

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GROUP III INTERNATIONAL, INC. and EVERKI USA, INC.,  
Petitioner,

v.

TARGUS INTERNATIONAL LLC,  
Patent Owner.

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IPR2021-00371  
Patent 8,567,578 B2

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Before JAMES J. MAYBERRY, FREDERICK C. LANEY, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request on Rehearing of Decision Granting  
Petitioner's Motion to Submit Amended Declaration  
*35 C.F.R. § 42.71(d)*

## I. INTRODUCTION

Targus International LLC (“Patent Owner”) filed a Request for Rehearing (Paper 41, “Req. Reh’g”) of the Board’s Decision Granting Petitioner’s Motion to Submit Amended Declaration (Paper 33, “Decision” or “Dec.”). For the reasons set forth below, Patent Owner’s Request is *denied*.

## II. BACKGROUND

Group III International, Inc. and Everki USA, Inc. (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 1–6, 12–14, 17–19, 21–24, 27–33, 38, 39, and 42–57 (“the challenged claims”) of U.S. Patent No. 8,567,578 B2 (Ex. 1002, “the ’578 patent”). Paper 3 (“Pet.”), 3. Targus International LLC (“Patent Owner”) filed a Preliminary Response. Paper 14. We instituted *inter partes* review on July 9, 2021. Paper 21 (“Inst. Dec.”).

On July 23, 2021, Patent Owner filed Objections to Petitioner’s Evidence in which Patent Owner objected to the declaration of Petitioner’s expert witness, Mr. Godshaw, for a variety of reasons, including the improper incorporation of claim charts filed as exhibits. Paper 23, 1. In response, Petitioner filed a motion seeking authorization to file an amended declaration of Mr. Godshaw that included the text of these claim charts. Paper 26 (“Motion”). Patent Owner filed an opposition to the Motion. Paper 31 (“Opposition” or “Opp.”). We granted Petitioner’s Motion. Dec. 6.

### III. ANALYSIS

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *Id.*

Patent Owner presents two arguments in support of its Request for Rehearing. Reg. Reh’g 1. First, Patent Owner argues that the Decision “violated the AIA by departing from the Petition and changing the IPR grounds after institution.” *Id.* Patent Owner argues that, because “the Board held at institution that the Petition in this IPR excludes the claim charts added to the amended Godshaw declaration,” it follows that “the claim charts cannot be relevant to an instituted claim.” *Id.* at 2–3 (emphasis omitted).

In the Institution Decision, we noted that the Petition referenced claim charts filed as exhibits and stated “[t]o the extent Petitioner attempts to incorporate arguments from the exhibits into the Petition, we do not consider such arguments.” Inst. Dec. 28. However, this does not mean that the claim charts are not relevant to a challenged claim. As we explained in the Decision, “information is relevant if ‘it has any tendency to make a fact more or less probable than it would be without the evidence’ and ‘the fact is of consequence in determining the action.’” Dec. 4–5 (quoting Fed. R. Evid. 401) (citing 37 C.F.R. § 42.62). As we also noted in the Decision, “[t]he Petition relies on Mr. Godshaw’s declaration.” *Id.* at 5 (citing Pet. 55). “Thus, Mr. Godshaw’s testimony, including the added claim charts, is relevant to a claim for which trial has been instituted.” *Id.* Patent

Owner fails to explain adequately how we misapprehended or overlooked any matter in determining the added claim charts to be relevant to a challenged claim.

Similarly, Patent Owner fails to explain adequately how allowing Petitioner to file an amended declaration of Mr. Godshaw changes the grounds challenging the '578 patent claims as set forth in the Petition. *See* Req. Reh'g 1. To the contrary, the Petition has not been modified. Allowing Petitioner to file an expert declaration amended to include language filed initially as exhibits does not alter any aspect of the Petition. *See* Dec. 5 (“Petitioner seeks to amend Mr. Godshaw’s declaration, not the Petition.”).

Next, Patent Owner argues that the Decision violated the Administrative Procedure Act (“APA”) by ignoring rules limiting petitions for *inter partes* review to 14,000 words and prohibiting the incorporation of arguments by reference. Req. Reh'g 3–5. Regarding the word limit, Patent Owner argues that “[a]llowing Petitioner to submit an amended declaration with 138 pages of claim charts is . . . an end-run around the 14,000-word limit for Petitions.” *Id.* at 4. Regarding incorporation by reference, Patent Owner argues that “[t]he Board refused at institution to consider the four claim charts because they violated the rule on incorporation by reference.” *Id.*

As a preliminary matter, we disagree with Patent Owner’s characterization of the Institution Decision. As noted above, we explained in the Institution Decision that we did not consider the referenced exhibits to be part of the Petition. *See* Inst. Dec. 28. We did not, however, refuse “to consider the four claim charts” as asserted by Patent Owner. Req. Reh'g 4.

Patent Owner's arguments to the contrary fail to explain adequately how we misapprehended or overlooked any matter in determining the added claim charts to be relevant to a challenged claim.

Allowing Petitioner to file an amended expert declaration is not an "end-run around" the word limit for petitions because the Petition has not been amended. Patent Owner's arguments to the contrary are reiterations of its arguments in the Opposition, which we addressed in the Decision:

Patent Owner insinuates repeatedly that the amended declaration would alter the asserted grounds of unpatentability set forth in the Petition. *See, e.g.,* Opp. 2. However, *Petitioner seeks to amend Mr. Godshaw's declaration, not the Petition.* Furthermore, the original declaration sought to incorporate the claim charts Petitioner seeks to add to the declaration. . . . These attempts to incorporate the claim charts into the original declaration provide ample notice that Mr. Godshaw relied upon the arguments set forth therein. As we previously noted (*see* Paper 24, 3), Petitioner filed the claim charts on the same day that it filed the Petition. *Adding the language from the exhibits into the declaration neither changes the evidence relied upon in the Petition nor violates any word count requirement.*

Dec. 5 (emphases added). Patent Owner's arguments fail to explain adequately how we misapprehended or overlooked any matter or violated the APA in determining the added claim charts not to add any words to the Petition itself, and, thus, did not waive the rule directed to word limits.

#### IV. CONCLUSION

For the reasons discussed above, we deny Patent Owner's Request for Rehearing because we determine that Patent Owner has not met its burden to show that in the Decision, the panel misapprehended or overlooked any matter.

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V. ORDER

In consideration of the foregoing, it is hereby ordered that Patent Owner's Request for Rehearing is *denied*.

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