

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

YITA LLC,  
Petitioner

v.

MACNEIL IP LLC,  
Patent Owner

---

Case IPR2020-01139  
U.S. Patent No. 8,382,186

---

**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
MOTION TO SUBMIT SUPPLEMENTAL INFORMATION  
PURSUANT TO 37 C.F.R. § 42.123(b)**

*Mail Stop "PATENT BOARD"*  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

I. Introduction .....1

II. Legal Standards .....2

III. The Board should deny PO’s motion to submit supplemental information because PO inappropriately seeks to remedy its procedural and substantive failures. ....4

    A. A translator available for deposition could have been obtained earlier and EX2137 would prejudice Petitioner. ....5

    B. PO inappropriately seeks to augment its alleged secondary considerations of non-obviousness with EX2132-EX2136 and EX2127.....10

    C. Complete certified translations could have been reasonably obtained earlier (EX2115 and EX2128).....12

    D. PO improperly seeks to submit new “probative evidence” (EX2129) in response to Petitioner’s objections.....13

    E. Corrected declarations EX2114 and EX2126 are untimely supplemental evidence. ....14

IV. Conclusion .....15

## I. Introduction

The Board should deny Patent Owner MacNeil IP LLC's ("PO") motion to submit supplemental information. PO's motion is a belated attempt to introduce twelve new exhibits to correct deficient evidence it relied on in its Patent Owner's Response ("POR"). But "late submission of supplemental information" requires two factors: 1) that the "information reasonably could not have been obtained earlier," and 2) that its consideration "would be in the interests-of-justice." 37 C.F.R. § 42.123(b). PO satisfies neither.

PO concedes its new exhibits are in response to Petitioner's objections;<sup>1</sup> therefore, they are supplemental *evidence*, not supplemental *information*. Moreover, the new exhibits *all* reasonably *could have* been obtained earlier, as detailed below. And the Board should not allow PO's principal argument—that it was unaware of its own numerous errors until Petitioner's objections—to be the fulcrum PO uses to leverage its own errors to its advantage to submit new exhibits as supplemental information. Mot., 1, 8, 9-10, 11, 12, 13, 15.

---

<sup>1</sup> PO complains about the number of Petitioner's objections, Mot., 1, EX2138, 9:15-22, but PO's deficient evidence compelled Petitioner's objections, which are required to preserve Petitioner's right to file a motion to exclude. 37 C.F.R. § 42.64.

PO alleges that it seeks to address “informalities and filing oversights involving a small subset of exhibits....” Mot., 1. But, PO mischaracterizes the extent of its corrections, which include substantive additions to the record (not “informalities”) after neglecting Board Rules (not “filing oversights”). PO’s new translation, amended claims charts, new testimony, new translation certifications, U.S. Customs and Border Protection forms, and corrected declarations attempt to fix failures, not mere “informalities” or minor “inadvertent errors.” Mot., 12, 13, 14.

All but admitting that its own mistakes do not satisfy the requirements for supplemental information under Section 42.123(b), PO asks the Board to waive the Rule and allow PO to supplement its arguments and augment the record. Mot., 14-15. Doing so would be prejudicial and against the interests-of-justice. The Board’s Rules are designed to secure the just, speedy, and inexpensive resolution of every proceeding. PO’s disregard for the Board’s Rules should not be rewarded by allowing PO’s supplemental information. The Board should deny PO’s motion.

## **II. Legal Standards**

As the party moving to submit late supplemental information, PO has the burden to 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).<sup>2</sup> Thus, PO must explain specifically why the Board should admit the evidence *now*, because supplemental information is not intended to provide an avenue for bolstering deficiencies, as PO plainly is attempting here. *See Samsung Elecs. Co., Ltd. v. Immersion Corp.*, IPR2018-01499, Paper 19 at 3 (P.T.A.B. May 16, 2019); *Pacific Mkt. Int’l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 3 (P.T.A.B. Dec. 2, 2014); *GoPro v. Contour IP Holdings*, IPR2015-01078, Paper 40 at 2-4 (P.T.A.B. Apr. 7, 2016) (rejecting patent owner’s argument that it reasonably could not have obtained supplemental information earlier because it was unaware of petitioner’s objections until petitioner made them).

The Board also denies motions to submit supplemental information when the other party would be prejudiced by the new evidence and arguments. *See, e.g., Hyberbranch Med. Tech., Inc. v. Incept LLC*, IPR2016-01836, Paper 32 at 6 (P.T.A.B. Oct. 30, 2017) (“Filing the documents as late supplemental information would, therefore, add information to the record in an untimely manner prejudicing Petitioner.”); *Polycom, Inc. v. Directpacket Research, Inc.*, IPR2019-01235, Paper 56 (P.T.A.B. Sept. 14, 2020).

Even if PO met the requirements of Section 42.123—which it does not—the Board has discretion to deny the motion. *Redline Detection, LLC v. Star*

---

<sup>2</sup> Emphasis added unless noted.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.