



PTAB Allows Petitioner to Supplement Record Regarding Publication Date of Prior Art Reference

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Patent Owner first argued that the information “should have and could have” been included in the Petition. The PTAB held that 37 C.F.R. § 42.123 imposes no such requirement when, as here, the party seeking to submit the information requests to file the motion within one month of the date the trial is instituted. *Compare* 37 C.F.R. § 42.123(b) (addressing requests more than one month after institution and requiring a showing of “why the supplemental information reasonably could not have been obtained earlier”) to 37 C.F.R. § 42.123(a) (addressing requests within one month of institution and requiring only that the information “be relevant to a claim for which the trial has been instituted”). Because the request was timely and the asserted reference’s publication date was “important” in view of the challenged claims’ potentially earlier effective filing date, the Motion met the requirements of 37 C.F.R. Section 42.123(a).

In similar arguments, Patent Owner further contended that Petitioner sought to “change the evidence originally relied upon in the Petition,” “remedy the insufficiencies in its Petition that the Board raised in the Rehearing and Institution Decision,” and “present[] the publication date of [the reference] as a moving target.” The PTAB rejected each of these arguments because Petitioner included the contention that the reference was published on January 17, 1997 in its original Petition and was now seeking to supplement that “original theory” in “respon[se] to circumstances that changed after institution of the proceeding.” Notably, the Institution Decision expressed concern over Petitioner’s ability to address potential changes to the challenged claims’ effective filing date. The PTAB “discern[ed] nothing improper or

prejudicial to Patent Owner in responding to these efforts to sensitize the parties to post-institution developments that might bear on issues in the proceeding.”

Patent Owner also contended that “Petitioner’s supplemental information attempt[ed] to address arguments that have not been raised in these proceedings” and was “not relevant” because “the prior art status of [the reference] ha[d] not been contested.” The PTAB rejected this argument based on its “independent duty to ascertain whether a petitioner ‘prove[s] a proposition of unpatentability by a preponderance of the evidence.’” See 35 U.S.C. § 316(e).

Blue Coat Systems, Inc. v. Finjan, Inc., IPR2016-01444 (PTAB October 23, 2017)

[Arpin, Yang, Boucher (opinion)]

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