

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRILLER, INC.,
Petitioner,

v.

TIKTOK PTE. LTD.,
Patent Owner.

IPR2022-00179 (Patent 9,648,132 B2)
IPR2022-00180 (Patent 9,992,322 B2)¹

Before JOHN D. HAMANN, MICHAEL T. CYGAN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

¹ The parties are not permitted to use this style unless authorized by the Board.

I. INTRODUCTION

We authorized Triller, Inc. (“Petitioner”) to file a Motion to Submit Supplemental Information (Paper 11,² “Motion”), TikTok Pte. Ltd. (“Patent Owner”) to file an Opposition (Paper 12, “Opp.”) to the Motion, and Petitioner to file a Reply (Paper 14, “Reply”) to the Opposition. In its Motion, Petitioner seeks authorization to submit the Supplemental Declaration of Michael Shamos, Ph.D. (Exhibit 1031). Motion 1. Upon consideration of the papers, and for the reasons stated below, we *deny* the Motion.³

II. ANALYSIS

The requirements for filing a motion for the submission of supplemental information once an *inter partes* review (“IPR”) has been instituted—as is the case here (Paper 9, “Dec. on Inst.”)—are as follows: “(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 must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). Petitioner meets both of these requirements, which is not in dispute. Motion 2; *see generally* Opp.

These requirements, however, only set forth the conditions to permit filing a motion. Section 42.123(a) does not provide that we must grant the motion so long as it is timely and relevant. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015). “Rather, timeliness and relevancy provide additional requirements that must be construed within

² The papers cited herein are substantively identical and have the same paper numbers for both cases.

³ We previously informed the parties that Petitioner’s Motion was denied. This Order formalizes that denial and provides our reasoning.

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the overarching context of the PTAB’s regulations governing IPR and general trial proceedings.” *Id.* at 446. Moreover, our “guiding principle . . . in making any determination is to ‘ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.’” *Id.* at 445 (citing 35 U.S.C. § 316(b)). Accordingly, when determining if a party may submit supplemental information, it is important to consider how supplemental information fits within the context of *inter partes* reviews.

Parties generally submit evidence to support positions in a brief. What makes supplemental information unique is that it is a submission of evidence itself, separate and apart from any brief. Petitioner bears the burden of establishing why we should allow the submission of such evidence now. 37 C.F.R. § 42.20(c).

Here, Petitioner submits that the supplemental declaration addresses three categories of issues:

(1) issues unanticipated by Petitioner, raised by Patent Owner for the first time in the Patent Owner Preliminary Response, and addressed by the Board in the Institution Decision (“Category 1”), (2) issues of inherency which the Board addressed in the Institution Decision and requested the parties to further address during trial (“Category 2”), and (3) passages identified for the first time in the Patent Owner Preliminary Response (and then addressed in the Institution Decision) alleged to disclose claimed subject matter in the May 2007 PCT application priority document (“Category 3”).

Motion 1. In short, Petitioner now seeks to provide arguments via the supplemental declaration for issues addressed by Patent Owner in its Preliminary Response or by us in the Decision on Institution. *Id.* We view

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this as unwarranted.⁴ *See Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 21 at 3 (PTAB Sept. 10, 2018) (“The provision for submitting supplemental information is not intended to offer a petitioner a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a preliminary response.”); *American Well Corp. v. TelaDocHealth, Inc.*, IPR2021-00748, Paper 23 at 6–7 (PTAB Feb. 28, 2022) (gathering cases and finding that the Board has denied motions for supplemental information “where the petitioner sought to use the supplemental information to refine or bolster challenges originally presented in the petition, based on information in the preliminary response or institution decision”) (citations omitted).

Moreover, Petitioner has not shown good cause for submitting supplemental information to address these issues. First, we are not persuaded by Petitioner’s argument that we should allow the supplemental declaration now so that Patent Owner would be able to cross-examine Dr. Shamos on both his initial and supplemental declarations at the same time. *See, e.g.*, Motion 6 (citing *Pacific Market Int’l LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 4 (PTAB Dec. 2, 2014)). As Patent Owner argues, “there is currently no paper of record that cites to Dr. Shamos’s supplemental declaration,” and “[i]t is therefore unclear how [Petitioner] plans to rely on this additional testimony.” Opp. 6. Second, we are not persuaded that allowing the supplemental declaration now would decrease the number of depositions, as Petitioner argues. Motion 6 (citing

⁴ Our Order does not reach whether the proffered supplemental declaration (Exhibit 1031) is of a proper scope to be submitted with Petitioner’s Reply. Rather, we will address that issue, if needed, based on our Rules concerning reply evidence at that time.

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Pacific Market, Paper 23 at 4). Rather, we agree with Patent Owner that Petitioner “has made no assurances that it will not submit additional declaration testimony from Dr. Shamos (or another expert) with its Petitioner’s Reply,” which “may require further deposition with respect to that testimony.” Opp. 7; *see also* Reply 2 (acknowledging that “there may well be two depositions of Dr. Shamos”). Third, we find unavailing Petitioner’s argument that by allowing the supplemental declaration now that “Patent Owner will have ‘the opportunity to provide testimony from its own expert witness in response to [Dr. Shamos’s] testimony as part of its Patent Owner Response.’” *E.g.*, Motion 6 (quoting *Pacific Market*, Paper 23 at 4) (alteration in original). Patent Owner’s opposition to Petitioner’s Motion shows that Patent Owner does not view this opportunity as a sufficient reason for allowing the supplemental declaration now. We will not second-guess Patent Owner as to whether it should forego this opportunity.

In addition, we note that although Petitioner relies on reasoning from *Pacific Market*, Petitioner does not address substantive changes to the briefing process since *Pacific Market* was entered. In particular, Petitioner does not account for what impact, if any, the following changes have on the cited reasoning from *Pacific Market*: (i) a petitioner, in its reply brief, may address issues discussed in the institution decision; and (ii) a patent owner may file a sur-reply as a matter of right. *See* Consolidated Trial Practice Guide (“CTPG”) (Nov. 2019)⁵, 73.

In addition, we do not view our statements in the institution decision that the parties should consider addressing certain issues during trial as inviting supplemental information, as Petitioner argues. *See* Motion 9–10;

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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