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571-272-7822

Paper 70  
Date: October 17, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SHARKNINJA OPERATING LLC,  
SHARKNINJA MANAGEMENT LLC,  
and SHARKNINJA SALES COMPANY,  
Petitioner,

v.

IROBOT CORPORATION,  
Patent Owner.

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IPR2021-00544  
Patent 9,884,423 B2

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Before BARRY L. GROSSMAN, TERRENCE W. McMILLIN, and  
JASON W. MELVIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER  
Denying Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(b)*

## I. INTRODUCTION

On September 28, 2022, iRobot Corporation (“Patent Owner”) filed a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b). Paper 64 (“Motion” or “Mot.”).<sup>1</sup> SharkNinja Operating LLC, SharkNinja Management LLC, and SharkNinja Sales Company (“Petitioner”) filed an Opposition. Paper 66 (“Opposition” or “PET Opp.”). Patent Owner filed a Response to Petitioner’s Opposition. Paper 69.

According to 37 C.F.R. § 42.123(b), the Motion “must 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.” *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017) (noting that “The PTO considers the interests of justice as slightly higher than good cause.” and “Under the interests-of-justice standard, the moving party would also be required to show that it was fully diligent in seeking discovery and that there is no undue prejudice to the non-moving party.”). Because Patent Owner has not met the requirements of Rule 42.123(b), we deny the Motion.

## II. BACKGROUND

The Board instituted an *inter partes* review of claims 1–4, 6–10, 12–15, 18–23, 25, and 26 (the “challenged claims”) of U.S. Patent 9,884,423 B2 (Ex. 1001, the “’423 patent”). Paper 13 (Decision Granting Institution), 31. Independent claim 1 of the ’423 patent is directed to “[a] method of docking a robotic cleaning device with a base station” and includes the following limitations: “detecting contact with charging terminals on the base station”

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<sup>1</sup> Patent Owner originally sought leave to file its motion to submit supplemental information in an email to the Board on September 14, 2022.

and “stopping the forward movement of the robotic cleaning device in response to detecting contact with the charging terminals on the base station.” Ex. 1001, 19:32–52.

Petitioner asserts that independent claim 1 of the ’423 patent is unpatentable as obvious<sup>2</sup> in view of the combinations of (i) Jeon<sup>3</sup> and Everett<sup>4</sup> and (ii) Jeon, Everett, and Abramson.<sup>5</sup> Paper 1 (“Petition” or “Pet.”), 2. Petitioner alleges that Jeon and Abramson are prior art under 35 U.S.C. §102(e).<sup>6</sup> Pet. 8, 11. Patent Owner contends that Jeon and Abramson are not prior art to this claim, because the inventors conceived of the recited invention prior to the filing dates of the applications for Jeon<sup>7</sup> and Abramson.<sup>8</sup> Paper 25 (“Response” or “PO Resp.”), 1–2. In support of this contention, Patent Owner repeatedly cited and relied heavily on the Declaration of Clara Vu (Ex. 2063 (“Original Vu Declaration”)) in an effort

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<sup>2</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority to applications filed before March 16, 2013, we refer to the pre-AIA version of § 103. Our opinions on the present record would not change if the AIA versions of § 103 were to apply.

<sup>3</sup> US 2004/0178767 A1, published Sept. 16, 2004 (Ex. 1003).

<sup>4</sup> H. R. Everett, “Sensors for Mobile Robots: Theory and Application,” ISBN 1-56881-048-2, 1995 (Ex. 1004).

<sup>5</sup> US 2005/0010330 A1, published Jan. 13, 2005 (Ex. 1006).

<sup>6</sup> 35 U.S.C. § 102(e) (2002) provides: “[a] person shall be entitled to a patent unless . . . the invention was described in . . . an application for a patent . . . before the invention by the applicant for patent.”

<sup>7</sup> Jeon claims priority to an application filed June 23, 2003. Ex. 1003, code (22).

<sup>8</sup> Abramson claims priority to an application filed July 11, 2003. Ex. 1006, code (22).

to establish conception prior to June 23, 2003. *See id.* at 2–27. Ms. Vu was one of the inventors of the ’423 patent. Ex. 1001, code (72).

In its Reply, Petitioner argues that Patent Owner failed to prove conception of claim 1 earlier than the filing date of either Jeon or Abraham. Paper 46 (“Reply” or “PET Reply”), 1–2. The Reply asserts the Patent Owner “does not provide evidence of . . . earlier conception of detecting the charging contacts of the base station or stopping forward motion upon detecting those contacts.” *Id.* at 1. In its Sur-Reply, Patent Owner responds, contending that its evidence sufficiently establishes conception of those elements. Paper 51 (Sur-reply or “PO Sur-reply”), 2–13. Here again, Patent Owner cited and relied on the Original Vu Declaration (Ex. 2063). *Id.* at 2, 9–11.

### III. ANALYSIS

#### A. *The Second Vu Declaration Does Not Clarify the Original Vu Declaration*

Patent Owner “moves to submit the Second Declaration of Clara Vu (attached as an Appendix [“Second Vu Declaration”]) that offers testimony to clarify what she intended to establish through her prior testimony.” Mot. 1. The Second Vu Declaration offers this testimony that is purported to clarify testimony in the Original Vu Declaration:

In my first declaration (e.g., at paragraphs 10-17, 27, and 41-43), I discussed conception before June 23, 2003. . . In this second declaration, I confirm that my testimony in my first declaration was intended to include the concept of the Roomba 2 cleaning robot detecting contact with charging terminals of the base station and stopping forward movement of the Roomba 2 cleaning robot in response to detecting contact with the charging terminals of the base station, which myself and my co-inventors conceived prior to June 23, 2003. . . . paragraph 27 in my first declaration . . . was intended to include the concept of

stopping forward movement in response to the indicator indicating detection of electrical connection made by contact with the charging terminals of the base station . . . paragraph 43 in my first declaration . . . was intended to include the concept of stopping forward movement (“docking”) in response to detecting whether a charger is available, which involves detecting contact with the charging terminals of the base station.

*Id.* at Appendix ¶ 1. In the paragraphs of the Original Vu Declaration that are cited in the Second Vu Declaration, there is no specific reference to “detecting contact with charging terminals on the base station” or “stopping the forward movement of the robotic cleaning device in response to detecting contact with the charging terminals on the base station” as recited in claim 1 (Ex. 1001, 19:32–52). *See* Ex. 2063, ¶¶ 10-17, 27, 41-43. Paragraphs 10–17 and 41–43 of the Original Vu Declaration (Ex. 2063) contain no testimony that could be construed as providing evidence that the named inventors conceived the concepts recited in these limitations of claim 1 (i.e., detecting contact with the charging terminals on the base station and stopping forward movement of the robot in response to detecting contact with the charging terminals on the base station).

Paragraph 27 of the Original Vu Declaration (Ex. 2063) states (emphasis added):

Exhibit 2013 is a copy of a source code file named “user.tl”.<sup>[9]</sup> Lines 14- 50 of “user.tl” define behaviors for the Roomba 2 that are initiated depending on whether a charger is available (i.e., “charger-available?”) and whether a battery is

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<sup>9</sup> The Patent Owner’s Response to the Petition states, “The code file user.tl . . . was . . . checked into [Patent Owner]’s repository by Mr. Mass and Ms. Vu on April 17, 2003. Ex-2065, ¶¶13, 16; Ex-2036, 2; Ex-2056, 1.” PO Resp. 8.

available (i.e., “battery-available?”). ***The identifier “charger-available?” refers to a function that outputs an indicator of whether a battery charger, such as a base station, is electrically connected to the Roomba 2 and thus capable of charging the Roomba 2.*** The identifier “battery-available?” refers to a function that outputs an indicator whether a battery of the Roomba 2 is present on the Roomba 2. The behavior at lines 14-19 is initiated if a charger is not available. The behavior at lines 23-29 is initiated if a battery is not available. The behavior “user-charge” at lines 33-50 is initiated if a charger is available. If the charger is available, this behavior at line 37 sets the state of the Roomba 2 to “charging.” ***And at line 38, the “stop-all” function is called. This function stops all motors of the Roomba 2, thereby stopping forward movement of the Roomba 2.***

To the extent the Motion explains how the Second declaration clarifies the Original, it discusses only paragraph 27 of the Original. *See* Mot 1–2. Patent Owner reasons that, “as discussed in [Patent Owner]’s Sur-reply (at 4), the Petition used the same ‘is electrically connected’ language (Pet. 23) as the inventors used in discussing conception.” *Id.* (citing Ex. 2063 ¶ 27). In the Sur-reply, Patent Owner argues that “is electrically connected” and “charger-available?” indicate that the inventors had conceived of detecting contact with the charging terminals. *See* PO Sur-reply 4–5. But none of the paragraphs from the Original Vu Declaration referred to in the Second Vu Declaration, including paragraph 27, make any mention of charging terminals of the base station, detecting charging terminals, or stopping the robot upon detecting charging terminals. And, in testimony that Patent Owner cites in its Sur-reply, Ms. Vu testified that, prior to June 23, 2003, the hardware that they were using did not have charging contacts and instead used a bump sensor to stop the robot. *See id.* at 6–7. Patent Owner’s Sur-reply states:

As Ms. Vu testified with respect to the code files saved prior to June 23, 2003, “this is a prototype version,” and “we had not yet built the hardware because... it always takes longer to build hardware than software.” Ex-1051, 84:5-86:20. “So our early prototypes... were actually done just with two virtual walls next to each other.... So the way that that hardware at the time knew when to stop was from the bump sensor. We didn’t yet have charging contacts.” *Id.*

*Id.* We determine that, rather than clarifying the Original Vu Declaration, the Second Vu Declaration contains new testimony not found in the Original Vu Declaration and contradicts her deposition testimony. Patent Owner has not established that the Second Vu Declaration is a clarification of testimony in the Original Vu Declaration and we determine that the contrary is true.

*B. The Supplemental Information Reasonably Could Have Been Obtained Earlier*

As noted above, pursuant to 37 C.F.R. § 42.123(b), the Motion “must show why the supplemental information reasonably could not have been obtained earlier.” We determine that Patent Owner has failed to show why the testimony in the Second Vu Declaration reasonably could not have been obtained earlier.

As early in this case as the Patent Owner’s Response filed on February 16, 2022, Patent Owner recognized that it needed to provide evidence of conception of claim 1’s invention prior to June 23, 2003, in order to establish that Jeon and Abramson were not prior art. *See* PO Resp. 1; *see also* PO Sur-reply 1 (filed June 29, 2022) (“[Patent Owner] has the burden of production of sufficient evidence antedating Jeon and Abramson”) (citations omitted). And, in the Patent Owner’s Response, Patent Owner contended it had evidence of conception by the inventors of “detecting contact with charging terminals on the base station” and

“stopping the forward movement of the robotic cleaning device in response to detecting contact with the charging terminals on the base station” as recited in claim 1 (Ex. 1001, 19:32–52) including paragraph 27 of the Original Vu Declaration. PO Resp. 12. However, the only evidence Patent Owner cited that made specific reference to charging terminals of the base station was the declaration testimony of Daniel Ozick (Ex. 2064), another of the inventors (*see* Ex. 1001, code (72)). PO Resp. 12 (citing Ex. 2064 ¶ 27) (“The behavior “use-charge” [described in Ex. 2013] would be activated if the Roomba is connected to the charging contacts of the base station and would stop movement of the Roomba and initiate the charging process.”). Thus, Patent Owner recognized the need for evidence of conception of claim 1’s limitations as early as the Response to the Petition and attempted to supply such evidence. At the same time, Patent Owner submitted the Original Vu Declaration (Ex. 2063). Patent Owner does not argue, nor does it provide any persuasive supporting evidence, that it reasonably could not have obtained and provided the testimony that is in the Second Vu Declaration (the proffered supplemental information) at that same earlier time.

In its Reply, Petitioner argued that Patent Owner’s evidence did not show conception of detecting contact with the charging terminals on the base station and stopping forward movement of the robot in response to detecting contact with the charging terminals on the base station as recited in claim 1. *See* PET Reply 2–3. The Petitioner argued:

Conception is the “formation, in the mind of the inventor, of a definite and permanent idea of a complete and operative invention,” that is, what is *claimed*. *Solvay S.A. v. Honeywell Int’l Inc.*, 742 F.3d 998, 1000 (Fed. Cir. 2014). [Patent Owner] instead rewrites the claims to try to match its



evidence. [Patent Owner] asserts that element [1d], “detecting contact *with charging terminals* on the base station,” *instead* means detecting whether a base station charger “is electrically connected,” POR, 8, 12, 42, and that element [1e], “stopping the forward movement of the robotic cleaning device in response to detecting contact *with the charging terminals* on the base station,” *instead* means stopping a cleaning robot’s forward movement “in response to detecting that the [cleaning robot][<sup>10</sup>] is electrically connected to the base station.” POR, 8, 12, 39, 42. [Patent Owner]’s attempt to excise the requirement of detecting contact *with the charging terminals* is improper and contrary to the claims. Because [Patent Owner] fails to address what is *actually claimed*, its conception arguments should be rejected.

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[Patent Owner] contends that the “(charger-available?)” macro in EX2013 supports earlier conception of elements [1d] and [1e]. POR, 8, 12. In particular, [Patent Owner] argues that (charger-available?) indicates “whether a battery charger, such as a base station, is electrically connected to the Roomba,” and “if the charger is available,” a (stop- all) function “stops all motors, and thus forward movement.” POR, 12. But [Patent Owner] does not provide evidence defining these functions from the time of alleged conception before June 23, 2003. For example, [Patent Owner] fails to provide evidence of how (charger-available?) operates or whether it “detect[s] contact with the charging terminals,” as required by elements [1d] and [1e].

*Id.* (footnote omitted). Thus, in its Reply filed May 18, 2022, Petitioner challenged Patent Owner’s arguments and evidence regarding conception of claim 1 including specifically citing the Original Vu Declaration (Ex. 2063) including paragraph 27. *See* PET Reply 5–8, 10. Petitioner argued, “The

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<sup>10</sup> This change is in the original.

inventor declarations (EX2063 [Original Vu Declaration], EX2064) fail to address these inconsistencies with [Patent Owner]’s alleged conception date. The ‘Commit Messages’ also provide no identification of detecting contact with the charging terminals or stopping in response to such detection, as required by elements [1d]/[1e]” (*id.* at 6–7) and “EX2016 does not describe the ‘(charger-available?)’ macro from EX2013, and the declarations do not allege that Section 1.4 discloses detecting contact with the charging terminals or stopping forward movement in response to the detected contact, as claimed” (*id.* at 7 (citing Ex. 2063 [Original Vu Declaration] ¶¶41–42; Ex. 2064 ¶¶41–42)). Accordingly, Petitioner’s Reply specifically challenged Patent Owner’s arguments and evidence—including the Original Vu Declaration—regarding conception of claim 1’s limitations.

In responding to the Reply in which its arguments and evidence were challenged, Patent Owner had another, earlier opportunity to submit additional evidence relating to the conception of claim 1 and failed to do so. *See generally* PO Sur-reply (filed June 29, 2022). In its Sur-reply, Patent Owner clearly recognized that its arguments and evidence relating to conception of detecting contact with the charging terminals on the base station (referred to by the parties as element [1d]) and stopping forward movement of the robot in response to detecting contact with the charging terminals on the base station (referred to by the parties as element [1e]) was being challenged. *Id.* Patent Owner included a 7-page section in its Sur-reply with the heading, “[Patent Owner] produced sufficient evidence of conception of elements [1d] and [1e]” (*id.* at 2–8) in which Patent Owner cited the Original Vu Declaration (*id.* at 2) and relied on Ms. Vu’s deposition testimony (*id.* at 5, 6–7). Indeed, Patent Owner argued that “the

inventors' account of conception is supported by overwhelming documentary evidence.” *Id.* at 7. Patent Owner has not shown why the Second Vu Declaration and the information in it was not obtained and submitted at the earlier time of filing its Sur-reply.<sup>11</sup>

In its Motion, Patent Owner contends that the Second Vu Declaration, the proffered supplemental information, reasonably could not have been obtained earlier because Petitioner first raised questions regarding Ms. Vu's testimony regarding conception of the limitations of claim 1 during oral argument. *See* Mot. 1–4. Patent Owner argues, “[Patent Owner] could not have obtained Clara Vu's additional testimony earlier because [Patent Owner] and the inventors believed/believe (and were given by [Petitioner] no reason to earlier doubt) that the inventors' prior testimony was sufficient to establish direct evidence of conception of all claim limitations prior to June 23, 2003.” *Id.* at 1. In its Opposition to the Motion, Petitioner argues:

[Patent Owner] claims [Petitioner] first challenged its failure to demonstrate conception of elements 1[d] and [e] at the Hearing. Yet the *first section* of [Petitioner]'s Reply expressly stated that “[Patent Owner] does not address what is actually recited in elements [1d] and 1[e]” and that: (1) rather than addressing “what is *claimed* . . . [Patent Owner] instead rewrites the claims to try to match its evidence;” and (2) “[b]ecause [Patent Owner] fails to address what is *actually claimed*, its conception arguments should be

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<sup>11</sup> The PTAB Consolidated Trial Practice Guide, 73 provides that “[t]he sur-reply may not be accompanied by new evidence other than the deposition transcripts of the cross-examination of any reply witness.” (84 Fed. Reg. 64,280 (Nov. 21, 2019) (*available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>)). However, Patent Owner could have sought authorization to file a motion to submit supplemental information at this earlier time.

rejected.” Paper 46 at 2. This issue was squarely raised before the Hearing.

PET Opp. 1. We agree with Petitioner. As shown above, Patent Owner knew that the testimony in the Original Vu Declaration was being challenged and the issue of whether conception of detecting contact with the charging terminals on the base station (element [1d]) and stopping forward movement of the robot in response to detecting contact with the charging terminals on the base station (element [1e]) as recited in claim 1 had been established was being disputed months prior to the oral argument.

Patent Owner has not shown why the supplemental information reasonably could not have been obtained earlier. To the contrary, the record of this case shows that Patent Owner had ample opportunity to submit the proffered supplemental information, the Second Vu Declaration, earlier.

*C. Consideration of the Supplemental Information Would Be Contrary to the Interests-of-Justice*

In contending that the interests-of-justice compel consideration of the proffered supplemental information, the Second Vu Declaration, Patent Owner again argues that the supplemental information relates to an issue raised by Petitioner for the first time at oral argument and that Patent Owner was diligent in obtaining the Second Vu Declaration and seeking to submit it. *See* Mot. 4–5. As discussed above, the record of this proceeding does not support Patent Owner’s contention.

Patent Owner also argues that consideration of the supplemental information “does not result in undue prejudice to [Petitioner],” because, although “unnecessary,” “[Patent Owner] agrees to make Ms. Vu available for deposition upon request and proposes that [Petitioner] be allowed to submit observations on the deposition testimony, pursuant to the Trial

Practice Guide, 77 Fed. Reg. 48,767-48,768 (Aug. 14, 2012).” Mot. 4–5. We determine that another deposition of Ms. Vu and allowing Petitioner to submit observations would not cure the prejudice to Petitioner.

The record in this case was closed at the end of the oral argument without objection or comment by Patent Owner. Paper 62 (hearing transcript), 77. The adequacy of Patent Owner’s evidence of conception of the limitations of claim 1 was the subject matter of much argument at the oral argument and, immediately prior to oral argument being closed, Patent Owner argued that the Original Vu Declaration “certainly shows conception of these features.” *Id.* at 76–77.

Petitioner contends that consideration of the Second Vu Declaration is not in the interests-of-justice because “[t]he new testimony is inconsistent with prior testimony of the same declarant” and “this type of contradictory evidence should not be permitted after the Hearing.” PET Opp. 3–4. Petitioner argues that “[t]he prejudice to [Petitioner] is compounded by the late stage of the request because [Petitioner] cannot fully brief the issues, consult with its expert, potentially submit evidence in response, or confront [Patent Owner]’s substantial change at a hearing.” *Id.* at 4. We agree with Petitioner that the proffered supplemental information is inconsistent with and contradicts Ms. Vu’s prior declaration and deposition testimony (*see* Ex-1051, 84:5-86:20; Ex. 2063 ¶ 27) and that Petitioner would be prejudiced by consideration of the proffered supplemental information.

In *Ultratec*, the issue was the Board's refusal to enter newly-available, allegedly inconsistent expert testimony in a case where neither the reasons for the Board's refusal nor the testimony were made of record.

*Ultratec*, 872 F.3d at 1272–73. The Federal Circuit reversed the Board. Our facts are different.

Moreover, we recognize that “the introduction of new evidence in the course of the [PTAB] trial is to be expected in *inter partes* review trial proceedings and, as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible under the APA.”. *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 1345–46 (Fed. Cir. 2019) (quoting *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016)). Here, as explained above, Patent Owner has not met the requirements for timely seeking authorization to submit new evidence and for establishing that considering the proffered information is in the interests of justice.

Rule 42.123(b) sets forth the conditions to *file* a motion for supplemental information; it does not set forth the sole conditions to *grant* a motion for supplemental information. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445–449 (Fed. Cir. 2015). The movant retains the burden of establishing that the relief requested is warranted. 37 C.F.R. § 42.20(c). Among other things, we look to whether the moving party has articulated a specific reason to enter the evidence at that particular time under the guise of supplemental information.

The parties (and the Board) have expended much time and effort considering the record on conception of the limitations of claim 1 based on the evidence, including the Original Vu Declaration, that Patent Owner previously and timely submitted and argued. Patent Owner has not shown that it was prevented from proffering the Second Vu Declaration earlier in

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this proceeding or has been otherwise treated unfairly in a way that justifies consideration of the late-submitted supplemental information. To allow Patent Owner to change the record after the evidentiary record was closed would be very unfair to Petitioner. Consideration of the supplemental information would be contrary to the interests-of-justice.

#### IV. ORDER

For these reasons, it is hereby ORDERED that:

Patent Owner's Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b) (Paper 64) is *denied*.

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