

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANFIELD SCIENTIFIC, INC.,
Petitioner,

v.

MELANOSCAN, LLC,
Patent Owner.

Case IPR2017-02125
Patent 7,359,748 B1

Before JOHN C. KERINS, MICHAEL W. KIM, and SCOTT C. MOORE,
Administrative Patent Judges.

MOORE, Administrative Patent Judge.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. §§ 42.5, 42.123

I. INTRODUCTION

On May 16, 2018, Petitioner filed a Motion to Submit Supplemental Information. Paper 19 (“Motion” or “Mot.”). Specifically, Petitioner seeks to submit the following materials: Exhibit 1031, the Second Declaration of Dr. Jan-Peter Muller; Exhibit 1033, an article titled “Three-dimensional surface capture for body measurements using projected sinusoidal patterns”; and Exhibit 1034, U.S. Patent 6,373,963. Mot. 1.

Patent Owner filed an Opposition to the Motion on May 23, 2018. Paper 21 (“Opposition” or “Opp.”).

II. ANALYSIS

Supplemental information is information submitted after institution of a trial that is relevant to a claim for which trial has been instituted. *See* 37 C.F.R. § 42.123(a). A motion to submit supplemental information is timely if authorization to file is requested “within one month of the date the trial is instituted.” *Id.* The type of relief that Petitioner seeks is discretionary in nature, and complying with the requirements of 37 C.F.R. § 42.123 does not automatically entitle Petitioner to submit supplemental information. *See, e.g., Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 446–47 (Fed. Cir. 2015) (the Board has discretion to deny a motion for supplemental information that complies with 37 C.F.R. § 42.123, and nothing in 37 C.F.R. § 42.123 exempts supplemental information from the Board’s rules and regulations.)

Petitioner requested authorization to file its Motion on April 30, 2019, which is within the time limit of 37 C.F.R. 42.123(a)(1). *See id.* at 1. There also appears to be no dispute that Exhibits 1031, 1033, and 1034, if allowed,

would constitute “supplemental information” within the meaning of 37 C.F.R. § 42.123(a).

The focus of the parties’ dispute relates to how Petitioner intends to use this supplemental information. Petitioner asserts that it will rely on these Exhibits “to provide further confirmatory evidence of the two specific assertions in its original petition relating to instituted grounds of invalidity,” and asserts that these Exhibits “neither chang[e] the grounds on which Petitioner seeks invalidity nor the evidence relied upon.” Mot. 3. Patent Owner, in contrast, argues that Petitioner “wants the Board to consider the new exhibits as additional substantive evidence of unpatentability, and also for interpreting [the cited Hurley reference] as containing disclosure it does not have.” Opp. 3. Patent Owner is correct in its assertion that Petitioner may not use supplemental information to make new substantive arguments or in a way that would modify the substantive contentions set forth in the Petition.

A petition for *inter partes* review must identify “*with particularity . . . the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.*” 35 U.S.C. § 312(a)(3) (emphasis added). “Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). In an *inter partes* review, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363

(Fed. Cir. 2016). Thus, although “the introduction of new evidence in the course of the trial is to be expected in inter partes review trial proceedings,” *Genzyme Therapeutic Prods. LP v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016), the shifting of arguments is not, *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017).

In the circumstances present here, we accept Petitioner’s representation that it intends to use Exhibits 1031, 1033, and 1034 for proper purposes, and find that Petitioner has shown good cause to submit supplemental information in order to support contentions that are set forth in detail in the Petition. Petitioner, however, will not be permitted to use this supplemental information to modify contentions set forth in the Petition or to make new substantive arguments.

III. ORDER

For the above reasons, it is

ORDERED that Petitioner’s Motion to Submit Supplemental Information (Paper 19) is *Granted*, and Exhibits 1031, 1033, and 1034 are admitted into evidence; and

FURTHER ORDERED that Exhibits 1031, 1033, and 1034 shall only be used to support contentions that are set forth in detail in the Petition, and may not be used to modify contentions set forth in the Petition or make new substantive arguments.

IPR2017-02125
Patent 7,359,748 B1

PETITIONER

Julianne Hartzell
Sandip Patel
Thomas Duston
MARSHALL, GERSTEIN & BORUN LLP
jhartzell@marshallip.com
spatel@marshallip.com
tduston@marshallip.com

PATENT OWNER:

Mark Giarratana
Kevin Reiner
MCCARTER & ENGLISH, LLP
mgiarratana@mccarter.com
kreiner@mccarter.com