

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CURT G. JOA, INC.,
Petitioner,

v.

FAMECCANICA.DATA S.P.A.,
Patent Owner.

Case IPR2016-00906
Patent 6,994,761 B2

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION

Petitioner's Motion for Late Submission of Supplemental Information
37 C.F.R. § 42.123(b)

On June 9, 2017, with Board authorization (*see* Paper 54), Petitioner filed a Motion to Submit Supplemental Information more than one month after the date of institution of the present *inter partes* review. Paper 57 (“Mot.” or “Motion”). Patent Owner filed an Opposition to the Motion. Paper 58 (“Opp.”). Having reviewed the record on this matter, we grant Petitioner’s Motion, subject to the qualifications set forth herein.

A motion for the late submission of supplemental information is governed by 37 C.F.R. § 42.123(b), which requires the movant to 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. Moreover, as stated in 37 C.F.R. § 42.1(b), trial rules are construed to secure the just, speedy, and inexpensive resolution of every proceeding.

Petitioner seeks to submit the “Approved Judgment of the High Court of Justice, Chancery Division, Intellectual Property Enterprise Court, London in Case No. IP-2015-000205 between Curt G. Joa, Inc. and Fameccanica.Data SpA” (“the UK Decision”). Mot. 2. According to Petitioner:

The UK Court made a number of factual findings in the aforementioned decision. It is the position of the Petitioner that the factual findings of the UK Court must be addressed in the present case, either by adopting the findings entirely or, at a minimum, by giving them deferential weight.

Id. Petitioner contends that the UK Decision could not have been obtained “earlier than its public dissemination date of May 24, 2017.” *Id.* at 2–3. Petitioner further contends that consideration of the supplemental information would be in the interests-of-justice because (1) “[i]t would be the epitome of injustice to permit Patent Owner to rely on testimony in the

US that is contradictory to the fact findings made on that same subject matter in a competent foreign tribunal” (*id.* at 3); (2) “[i]t is the position of the Petitioner that factual determinations of the UK court with respect to the common specification support its Petition in the present case” (*id.*); and (3) Patent Owner has an obligation under 37 C.F.R. § 42.51(b)(1)(iii) to submit the UK Decision as “inconsistent information” (*id.* at 6).

Patent Owner opposes, arguing that (1) Petitioner has previously argued “‘the outcome of the [UK] proceeding has no bearing on the outcome of this proceeding’” (Opp. 4 (citing Paper 51, 2 (emphasis and alterations by Patent Owner))); and (2) Petitioner “has failed to [e]stablish whether there are any findings of fact which might underlie the UK Decision, and whether any of those findings of fact could have preclusive effect. Petitioner has not even discussed UK patent law, or the issues available in patent cases before the [UK court]” (*id.* at 5); and (3) granting Petitioner’s Motion “is not in the interests of justice” because it “would require significant additional briefing by the Parties to determine whether the UK Decision contains any factual findings that may be entitled to preclusive effect in this proceeding,” “issue preclusion is inapplicable between the UK proceeding and this *inter partes* review,” and “whether information from the UK proceeding should have been exchanged pursuant to the Parties’ routine discovery obligations should have no bearing on whether to grant Petitioner’s motion” (*id.* at 9).

Regarding whether the UK Decision could not have been obtained earlier, we agree with Petitioner that the decision could not have been obtained prior to the date upon which it became publicly available, i.e., May 24, 2017. Regarding the parties’ interests-of-justice arguments, we

determine that consideration of the supplemental information would be in the interests-of-justice. We are not persuaded, however, that any factual or legal findings set forth in the UK Decision have preclusive effect in this *inter partes* review proceeding. *Cf. Novartis AG v. Noven Pharms. Inc.*, 853 F.3d 1289, 1293–94 (Fed. Cir. 2017) (determining that the Board was not bound by prior judicial opinions relating to the challenged patent). Although we are not bound by the UK Decision, the parties acknowledge that it addresses and analyzes a closely related patent, and thus, it may be useful for the parties and the Board to have the UK Decision in the record.

According, it is:

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *granted*, subject to the qualifications set forth herein; and

FURTHER ORDERED Petitioner shall submit a copy of the UK Decision as an Exhibit no later than June 23, 2017.

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