IPR2023-00701 (U.S. Patent No. 8,510,407) PO's Opposition

UNITED STA	ATES PATENT AND TRADEMARK O	FFICE
BEFORE TI	HE PATENT TRIAL AND APPEAL BO)ARD
SAI	MSUNG ELECTRONICS CO., LTD., Petitioner	

v.

DODOTS LICENSING SOLUTIONS LLC, Patent Owner

Case IPR2023-00701 U.S. Patent No. 8,510,407 B1

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



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I. Introduction.

Patent Owner opposes Petitioner's Motion to Submit Supplemental Information pursuant to 37 C.F.R. §42.123(a). Specifically, though Petitioner claims that it is seeking to submit a supplemental Schmidt declaration that supposedly provides "clarification from Dr. Schmidt regarding the claim construction standard that he relied upon in his providing his opinion," in reality, it is an amended and new declaration that seeks to bolster deficiencies in its Petition. Motion at 1. Petitioner tries to do far more with Dr. Schmidt's purported supplemental declaration—not only does Dr. Schmidt state in a conclusory manner that he used the *Phillips* standard to construe the challenged claims, his supplemental declaration also makes substantive changes to Petitioner's invalidity arguments by modifying citations, adding new citations, omitting figures, and, in the process, altering certain invalidity arguments. Allowing Petitioner to make such after-the-fact changes to its arguments is improper and prejudicial to the Patent Owner. As a result, this Board should deny the Petitioner's request to file this supplemental declaration.

II. Samsung's motion fails under 37 CFR § 42.123(a).

Samsung moves to submit a revised Schmidt declaration as supplemental information under 37 C.F.R. § 42.123(a), which in relevant part provides, "the supplemental information must be relevant to a claim for which a trial has



been instituted." In other words, any supplemental information must be relevant to a claim as opposed to a ground for which trial has been instituted. This distinction was drawn by the Federal Circuit in *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435 (Fed. Cir. 2015) where the petitioner sought to submit a supplemental declaration that changed the grounds for which trial was instituted. The Federal Circuit, in affirming the PTAB's denial of Redline's request, found that 37 C.F.R. 42.123(a) "does not offer a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary Response . . . [and that Petitioner] should not expect a 'wait and see' opportunity to supplement a petition after initial comments or argument have been laid out." *Id.* This is exactly what Samsung is attempting here.

Samsung moves to submit a supplemental declaration from Dr. Schmidt to purportedly provide clarification regarding the claim construction standard that he used when opining on the validity of the challenged claims. Mot. at 1. But a closer review of the supplemental declaration reveals that Samsung is attempting to do more—namely, Samsung is trying to clean up and bolster deficiencies in its invalidity positions after seeing DoDots' POPR and Preliminary Sur-Reply. For example, though paragraph 54 in Dr. Schmidt's original declaration cites to a single paragraph (paragraph 29) to support an argument, the Supplemental Declaration cites to Section I.C.2. Likewise, in paragraph 63 of his original



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