

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OOMA, INC.,
Petitioner,

v.

DEEP GREEN WIRELESS LLC,
Patent Owner.

Case IPR2017-01541
Patent RE42,714 E

Before RAMA G. ELLURU, DANIEL J. GALLIGAN, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On January 19, 2018, we held a conference call with Petitioner and Patent Owner, pursuant to Petitioner's January 12, 2018 email request seeking authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a). Petitioner indicated that the supplemental information pertains to the level of ordinary skill in the art.

37 C.F.R. § 42.123(a) sets forth two requirements for filing supplemental information – that the request be made within one month of institution, and that the supplemental information be relevant to a claim for which the trial has been instituted. Our Decision instituting *inter partes* review was issued on December 18, 2017. Paper 8. Thus, Petitioner's January 12 email request for authorization to file the motion occurred within one month of the date of institution. The level of ordinary skill in the art is relevant to all claims on which review was instituted, as review was instituted on obviousness grounds for each claim.

During the call, Petitioner indicated that, having fulfilled the two requirements set forth in 37 C.F.R. § 42.123(a), it should be authorized to file the supplemental information. Furthermore, Petitioner argued that, while the Petition was not deficient with respect to the showing of ordinary skill, additional evidence with respect to the level of ordinary skill would allow the further development of this issue in advance of the filings set forth in the scheduling order. Petitioner indicated that the level of ordinary skill was addressed in its expert's declaration and that the additional information would only supplement information already provided in the Petition and declaration. Patent Owner argued that such additional development is unnecessary at this stage of the proceeding and that Petitioner could submit the information in the scheduled Reply, if appropriate.

The requirements laid out in 37 C.F.R. § 42.123(a) do not prohibit us from exercising discretion. *Redline Detection, LLC v. Star Enivrotch, Inc.*, 811 F.3d 435, 446–49 (Fed. Cir. 2015). The enumerated requirements are “additional requirements that must be construed within the overarching context of the PTAB’s regulations governing IPR and general trial proceedings.” *Id.* at 446.

Here, Petitioner has not sufficiently persuaded us why the supplemental information could not have been filed with the Petition or why granting such a motion would be more than an opportunity “to supplement a petition after initial comments or arguments have been laid out by a patent owner.” *Pacific Market Int’l, LLC v. Ignite USA, LLC*, IPR2014–00561, 2014 WL 6772228, Paper 23 at 3 (PTAB Dec. 2, 2014) (quoted in *Redline*, 811 F.3d at 448).

The Petition included obviousness grounds, and Petitioner has not indicated sufficient reason that this supplemental information relating to these grounds could not have been obtained earlier. Petitioner had the burden to present in its Petition information which would show a reasonable likelihood of success. *See* 35 U.S.C. § 314(a). Patent Owner argued in its Preliminary Response that the Petition’s identification of the level of skill corresponding to one of ordinary skill was insufficient to institute on obviousness grounds. Paper 7, 27–29. We instituted, and entered a scheduling order detailing the due dates for each party to take action after the institution of the proceeding. Paper 8, 10.

Supplemental information is not intended to provide a petitioner an advantageous “wait-and-see” opportunity to use a patent owner’s preliminary response and our decision on institution in order to refine or

bolster petitioner's position. In this case, Petitioner has not presented sufficient explanation for the requested introduction of the information at this point in the proceedings. Therefore, in light of the goal of securing the just, speedy, and inexpensive resolution of every proceeding, we decline at this point to allow Petitioner to add supplemental testimony regarding the level of ordinary skill in the art.

For the reasons discussed above, the filing of a motion to submit supplemental information is not authorized.

It is

ORDERED that Petitioner's request for authorization to file a motion to submit supplemental information is denied.

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