

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS, LTD.,
Patent Owner.

Case IPR2020-00878
Patent 10,330,897 B2

Before BRYAN MOORE and MONICA S. ULLAGADDI, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

Conduct of Proceedings

37 C.F.R. § 42.5

I. INTRODUCTION

Petitioner requested a phone conference regarding its request for authorization to file a motion to submit supplemental information under 37 CFR § 42.123(b) to add the following from the record of IPR2020-00897 to the record of IPR2020-00878: Petitioner’s Reply, Paper 22, pp. 22-24; Ex. 1037, pp. 17-19; Ex. 1038; Ex. 1039; Ex. 1040; Sur-Reply, Paper 23, pp. 12-14; Ex. 2012, pp. 39-40. Petitioner asserts these documents relate to a position taken by Patent Owner in IPR2020-00897 which it alleges is inconsistent with the position taken by Patent Owner in this *inter partes* review.

On September 23, 2021, we held a conference call with Judges Moore and Ullagaddi and counsel for the parties, in which we denied, by oral order, Petitioner’s request for authorization to file a motion to submit supplemental information. *See* 37 C.F.R. § 42.20(b) (“A motion will not be entered without Board authorization”); *see also* 37 C.F.R. § 42.123(b) (explaining that the late submission of supplemental information must be in the interests of justice).

A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

37 C.F.R. § 42.123(b)

Below we provide a brief summary of the result of that call.

Petitioner agreed on the call that, although it was aware of the documents prior to the oral hearing, the documents requested were not included in any

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demonstratives at the hearing nor were they specifically discussed at the oral hearing in this *inter partes* review. Petitioner asserted that it wanted the documents entered into this proceeding to provide a “complete record” on an issue which it believes Patent Owner has taken inconsistent positions in IPR2020-00897 from its positions in IPR2020-00878. Given the many similarities and subtle differences in the proceedings at issue, we find that rather than providing a “complete” record, such documents may introduce unnecessary confusion between the two proceedings into the record.

Additionally, Petitioner did not request further briefing on any issue in the case. We note that if we were to rely on these documents in the Final Written Decision without briefing, Patent Owner would not have had an opportunity to respond to them.

In sum, we would not and will not rely, in the Final Written Decision in this *inter partes* review, on these documents, i.e. documents from another proceeding about which there is no briefing or testimony in this proceeding. Additionally, each of the documents except the Sur-Reply and expert testimony (Ex. 2012) reasonably could have been obtained earlier and submitted in this proceeding. For at least those reasons, it was apparent on the call that the interest of justice would not be served by allowing these documents in the record and that the briefing of such an apparent issue at this late stage of the proceeding would prejudice the Patent Owner and waste the Board’s resources.

Neither Petitioner nor Patent Owner requested or provided a court reporter to record the proceedings and, as such, no transcript of the proceeding is in the record. On the call, Petitioner indicated it wishes its

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denial of authorization to file late evidence to be memorialized, this paper serves such purpose.

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