.F.R. § 42.123(a)(1).

All of the information LGE is seeking to add to the proceeding is regarding the availability of capability of Code V prior to 2001, the alleged priority date of the '990 patent (May 11, 2001). This is not a case where the supplemental

information is being used to change the grounds of unpatentability or the evidence initially presented in the petition to support the original grounds of unpatentability. Rather, this evidence simply buttresses the evidence already included with the petition on this point and is the additional evidence that Patent Owner specifically said it wanted. *See* POPR at 22 (“Neither Petitioner nor Dr. Chipman submitted any other evidence, such as documentation on Code V (*e.g.*, a user manual or advertisement), screenshots of a 2001 or earlier version of Code V, or other sworn testimony.”). Moreover, the supplemental information LGE is seeking to add is the exact type of information that the Board has routinely permitted. *See, e.g., Palo Alto Networks*, IPR2013-00369, slip op. at 2-3 (allowing documents that constitute additional evidence to confirm the public accessibility of prior art references that are the basis of the instituted grounds of unpatentability); *R.J. Reynolds Vapor Co. v. Fontem Holdings I B.V.*, IPR2016-01692, Paper 16, slip op. at 2-3 (P.T.A.B. April 27, 2017) (allowing supplemental declaration that provided corroborating evidence for opinions expressed in declaration submitted with petition); *Canfield Scientific, Inc. v. Melanoscan, LLC*, IPR2017-02125, Paper 61, slip op. at 3 (P.T.A.B. March 22, 2019) (allowing supplemental documents and declarations “in order to support contentions that are set forth in detail in the Petition”).

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