

Norman International, Inc. v. Andrew J. Toti Testamentary Trust, Russell L. Hinckley, Sr. (Co-Trustee) and Robert F. Miller (Co-Trustee) Granting and Denying Motion to Submit Supplemental Information

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[Takeaway: Supplemental information, offered to support an argument on the merits, should not be filed as an exhibit with the motion to submit the supplemental information, but rather, should be filed after the motion is granted.](#)

In its [Decision](#), the Board granted-in-part Petitioner's Motion to Submit Supplemental Information. As a preliminary matter, the Board noted that Patent Owner filed an opposition and Petitioner filed a reply to the opposition without authorization by the Board. Although the Board considered the unauthorized papers in this case, it explained that parties must seek authorization to file a responsive paper when the motion requires authorization.

Turning to the Motion, the Board noted that a party may file such a motion where “(1) 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. (2) The supplemental information must be relevant to a claim for which the trial has been instituted.”

Petitioner relied upon a Japanese reference, Tachikawa, in the Petition and submitted as an exhibit the Japanese version with what Petitioner contended was “an exact copy of the English translation of Tachikawa that Patent Owner filed in a ‘Supplemental Information Disclosure Statement’ for submitting Tachikawa to the Office” during prosecution. Patent Owner objected to the Tachikawa exhibit as allegedly being inadmissible for failing to file an affidavit attesting to the translation's accuracy. Petitioner responded by serving Exhibit 1010 on Patent Owner, and, on the same day, filed the instant Motion to Submit Supplemental Information with Exhibits 1010 and 1011.

Exhibit 1010 includes: (a) the Japanese version of Tachikawa; (b) the Supplemental Information Disclosure Statement attaching a translation; (c) an additional certified English translation; (d) a certification attesting to the accuracy of the translation in (c); and (e) a comparison of the two translations in (b) and (c). Exhibit 1011 was a declaration including appendices that were the same as documents (a)-(e) described above.

First, the Board expunged both Exhibits 1010 and 1011 because authorization to file the motion “is not an authorization to file the information as exhibits.” Rather, the information should be filed after the motion is authorized and granted. The Board noted other deficiencies in the filing. In particular, Petitioner filed documents already in the record in violation of **37 C.F.R. § 42.6(d)**, and the pages of the exhibits were not uniquely numbered in sequence in violation of **37 C.F.R. § 42.63(d)(2)(ii)**.

Turning to the merits of the Motion, the Board noted that Petitioner bears the burden to establish that the documents are supplemental information (evidence to support an argument on the merits) rather than supplemental evidence (offered to support admissibility of originally-filed evidence to defeat a motion to exclude). The Board agreed with Petitioner that documents (b)-(e) were being offered “to support its position that Tachikawa discloses what Petitioner purports it discloses in the Petition,” and are therefore supplemental information, but that document (a) was a duplicate already presented in another exhibit. The Board found that the supplemental information would not change any instituted grounds nor the evidence initially presented; there was no indication the information was withheld; and the information would not limit the Board’s ability to complete the proceeding in a timely manner. Thus, Petitioner was authorized to re-file documents (b)-(e) as separate exhibits and Exhibits 1010 and 1011 were expunged.

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Paper 29: Decision on Petitioner’s Motion to Submit Supplemental Information Dated: September 29, 2014

Patent: 6,283,192 B1

Before: Toni R. Scheiner, Linda M. Gaudette, and Jacqueline Wright Bonilla Written by: Gaudette

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