

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Cases IPR2017-00210 (Patent 7,116,710 B1)
IPR2017-00211 (Patent 7,116,710 B1)
IPR2017-00219 (Patent 7,116,710 B1)

Before KALYAN K. DESHPANDE, TREVOR M. JEFFERSON and
JOHN A. HUDALLA, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding and Motion to Correct Petition
37 C.F.R. §§ 42.5 and 42.104(c)

IPR2017-00210 (Patent 7,116,710 B1)
IPR2017-00211 (Patent 7,116,710 B1)
IPR2017-00219 (Patent 7,116,710 B1)

A. Background

The Board held a conference call on Friday, February 24, 2017, at approximately 1:00 p.m. between counsel for Petitioner, Apple Inc., and counsel for Patent Owner, California Institute of Technology, and Judges Jefferson and Hudalla. Petitioner sought the conference to request leave to file corrected exhibits in IPR2017-00210 (“IPR’210”), IPR2017-00211 (“IPR-211”), and IPR2017-00219 (“IPR-219”).¹ Patent Owner opposed Petitioner’s request.

In each of these IPRs, Petitioner sought to file three corrected exhibits, asserting that a clerical error caused incorrect exhibits to be filed in each IPR. Noting that the Petitioner was not time-barred from refileing the Petitions in each of the IPRs, Petitioner sought to file corrected exhibit copies in each case. Patent Owner objected to the timing of Petitioner’s request, given that Patent Owner Preliminary Response is currently due on March 1, 2017. Patent Owner also objected to the characterization of Petitioner’s exhibit filings as clerical mistakes.

In light of the timing involving multiple IPRs with similar exhibits, we authorized Petitioner to file a motion pursuant to 37 C.F.R. § 42.104(c) addressing the clerical error correction of the three exhibits by Tuesday,

¹ Petitioner also sought leave to file the three corrected exhibits at issue in IPR-210, IPR-211, and IPR-219 in five additional IPRs; namely, IPR2017-00297, IPR2017-00423, IPR2017-00700, IPR2017-00701, and IPR2017-00728.

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February 28, 2017.² We also directed Petitioner to confer with Patent Owner to determine whether the motion would be opposed. We further discussed with the parties that up to a one-month extension of time for filing Patent Owner's Preliminary Response would be considered in the IPR-210, IPR-211, and IPR-219. No additional time extensions were discussed or authorized in the present cases or other related IPRs.

Pursuant to our authorization, Petitioner filed an "Unopposed Motion to Submit Replacement Exhibits Pursuant to 37 C.F.R. § 42.104(c)" in IPR2017-00210, IPR2017-00211, and IPR2017-00219. Paper 13 (IPR-210); Paper 12 (IPR-211); Paper 12 (IPR-219). The motion indicates that Patent Owner does not oppose the relief requested by Petitioner but does not acquiesce to any of Petitioner's factual assertions. Paper 13, 7 (IPR-210), Paper 12, 7 (IPR-211), Paper 12, 7 (IPR-219). Petitioner also filed copies of the corrected exhibits it seeks to submit in each case as appendices to each motion. *Id.*

B. Motion to Correct Exhibits

The Board's rules allow for the correction of certain clerical mistakes:

A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

² During the conference, the Board also authorized Petitioner to file a motion pursuant to 37 C.F.R. § 42.104(c) in the five additional IPRs (IPR2017-00297, IPR2017-00423, IPR2017-00700, IPR2017-00701, and IPR2017-00728) by Friday, March 3, 2017.

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37 C.F.R. § 42.104(c). Our cases have noted that § 42.104(c) is remedial in nature and entitled to a liberal interpretation. *See ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, slip op. at 7 (PTAB Jan. 16, 2013) (Paper 21); *Syntroleum Corp. v. Neste Oil OYJ*, IPR2013-00178, slip op. at 5 (PTAB July 22, 2013) (Paper 21); *Owens Corning v. Certainteed Corp.*, IPR2014-01397, slip op. at 2 (PTAB Dec. 17, 2014) (Paper 10).

In the present cases, based on our review of the facts set forth in the supporting declarations and Petitioner's unopposed motion, we determine that Petitioner has met its burden of establishing that a clerical error led to the filing of incorrect exhibits in IPR-210 (Ex. 1002, Ex. 1003, and Ex. 1020; IPR-211 (Ex. 1102, Ex. 1103, and Ex. 1120); and IPR-219 (Ex. 1202, Ex. 1203, and Ex. 1220). Paper 13 (IPR-210); Paper 12 (IPR-211); Paper 12 (IPR-219). Accordingly, we grant Petitioner's request to replace the identified exhibits in IPR-210, IPR-211, and IPR-219.

C. Conduct of Proceeding

Patent Owner's Preliminary Response in IPR-210, IPR-211, and IPR-219 is currently due March 1, 2017. During the conference with the parties, the Board indicated that up to a one-month extension of time for filing the Preliminary Response would be considered should the Board grant Petitioner's motion to correct exhibits at this late juncture. Petitioner noted that it does not oppose a one-month extension to April 3, 2017, for the filing of the Patent Owner's Preliminary Response under these circumstances. Paper 13 (IPR-210); Paper 12 (IPR-211); Paper 12 (IPR-219).

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In light of the substitute exhibits in IPR-210, IPR-211, and IPR-219, we grant Patent Owner a one-month extension to file its Patent Owner's Responses in IPR-210, IPR-211, and IPR-219. *See* 37 C.F.R. § 42.5(c). These filings are now due on or before April 3, 2017.

ORDER

It is, therefore,

ORDERED that Petitioner's Motion to Submit Replacement Exhibits Pursuant to 37 C.F.R. § 42.104(c) is granted; and

FURTHER ORDERED that Petitioner shall file the corrected exhibits in IPR2017-00210 (Ex. 1002, Ex. 1003, and Ex. 1020); IPR2017-00211 (Ex. 1102, Ex. 1103, and Ex. 1120); and IPR2017-00219 (Ex. 1202, Ex. 1203, and Ex. 1220) and note that the exhibits are replacement or corrected in the filing metadata where applicable; and

FURTHER ORDERED that the due date for Patent Owner's Preliminary Responses in IPR2017-00210, IPR2017-00211, and IPR2017-00219 is extended to April 3, 2017.

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