

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOBEBE US INC.,
Petitioner,

v.

MAYBORN (UK) LIMITED,
Patent Owner.

IPR2023-00465
Patent 11,207,244 B2

Before ULRIKE W. JENKS, MICHAEL L. WOODS, and
CYNTHIA M. HARDMAN, Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

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

A teleconference was held on July 25, 2023, granting Petitioner, Nanobebe US Inc., authorization to file a motion to submit supplemental information. *See* Paper 14; Ex. 3001. On August 2, 2023, Petitioner filed a motion to submit supplemental information under 37 C.F.R. § 42.123(a) including Appendix A and B in this proceeding. Paper 16 (“Motion” or “Mot.”).¹ Patent Owner, Mayborn (UK) Limited, opposes this request. Paper 17 (“Opp.”).

For the reasons discussed below, the Motion is *denied*.

The requirements for submission of supplemental information under 37 C.F.R. § 42.123(a) are as follows:

(a) *Motion to submit supplemental information*. Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

- (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.
- (2) The supplemental information must be relevant to a claim for which the trial has been instituted.

With respect to the first requirement, we agree with Petitioner that the request for the authorization was made within one month of the date the trial was instituted in this proceeding. *See* Mot. 2; Paper 14, 2; Paper 11 (“Decision” or “Dec.”); Ex. 3001. Patent Owner does not dispute that the request for authorization was made within the one-month time period. *See generally* Opp.

¹ Petitioner initially filed the motion to submit supplemental information on July 28, 2023, with Appendix A and B highlighted instead of redlined. Paper 15 (now expunged); *see* Exs. 3002, 3003.

As to the second requirement, Petitioner argues that the “Supplemental Information is relevant to the unpatentability of instituted Claim 23” in accordance with 37 C.F.R. § 42.123(a), by addressing issues “relevant to a claim for which the trial has been instituted and should be considered.” Mot. 2–3.

Patent Owner argues that even though Petitioner has met the minimum requirements set forth in § 42.123(a), the Board should exercise its discretion and deny the Motion because “Petitioner’s proposed expansion of Ground 1 ‘goes beyond merely supplementing [Petitioner’s] position—it changes it entirely.’” Opp. 2 (citing *Am. Well Corp. v. TelaDoc Health, Inc.*, IPR2021-00748, Paper 23 at 13). Patent Owner contends that “Petitioner seeks to introduce new analysis on a claim not presently challenged in Ground 1. . . . [In other words,] Petitioner is trying to create a new position on Claim 23 that does not exist.” *Id.*

Although Petitioner’s request was timely and the information appears relevant to a claim instituted at trial, we are not persuaded that the supplemental Petition and Declaration should be entered in this proceeding. Here, Petitioner seeks to bolster its Petition by including further analysis and arguments with respect to the Ishimaru reference (Ex. 1008) as it applies to omitted claim 23 in Ground 1 (*see* Mot. Appendix A ¶¶ 416–420, and Appendix B, 42) as identified in our institution decision. *See* Dec. 6 (identifying asserted grounds of unpatentability that does not include claim 23), 17 (identifying claims associated with Ground 1 and does not include claim 23), 31, 37. We note that neither the initial Petition nor the initial Declaration discusses how Ishimaru (Ex. 1008) discloses the subject matter of claim 23.

On this record, therefore, it appears that Petitioner is trying to modify the Petition and Declaration by including arguments with respect to the subject matter found in claim 23 as it applies to Ground 1 that were not included with the initial Petition or Declaration. *See* Mot. 4. Here, the discussion of the subject matter of claim 23 as set out in Ground 2 simply references back to the omitted discussion of claim 23 in Ground 1. *See* Pet. 59. Thus, the supplemental information Petitioner seeks to add with its motion would impact both Grounds 1 and 2 as set out in the Petition.

Our regulations require that the Petition must “[p]rovide a statement of the precise relief requested for each claim challenged,” including “[h]ow the construed claim is unpatentable,” “where each element of the claim is found in the prior art,” and “identifying specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b). Denying entry of supplemental information that effectively changes the argument and evidence originally relied upon in a petition – whether inadvertently omitted or not – is in accord with the statutory requirement that a petition must identify, with particularity, the evidence supporting the challenge to each claim. *See Am. Well Corp.*, IPR2021-00748, Paper 23 at 13 (citing 35 U.S.C. § 312(a)(3) (“the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim”)).

Petitioner argues that it intended to include claim 23 not only in Ground 2 but also in Ground 1. In support of this position, Petitioner directs attention to the table of contents found in Mr. Silver’s Declaration that shows “Error! Bookmark not defined” associated with claim 23 under

Ground 1 in the table of contents. *See* Mot. 4; Ex. 1005, 4 (Table of Contents), ¶¶ 505–509. We note that the discussion of claim 23 in the Petition and Declaration with respect to Ground 2 only references the omitted discussion of that subject matter of Ground 1. *See* Pet. 59; Ex. 1005 ¶ 506 (“I incorporate my Ground 1 of the ’244 Patent analysis in the *Ishimaru-Atkin* combination”). Because neither the Petition nor the Declaration discusses how *Ishimaru* meets the elements of claim 23, introducing this discussion now would incorporate a new analysis into both grounds of unpatentability asserted in the Petition.

We agree with Patent Owner that Petitioner has not identified any precedent or rule that suggests we can simply correct errors and omissions in a petition using supplemental information that results in the addition of a new analysis. Opp. 2 (citing *Am. Well Corp.*, IPR2021-00748, Paper 23 at 13 (“Petitioner identifies no statute, regulation, or Board decision as precedent permitting it to use supplemental information to fill the type of evidentiary void (whether inadvertent or not) left open by the Petition.”); *Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 20 at 3 (“Nor should the proposed supplemental information change any grounds of unpatentability that were authorized in this proceeding[.]”)).

Additionally, Petitioner has not sufficiently explained why the supplemental information could not have been presented earlier. *See* Ex. 1005, 4 (“Error! Bookmark not defined”). There is no reason why Petitioner should expect the Board or Patent Owner to identify these types of errors and omissions in the Petition, when such errors could have easily been identified by Petitioner prior to filing the Petition. The Board may take into account under 37 C.F.R. § 42.123(a) whether the supplemental information

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was reasonably available to the Petitioner at the time the Petition was filed. *See Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 448 (Fed. Cir. 2015).

Accordingly, we are not persuaded that Petitioner has shown sufficiently that it is entitled to submit a revised Petition and Declaration as supplemental information in this proceeding at this time.

ORDER

In consideration of the foregoing, it is
ORDERED that the Motion to submit supplemental information under 37 C.F.R. § 42.123(a) is *denied*.

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