

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FRAMELESS HARDWARE COMPANY LLC,  
Petitioner,

v.

C.R. LAURENCE CO., INC.,  
Patent Owner.

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IPR2022-00356<sup>1</sup>  
Patent 9,074,413 B1

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Before FRANCES L. IPPOLITO, ERIC C. JESCHKE, and  
PAUL J. KORNICZKY, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(a)*

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<sup>1</sup> Case IPR2022-00620 has been consolidated with the instant proceeding.

## A. INTRODUCTION

Petitioner Frameless Hardware Company LLC filed two petitions challenging claims of U.S. Patent No. 9,074,413 B1 (IPR2022-00356, Ex. 1001, “the ’413 patent”). The first petition, filed on December 22, 2021 in IPR2022-00356, challenges claims 1, 4, 5, 7, and 8 of the ’413 patent. IPR2022-00356, Paper 2. On July 8, 2022, we instituted an *inter partes* review of claims 1, 4, 5, 7, and 8 of the ’413 patent in IPR2022-00356. IPR2022-00356, Papers 11–12. On February 18, 2022, Petitioner filed a second petition requesting *inter partes* review of claim 8 of the ’413 patent. IPR2022-00620, Paper 2. On September 13, 2022, we instituted review based on all challenges presented in the second petition. IPR2022-00620, Paper 8. On October 5, 2022, we granted the parties’ joint request to consolidate IPR2022-00620 with IPR2022-00356. Paper 27.

With our prior authorization, Petitioner filed a Motion to Submit Supplemental Information (Paper 21, “Motion” or “Mot.”). In its motion, Petitioner seeks to submit a Supplemental Declaration of Steven M. Tipton, Ph.D. (“Tipton Supp. Decl.”), which Petitioner has attached as Exhibit A to its Motion. Patent Owner filed an Opposition to the Motion (Paper 23, “Opposition” or “Opp.”). For the reasons discussed herein, we grant Petitioner’s Motion to Submit Supplemental Information.

## B. DISCUSSION

With prior authorization, a party may file a motion to submit supplemental information after trial has been instituted in accordance with the following requirements: (1) a request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial has been instituted; and (2) the supplemental information must

be relevant to a claim for which the trial has been instituted. 37 C.F.R. § 42.123(a) (“Rule 123”). In short, the request for authorization must be timely, and the supplemental information relevant.

Meeting those two requirements of Rule 123 does not, however, guarantee that a motion to submit supplemental information will be granted. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (rejecting that “the PTAB must accept supplemental information if timely submitted and relevant”). The Board is also guided by, *inter alia*, the need to ensure efficient administration of the Office and the ability to complete IPR proceedings in a timely manner. *Id.* Moreover, “the PTAB has discretion to grant or deny motions as it sees fit.” *Id.* at 446–447 (citing 37 C.F.R. § 42.5(a), (b)). And, we do not treat Rule 123 as offering a routine avenue for a petitioner to bolster deficiencies in a petition called out by patentee—it is not a “wait-and-see” opportunity to fix what could and should have been addressed when the petition was filed. *Id.* at 448 (citing *Pac. Mkt. Int’l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 4 (PTAB Dec. 2, 2014)). The Board also sometimes cites prejudice to the non-moving party as a reason for denying submission of supplemental information. *See, e.g., Polycom, Inc. v. DirectPacket Rsch., Inc.*, IPR2019-01235, Paper 56 at 4 (PTAB Sept. 14, 2020) (“Petitioner has persuaded us that it would be prejudiced by introduction of [Patent Owner’s] new evidence and arguments at this late stage of the proceeding because Petitioner would not have an opportunity to respond.”).

As the moving party, Petitioner must persuade us that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Petitioner contends, with no dispute from Patent Owner, that it timely sought authorization to file this

Motion. Mot. 3. We agree because Petitioner’s request for authorization was made within 30 days of our institution decision. *See* Paper 17 at 2 (“Petitioner’s request was made initially by an email communication to Board staff dated August 8, 2022, which is within one month of the institution date July 8, 2022. In this regard, we agree that Petitioner’s request for authorization to file its motion is timely.”).

According to Petitioner, the Supplemental Tipton Declaration provides additional information about six physical models that Petitioner’s expert Dr. Tipton previously built of the primary prior-art references in this proceeding. Mot. 1. According to Petitioner, the models that are the subject of the Supplemental Tipton Declaration provide corroboration that U.S. Patent No. 6,434,905 to Sprague (“Sprague ’905”) and Figures 1–2 of French Patent Publication No. FR2367178A1 to Girardy (“Girardy”) show rail systems having, among other things, a spring action clamping member, which is a limitation required by all of the challenged claims. *Id.* at 3. Petitioner adds that “the Supplemental Tipton Declaration relates to relevant evidence that is already in the record, i.e., the physical models that were depicted and discussed in Dr. Tipton’s original declaration submitted with the Petition.” *Id.*

In its Opposition, Patent Owner contends that the Supplemental Tipton Declaration is not relevant because the models are not prior art and cannot be the basis of an *inter partes* review. Opp. 1–2. Patent Owner adds that Petitioner’s models do not accurately reflect the teachings in Sprague ’905 and Girardy and improperly expand the disclosures of the references. *Id.* at 2–3. Patent Owner further asserts “the models do not purport to be the ‘rail system’ of Sprague ’905 or the ‘plinth’ of Girardy, and Dr. Tipton

makes no effort to link how they were created to any specific teaching of Sprague '905 or Girardy, aside from simply eyeballing a few figures.” *Id.* at 3. Patent Owner further contends that the Supplemental Tipton Declaration is irrelevant because he guesses “at the dimensions of the figures in Sprague '905 and Girardy” rather than relies on any disclosure in either patent. *Id.*

In addition, Patent Owner argues that the information in the Supplemental Tipton Declaration is untimely and should have been submitted with the Petition. Opp. 4. Patent Owner asserts the Supplemental Tipton Declaration contains new assertions that “each of the models also satisfies all of the claim elements of claims 1, 5, and 7 of the ‘413 Patent.” *Id.* (citing Mot., Ex. A ¶¶ 4, 12, 19).

Having considered the parties’ positions, Petitioner persuades us that the Supplemental Tipton Declaration is relevant to claims for which trial has been instituted here. We note first that the models described in the Supplemental Tipton Declaration were discussed at length in Dr. Tipton’s original declaration. For example, in paragraph 70 of Dr. Tipton’s original declaration, he testifies that he built two models based on Sprague '905’s rail system 200 shown in Figure 12. Ex. 1007 ¶ 70. Dr. Tipton provides photographs of the models and asserts that “[t]he model on the right is made of aluminum, and the model on the left is made of 3D-printed onyx. In building the models, [he] configured the screw so that the arms of the clamp member would be driven toward each other when the screw is tightened as described in the specification of Sprague '905.” *Id.* In paragraph 83 of his original declaration, Dr. Tipton asserts that the written disclosure of Sprague '905 teaches the “spring action clamping member” recited in claim 1, and then adds that the constructed models confirmed his conclusions. Ex. 1007

¶ 83 (“I observed for all of the models that, when I loosened the screw, the upper ends of the clamp arms sprang back to their original positions, furthering confirming that the clamp arms shown in Figure 12 produce an outwardly directed spring force.”).

Similarly, Dr. Tipton testifies that he constructed “models of the rail assembly of [Girardy’s] Figures 1 and 2 . . . out of aluminum and 3D-printed onyx.” Ex. 1007 ¶ 123. Dr. Tipton further explains that he tested these models by, among other things, measuring the distance between the flanges of the clamping element before and after tightening the screw. *Id.* ¶¶ 124, 126. While Dr. Tipton addresses the limitations of the challenged claims based on the written disclosure of Girardy, Dr. Tipton further testifies that he conducted the tests on the models to confirm his understanding of the prior art teachings. *See id.* ¶¶ 135–137.

In his Supplemental Declaration, Dr. Tipton refers to the pages of his original declaration that discuss the models he constructed and tested based on the disclosure in Sprague ’905 and Girardy. Mot., Ex. A ¶¶ 5, 20. For example, Dr. Tipton explains that

I first made a 3D CAD model of the rail system of Figure 12 of Sprague ’905 that reliably reflected the proportions and relative dimensions of the parts shown in that Figure 12. I then used this 3D CAD model to make the aluminum and Onyx models shown in the photograph. Reproduced above is a drawing generated from the 3D CAD model, showing the dimensions of the model.

Mot., Ex. A ¶ 5. Dr. Tipton further explains that he constructed modified models based on Sprague ’905 “by making the rail housing slightly thicker and the clamp member slightly thinner.” *Id.* ¶ 12. With respect to the physical models made based on Figures 1 and 2 of Girardy, Dr. Tipton testifies that he used a similar approach in using a 3D CAD model with

proportions and dimensions based on the figures in Girardy. *See id.* ¶ 20. Additionally, Dr. Tipton testifies that these models “reliably” or “closely” reflect the teachings of the prior art. *Id.* ¶¶ 4, 12, 19. Thus, in this respect, Dr. Tipton’s Supplemental Declaration largely mirrors his original declaration in subject matter and provides additional details on how he designed and constructed the models he relies upon for his original testimony.

Further, we observe that in the original declaration, Dr. Tipton relies on the tests performed on his models for his expert testimony that the prior art references teach or suggest a “spring action clamping member” recited in independent claim 1. *See* Ex. 1007 ¶ 137 (“I observed for both models that, when I loosened the screw, the upper ends of the clamping flanges sprang back to their original positions, furthering confirming that the flanges 9 shown in Figure 1 produce an outwardly directed spring force.”). The Supplemental Tipton Declaration addresses these same models and provides additional underlying facts or data on which Dr. Tipton’s opinion is based. Notably, the Supplemental Tipton Declaration provides information on how the models were designed and constructed. This information is relevant to the evaluation of Dr. Tipton’s test data, which at a minimum provides, in these circumstances, other information necessary for the Board to evaluate Dr. Tipton’s tests and data. *See* 37 C.F.R. 42.65(b)(5). Indeed, this information is generally what we consider when ascribing weight to expert testimony. *See* 37 C.F.R. 42.65(a).

We also are not persuaded by Patent Owner’s arguments that the Supplemental Tipton Declaration is not relevant because the models are not prior art and cannot be the basis of an *inter partes* review. Opp. 1–4; *see id.*

at 3 (“The Supplement[al] Tipton Declaration is directed to . . . ‘speculative modeling.’”). While we agree that the models themselves are not prior art, we understand the Supplemental Tipton Declaration to provide information regarding the data and tests which Dr. Tipton relies upon for his testimony that the challenged claims are unpatentable. In other words, the Supplemental Declaration provides the panel additional information to evaluate how much weight to give Dr. Tipton’s testimony, which will include our consideration of whether Dr. Tipton’s testimony is supported by or consistent with the disclosures in Sprague ’905 and Girardy. In this capacity, the Supplemental Tipton Declaration is relevant to a claim for which the trial has been instituted.

Likewise, we disagree with Patent Owner that the Supplemental Tipton Declaration is untimely or that Petitioner has raised a new ground of unpatentability based on the models. First, Dr. Tipton’s original declaration discusses his models in detail, including the materials used to construct the models. Ex. 1007 ¶¶ 70, 125, 136. The Supplemental Tipton Declaration seeks to add twenty-four (24) paragraphs that further explain the construction of the models already discussed in the original declaration. Although these twenty-four (24) paragraphs are not in the original declaration, we are not persuaded by Patent Owner that testimony regarding the construction of the models is untimely given that Dr. Tipton addressed these models in his original declaration. Moreover, the construction, design, and testing of the models are very much at issue in this proceeding. At the August 24, 2022 conference call between the panel and the parties, the panel resolved discovery disputes between Patent Owner and Petitioner regarding Patent Owner’s access to and parameters for testing Petitioner’s models.



Paper 17 at 3–4. Additionally, we do not understand Petitioner to rely on the models for separate grounds of unpatentability at this stage. Rather, Petitioner’s expert, Dr. Tipton, relies upon the constructed models for his understanding of the disclosure in the prior art references. Thus, we do not agree that the Supplemental Tipton Declaration is untimely or introduces new unpatentability challenges into this proceeding.

C. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *granted*;

FURTHER ORDERED that Proposed Exhibit A will be entered into the record as the next exhibit number in the 1000 series; and

FURTHER ORDERED that Petitioner must file Proposed Exhibit A in this proceeding within seven days of this Order.

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