UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,

Petitioner,

v.

CYTONOME/ST, LLC,

Patent Owner.

Case No. IPR2017-02184

Patent No. 7,208,265

PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. §42.123(a)

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I. Introduction

Petitioner ABS Global, Inc. respectfully moves under 37 C.F.R. §42.123(a) to submit Exhibits 1035-47 as supplemental information relevant to the public accessibility of Fugger, a prior art reference at issue in this trial published in the September 1998 issue of "Human Reproduction." The exhibits include library-stamped copies of Fugger and other documents that confirm its accessibility in September 1998. The exhibits supplement information present in the record, do not alter the instituted grounds, and their consideration will not delay the trial's schedule or prejudice Patent Owner. Petitioner thus requests that its motion be granted.

II. Stage of Proceeding and Legal Standard

The Board instituted trial on the challenged claims on the ground that they are unpatentable as obvious in view of Fugger (Ex. 1007) in combination with Salisbury. Paper 1, 16; Paper 10, 27. Fugger, as stated in the institution decision was "published . . . in September of 1998." Paper 10, 19. After institution, Patent Owner objected to Fugger's public accessibility. Paper 12. Petitioner served Exhibits 1035-47 as supplemental evidence in response, *see* Paper 14, and now moves to submit these exhibits (filed in support herewith (Paper 15, 2)) as supplemental information.

A party may submit supplemental information under §42.123(a) if: 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" and the "supplemental

information [is] relevant to a claim for which the trial has been instituted." The Board has considered whether the information changes "the grounds of unpatentability authorized in this proceeding" or "the evidence initially presented in the Petition to support those grounds." *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37, 3 (Feb. 5, 2014). The Board has also considered whether granting the motion would prevent the just, speedy, and inexpensive resolution of the proceeding, *id.*, 4, or prejudice the other party, *Unified Patents Inc., v. Dragon Intellectual Prop., LLC*, IPR 2014-01252, Paper 43, 3 (Apr. 14, 2015). Where, as here, the evidence confirms the public accessibility of a prior art reference at issue in the trial, the Board has accepted it under §42.123(a). *See Apple Inc. v. VirnetX Inc.*, IPR2015-00810, Paper 21, 3-8 (Nov. 2, 2015); *Palo Alto*, Paper 37, 2-5.

III. Argument

A. The Proffered Information Is Timely and Relevant

Petitioner requested authorization to file this motion within one month of institution. Ex. 3002. The Board authorized Petitioner to file this motion within 5 business days of May 16, 2018. Paper 15, 3. Thus, Petitioner's motion is timely under §42.123(a)(1). As explained below, Exhibits 1035-47 are "relevant to a claim [at issue in] the trial" under §42.123(a)(2) because they support Petitioner's assertions and the Board's preliminary findings about Fugger's public availability.

Copies of Fugger (Exs. 1035-40 and 1042): The copy of Fugger submitted with the Petition from the September 1998 issue (no. 9) of "Human Reproduction" bears a "Sep 24, 1998" library date stamp. Ex. 1007, Cover. Exhibits 1035-39 are copies of Fugger obtained from other libraries from the same September 1998 issue of "Human Reproduction," each with a September 1998 date stamp. **Ex. 1035** is a copy from the University of Minnesota Bio-Medical Library with a September 22, 1998 stamp. Ex. 1035, Cover 1, Cover 4, 2367. **Ex. 1036** is a copy from the Iowa State University of Science and Technology library with a September 23, 1998 stamp. Ex. 1036, Cover, 2367. **Ex. 1037** is a copy from the University of Missouri Health Sciences library with a September 24, 1998 stamp. Ex. 1037, Cover, 2367. **Ex. 1038** is a copy from the University of Iowa library with a September 25, 1998 stamp. Ex. 1038, Cover 3, 2367. **Ex. 1039** is a copy from the British Library with a September 21, 1998 stamp. Ex. 1039, Cover, 2367. **Ex. 1040** is the copy of Fugger submitted in a prior *inter partes* review proceeding (IPR2014-01550)—in which the Board cancelled claims of related U.S. Patent No. 7,820,425—that bears the same September 24, 1998 date stamp as Exhibit 1007. Ex. 1040, Cover 1. **Ex. 1042** is a file-history excerpt from related application 13/752,082, in which Patent Owner submitted a September 1998 copy of Fugger to the Patent Office. Ex. 1042, 2, 2367.

Corroborating Declarations (Exs. 1041 and 1043): Exhibits 1041 and 1043 are declarations corroborating the publication and public accessibility of Fugger in

September 1998. **Exhibit 1041** is a declaration from Deborah Ward, the Director of the Health Sciences Libraries at the University of Missouri regarding Fugger. Ex. 1041 ¶¶3-5. Ms. Ward confirms that Fugger was published in September 1998; received by her library September 24, 1998; and made available on the current journal shelf to library patrons by September 25, 1998. Ex. 1041 ¶¶6-12. **Ex. 1043** is a supplemental declaration from Dr. Marvin M. Pace, an expert who submitted declarations in this proceeding and in IPR2014-01550 addressing Fugger. Ex. 1003 ¶¶161-62; IPR2014-01550, Ex. 1003, ¶¶213-14. Dr. Pace confirms that Fugger was published and publicly accessible in September 1998 and that Exs. 1007 and 1035-41 are authentic copies of Fugger. Ex. 1043 ¶¶1-12.

Documents from Prior IPR Proceeding (Exs. 1044-47): Exhibits 1044-47 are documents from IPR2014-01550 that further corroborate Fugger's publication in September 1998. **Ex. 1044** is an excerpt from Patent Owner's Response, ***in which it argued that it had not misled the Patent Office*** by identifying a web version of Fugger it submitted to the Patent Office as published on "Mar. 19, 2003." Patent Owner emphasized that the web version "expressly states that the 'text corresponds to the manuscript published ***September 1998*** in the journal Human Reproduction.'" *Id.*, 13 (original emphasis); *id.* ("Upon review of the document, the Examiner would have understood that Fugger was published on September 1998…."). **Ex. 1045** is the web version of Fugger referred to in Ex. 1044. **Ex. 1046** is an excerpt from Patent

Owner's own expert declaration that identifies the "Publication or Issue Date" of Fugger as "September 1998." Ex. 1046, 35-36. **Ex. 1047** is the Final Written Decision in which the Board noted Fugger's publication date as "Sept. 1998" when cancelling the challenged claims in that proceeding under §103(a). Ex. 1047, 2 n.4.

Exhibits 1035-47 thus support Petitioner's assertion that Fugger is prior art to the challenged claims and are relevant to these claims under §42.123(a).

B. Consideration of the Supplemental Information Is Appropriate

The exhibits proffered by Petitioner satisfy other factors the Board has considered for motions to submit supplemental information. They supplement information presented with the Petition with respect to Fugger, Paper 1, 16; Ex. 1003 ¶¶161-62, and are additional evidence that Fugger was publicly accessible as of the date listed on its face, which is information properly submitted under §42.123(a). *See Apple Inc.*, Paper 21, 8. As such, they do not change the authorized grounds of unpatentability or the evidence initially presented in the Petition to support those grounds. *See Palo Alto*, Paper 37, 3. Consideration of the information will not prejudice Patent Owner or delay the proceedings. *See id.*, 4; *Unified Patents*, Paper 43, 3. Indeed, Patent Owner previously represented to the Board in an earlier proceeding that Fugger was published in September 1998, Ex. 1044, 13, and may address the proffered information in its Response. Petitioner thus respectfully requests that the Board grant this motion.

Dated: May 22, 2018

Respectfully Submitted,

/ Jeffrey P. Kushan /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), this is to certify that on May 22, 2018, I caused to be served by email a true and correct copy of the foregoing Petitioner's Motion to Submit Supplemental Information and Exhibits 1035-1047 on the following counsel for Patent Owner:

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Respectfully submitted,
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