

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL INC.
Petitioner,

v.

CREE, INC.,
Patent Owner

Case IPR2015-01361
U.S. Patent No. 8,860,058

**UNOPPOSED MOTION TO CORRECT PURSUANT TO
37 C.F.R. §§ 42.104(c), 42.5(b), and 42.5(c)(3)**

Petitioner Honeywell International Inc. moves to correct Exhibits 1007 and 1008 pursuant to 37 C.F.R. §§ 42.104(c), 45(b) and/or 45(c)(3). Patent Owner does not oppose this motion. On October 2, 2015, the Patent Trial and Appeal Board (“Board”) authorized Petitioner’s request to file this unopposed motion.¹

STATEMENT OF FACTS

1. On June 8, 2015, Petitioner filed a Petition to Institute *Inter Partes* Review against U.S. Patent No. 8,860,058 (IPR2015-01361). [Paper No. 1]. In that Petition, Petitioner relied on Exhibit 1007 (Japanese Patent Application Publication No. H05-152609 to Tadatsu) and Exhibit 1008 (Japanese Patent Application Publication No. S50-79379 to Tabuchi) to support its request for *inter partes* review. [Paper No. 1, Exhibit List].

2. For Exhibits 1007 and 1008, Petitioner submitted English translations for each respective Japanese reference, but inadvertently omitted the Japanese originals during the processing of Exhibits 1007 and 1008. [Paper No. 1, Exs. 1007, 1008]. The omitted Japanese originals are references

¹ The Board also authorized Petitioner’s unopposed motion to correct the same Exhibit 1007 and Exhibit 1008 found in the petitions for *inter partes* review filed in IPR2015-01360 and IPR2015-01378.

cited and filed by the Patent Owner during the original prosecution of U.S.

Patent No. 8,860,058. [See Paper No. 6, p. 2]. The English translations that Petitioner provided in Exhibits 1007 and 1008 were the very same translations that Patent Owner itself filed and relied upon during the original prosecution. [Paper No. 6, p. 2 (“they are file history copies of translations”)].

3. On September 17, 2015, Patent Owner filed its Preliminary Response, where Patent Owner raised the issue that Exhibits 1007 and 1008 did not contain the original Japanese references. [Paper No. 6, p. 2]. Patent Owner also raised the issue that Petitioner did not provide certifications for the translations in Exhibits 1007 and 1008. [Paper No. 6, p. 2].

4. In its Preliminary Response, Patent Owner did not allege that the translations were inaccurate and did not allege that it has been prejudiced either by the omission of the original Japanese references or by the omission of the certifications for the translations. [Paper No. 6].

5. In an effort to resolve this issue, the parties exchanges correspondence whereby Petitioner explained its basis for the requested corrections. Patent Owner has agreed not to oppose this motion.

RELIEF REQUESTED

By its motion, Petitioner requests that Exhibit 1007 and Exhibit 1008 be replaced with a corrected Exhibit 1007 and Exhibit 1008, where the corrected

Exhibits add the original Japanese reference (which is located in the file history) and a certification for the already submitted English translation, whereby the filing date of IPR2015-01361 remains unchanged. Petitioner attaches to this motion corrected Exhibit 1007 and corrected Exhibit 1008 as Exhibit 1015 and Exhibit 1016, respectively.

DISCUSSION

“A motion may be filed that seeks to correct a clerical or typographical mistake in the petition.” 37 C.F.R. § 42.104(c); *Arthrex, Inc. v. Bonutti Skeletal Innovations, LLC*, No. IPR2013-00631, (Paper 20) at 7 (P.T.A.B. Apr. 16, 2014) (granting motion to correct where petitioner supplied the English translations but inadvertently omitted the corresponding foreign originals). In the instant proceeding, Petitioner’s clerical error arose during the gathering and processing of the Exhibits for the petition. The attorneys worked with the legal assistant staff, where the staff were told that Exhibit 1007 and Exhibit 1008 were Japanese references that had accompanying English translations from the file history. The legal assistant staff worked to gather materials for each Exhibit in advance of filing, but the Japanese references were inadvertently omitted and not accompanied with the English translation at the back within each of Exhibit 1007 and Exhibit 1008.

“When determining whether to grant a motion to correct a petition, the

Board will consider any substantial substantive effect, including any effect on the patent owner's ability to file a preliminary response." 77 Fed. Reg. 48680, 48699; *Arthrex, Inc. v. Bonutti Skeletal Innovations, LLC*, No. IPR2013-00631, (Paper 20) at 5 (P.T.A.B. Apr. 16, 2014) (finding that "the substance of the [prior art] was revealed completely in the English-language translations" and that no evidence showed "a material effect on Patent Owner's ability to file its Patent Owner Preliminary Response"). In the instant proceeding, for its Preliminary Response, Patent Owner had the English translations for the prior art at issue, and did not assert that the translations were inaccurate and did not otherwise allege any prejudice due to the omission of the original foreign documents. The English translations that Petitioner filed in Exhibit 1007 and Exhibit 1008 were very same translations that Patent Owner itself filed and relied upon during prosecution of U.S. Patent No. 8,860,058 that is under petition here. [Paper No. 6, p. 2 ("they are file history copies of translations")]. The translations also identified the publication numbers for the Japanese originals, which are publicly available. [Paper No. 1, Exs. 1007, 1008].

On an independent and alternative basis, Petitioner seeks correction of the exhibits under 37 C.F.R. §§ 42.5(b) and 42.5(c)(3). The "conduct of proceeding" rule provides that "[t]he Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or

suspension.” 37 C.F.R. § 42.5(b). Further, this rule also provides that the Board may accept a late action “upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). In *Volkswagen Group of America, Inc. v. Emerachem Holdings, LLC*, IPR2014-01555, Paper No. 20, the Board allowed under 37 C.F.R. §§ 42.5(b) and 42.5(c)(3) the correction of exhibits with verified translations of Japanese prior art. *Id.* at 6-7. With the instant motion, Petitioner seeks to correct exhibits by adding the Japanese originals and certifications for the English translations it already submitted in Exhibits 1007 and 1008. The Japanese originals are cited prior art that Patent Owner itself filed during the original prosecution of U.S. Patent No. 8,860,058. The certifications would certify the accuracy of the very same English translations that Patent Owner filed and relied upon during prosecution. The Patent Owner, in its Preliminary Response, does not dispute the accuracy of the translations and did not otherwise assert any prejudice from the omission of the original Japanese references or the certifications of translation. [Paper No. 6, p. 2]. Accordingly, Petitioner requests permission to file corrected Exhibits 1007 and 1008.

Dated: October 6, 2015

Respectfully submitted,

By: /Jennifer A. Sklenar/
Jennifer A. Sklenar
(Reg. No. 40,205)

Case IPR2015-01361

Patent No. 8,860,058

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CERTIFICATE OF SERVICE

I hereby certify that on October 6, 2015, I caused a true and correct copy
of

1. UNOPPOSED MOTION TO CORRECT PURSUANT TO 37 C.F.R.
§§ 42.104(c), 42.5(b), and 42.5(c)(3)

2. Exhibits 1015-1016

to be served via electronic mail on the following counsel for Patent Owner
Cree, Inc.:

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Dated October 6, 2015

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