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# Motions to Submit Supplemental Information: An Infrequently Utilized Procedure

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## INTRODUCTION

Timely motions to submit supplemental information provide a vehicle for parties, typically petitioners, to supplement their case after an institution decision but before a Patent Owner Response in post-grant proceedings before the Patent Trial and Appeal Board (PTAB). Although uncommon (697 Motions decided in 7,711 instituted IPR/PGR/CBM trials from 2012-2022), submission of supplemental information can blunt allegations that evidence is untimely (e.g., Petitioner evidence otherwise submitted with a Petitioner Reply). This paper reviews the history of the PTAB's treatment of motions to submit supplemental information and discusses recent cases to illustrate the proper use of this procedure.

### I. BACKGROUND

The Leahy-Smith America Invents Act of 2011 (AIA) established new post-grant proceedings, including post-grant review (PGR), inter partes review (IPR), and transitional post-grant review of covered business method patents (CBM),<sup>[505]</sup> to challenge patents to create a more efficient and transparent patent system.<sup>1</sup> The AIA concurrently established the Patent Trial and Appeal Board (PTAB) to govern these proceedings.<sup>2</sup> PTAB rules and policies involving such proceedings encourage Petitioners to set forth their best grounds of unpatentability and support their petitions with *all* available evidence to avoid the risk that the PTAB does not institute review.<sup>3</sup> Evidence deemed not timely submitted with the petition runs the risk of not being considered in a final written decision.<sup>4</sup> Motions to submit supplemental information (herein also referred to as “Supplemental Motion(s)”) are available after institution to allow movants, in some stances, to supplement their case.<sup>5</sup>

Supplemental information is evidence submitted after the institution and apart from parties' other briefs that supports an argument on the merits.<sup>6</sup> Supplemental information is authorized only if a Motion to file is first authorized and then subsequently granted.<sup>7</sup> If the PTAB authorizes a Motion,

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1. See 125 Stat. 284.

2. Leahy-Smith America Invents Act § 6, Pub. L. No. 112-29, 125 Stat. 284, 299-313 (2011).

3. Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680, 48,707-08 (Aug. 14, 2012) (hereinafter Changes to Implement).

4. See 37 C.F.R. § 42.23(b); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (determining that the Board did not abuse its discretion in refusing to consider reply brief arguments advocating a “new theory” of unpatentability under 37 C.F.R. § 42.23(b)).

5. See 37 C.F.R. § 42.123.

6. *HandiQuilter, Inc. v. Bernina Int'l AG*, Case No. IPR2013-00364, slip op. at 2-3 (P.T.A.B. Jun. 12, 2014) (Paper 30). This is contrasted with supplemental evidence, which is offered solely to support admissibility of previously filed evidence. *Id.*; see also 37 C.F.R. § 42.64(b)(2).

7. *HandiQuilter*, Case No. IPR2013-00364, slip op. at 2-3.

it does not mean that the Motion will necessarily be granted.<sup>8</sup> Once the PTAB grants permission to file a Motion, the movant files its Motion, and the non-movant may file an opposition.<sup>9</sup> The burden is on the moving party to persuade the PTAB that it is entitled to the requested relief.<sup>10</sup> The PTAB has wide discretion to deny or grant a Motion.<sup>11</sup>

Motions to Submit Supplemental Information are either timely or untimely.<sup>12</sup> A timely Motion is filed within one month of the institution of the proceeding and must show why the supplemental information is relevant to a claim for which trial is instituted.<sup>13</sup> Given the filing timing of a timely motion, Petitioners typically file their timely Motions to supplement their Petitions before the Patent Owner Response.<sup>14</sup> A Motion is untimely if it is filed more than one month after the trial date institution, where the moving party must further show why the information reasonably could not have been obtained earlier and its entry in the interests of justice.<sup>15</sup>

There are limits to filing supplemental information beyond the basic requirements of the rules. For example, PTAB decisions state that Motions may be denied where they attempt to change the grounds of unpatentability of the Petition,<sup>16</sup> include information that could have been filed earlier,<sup>17</sup> or seek to bolster deficiencies in the Petition.<sup>18</sup> Furthermore, the Board has stated that the filing of Supplemental Information should not alter the schedule of the proceeding.<sup>19</sup> Moreover, a Motion to Submit Supplemental

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8. *See, e.g., Pacific Mkt. Int'l, LLC v. Ignite USA, LLC*, Case No. IPR2014 00561, slip op. at 3 (P.T.A.B. Dec. 2, 2014) (Paper 23).

9. Changes to Implement, *supra* note 3, at 48,716.

10. 37 C.F.R. § 42.20(c).

11. *See generally* 37 C.F.R. § 42.123(a)-(b).

12. *See* 37 C.F.R. § 42.123(a); *Azure Gaming Macau, Ltd. v. MGT Gaming, Inc.*, Case No. IPR2014-01288, slip op. at 3 (P.T.A.B. Dec. 4, 2014) (Paper 9); *BioMarinPharm. Inc. v. Duke Univ.*, Case No. IPR2013-00535, slip op. at 2 (P.T.A.B. Dec. 31, 2013) (Paper 15).

13. 37 C.F.R. § 42.123(a).

14. After institution of a proceeding, patent owners are typically given three months to file a response to the petition addressing any grounds not already denied. *See* 37 C.F.R. § 42.120. Therefore, Motions to Submit Supplemental Information are less likely to be a tool used by a patent owner after institution as the Patent Owner Response would give them ample opportunity to provide supplemental information for their case. However, patent owners may also file such Motions. 37 C.F.R. § 42.123; *see, e.g., Group III Int'l, Inc. v. Targus Int'l LLC*, Case No. IPR2021-00371, slip op. at 3–5 (P.T.A.B. Mar. 28, 2022) (Paper 76) (granting patent owner's Motion under §42.123(b) to file as Supplemental Information documents that had been presented in post-Reply deposition).

15. 37 C.F.R. § 42.123(b). Unlike “timely” Motions, Motions under § 42.123(b) are filed by both petitioners and patent owners as needed to provide information that may not have been available earlier. *Id.*

16. *See, e.g., B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, Case No. IPR2014-01510 (P.T.A.B. Apr. 28, 2015) (Paper 37); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case No. IPR2013-00369 (P.T.A.B. Feb. 5, 2014) (Paper 37).

17. *Rackspace US, Inc. v. Personal Web Techs., LLC*, Case No. IPR2014-00057, slip op. at 4 (P.T.A.B. Apr. 30, 2014) (Paper 16).

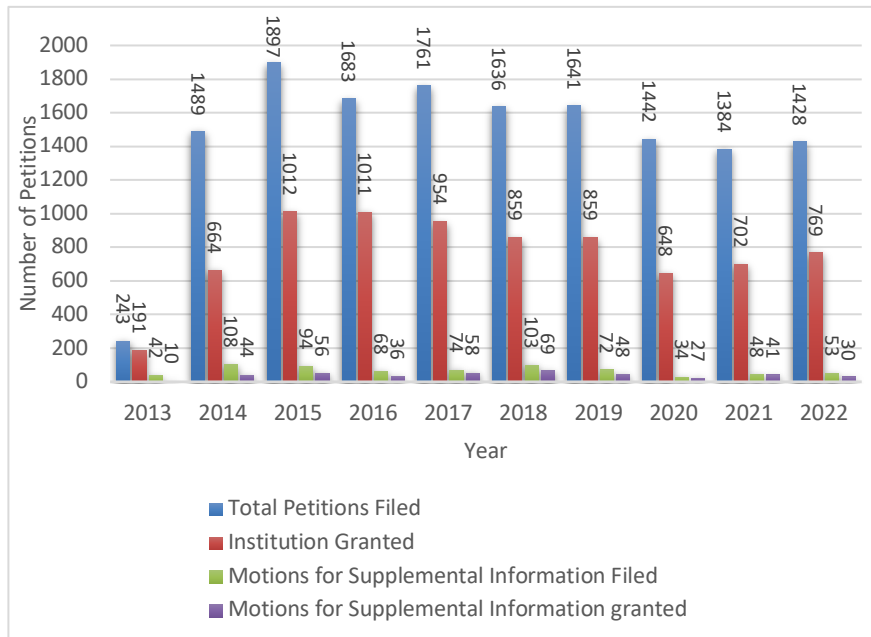
18. *Pacific Mkt. Int'l, LLC v. Ignite USA, LLC*, Case No. IPR2014-00561 (P.T.A.B. Dec. 2, 2014) (Paper 23).

19. *Rackspace US, Inc.*, Case No. IPR2014-00057 at 4-5.

Information that meets these requirements may still be denied if it does not comport with the PTAB's obligation to ensure the Office's efficient administration and ability to timely complete proceedings.<sup>20</sup> A successful motion to submit supplemental information will generally not stray beyond these limitations.

## II. THE STATISTICS BEHIND MOTIONS TO SUBMIT SUPPLEMENTAL INFORMATION

Motions to submit supplemental information have been infrequently utilized. Figure 1 shows the number of IPR, PGR, and CBM Petitions filed each year, the number of petitions granted institution each year, the number of motions filed each year, and the number of motions granted each year.<sup>21</sup>



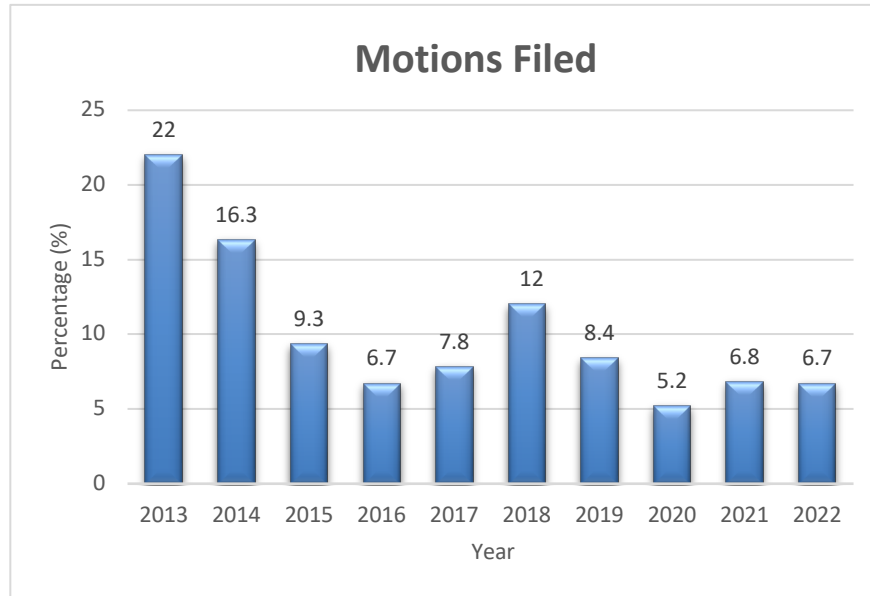
**Figure 1. Frequency of Motions for Supplemental Information filed, and granted per petition, annually.**<sup>22</sup>

20. *See Sling TV, LLC et al. v. Realtime Adaptive Streaming LLC* (IPR2018-01342)(Paper 17); *Merck Sharp & Dohme Corp. et al. v. GlaxoSmithKline Biologicals SA* (IPR2018-01234)(Paper 21).

21. *Trial statistics archive*, USPTO <https://www.uspto.gov/patents/ptab/statistics/aia-trial-statistics-archive> [<https://perma.cc/6Z5B-J4MG>] (hereinafter "Trial Stats"); <https://search.docketnavigator.com/patent/search>. See footnotes Figures 1 and 2 for more detail.

22. *Trial Stats*, *supra* note 21. Data for the Total Petitions filed and Institution Granted was found in the USPTO AIA Trial Archives. <https://www.uspto.gov/patents/ptab/statistics/aia-trial-statistics-archive> [<https://perma.cc/6Z5B-J4MG>]; Data for the Motions for Supplemental Information Filed and Granted was extracted from Docket Navigator using the Document Search Tool, where Type of Document selected is PTAB Motion to Submit Supplemental Information and filtered by Document Filing Date based on the year. [https://search.docketnavigator.com/patent/search/patent\\_events](https://search.docketnavigator.com/patent/search/patent_events). The last search was conducted on 2/20/2023.

On average, about 1,600 Petitions are filed annually, of which a little over half are instituted.<sup>23</sup> In the last few years, the number of Petitions has been below 1,600, but Petition filing rates are relatively stable.<sup>24</sup> Filing rates at which Motions to Submit Supplemental Information are filed have been consistently low.<sup>25</sup> As illustrated in Figure 2, Motions to Submit Supplemental Information all-time have been filed in 8-9% of the proceedings that are instituted.<sup>26</sup> This number has decreased to about 5-6% in recent years.<sup>27</sup>



**Figure 2 Percentage of Instituted Trials Where Motions Were Filed.<sup>28</sup>**

As shown in Figure 3, Motions have been consistently granted between 60-80% of the time since inception.<sup>29</sup>

23. *Trial Stats*, *supra* note 21. The data from 2014-2022 was averaged from the USPTO statistics archive. 2013 was omitted as it was the first year these proceedings were implemented and is not reflective of subsequent practice. 2023 was omitted as the USPTO has not yet posted complete statistics for the year.

24. *See* Figure 1.

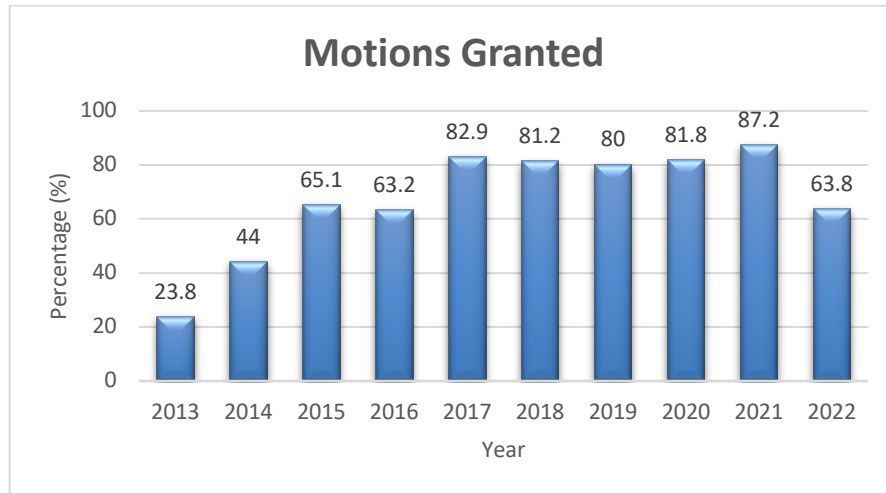
25. *See* Figure 1; *see also* Figure 2.

26. *See* Figure 2.

27. *See* Figure 2.

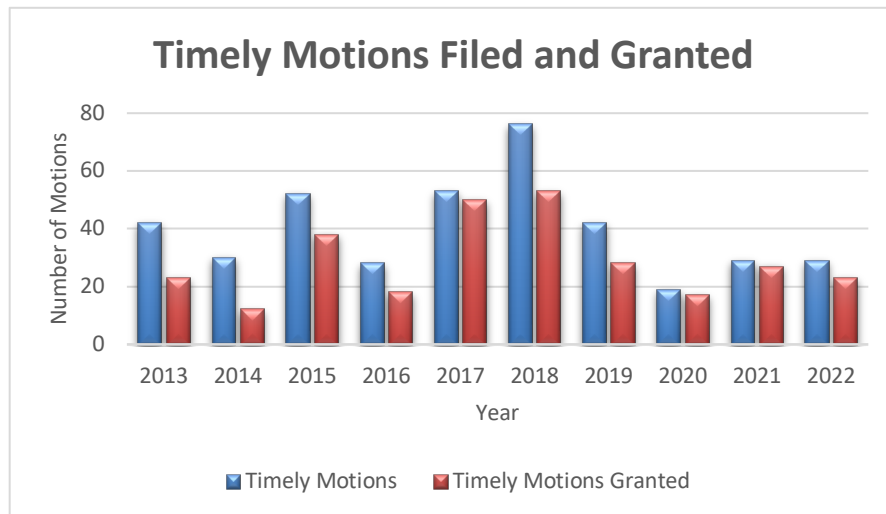
28. The data from Figure 1 was used to calculate the percentages. The number of Motions to Submit Supplemental Information filed were divided by the number of Petitions that were granted institution.

29. *See* Figure 3.



**Figure 3 Percentage of Motions Granted.<sup>30</sup>**

Since 2013, timely Motions, the more commonly filed type of Motion, 31 are granted about 72% of the time, as shown in Figure 4.32



**Figure 4 Number of § 42.123(a) (or “Timely”) Motions Filed and Granted<sup>33</sup>**

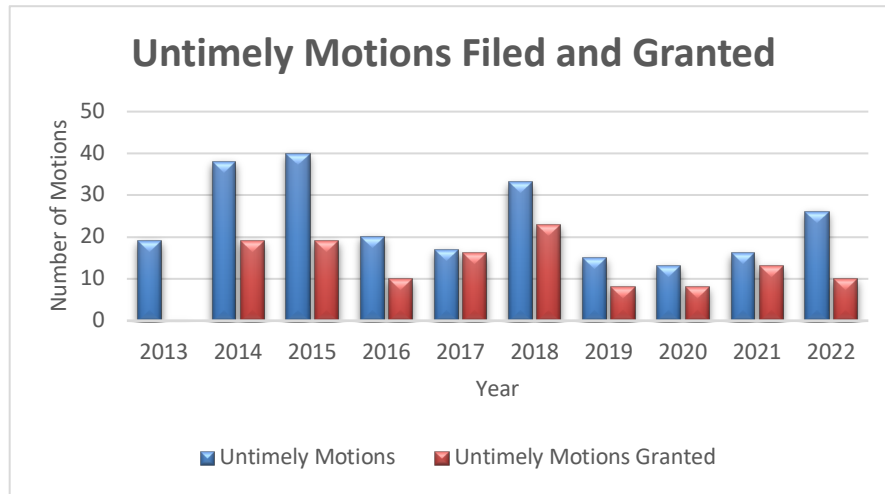
30. Using the data from Figure 1, the number of Motions granted was divided by the number of Motions Granted plus the number of motions denied filed to calculate the Percentage of Motions Granted. Thus, this value does not include motions that were denied in part, denied without prejudice or denied as moot.

31. See Figures 4 & 5.

32. See Figure 4; the sum of § 42.123(a) (or “timely”) Motions granted was divided by the sum of timely Motions filed based on the data collected for Figure 4 to obtain the percentage of the overall Motion grant rate.

33. In Docket Navigator, the following search terms were used: where Type of Document selected is “PTAB Motion to Submit Supplemental Information,” document text for Timely Motions was

In contrast, as shown in Figure 5 (or “untimely”), Motions have a lower overall grant rate; only 53% of untimely Motions filed since 2013 have been granted.<sup>34</sup>



**Figure 5 Number of § 42.123(b) (Or “Untimely”) Filed Motions and Granted.<sup>35</sup>**

These statistics demonstrate that while Motions are only filed in roughly 8-9% of cases since the inception of post-grant proceedings, they have a high rate of being granted. “Timely” Motions are granted over 70% of the time, while “untimely” Motions are granted over 50% of the time.

Motions to Submit Supplemental Information are a tool that parties to post-grant proceedings before the PTAB should consider utilizing more often after institution.

### III. RECENT SUPPLEMENTAL INFORMATION CASES

Reviewing recent supplemental information cases suggests some possibly significant distinctions between successful and unsuccessful Motions. Five illustrative cases decided in 2022 are summarized below to show the PTAB’s recent treatment of motions for supplemental information.

“42.123(a)” and filtered by Document Filing Date based on the year. To obtain the Number of Motions granted, these were further filtered by Result of Motion, where “Granted” was selected. [https://search.docketnavigator.com/patent/search/patent\\_events](https://search.docketnavigator.com/patent/search/patent_events).

34. See Figure 5.

35. In Docket Navigator, the following search terms were used: where Type of Document selected is “PTAB Motion to Submit Supplemental Information,” document text for Untimely Motions were “42.123(b)” and filtered by Document Filing Date based on the year. To obtain the Number of Motions granted, these were further filtered by Result of Motion, where “Granted” was selected. [https://search.docketnavigator.com/patent/search/patent\\_events](https://search.docketnavigator.com/patent/search/patent_events)



### A. “Timely” Motions (§ 42.123(a))

Timely Motions (i.e., those filed within one month of an institution of a proceeding) must establish how the information is relevant to a claim for an instituted trial.<sup>36</sup> The motion may not be granted even if the information is relevant. The PTAB must nonetheless ensure the Office runs efficiently and that the IPR proceedings are concluded promptly.<sup>37</sup> Further, “the PTAB has [the] discretion to grant or deny motions as it sees fit.”<sup>38</sup>

As noted above, grant rates for “timely” Motions are relatively high.<sup>39</sup> For example, in *Frameless Hardware Company LLC v. C.R. Laurence Co. Inc.*, the Petitioner successfully filed a Motion to Submit a Supplemental Declaration and was found to have demonstrated that its Motion was not an attempt to bolster weaknesses in its original Petition.<sup>40</sup> Specifically, the Petitioner sought to introduce a supplemental declaration by its expert witness, who built six physical models of structures disclosed in the Petition’s primary prior art references.<sup>41</sup> The Petitioner argued that the supplemental declaration would offer additional details on the models included in its expert’s initial declaration.<sup>42</sup> Because the models were not prior art and allegedly did not adequately demonstrate the teachings of the prior art references, the Patent Owner argued that the Supplemental Information was irrelevant.<sup>43</sup> Further, the Patent Owner asserted that the additional declaration could have been included in the original Petition, and the information was therefore improper.<sup>44</sup>

The PTAB granted the Motion and found that the supplemental declaration was relevant to the claims in the instituted trial.<sup>45</sup> The additional declaration “largely mirror[ed] his original declaration in subject matter” and expanded on the models that he relied on during his original testimony.<sup>46</sup> Furthermore, the supplemental declaration was properly tied to the Petition because the original declaration described the physical models in detail, and the supplemental declaration explained the construction of the models

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36. See 37 C.F.R. § 42.123(a)

37. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (rejecting proposition that “the PTAB must accept supplemental information if timely submitted and relevant”).

38. *Id.* at 446-47 (citing 37 C.F.R. § 42.5(a)-(b)). The Board has stated that § 42.123 should not be used as “a routine avenue for a petitioner to bolster deficiencies in a petition called out by patentee—it is not a ‘wait-and-see’ opportunity to fix what could and should have been addressed when the petition was filed.” *Stryker Corp. v. OsteoMed LLC*, Case No. IPR2021-01450 et al., slip op. at 4 (P.T.A.B. May 13, 2022) (Paper 20) (citing *Redline Detection*, 811 F.3d at 448).

39. *Supra* note 27.

40. *Frameless Hardware Co. LLC v. C.R. Laurence Co. Inc.*, Case No. IPR2022-00356, slip op. at 8-9 (P.T.A.B. Oct. 25, 2022) (Paper 29).

41. *Id.* at 4.

42. *Id.*

43. *Id.* at 4-5.

44. *Frameless Hardware*, Case No. IPR2022-00356 (P.T.A.B. Oct. 25, 2022) (Paper 29) at 5.

45. *Id.*

46. *Id.* at 7.

already discussed in the original declaration.<sup>47</sup> While the PTAB often cautions parties that Supplemental Information is not a “routine avenue” to bolster weaknesses in the Petition, the PTAB found in *Frameless Hardware Company* that the supplemental declaration was sufficiently aligned with the original declaration and provided additional details that would help the PTAB consider the weight of an expert’s opinions.<sup>48</sup>

Motions to submit supplemental information may also clarify information cited in the original Petition. *Celltrion Inc. v. Chugai Seiyaku Sabuskiki Kaisa* provides another example of Supplemental Information deemed not as bolstering deficiencies in a Petition but rather providing the PTAB with clarity.<sup>49</sup> In seeking admission of a declaration explaining how a person of ordinary skill in the art would understand a prior art reference, Petitioner satisfied both the timeliness and relevance requirements for submitting Supplemental Information.<sup>50</sup>

The PTAB then decided whether the Motion “comport[ed] with [their] guiding principles of efficiency.”<sup>51</sup> The Patent Owner did not dispute the Petitioner’s argument that the Motion would not delay the proceedings.<sup>52</sup> Rather, the Patent Owner argued that the Supplemental Information sought to bolster deficiencies in the original Petition that the PTAB’s Decision on Institution had pointed out.<sup>53</sup> Specifically, the PTAB’s institution decision found that the Petitioner would likely not prevail over the prior art reference relevant to the Motion.<sup>54</sup>

The PTAB disagreed with the Patent Owner and granted the Motion. It found that the Supplemental Information would explain why the PTAB’s interpretation of the prior art reference was incorrect and help understand the data cited by the reference.<sup>55</sup> The PTAB did not consider this to change the grounds of patentability or as providing information seeking to improperly bolster the Petition based on institution decision.<sup>56</sup> The PTAB found that this was a close call, where Patent Owner was correct that Supplemental Information included claim construction and obviousness arguments that went beyond clarifying the prior art reference.<sup>57</sup> Nevertheless, in granting the Motion, the PTAB concluded that admitting the additional declaration as

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47. *Id.* at 8.

48. *See id.* at 3, 5-9.

49. *See Celltrion, Inc. v. Chugai Seiyaku Kabuskiki Kaisa*, Case No. IPR2022-00578 (P.T.A.B. Oct. 25, 2022) (Paper 22).

50. *Id.* at 3.

51. *Id.*

52. *Celltrion*, Case No. IPR2022-00578 (P.T.A.B. Oct. 25, 2022) (Paper 22) at 3.

53. *Id.*

54. *Id.* at 3-4.

55. *Id.* at 4, 6.

56. *Id.* at 4-5.

57. *Id.* at 5.

Supplemental Information at this stage in the proceeding aligned with its goals of efficiency more than allowing the Petitioner to include it in its reply would.<sup>58</sup>

Contrast these cases with the outcome in *American Well Corporation v. Teladoc Health, Inc.*, where the PTAB denied a motion to submit supplemental evidence consisting of a supplemental declaration, and finding that the declaration sought to supplant the expert's original statements rather than to supplement them.<sup>59</sup> In that case, Petitioner wanted to introduce a supplemental declaration that addressed errors and omissions that the PTAB identified in its Institution Decision.<sup>60</sup> Similar to *Celltrion*, in its Institution Decision, the PTAB found that the Petition had not sufficiently shown that certain combinations of prior art taught the challenged claims.<sup>61</sup> Patent Owner argued that the Petitioner was changing its arguments to address deficiencies in the Petition that it should have addressed at the time of the Petition.<sup>62</sup> The PTAB agreed with the Patent Owner and denied the Motion. The PTAB found that the Supplemental Information introduced new citations and conclusions by the Petitioner's expert "that supplant, not supplement, the original motivation-to-combine argument in the Petition, which are specifically tailored to address the deficiencies identified by the Board."<sup>63</sup>

A fine line exists between bolstering a petition and supplementing it. But petitioners who can traverse this distinction via a timely filed motion to submit supplemental information may be able to clarify misunderstandings in institution decisions ahead of the patent owner's response, thus avoiding allegations of improper new evidence and argument in the petitioner's later reply.

#### B. "Untimely" Motions (42.123(b))

Introducing supplemental information more than a month after the date of institution is referred to as "untimely" and comes with a higher burden. The moving party must "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."<sup>64</sup> Nevertheless,

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58. *Id.* at 6 (citing *The Boeing Co. v. Levine*, Case No. IPR2015-01341, slip op. at 4–5 (P.T.A.B. Apr. 15, 2016) (Paper 30) (granting motion to submit supplemental declaration, stating that "inclusion of the evidence at this stage in the proceeding will provide Patent Owner with a greater opportunity to respond to the supplemental information and will further the Board's mandate to 'secure the just, speedy, and inexpensive resolution' of the proceeding").

59. *See Am. Well Corp. v. Teladoc Health, No. Inc.*, Case No. IPR2021-00748 (P.T.A.B. Feb. 28, 2022) (Paper 23).

60. *Id.* at 3.

61. *Id.* at 2.

62. *Id.* at 3.

63. *Id.* at 10.

64. 37 C.F.R. § 42.123(b).

much like some “timely” motions are denied, some “untimely motions” are granted.

*Fresenius Kabi USA v. Chugai Seiyaku Kabushiki* provides an example where the PTAB did not grant a Motion because it not only failed to meet the “interests-of-justice” burden under § 42.123(b), it also would have delayed the proceedings.<sup>65</sup> One day before its Sur-Reply, Patent Owner requested authorization to file a motion to submit supplemental information to provide evidence that would attempt to demonstrate that a prior art reference was publicly available as of the priority date for the challenged patent.<sup>66</sup> Patent Owner did not argue that the information could not have been obtained earlier, but that it did not appreciate that the prior art status was at issue until Petitioner contested the prior art’s public accessibility in its Reply.<sup>67</sup> Petitioner argued that the motion was prejudicial and did not meet the requirements of late submission of supplemental information.<sup>68</sup> The Board agreed with Petitioner and denied the motion.<sup>69</sup> The Board found that the requirements for supplemental information were not met and that the timing of the request was problematic with the current schedule.<sup>70</sup>

While untimely Motions will often be denied, as in *Fresenius Kabi*, that is not always the case. For example, in *Group III International, Inc v. Targus International LLC*, the PTAB granted a Patent Owner’s Motion for Supplemental Information to admit evidence contradicting the unpatentability opinion of Petitioner’s expert, which was first brought up in Petitioner’s reply.<sup>71</sup> There, Patent Owner presented two new pieces of evidence during the expert’s deposition: a patent issued to the expert and a web page from the expert’s company showing an anti-theft courier bag his company sold.<sup>72</sup> The next day, the Patent Owner asked for authorization to file a Motion under § 42.123(b).<sup>73</sup> In its Motion, the Patent Owner argued that it could not have reasonably obtained the evidence earlier because the Patent Owner was

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65. See generally *Fresenius Kabi USA, LLC et al v. Chugai Seiyaku Kabushiki Kaisha*, Case No. IPR2021-01025 (P.T.A.B. Sep. 6, 2022) (Paper 55); 37 C.F.R. § 42.23(b) (stating that Sur-Reply cannot include new evidence).

66. *Fresenius*, Case No. IPR2021-01025 (P.T.A.B. Sep. 6, 2022) (Paper 55) at 2.

67. *Id.* at 2-3. Petitioner originally objected to the prior art reference, submitted by the Patent Owner with its Preliminary Response, asserting that it did not establish that it was prior art on its face. *Id.* at 2. Patent Owner again referred to the prior art reference in its Patent Owner Response, which the Petitioner again objected to because the Patent Owner had not established that it was published or publicly accessible. *Id.*

68. *Id.* at 3.

69. *Id.*

70. *Id.*

71. *Group III Int’l, Inc. v. Targus Int’l LLC*, Case No. IPR2021-00371 (P.T.A.B. Mar. 28, 2022) (Paper 76). The patent in *Group III* covers a “portable computer case” with different sections, including one that holds a computer. On July 9, 2019, the IPR was instituted by the PTAB, which led to the deposition of Petitioner’s expert on January 17, 2022. *Id.*; *Group III Int’l, Inc* (Paper 21); U.S. Patent 8,567,578

72. *Id.* at 2.

73. *Id.* at 2-4.

focused on finding prior art showing that such bags could include metal that would disrupt a scanner despite containing zippers, which was an issue that arose from the expert's supplemental declaration supporting the Petitioner's reply.<sup>74</sup> Further, Patent Owner argued that it was "in the interests of justice" under Rule 42.123(b) because the exhibits contradicted the expert's testimony that such bags could not be made of metal when they included zippers.<sup>75</sup> The Petitioner argued that the exhibits were irrelevant because the expert's original and supplemental declarations consistently stated that the patent could cover cases with some metal, but did not cover cases with solid metal panels.<sup>76</sup>

The PTAB granted the Motion. The PTAB agreed with the Patent Owner that the exhibits could not have been obtained earlier as the issue regarding the metal-zipper-case was raised after the one-month deadline to file timely Motions.<sup>77</sup> Further, the PTAB found that it was in the interest of justice because the Supplemental Information would help weigh the credibility of the expert's testimony and provide a more complete record.<sup>78</sup>

### CONCLUSION

Motions to submit supplemental information are a procedural and evidentiary tool that parties can use after trial institution. The statistics show that this tool is infrequently used but has a relatively high success rate in being granted. Based on a review of recent cases, parties can increase their success in having the motion granted by not only meeting the letter of the supplemental information motion rules (*i.e.*, that it is timely and relevant) but also by confirming for the PTAB that the submission supplemental information will not interfere with the PTAB's obligation to ensure the Office's efficient administration and ability to timely complete proceedings. Motion-opponents have their best chance for success when they can raise motion-timeliness issues and characterize the Motion as seeking to fundamentally change the arguments (*e.g.*, Petitioner arguments) on which the Movant's case is based.

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74. *Id.*, See also *Group III*, Case No. IPR2021-00371 (P.T.A.B. Jan. 27, 2022) (Paper 61) (Patent Owner cited Board statements in other proceedings as allegedly showing that "supplemental information rebutting positions first raised in an expert's reply declaration" were sufficient to grant a 42.123(b) motion).

75. *Group III Int'l, Inc. v. Targus Int'l LLC*, Case No. IPR2021-00371 (P.T.A.B. Mar. 28, 2022) (Paper 76).

76. See generally *Group III*, Case No. IPR2021-00371 (P.T.A.B. Feb. 03, 2022) (Paper 64).

77. *Group III*, Case No. IPR2021-00371 (P.T.A.B. Mar. 28, 2022) (Paper 76).

78. *Id.*