

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ABB INC.  
Petitioner

v.

ROY-G-BIV CORP.  
Patent Owner

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Case IPR2013-00063 (TLG)  
US Patent 6,513,058

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Before THOMAS L. GIANNETTI, *Administrative Patent Judge*.

DECISION  
MOTION TO CORRECT PETITION  
37 C.F.R. § 42.104(c)

## PROCEDURAL HISTORY

On November 26, 2012, ABB Inc. (“ABB”) moved under 37 C.F.R. § 42.104(c) to correct the Petition uploaded in this proceeding on November 21, 2012. Paper No. 8. On December 13, 2012, the Board denied the motion without prejudice. Paper No. 14. In denying the original motion, the Board gave ABB leave to renew the motion. *Id.* On December 24, 2012, ABB filed a renewed motion (Paper No. 17) supported by three declarations. EX 1035-37.<sup>1</sup> On January 2, 2013, the Patent Owner, ROY-G-BIV Corporation (“RGB”), filed an opposition. Paper No. 20. For the reasons set forth below the Board grants the renewed motion.

## FINDINGS OF FACT

In denying ABB’s earlier motion without prejudice, the Board gave ABB an opportunity to submit additional evidence under oath and renew the motion. Paper No. 14, pp. 3-4. As noted *supra*, ABB submitted three declarations in support of its renewed motion. The Board has reviewed these declarations and found them to be both credible and essential to its decision. Based on these evidentiary showings, which are undisputed by RGB, the Board makes the following findings of fact:

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<sup>1</sup> EX 1035: Declaration of Richard D. Mc Leod; EX 1036: Declaration of Toni Kammers; EX 1037: Declaration of Emmy Burns.

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1. On November 21, 2012, ABB's counsel, using the PTO's Patent Review and Processing System ("PRPS"), filed requests for inter partes review of two patents owned by Patent Owner RGB. Those patents are US Patents 6,516,236 ('236 patent) and 6,513,058 ('058 patent).

2. ABB's counsel was assisted in the filing by several legal assistants. The first legal assistant, using PRPS, opened a new matter for uploading and filing documents for an inter partes review directed to the '058 patent. Burns Decl. ¶ 4. The first legal assistant correctly input the patent number, the number of challenged claims, the identification of the challenged claims, the grounds on which the claims are challenged, as well as correctly identifying the petitioner and the patent owner. *Id.* The new proceeding was designated IPR 2012-00063 by PRPS. *Id.* Appendix A.

3. The first legal assistant also uploaded through PRPS the correct exhibits to IPR2012-00063 from a network server on the firm's computer network. Burns Decl. ¶ 5.

4. At around noon on November 21<sup>st</sup>, counsel for ABB received authorization from the client to file the petition directed to the '236 patent and the petition directed to the '058 patent. McLeod Decl. ¶11.

5. In the afternoon of November 21<sup>st</sup>, a second legal assistant, who had previously uploaded the exhibits for the proceeding directed to the '236 patent, was told that both petitions were ready for filing with the PTO. Kammers Decl. ¶¶ 7, 10.

6. The documents for both proceedings (petition, exhibit list, and transmittal letter) were stored on the network server of ABB's counsel. The second legal assistant created the final PDF files for uploading through PRPS. *Id.* ¶ 10.

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7. The PDFs of the transmittal letter, exhibit list, and petition for the '058 patent request were stored on the network server in a subdirectory designated \-01 IP RX Review re USP 6,513,058\. *Id.* ¶¶12-14.

8. The PDFs of the transmittal letter, exhibit list, and petition for the '236 patent request were stored in a subdirectory designated \-02 IP RX Review re USP 6,516,236\. *Id.* ¶¶11, 15-16.

9. Joined by the first legal assistant, and a third legal assistant who had previous experience with PRPS, the second legal assistant uploaded the correct PDFs for the inter partes review request for the '236 patent, which PRPS had designated as IPR2013-00062. *Id.* ¶¶ 6, 17-18.

10. At that point the first legal assistant left to package the documents for service on the Patent Owner. *Id.* ¶ 19.

11. When uploading the final PDF documents for the proceeding (IPR2013-00063) directed to the '058 patent, the second legal assistant mistakenly navigated to the wrong folder on the network server. *Id.* ¶ 21. Instead of uploading the transmittal letter, exhibit list, and petition from the directory for the '058 patent, the legal assistant uploaded the corresponding documents from the directory for the '236 patent. *Id.* ¶ 22.

12. The uploading of the documents from the wrong directory was accidental and unintentional, and was the result of the second legal assistant confusing the "02" matter number in the directory name with the second IPR filing, namely IPR2013-00063.

*Id.* ¶¶21-22.

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13. The error was not noticed by ABB's counsel until Sunday, November 25, 2012.<sup>2</sup> ABB's counsel contacted the second legal assistant to report the error and began drafting a motion to correct the mistake. Mc Leod Decl. ¶19. Kammers Decl. ¶ 26.

14. A motion to correct the error was filed by ABB on Monday, November 26<sup>th</sup>, before the normal intake processing of the Petition was complete and the error was noticed by the Board. Paper No. 8.

15. The substitute documents submitted with the motion as Exhibits 1032-34 were the same documents that had been prepared for filing on November 21<sup>st</sup>. Mc Leod Decl. ¶ 20.

16. On November 21, 2012, copies of the correct documents for both cases were served on Patent Owner by Express Mail. Burns Decl. ¶¶ 8-10. The documents were delivered to Patent Owner on November 23<sup>rd</sup>. *Id.* ¶10.

## DISCUSSION

### *Clerical Error*

An inter partes review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104. The purpose is to give adequate notice to the Patent Owner of the basis for relief by laying out the petitioner's grounds and supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763 (Aug. 14, 2012). Where a party files an incomplete petition no filing date is accorded. 37 C.F.R. § 42.106.

The Board's rules, however, make allowance for correction of certain clerical mistakes. Thus, 37 C.F.R. § 42.104(c) provides:

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<sup>2</sup> Thursday, November 22nd, was a national holiday (Thanksgiving Day).

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.

As this rule is new, effective only as of September 16, 2012, it has not previously been considered by the Board pursuant to its power to interpret its own rules. *See, e.g., Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008); *cf. Chase Bank USA, N.A. v. McCoy*, 131 S.Ct. 871, 881-82 (2011). The Federal Circuit and its predecessor court, however, have addressed the nature of “clerical error” in the context of customs law. *See S. Yamada v. United States*, 26 C.C.P.A. 89 (CCPA 1938). In *Yamada*, a customs broker was requested by his supervisor to file certificates in a certain form. The broker intended to file the correct certificates to secure a refund and protect the importer’s rights, but by mistake filed certificates that were no longer used. 26 C.C.P.A. at 92. The trial court found no clerical error. The CCPA reversed, concluding that “[w]e think the instant case shows inadvertence and mistake resulting in clerical error within the meaning of the controverted provision.” *Id.* at 95 (citation omitted). More recently, *Yamada* was cited approvingly and followed by the Federal Circuit in *Ford Motor Co. v. United States*, 157 F.3d 849, 859-60 (Fed. Cir. 1998).

To a similar effect is the decision of the District of Columbia Circuit in *Brenner v. State of Israel*, 400 F.2d 789 (D.C. Cir 1968), an action against the Commissioner of Patents under 35 U.S.C. § 145. In *Brenner* the patent owner, due to clerical error, failed to file the certified copy of the original foreign application required to claim foreign priority under 35 U.S.C. § 119. *Id.* at 790. Within three weeks after the patent had issued, the patent owner submitted the certified copy and applied to the Patent Office for a reissue of the patent. *Id.* The Board

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concluded that the filing of the certified copy was a prerequisite to claiming priority that could not be corrected; the district court reversed, and the Commissioner appealed. 400 F.2d at 790. In affirming the district court decision, the D.C. Circuit remarked: “There is force in appellant’s contention that Section 119 is a mandatory provision which specifically and without equivocation prohibits the granting of priority rights unless its procedural requirements are fulfilled....Nevertheless, to ascertain the will of Congress in this very narrow context, care must be taken before concluding that a trivial clerical error, such as the one which occurred here, should operate forever to deprive a patent applicant of a priority right to which he would otherwise be entitled.” *Id.* at 790-91 (footnote omitted).

The Board concludes, based on the undisputed facts set forth *supra* and the guidance provided by the above authorities, that the error by ABB’s counsel in failing to upload the correct documents qualifies as clerical error under 37 C.F.R. § 42.104(c).

*Availability of Correction under §42.104(c)*

In analyzing the availability of correction under 37 C.F.R. § 42.104, the Board starts with the proposition that the rule is remedial in nature and is therefore entitled to a liberal interpretation. *See, e.g., Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967) (“[W]e are guided by the familiar canon of statutory construction that remedial legislation should be construed broadly to effectuate its purposes.”) In that respect the rule is similar to the reissue statute discussed *supra* in connection with the *Brenner* decision. *See also In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984).

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In *Medrad, Inc. v. Tyco Healthcare Group LP*, 466 F.3d 1047 (Fed. Cir. 2006), an appeal from a decision of the ITC, the Federal Circuit construed the reissue statute as permitting correction of a reissue patent by filing supplemental reissue declarations under 37 C.F.R. § 1.175. The ITC had construed the reissue statute as limited to correction of errors in the specification, drawings, or claims, but not the filing of declarations. 466 F.3d. at 1049. Because the failure to file the proper declarations was deemed “procedural” the ITC declared the patent invalid. *Id.* at 1049-50. In reversing the ITC decision, the Federal Circuit pointed to the remedial nature of the reissue statute, and concluded that the error to be cured by reissue did not have to occur in the actual language of the claims themselves. *Id.* at 1052-53. Another example of such liberal construction by the Federal Circuit is *In re Staats*, 671 F.3d 1350 (Fed. Cir. 2012). In *Staats*, the two-year bar for presenting broadened claims in a reissue was held not to be applicable where a first broadened reissue application was filed within the two-year limit, even though the challenged claims were not. *See* discussion at 671 F.3d 1355-56.

Consistent with the approach followed by the Federal Circuit, the Board concludes that 37 C.F.R. § 42.104(c) is available to ABB to correct the error in uploading the petition in this proceeding. As in *Brenner* and *Medrad*, the rule is not limited to correcting errors in previously-filed documents, but is broad enough to encompass clerical errors in uploading the documents especially where, as here, the correct documents were served. Not only is this consistent with the remedial nature of the rule, but also with the realities of the modern work place, where errors are as likely to be the result of clicking on the wrong link as hitting the wrong key.

Notwithstanding the remedial nature of the rule, however, the burden remains on the moving party and the evidence of clerical error will be closely



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scrutinized. Only where there is a strong showing will relief be granted. Here that burden was met by Petitioner's three credible declarations detailing the circumstances of the error.

*Patent Owner's Opposition*

The Board is not persuaded by Patent Owner's arguments as to why the motion should be denied. *See* Patent Owner Roy-G-Biv Corporation's Opposition to Petitioner ABB Inc.'s Motion to Correct Clerical Error under 37 C.F.R. § 42.104(c). ("RGB Opp.")

Patent Owner first argues that the uploading of incorrect documents is not a "clerical or typographical" mistake that can be corrected under the rule. RGB Opp. 5. The Board does not agree. The decisions in *Yamamoto* and *Ford Motor Company*, *supra*, and the D.C. Circuit's decision in *Brenner* make clear that the error by ABB's counsel is clerical in nature. Furthermore, the certificate of correction statute and related cases relied on by Patent Owner (RGB Opp. 5) are unavailing. With certificates of correction the concern is the addition of new matter that is not subject to examination. Thus, the statute quoted in part by Patent owner (35 U.S.C. § 255) further provides: "[T]he Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes as would constitute new matter or would require reexamination." That is not a concern here as the petition and related documents will be reviewed thoroughly in determining whether to institute this proceeding.

Next Patent Owner contends that granting the motion would have a "profound and substantial substantive effect" on their ability to file a preliminary response. RGB Opp. 6. The Board does not agree. Patent Owner received the correct petition and other documents on November 23<sup>rd</sup>. As it is, Patent Owner

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will have a full three months from the date of this order to file a preliminary response. *See* Order, *infra*. Nor will the Board’s decision whether to institute a review be impacted. RGB Opp. 6-7. The Board will have three months from the date of the preliminary response to make that decision. Nor should there be concern about prejudice to the public, as the correct information entered by ABB on November 21<sup>st</sup> provided notice of the parties, patent number, challenged claims, statutory grounds, and exhibits relied upon by ABB. *See supra*, Findings of Fact ¶¶ 2-3.

Patent Owner’s citation of IPR2012-0022 as evidence that “far less serious errors than ABB’s ... cannot be corrected under § 42.104,” and its description of IPR2013-00036, and IPR2013-00034 as reflecting “decisions under § 42.104(c)” mischaracterize the record in those proceedings. RGB Opp. 7-8, n.1. There were no requests for correction under § 42.104(c) in any of those matters and the referenced orders in those cases specifically cited to § 42.6(a)(2)(iii), not § 42.104(c).

The Board is not persuaded by Patent Owner’s argument narrowly construing the language “in” the petition to exclude errors in uploading the petition and related documents. RGB Opp. 8-10. A similar argument for narrow construction of a remedial statute was rejected by the Federal Circuit in *Medrad*, *supra*, and by the D.C. Circuit in *Brenner*, *supra*.

Nor is the Board convinced by the argument, based on the language of § 42.104(c), that the filing date of the petition would not change if the motion is granted. RGB Opp. 10-11. Correctly construed, the language of the rule means that granting the motion gives the moving party the date of the erroneous filing. Accepting Patent Owner’s position would make the language “[t]he grant of such a motion does not change the filing date of the petition” superfluous.

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Finally, the Board does not agree that granting the motion would “violate” 35 U.S.C. § 315(b) (RGB Opp. 11-12), any more than the outcome in *Staats*, supra “violates” the two-year time bar for broadened reissue claims. In granting this motion the Board is simply exercising its power to interpret its own rules. *See* supra.

### ORDER

In light of the foregoing, it is, therefore,

**ORDERED** that ABB’s Renewed Motion to Correct Clerical Error is granted;

**FURTHER ORDERED** that ABB’s Petition (EX 1032), Exhibit List (EX 1033), and Transmittal Letter (EX 1034) shall be substituted for the corresponding documents uploaded on November 26, 2012, and will be granted a filing date of November 21, 2012;

**FURTHER ORDERED** that Patent Owner’s Preliminary Response to the Petition shall be due within three months from the date of this decision.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SCHOTT GEMTRON CORPORATION,  
Petitioner,

v.

SSW HOLDING COMPANY, INC.,  
Patent Owner.

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Case IPR2014-00367  
Patent 8,286,561 B2

Before JUSTIN T. ARBES, PHILIP J. HOFFMANN, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION  
Petitioner's Motion to Correct Filing Date  
*37 C.F.R. § 42.5*

IPR2014-00367  
Patent 8,286,561 B2

Petitioner filed a motion to correct the filing date accorded to its Petition in this proceeding. Paper 22 (“Mot.”). Patent Owner was authorized to file an opposition by September 4, 2014, but did not do so. *See* Paper 21 at 5. For the reasons stated below, Petitioner’s motion is *granted*.

Petitioner filed its Petition, along with Exhibits 1101–1109, in the Patent Review Processing System (PRPS) on January 18, 2014. Petitioner listed in its exhibit list that Exhibit 1109 was the “Declaration of Chris B. Schechter,” *see* Paper 2 at v, but the version of Exhibit 1109 filed on January 18, 2014 was a copy of U.S. Patent Application Publication No. 2004/0202872 A1, not a declaration. Petitioner subsequently filed Mr. Schechter’s declaration, also numbered as Exhibit 1109, on January 21, 2014. The Petition was accorded a filing date of January 18, 2014. Paper 3. Because the Petition as filed originally did not include a copy of Mr. Schechter’s supporting declaration as required by 35 U.S.C. § 312(a)(3)(B), we ordered that the Petition be accorded a filing date of January 21, 2014. Paper 21 at 3–4.

Petitioner argues in its motion that the Petition should be accorded a filing date of January 18, 2014, because the filing of the incorrect version of Exhibit 1109 was a clerical error. Mot. 3–5. Petitioner provides a declaration from its counsel describing the actions he took in filing the Petition. Ex. 1114. Petitioner’s counsel states that he inadvertently labeled two files as Exhibit 1109, and uploaded the incorrect version to PRPS by mistake. *Id.* ¶¶ 3–4. Petitioner’s counsel further explains that after discovering the error, he contacted the Board on the next business day (January 21, 2014) and filed the correct version of Exhibit 1109. *Id.* ¶¶ 6–8.

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Based on our review of the facts as set forth in the declaration of Petitioner's counsel, we are persuaded that uploading the incorrect version of Exhibit 1109 was a clerical error and that it would be appropriate under the circumstances to correct the filing date accorded to the Petition. The record supports Petitioner's position that it meant to file Mr. Schechter's declaration, as the exhibit list and body of the Petition reference the declaration as Exhibit 1109 throughout. *See* Paper 2 at v, 20, 23, 24, 36, 38, 44. Further, Petitioner served Patent Owner with a copy of Mr. Schechter's declaration on January 18, 2014, as Patent Owner acknowledged during a previous conference call. *See id.* at 59 (certificate of service); Paper 21 at 2–3; Ex. 1114 ¶ 5. Similar errors have been found correctable in other proceedings, upon a sufficient showing from the filing party that the error was clerical in nature. *See, e.g., Conmed Corp. v. Bonutti Skeletal Innovations LLC*, IPR2013-00624, slip op. (PTAB Feb. 21, 2014) (Paper 18); *Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178, slip op. (PTAB July 22, 2013) (Paper 21); *ABB Inc. v. Roy-G-Biv Corp.*, IPR2013-00063, slip op. (PTAB Jan. 16, 2013) (Paper 21).

Finally, we remind the parties of the need to review documents filed in PRPS to ensure that they are correct, and to notify the Board and the other party promptly if any error occurs.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's motion (Paper 22) to correct the filing date accorded to its Petition is *granted*;

FURTHER ORDERED that the Petition is accorded a filing date of January 18, 2014; and

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FURTHER ORDERED that the original version of Exhibit 1109 filed on January 18, 2014 (U.S. Patent Application Publication No. 2004/0202872 A1) is expunged from the record of this proceeding.



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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SYNTROLEUM CORPORATION,  
Petitioner

v.

NESTE OIL OYJ,  
Patent Owner

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Case IPR2013-00178  
Patent 8,212,094

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Before MICHAEL P. TIERNEY, JONI Y. CHANG, and  
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

DECISION  
Motion to Correct Petition  
*37 C.F.R. § 42.104(c)*

IPR2013-00178  
Patent 8,212,094

On July 3, 2013, Syntroleum Corporation (“Syntroleum”) filed a Motion to Correct Petition under 37 C.F.R. § 42.104(c), seeking to correct Exhibit 1006 uploaded with the Petition filed in this proceeding on March 8, 2013. Paper No. 16, “Mot.” The motion was supported by two declarations. Ex. 1036-37.<sup>1</sup> Syntroleum also filed a copy of the exhibit to be substituted for originally-filed Exhibit 1006. Ex. 1038. On July 10, 2013, the Patent Owner, Neste Oil Oyj (“Neste”), filed an opposition. Paper No. 18, “Opp.” For the reasons set forth below, the Board grants Syntroleum’s motion.

#### FINDINGS OF FACT

As noted above, Syntroleum submitted two declarations in support of its motion. The Board has reviewed these declarations and found them to be credible. Based on these evidentiary showings, the Board makes the following findings of fact:

1. In December of 2012, while preparing to file a petition for *inter partes* review of U.S. Patent No. 8,212,094 (“the ‘094 patent”) on behalf of his client Syntroleum, attorney Joseph P. Meara requested that a folder be created on his firm’s shared network drive to be a repository for all prior art cited during prosecution of the ‘094 patent. Ex. 1036 (Meara Decl.) ¶ 4. The network path for this folder was “J:\Syntroleum (102440)\Lit re US 8,212,094 (0116 matter).” *Id.*
2. A copy of European Patent 1396531 B1 (“EP ‘531 B1”), cited during the prosecution of the ‘094 patent, was placed in the “Lit re US 8,212,094 (0116 matter)” shared network drive at Mr. Meara’s request. *Id.* The reference was

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<sup>1</sup> Ex. 1036: Declaration of Joseph P. Meara; Ex. 1037: Declaration of Janet Lee.

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stored in PDF format with the title “EP001396531,” omitting any indication it was the B1 version of the reference. *Id.*

3. In late February and early March of 2013, Janet Lee, a legal assistant with Mr. Meara’s firm, assisted in the preparation of Syntroleum’s petition for *inter partes* review of the ‘094 patent. Ex. 1037 (Lee Decl.) ¶ 2. One of Ms. Lee’s responsibilities was to compile the exhibits to the petition and subsequently upload the exhibits to the Board’s Patent Review Processing System (PRPS). *Id.*

4. In compiling the exhibits to be filed with Syntroleum’s petition, Ms. Lee created a new folder on the shared network drive, named “J:\Syntroleum (102440)\0125 References for Inter Partes Review,” and collected references from various other folders on the network drive. *Id.* at ¶ 3. At that time, Ms. Lee copied the EP ‘531 B1 reference from its location in the “Lit re US 8,212,094 (0116 matter),” believing it to be one of the references cited in Syntroleum’s petition. *Id.*

5. As filed, Syntroleum’s petition does not cite EP ‘531 B1. Rather, both the petition and the Declaration of Dr. Edward L. Sughrue II submitted therewith reference Published European Patent Application EP 1396531 A2 (“EP ‘531 A2”), the application that eventually matured into the EP ‘531 B1 patent. *See* Petition (Paper No. 2) pp. 8, 12; Ex. 1002 ¶ 43.

6. Prior to and after uploading EP ‘531 B1 to PRPS, Ms. Lee reviewed the exhibit to verify it was properly uploaded. Ex. 1037 ¶ 4. At that time, while Ms. Lee verified that Exhibit 1006 was EP 1396531, she did not notice it was the B1 version instead of the A2 version cited in the petition. *Id.* Mr. Meara also verified that Exhibit 1006 was EP 1396531, but did not notice it was the B1 version. Ex. 1036 ¶ 9.

7. Ms. Lee’s submission of EP ‘531 B1 as Exhibit 1006 was accidental and unintentional. Ex. 1037 ¶ 5. Counsel for Syntroleum remained unaware the

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incorrect version of EP 1396531 had been uploaded to PRPS until June 14, 2013, when Neste filed its preliminary response. Ex. 1036 ¶ 10. Within two business days, counsel for Syntroleum contacted the Board to request permission to file a Motion to Correct. *Id.*

## DISCUSSION

An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104. A complete petition gives notice to the Patent Owner of the basis for relief by laying out the petitioner's grounds and supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763 (Aug. 14, 2012). Where a party files an incomplete petition, no filing date is accorded. 37 C.F.R. § 42.106.

The Board's rules, however, make allowance for the correction of certain clerical mistakes. Thus, 37 C.F.R. § 42.104(c) provides:

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.

We have previously noted that this rule is remedial in nature and therefore is entitled to a liberal interpretation. *See ABB Inc. v. ROY-G-BIV Corp.*, Case IPR2013-00063, Paper No. 21 (Decision – Motion to Correct Petition), at 7 (citing *Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967)). As we stated in *ABB*, Rule 42.104(c):

is not limited to correcting errors in previously-filed documents, but is broad enough to encompass clerical errors in uploading the documents .... Not only is this consistent with the remedial nature of the rule, but also with the realities of the modern work place, where errors are as likely to be the result of clicking on the wrong link as hitting the wrong key.

*Id.* at 8.

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Patent 8,212,094

Based on our review of the facts as set forth in the declarations of Mr. Meara and Ms. Lee, we have determined that Syntroleum has carried its burden of establishing that a clerical error led to the inadvertent submission of EP ‘531 B1 as Exhibit 1006. While a strong showing is required before a motion to correct will be granted, the Board concludes that Syntroleum has made such a showing.

Neste’s opposition to Syntroleum’s motion does not contend that Neste was prejudiced by Syntroleum’s clerical error or assert that Neste was not put on notice that Syntroleum had intended to rely on the EP ‘531 A2 reference. Rather, Neste’s opposition rests solely on the argument that neither Mr. Meara nor Ms. Lee state in their declarations that they were ever in possession of EP ‘531 A2. Opp. 2. According to Neste, “the evidence submitted by Petitioner fails to establish that anyone involved in preparing or submitting the amended petition for IPR ever possessed or reviewed a copy of [EP ‘531 A2].” *Id.* at 2-3.

The Board is not persuaded by Neste’s argument on this point. As we noted above, both Syntroleum’s originally filed petition and the declaration of Dr. Sughrue contain references to EP ‘531 A2. Furthermore, both the petition and Dr. Sughrue cite disclosures that are present in EP ‘531 A2 but absent from EP ‘531 B1. *See, e.g.*, Pet. 11 (discussing disclosure of TOFA in Example 1 of EP ‘531); Ex. 1002 ¶ 45 (discussing same). It is readily apparent that individuals involved in the preparation of Syntroleum’s petition possessed and reviewed EP ‘531 A2, contrary to Neste’s argument.

#### ORDER

In light of the foregoing, it is

**ORDERED** that Syntroleum’s Motion to Correct Clerical Error is granted;  
and

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Patent 8,212,094

**FURTHER ORDERED** that Syntroleum's Exhibit 1038 (EP 1396531 A2) shall be substituted for Exhibit 1006 (EP 1396531 B1), and will be granted a filing date of March 8, 2013.

For Petitioner:

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2015 WL 906007 (Patent Tr. & App. Bd.)

Patent Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

FLIR SYSTEMS, INC., PETITIONER,

v.

LEAK SURVEYS, INC., PATENT OWNER.

Case IPR2015-00065

[Patent 8,426,813 B2](#)

February 25, 2015

**FOR PETITIONER:**

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Before [FRED E. MCKELVEY](#), [JAMES T. MOORE](#), and TREVOR M. JEFFERSON

Administrative Patent Judges

JEFFERSON

Administrative Patent Judge

DECISION

Institution of *Inter Partes* Review

[37 C.F.R. § 42.108](#)

I. INTRODUCTION

FLIR Systems Inc. (“Petitioner”) filed a Petition (“Pet.”) requesting an *inter partes* review of claims 23-30, 32-36, 41 and 57 of [U.S. Patent No. 8,426,813 B2](#) (Ex. 1001, “the ‘813 patent”) pursuant to [35 U.S.C. §§ 311-319](#). Paper 2. Petitioner



subsequently withdrew claim 29 from the requested *inter partes* review, thus challenging only claims 23-28, 30, 32-36, 41 and 57 of the '813 patent. Paper 10. Pursuant to the Board's Order (Paper 7, 2), Leak Surveys, Inc. ("Patent Owner") filed a Preliminary Response in two parts, (Part 1 "Prelim. Resp. P1.," Paper 8 and Part 2 "Prelim. Resp.," Paper 16). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Upon consideration of the Petition, we determine that the information presented shows there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claims. Accordingly, pursuant to 35 U.S.C. § 314, the Board institutes *inter partes* review as to claims 23-28, 30, 32-36, 41 and 57 of the '813 patent.

#### A. Related Proceedings

\*2 Petitioner states that the '813 patent has been asserted by Patent Owner in *Leak Surveys, Inc. v. FLIR Systems, Inc.*, Civil Action No. 3:13-CV-02897-L (N.D. Tex.) (filed July 25, 2013). Pet. 1; Paper 4, 2. In addition, the '813 patent is the subject of two petitions for *inter partes* review. The first, *FLIR Systems, Inc. v. Leak Survey, Inc.*, IPR2014-00411, filed March 4, 2014, by Petitioner, and instituted September 5, 2014, and the second, *FLIR Systems, Inc. v. Leak Survey, Inc.*, IPR2014-00608, filed April 11, 2014, by Petitioner, and institution was denied September 5, 2014. *Id.* *Inter Partes* Review of U.S. Patent No. 8,193,496 ("the '496 patent"), to which the '813 patent claims priority was instituted on September 5, 2014, in *FLIR Systems, Inc. v. Leak Survey, Inc.*, IPR2014-00434. *Id.* The two instituted *inter partes* reviews, IPR2014-00434 and IPR2014-0411, were consolidated into a single proceeding. *FLIR Systems, Inc. v. Leak Survey Inc.*, Case IPR2014-00411 (PTAB Sep. 5, 2014) (Paper 11) (Order Consolidating Proceedings).

#### B. The '813 Patent

The '813 patent is based on an application which is a continuation of the application which matured into the '496 patent. Ex. 1001, 1:6-9. The '813 patent relates to an infrared (IR) camera system which can be used to visually detect and identify chemical, gas, and petroleum product leaks. Ex. 1001, 1:27-29 and 28:44-67.

The '813 invention is readily understood by reference to its drawings and exemplary claims 1, 23, and 24. Figs. 1 and 2 of the '813 patent are reproduced below.

Fig. 1 depicts a perspective view of a chemical leak detection system

Fig. 2 depicts a schematic of an infrared camera system of Fig. 1

Figures 1 and 2 show infrared camera system 22, lens assembly 40, and lens 38. Ex. 1001, 5:34-38. Camera system 22 has refrigerated portion 42 cooled by refrigeration system 60. *Id.* at 5:34-41; 5:66-67. The refrigerated portion 42 also comprises infrared sensor device 44 and optical bandpass filter 46. *Id.* at 5:41-43. The refrigeration cools optical bandpass filter 46, reducing the background noise of bandpass filter 46 as perceived by infrared sensor device 44. *Id.* at 6:454-46. Optical bandpass filter 46 is located along an optical path between lens 38 and infrared sensor device 44. *Id.* at 5:41-43. At least part of a pass band for optical bandpass filter 46 is within an absorption band for the detected chemical. The infrared image of the detected chemical passes through the lens and optical bandpass filter and the filtered infrared image of the leak is received with the infrared sensor device. *Id.* at 3:4-11. The visible image of the leak is produced by processing the filtered infrared image received by the infrared sensor device. *Id.*

\*3 Independent claim 1 and dependent claims 23 and 24 are illustrative of the claimed subject matter.

1. A system for producing a visible image of a leak of any one or more chemicals of a group of chemicals, the leak emanating from a component, including:

a passive infrared camera system including:

a lens assembly including a lens;

a refrigerated portion including an interior;

an infrared sensor device located in the interior of the refrigerated portion;

a single filter configuration located in the interior of the refrigerated portion and including an optical bandpass filter fixed along an optical path between the lens assembly and the infrared sensor device;

a refrigeration system that can cool the interior of the refrigerated portion;

wherein at least part of the pass band for the single filter configuration is within an absorption band for each of the chemicals; and

wherein the aggregate pass band for the single filter configuration is at least about 100 nm; and

a processor that can process a signal representing the filtered infrared image captured by the infrared sensor device to produce a visible image of the chemical emanating from the component under variable ambient conditions of the area around the leak.

23. The system of claim 1, wherein the aggregate pass band for the single filter configuration is at least about 200 nm.

24. The system of claim 1, wherein the pass band for the filter configuration has a center wavelength located between about 3375 nm and about 3385 nm.

Ex. 1001, 28:44-67; 30:3-7.

### C. The Asserted Grounds

Subject to the withdrawal of claim 29 (Paper 10), Petitioner asserts that the challenged claims of the '813 patent are unpatentable under 35 U.S.C. § 103 for the following specific grounds (Pet. 9):

References	Basis	Claims Challenged
Merlin Brochure <sup>1</sup> and Strachan <sup>2</sup>	§ 103(a)	23, 25, 28, 30
Merlin Brochure, Strachan, and Spectrogon <sup>3</sup>	§ 103(a)	27, 32-35, 41
Merlin Brochure, Strachan, and OCLI <sup>4</sup>	§ 103(a)	24, 26, 36, 57

Kulp <sup>5</sup> and Merlin User's Guide <sup>6</sup>	§ 103(a)	23, 33, 35
Kulp, Merlin User's Guide, and Spectrogon	§ 103(a)	25, 27, 28, 30, 32, 34, 41
Kulp, Merlin User's Guide, and OCLI	§ 103(a)	24, 26, 36, 57

## II. STANDING

### A. 35 U.S.C. § 315 Bar To Considering Petition

#### 1. Background

\*4 The petition in this case, IPR2015-00065, was filed on October 16, 2014. On November 7, 2014, Petitioner was informed by a voicemail message that the fee payment was deficient. *See* Paper 14, 5 (citing Ex. 1025 (Decl. of Rickard K. DeMille) ¶ 3). On November 10, 2014, Petitioner filed Petitioner's Authorization to Charge Fees for IPR2015-00065 to Petitioner's deposit account. Paper 5. Following submission of the fee authorization, a filing date of October 16, 2014, was accorded to the petition for *inter partes* review. Paper 6, 1.

The Board held a conference call with the parties on December 5, 2014, where the deficient fee issue was discussed. Paper 13, 5-6 (Post Conference Call Order, December 16, 2014). On November 10, 2014, the Board authorized the Patent Owner to brief the deficient fee issue and authorized the Petitioner to reply. Paper 13, 5.

The Board's Order noted that "USPTO records reveal that, when the petition was filed, Petitioner paid for 15 claims--\$23,000." Paper 13, 5; Ex. 1025 ¶ 2. The Board's Order added that because the Petition challenged only claims (*see* Pet. 2, 8-9) that "depend[] directly or indirectly from independent claim 1, Petitioner was required to pay for 16 claims--or \$23,400." Paper 13, 5; Ex. 1025 ¶ 3.<sup>7</sup> The Board's Order also authorized Petitioner to file a notice stating which dependent claim it was withdrawing from consideration, thereby reducing the number of claims challenged to the claims paid for with the petition filed on October 16, 2014. Paper 13, 5-6.

#### 2. Analysis

Patent Owner argues that Petitioner did not pay the required filing fee for the Petition as required under 35 U.S.C. § 312 (a)(1) and 37 C.F.R. § 42.3(b). Paper 11, 1 and 4. Patent Owner asserts that the Petition cannot be granted the original October 16, 2014, filing date, because Petitioner failed to file a corrected petition deleting portions of the Petition related to the excess claim as discussed in the Board's Patent Review Processing System (PRPS) Frequently Asked Questions (FAQ)<sup>8</sup> § E5. Paper 11, 6-9. Patent Owner contends that the proper filing date accorded should be when Petitioner first cured the fee deficiency in November (*see* 37 C.F.R. §§ 42.15(a); 42.106(a)(3); PRPS FAQ § D3). Paper 11, 6-7. Patent Owner contends that a November filing date bars the petition under 35 U.S.C. § 315. *Id.*

We disagree with Patent Owner that the October filing date of the petition is improper. The Board's PRPS FAQ guidance explains that a Petitioner may maintain an original filing date, if an appropriate number of claims are withdrawn. *See* PRPS FAQ § E5. The Board's PRPS FAQ guidance on how to withdraw claims to cure a fee deficiency is not limited to the method discussed in the PRPS FAQ § E5.

\*5 Petitioner, following the Board's advice "that [Petitioner] could withdraw a dependent claim for its challenge" (Paper 13), filed a notice withdrawing dependent claim 29. Paper 10. Under the facts of this case, we find that Petitioner withdrew a claim as advised by the Board, thereby correcting the fee deficiency. *See* Paper 10. Indeed, Patent Owner admits that Petitioner's time for correcting the fee deficiency did not expire until December 10, 2014. Paper 11, 4 (arguing that "[Patent Owner's] time for following the Board's rules expired December 10"). Even under Patent Owner's arguments, Petitioner's notice withdrawing a dependent claim from consideration, on December 9, 2014 (Paper 10), was timely notice to the Board that reduced the number of challenged claims to match the fee paid on October 16, 2014.

Our rules give the Board the authority to "determine a proper course of conduct in a proceeding for any situation not specifically covered" "to secure the just, speedy, and inexpensive resolution of [our] proceeding[s]." 37 C.F.R. §§ 42.1(b), 42.5(a). Exercising this authority, "[t]he Board may waive or suspend a requirement of [our Rules] and may place conditions on [such a] waiver or suspension." 37 C.F.R. § 42.5(b). In the present case, the Board's advice to the Petitioner and Petitioner's subsequent filing of a notice withdrawing claim 29 from consideration complied with the PRPS FAQ § E5 guidance and our rules. *See* 37 C.F.R. §§ 42.103 and 42.106(b); PRPS FAQ § E5. We find that Petitioner has provided sufficient and timely notice under the circumstances to maintain the filing date accorded the petition in Paper 6. Under the circumstances discussed above, we determine that the October 16, 2014, filing date accorded to the petition is correct, and thus, not barred under 35 U.S.C. § 315.

### III. DISCUSSION

#### A. Claim Construction

We determine the meaning of the claims as the first step of our analysis. In an *inter partes* review, we interpret claims using the broadest reasonable construction. *See* 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). Claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

\*6 Petitioner proposes construction for the claim terms "leak" and "produce a visible image of the chemical emanating from the component under variable ambient conditions of the area around the leak" of claim 1. Pet. 11-16. With respect to the '813 patent, we previously construed these terms in *FLIR Systems Inc. v. Leak Surveys, Inc.*, Case IPR2014-00411, slip op. at 15-18 (PTAB Sep. 5, 2014) (Paper 9) ("IPR2014-0411 Dec."). Patent Owner opposes the Board's prior constructions. Prelim. Resp. 14-21. For the limited purposes of this decision, however, we adopt the constructions in IPR2014-0411 Dec. at 17-18 provided in the table below.

Claim Term	Construction
"leak"	"is broad enough to include both fugitive and non-fugitive emissions"
"produce a visible image of the chemical emanating from the component under variable ambient conditions of the area around the leak"	"being able to produce a visible image under the ambient conditions of the area around the leak."

3. "a single filter configuration located in the interior of the refrigerated portion" (Claim 1)

Patent Owner argues that the broadest reasonable interpretation of “a single filter configuration located in the interior of the refrigerated portion” as recited in claim 1 “excludes filters outside the refrigerated portion which contains the sensor; excludes filter wheels, and other multiple configuration filters; and excludes movable and removable filters.” Prelim. Resp. 21-22. Patent Owner's also argues that the filter, comprised of one or more components, must result in a single configuration located in the interior of the refrigerated portion with the infrared sensor of the claim. *Id.* at 21.

\*7 For purposes of this decision, we are not persuaded that the term “a single filter configuration located in the interior of the refrigerated portion” requires construction apart from the ordinary and customary meaning.

*B. Grounds of Obviousness Based on the Merlin Brochure (Ex. 1007) and Strachan (Ex. 1008)*

Petitioner asserts that claims 23, 25, 28, and 30, which depend from independent claim 1, are obvious over the Merlin Brochure (Ex. 1007) and Strachan (Ex. 1008). Pet. 17-26 (claim 1), 26-28 (claims 23, 25, 28, and 30). In support of its contentions, Petitioner provides claim charts and citations to the Declaration testimony of Dr. Jonas Sandsten (Ex. 1006). *Id.*

In IPR2014-00411, we found that Petitioner demonstrated that there is a reasonable likelihood that Petitioner would prevail in showing that the claim 1 was unpatentable under § 103(a) as obvious over Merlin Brochure and Strachan. IPR2014-00411 Dec. 32-33.

Patent Owner asserts that the Merlin Brochure and Strachan fail teach or suggest “single filter configuration located in the interior of the refrigerated portion . . .” and a system “to produce a visible image . . . under variable ambient conditions of the area around the leak” as recited in claim 1. Prelim. Resp. 21-32. In addition, Patent Owner contends that “exhaust” detection, which the Merlin references address, differs from the claimed “leak” detection under various ambient conditions as described in claim 1. *Id.* at 29-32. Patent Owner, however, makes no specific arguments with respect to the limitations of dependent claims 23-28, 30, 32-36, 41 and 57 of the '813 patent. *Id.* at 27-37. Finally, Patent Owner argues that a person of ordinary skill in the art of “leak detection” would not have combined the Merlin Brochure and Strachan. *Id.* at 33-37.

On the record before us, we find that the Petitioner has made a sufficient showing that the Merlin Brochure and Strachan teaches or suggests the limitations of claims 23, 25, 28, and 30. Petitioner has provided sufficient support and declaration testimony that combining the filter selection of Strachan with the Merlin Brochure camera as design choice that combines known elements to yield predictable results. Pet. 17-18 (citing Ex. 1006 ¶ 55); 27.

Patent Owner's arguments that the combination of Merlin Brochure and Strachan do not teach customization using a single filter for leak detection (Prelim. Resp. 27-29) or leak detection “under variable ambient conditions” (Prelim. Resp. 29-33) are best addressed in a trial phase. *See* IPR2014-00411 Dec. at 34. At this stage of the proceeding, we are not persuaded by Patent Owner's argument that substituting the filters of Strachan into the Merlin MID camera described in the Merlin Brochure is not a use of known elements that yield expected results. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007); *see also* IPR2014-00411 Dec. at 33 (stating same). Patent Owner's arguments regarding the limits of modifying of the camera disclosed in the Merlin Brochure by the filters in Strachan are best addressed during the trial phase.

\*8 At this stage of the proceeding, the information presented demonstrates a reasonable likelihood that Petitioner would prevail in showing that dependent claims 23, 25, 28, and 30 are unpatentable as obvious over Merlin Brochure and Strachan. *See* Pet. 17-26, 26-28. We also find the information presented shows a reasonable likelihood that Petitioner would prevail in showing that dependent claims 27, 32-35, and 41 are unpatentable as obvious over the Merlin Brochure, Strachan, and Spectrogon (*see* Pet. 17-26, 28-37) and showing that dependent claims 24, 26, 36, and 57 are unpatentable as obvious over the Merlin Brochure, Strachan, and OCLI (*see* Pet. 17-26, 38-41).

*C. Grounds of Obviousness Based on Kulp (Ex.1012) and the Merlin User's Guide (Ex. 1011)*

Petitioner contends that claims 23, 33, and 35, which depend from independent claim 1, are obvious in view of Kulp and the Merlin User's Guide. Pet. 41-48. Petitioner provides claim charts and citations to the Declaration testimony of Dr. Jonas Sandsten (Ex. 1006) in support of its contentions. *Id.* Petitioner argues that Kulp discloses all the limitations of claim 1, expressly or inherently, except for the “refrigeration portion” limitation of claim 1. Pet. 41-43. With respect to refrigeration, Petitioner argues that it would have been obvious to locate the cooled filters and array disclosed in Kulp within the refrigeration portion of the Merlin User's Guide as it represents an obvious design choice. Pet. 43-44 (citing Ex. 1006 ¶¶ 98-100).

Patent Owner argues that neither Kulp nor the Merlin User's Guide teaches locating a single filter in the interior of the refrigerated portion for purposes of producing a visible image of a leak as recited in claim 1. Prelim. Resp. 37-38. Patent Owner's arguments are that Kulp and the Merlin User's Guide do not teach where to put the filter, that low temperature is required for gas detection, and that the use of the Merlin camera, as disclosed in the Merlin User's Guide, at the temperatures disclosed in Kulp. Prelim. Resp. 38-39. Finally, Patent Owner contends that the combination of the Merlin User's Guide and Kulp fails to teach a system “to produce a visible image . . . under variable ambient conditions of the area around the leak” as recited in claim 1. Prelim. Resp. 40-43.

On the record before us, we are not persuaded by Patent Owner's arguments. Patent Owner's argument that Kulp produced a visible image only under limited conditions, fails to address the evidence that Kulp teaches visible results at differing temperatures and times of day. Pet. 47 (citing Ex. 1012 at 277; Fig. 9). Patent Owner's arguments regarding the teachings of Kulp not being suited for passive IR leak detection (Prelim. Resp. 40-44) are best addressed at the trial phase of the proceeding.

Based on the record before us, we find that Petitioner has provided articulated reasoning with some rational underpinning to support the combination of Kulp and the Merlin User's Guide. Pet. 43-44. We are not persuaded by Patent Owner's argument that a person of ordinary skill in the art is limited to leak detection or the specific factory customization of the leak detection system disclosed in the specification of the '813 patent. Prelim. Resp. 43-44.

\*9 For the purposes of this decision and based on the present record, we find that the information presented shows a reasonable likelihood that Petitioner would prevail in showing that dependent claims 23, 33, and 35 are unpatentable as obvious over Kulp and the Merlin User's Guide. *See* Pet. 41-47.

At this stage of the proceeding, Patent Owner does not make separate arguments for challenged dependent claims 24-28, 30, 32, 34, 36, 41, and 57. Prelim. Resp. 37-41. Thus, on the record before us, we also find the information presented shows a reasonable likelihood that Petitioner would prevail in showing that dependent claims of 25, 27, 28, 30, 32, 34, and 41, are unpatentable as obvious over Kulp, the Merlin User's Guide, and Spectrogon (*see* Pet. 48-52), and showing that dependent claims 24, 26, 36, and 57 are unpatentable as obvious over Kulp, the Merlin User's Guide, and OCLI (*see* Pet. 53-54).

#### IV. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in demonstrating that claims 23-28, 30, 32-36, 41, and 57 of the '813 patent are unpatentable.

The Board has *not* made a final determination on the patentability of any challenged claims, nor has the Board made a final determination of any underlying factual or legal issue.



## V. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an inter partes review is instituted as to claims 23-28, 30, 32-36, 41, and 57 of the '813 patent for the following grounds of unpatentability:

- A. Claims 23, 25, 28, and 30 for obviousness under 35 U.S.C. § 103(a) over the Merlin Brochure and Strachan;
- B. Claims 27, 32-35, and 41 for obviousness under 35 U.S.C. § 103(a) over the Merlin Brochure, Strachan, and Spectrogon;
- C. Claims 24, 26, 36, and 57 for obviousness under 35 U.S.C. § 103(a) over the Merlin Brochure, Strachan, and OCLI;
- D. Claims 23, 33, and 35 for obviousness under 35 U.S.C. § 103(a) over Kulp and the Merlin User's Guide;
- E. Claims 25, 27, 28, 30, 32, 34, and 41 for obviousness under 35 U.S.C. § 103(a) over Kulp, the Merlin User's Guide, and Spectrogon; and
- F. Claims 24, 26, 36, and 57 for obviousness under 35 U.S.C. § 103(a) over Kulp, the Merlin User's Guide, and OCLI.

FURTHER ORDERED that no other grounds set forth in the petition are authorized for inter partes review as to the claims of the '813 patent; and

\*10 FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial that commences on the entry date of this decision.

## Footnotes

- 1 Indigo Systems Corporation, Merlin: The ultimate combination of flexibility and value in high-performance Infrared Cameras (Rev. A 1/02), dated ©2002 (Ex. 1007, "Merlin Brochure").
- 2 D.C. Strachan et al., *Imaging of Hydrocarbon Vapours and Gases by Infrared Thermography*, 18 J. PHYS. E: SCI. INSTRUM. 492-498 (1995) (Ex. 1008, "Strachan").
- 3 Spectrogon Catalog of Bandpass Filters at [http:// www.spectrogon.com/bandpass.html](http://www.spectrogon.com/bandpass.html), dated October 6, 2001 (Ex. 1017, "Spectrogon").
- 4 OPTICAL COATING LABORATORY, INC. SPECTRABAND STOCK PRODUCTS CATALOG, Vol. 5 (1994) (Ex. 1014, "OCLI").
- 5 Thomas J. Kulp et al., *Remote Imaging of Controlled Gas Release using Active and Passive Infrared Imaging Systems*, 3061 SPIE 269 (1997) (Ex. 1012, "Kulp").
- 6 Indigo Systems Corporation, MERLIN™ MID, INSB MWIR CAMERA, User's Guide, Version 1.10, 414-0001-10 (Ex. 1011, "Merlin User's Guide").
- 7 Among the fees due is a post-institution request fee: "(4) In addition to the *Inter Partes* Post-Institution request fee [37 C.F.R. § 42.15(a)(2) of \$14,000], for requesting review of each claim in excess of 15: \$400.00." The meaning of "claim" is discussed in the "Supplemental Information" of the Notice of Final Rule. *See, e.g., 77 Fed. Reg. 48,612, 48,619 (Aug. 14, 2012)* (Examples 1 and 2 and information preceding the examples, discussing the need to pay for an independent claim if dependent claims are included in a petition).
- 8 <http://www.uspto.gov/patents-application-process/appealing-patentdecisions/trials/patent-review-processing-system-prps-0> (last visited Feb 23, 2015)

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICRON TECHNOLOGY, INC. and  
MICRON CONSUMER PRODUCTS GROUP, INC.,  
Petitioner,

v.

e.DIGITAL CORPORATION,  
Patent Owner.

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Case IPR2015-00519  
Patent 5,839,108

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Before LYNNE E. PETTIGREW, DAVID C. McKONE, and  
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

IPR2015-00519  
Patent 5,839,108

On February 13, 2015, Patent Owner e.Digital Corporation (“Patent Owner”) filed a motion titled “Patent Owner’s Motion To Deny The Petition A Filing Date For Failure To Serve The Patent Owner At The Correspondence Address Of Record And To Dismiss The Petition For Failure To File The Petition Within One Year After Service Of A Complaint For Patent Infringement.” Paper 8 (“Mot.”). On February 24, 2015, Petitioner Micron Technology, Inc., and Micron Consumer Products Group, Inc. (collectively “Petitioner”) filed an Opposition to Patent Owner’s Motion. Paper 11 (“Opp.”). The Motion and Opposition had been authorized by the Board in an Order dated February 10, 2015. Paper 7.

*Background*

Our governing statute regarding service provides that a petition for *inter partes* review may be considered only if “the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.” 35 U.S.C. § 312(a)(5). Our rules state that the “petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service.” 37 C.F.R. § 42.105(a). Moreover, 37 C.F.R. § 42.106(a)(2) provides that the petition will not be accorded a filing date until the petition satisfies the requirement of effecting “service of the petition on the correspondence address of record as provided in 37 C.F.R. § 42.105(a).”

Regarding the one-year bar, 35 U.S.C. § 315(b) states: “An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” Additionally, 37 C.F.R. § 42.101(b) provides

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that a petitioner may file a petition for *inter partes* review unless the “petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner’s real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent.”

In the current proceeding, the underlying district court complaints were filed on December 30, 2013. Patent Owner represents that “Petitioners were each served with the complaints and summonses on January 16, 2014.” Mot. 1. The Petition in this proceeding was filed on December 31, 2014, and accorded a filing date of December 31, 2014. Papers 1, 6. Patent Owner’s Preliminary Response is due on April 29, 2015.

Petitioner states that Petitioner’s counsel served a copy of the Petition and supporting materials on Patent Owner’s litigation counsel of record on December 31, 2014. Opp. 1 ¶ 1. Email correspondence between Petitioner’s counsel and Patent Owner’s litigation counsel indicates that Patent Owner’s litigation counsel was in receipt of the documents at least as early as January 5, 2015. Ex. 1019, 1020. Also on December 31, 2014, Petitioner’s counsel served a copy of the Petition and supporting materials on the law firm of Thorpe, North & Western, which was the correspondence address of record for the patent at issue until October 17, 2014. Opp. 2 ¶ 3, 4. On October 30, 2014, the Law Office of Robert E. Purcell, PLLC became identified as the correspondence address of record for the patent at issue. Mot. 1 (citing Ex. 2003–2005). Petitioner’s counsel admits that he used petitions filed by Intel Corp. in August 2014 “as a reference in drafting the instant petition and certificate of service,” including the correspondence address for service. Ex. 1017 ¶ 10. As of the date of the Motion, Petitioner still had not served Patent Owner with a copy of the Petition at the current correspondence address of record. Mot. 1.

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Patent 5,839,108

*Analysis*

Patent Owner argues that the Motion is not premature. Mot. 7. Petitioner does not oppose the Board addressing the improper service arguments at present. Opp. 1, n.1. Accordingly, we address the substantive arguments in the Motion and Opposition at this time.

Patent Owner argues that (A) the Petition is not entitled to a filing date at this time; and (B) Petitioner’s failure to file a complete petition requires dismissal for failure to meet the one-year filing requirement.

Petitioner responds that (A) Petitioners effectively served Patent Owner before January 16, 2015; and (B) the circumstances of this case do not warrant changing the filing date or dismissal of the petition, because (1) Petitioners acted in good faith; and (2) Patent Owner cannot show any prejudice.

Based on the evidence presented, Petitioner has provided Patent Owner with copies of the required documents. Patent Owner states that Petitioner “served a ‘courtesy copy’ [of the instant petition] on the Patent Owner’s patent infringement litigation counsel” on December 31, 2014. Mot. 1. Petitioner states that on “December 31, 2014, Petitioner’s counsel served by email a copy of the petition and supporting materials on Patent Owner’s litigation counsel of record, including Mr. Anton Handal.” Opp. 1 ¶ 1 (citing Ex. 1017 ¶¶ 4–5). The statute requires only that a petitioner provide copies of the required documents “to the patent owner or, if applicable, the designated representative of the patent owner.” 35 U.S.C. § 312(a)(5). The parties appear to agree, and the evidence supports, that Petitioner provided copies of the required documents to a designated representative of Patent Owner in a timely manner. Thus, the statutory requirement has been met.

We agree with Patent Owner that Petitioner’s service of the Petition and supporting documents to the firm of Thorpe, North & Western failed to comply

IPR2015-00519  
Patent 5,839,108

with 37 C.F.R. § 42.105(a). 37 C.F.R. § 42.105(a) specifies that “[t]he petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent.” The correspondence address of record for a patent can be discovered simply by entering the number of the patent into the USPTO’s web-based Patent Application Information Retrieval (PAIR) portal (<http://portal.uspto.gov/pair/PublicPair>). Petitioner admits that, rather than serving the address of record for U.S. Patent No. 5,839,108, it served Patent Owner’s former counsel of record, as listed on *inter partes* review petitions filed by Intel Corp. Opp. 2 ¶ 3. Relying on the notice of service attached to an earlier petition filed by another party in lieu of consulting the Patent Office database to determine the correspondence address of record is not a good faith attempt to comply with Rule 42.105(a).<sup>1</sup>

Petitioner’s effective service of the Petition and supporting documents on the Patent Owner through its litigation counsel, however, is undisputed. Because Petitioner has complied with 35 U.S.C. § 312(a)(5); because counsel participating in this proceeding on behalf of Patent Owner actually received the Petition prior to the expiration of the one-year bar set forth in 35 U.S.C. § 315(b); and because Patent Owner does not allege that its time to respond to the Petition or its access to evidence has been affected meaningfully by Petitioner’s failure to comply, the

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<sup>1</sup> One example of a good faith attempt to comply with our rules is relying on out-of-date information in the Patent Office database and working diligently to effect service once that information is discovered to be incorrect. *See Synopsys, Inc. v. Mentor Graphics Corp.*, Case IPR2012-00042, slip op. at 2–4 (PTAB Apr. 11, 2013) (Paper 23). As another example, a good faith attempt to comply with our rules is mailing a Petition to the correct address using Federal Express®, rather than Express Mail®, yet failing to choose Saturday delivery. *See Facebook, Inc. v. Rembrandt Social Media, L.P.*, Case IPR2014-00415, slip op. 6–7 (PTAB July 7, 2014) (Paper 9).

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Patent 5,839,108

remedy Patent Owner seeks (effectively, dismissal of the Petition with no opportunity to re-file) is out of proportion to Petitioner's rule violation. Accordingly, on that basis, we exercise our discretion under 37 C.F.R. § 42.5(b) to waive the requirement of Rule 42.105(a) and deny Patent Owner's motion. Moreover, on these facts, we do not see any need to change the December 31, 2014, filing date accorded to the Petition. Paper 6. Petitioner, however, must comply with the Board's procedural rules for the remainder of this proceeding.

Accordingly, it is

ORDERED that Patent Owner's Motion is *denied*.

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Case IPR2015–00239, Paper 10  
Case IPR2015–00240, Paper 10  
Case IPR2015–00241, Paper 10  
Case IPR2015–00242, Paper 10  
Case IPR2015–00243, Paper 10  
Case IPR2015–00247, Paper 10  
Entered: January 15, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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2WIRE, INC.,  
Petitioner,

v.

TQ DELTA LLC,  
Patent Owner.

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Case IPR2015–00239 (Patent 7,471,721)  
Case IPR2015–00240 (Patent 8,090,008)  
Case IPR2015–00241 (Patent 8,073,041)  
Case IPR2015–00242 (Patent 8,218,610)  
Case IPR2015–00243 (Patent 8,355,427)  
Case IPR2015–00247 (Patent 7,292,627)

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Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and TREVOR M.  
JEFFERSON, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION  
Motion to Correct Filing Date  
37 C.F.R. § 42.5



Case IPR2015–00239 (Patent 7,471,721)  
Case IPR2015–00240 (Patent 8,090,008)  
Case IPR2015–00241 (Patent 8,073,041)  
Case IPR2015–00242 (Patent 8,218,610)  
Case IPR2015–00243 (Patent 8,355,427)  
Case IPR2015–00247 (Patent 7,292,627)

## BACKGROUND

On December 5, 2014, we authorized Petitioner to file in each of the instant proceedings a motion to correct the filing date accorded to the Petition (Paper 2) from November 6, 2014 to November 7, 2014. *See* Paper 6.<sup>1</sup> On December 12, 2014, Petitioner filed a motion to correct the filing date. Paper 8 (“Mot.”). On December 19, 2014, Patent Owner filed an opposition. Paper 9 (“Opp.”).

In its Motion, Petitioner states that it uploaded the Petition and accompanying exhibits to the Patent Review Processing System (PRPS) on November 6, 2014. Mot. 1–2. Petitioner further states that it served Patent Owner by USPS Express Mail and submitted the fee for the Petition on November 6, 2014. *Id.* at 2. According to Petitioner, the “Submit” button was not pressed until November 7, 2014 “due to either a technical issue (i.e., browser incompatibility) or inadvertent clerical error.” *Id.* at 1. Petitioner provides the declarations of lead counsel Mr. John D. Zele and backup counsel Mr. Adam Brooke to substantiate these statements. *See* Exs. 1023, 1024. Petitioner, accordingly, contends that it would be “unjust to bar review because of this single technicality.” *Id.* at 4.

## DISCUSSION

Petitioner has the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). The petition is a request to institute an *inter partes* review. 37 C.F.R. § 42.104. The purpose of a petition is to give adequate notice to a patent owner of the basis for relief by laying out the grounds of unpatentability

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<sup>1</sup> The papers filed in the above-identified cases are substantially similar. For convenience, we refer to those filed in IPR2015-00241.

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Case IPR2015-00241 (Patent 8,073,041)  
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proposed by a petitioner, as well as any supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762 (Aug. 14, 2012). A petition for *inter partes* review will not be accorded a filing date until the petition satisfies the following requirements: (1) the petition complies with 37 C.F.R. § 42.104; (2) the petitioner effects service of the petition on the correspondence address of record as provided in 37 C.F.R. § 42.105(a); and (3) the petition is accompanied by the fee to institute required by 37 C.F.R. § 42.15(a). 37 C.F.R. § 42.106(a); *see also* 35 U.S.C. § 312(a) (specifying requirements for a petition to be considered).

The manner of filing a petition is governed, in part, by 37 C.F.R. § 42.6(b)(1), which states that “[u]nless otherwise authorized, submissions are to be made to the Board electronically via the Internet according to the parameters established by the Board and published on the [website] of the Office.” 37 C.F.R. § 42.6(b)(1). The Board’s website states the following:

A8. How can I check whether I filed a document properly?

After you upload a document in the proper format (i.e., PDF or MPEG for exhibits and PDF for all other documents) and click “Submit,” you will receive an acknowledgement on the screen in PRPS and filing receipt via email if the document is filed properly. If you do not receive an acknowledgement on the screen or a filing receipt via email, the document most likely has not been uploaded properly and you should contact the Board at (571) 272-7822. You may also check whether the document is listed in the file contents of the proceeding.

<http://www.uspto.gov/ip/boards/bpai/prps.jsp#heading-5> (emphasis added). These instructions provide that in order to electronically file a petition with the Board, a petitioner must click “Submit” after uploading the documents. Only then will the

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petitioner receive a petition filing receipt indicating that the petition was filed properly.

On the record before us, Petitioner has satisfied all the statutory and regulatory requirements for filing the Petition on November 6, 2014, but for clicking the “Submit” button. *See* Mot. 1–2. Petitioner (1) uploaded all of the documents to the PRPS on November 6, 2014 (Ex. 1024 ¶ 3), (2) paid the requisite Petition fees and received a receipt of payment (Ex. 1026; Ex. 1024 ¶ 4), and (3) served Patent Owner with all of the documents (Ex. 1025, Ex. 1024 ¶ 2). Mr. Brooke attests to not recalling “whether there were further prompts on the [PRPS] screen indicating additional actions to be taken, or whether there were no further prompts.” Ex. 1024 ¶ 5. Upon learning that the Petition may not have been correctly filed, Mr. Brooke promptly took action to ensure the proper filing of the petitions. Ex. 1024 ¶¶ 7–8. After speaking with Board technical personnel, Mr. Brooke then subsequently clicked on the “Submit” button on November 7, 2014. *Id.* ¶¶ 9–10.

We have reviewed PRPS electronic records, which confirm that all documents were uploaded on November 6, 2014, and that the “Submit” button was clicked on November 7, 2014. Based on the evidence before us, we determine that Petitioner’s failure to click on the “Submit” button is a clerical error and that it would be appropriate under the circumstances to correct the filing date according to the Petition to November 6, 2014. *See generally Conmed Corp. et al. v. Bonutti Skeletal Innovations LLC*, IPR2013–00624, slip op. at 5 (PTAB Feb. 21, 2014) (Paper 18) (“*Conmed*”) (holding that the petitioner’s inadvertent delay in clicking

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on the “Submit” button was a clerical error); *see also SCHOTT Gemtron Corp. v. SSW Holding Corp.*, IPR2014-00367, slip op. at 2–3 (PTAB Sept. 22, 2014) (Paper 30) (granting motion to correct filing date); *ABB Inc. v. Roy-G-Biv Corp.*, IPR2013-00063, slip op. at 6–9 (PTAB Jan. 16, 2013) (Paper 21) (holding that error in failing to upload the correct documents qualified as a clerical error under 37 C.F.R. § 42.104(c)).

Patent Owner does not dispute the facts before us. Rather, Patent Owner argues that (1) granting the motion would erase the Board’s rules for filing petitions; (2) Petitioner’s request is tantamount to a one day extension of the filing deadline under 35 U.S.C. § 315(b); (3) the Board has held that the requirements for filing an IPR are strictly applied (*see Zoll Lifecor Corp. v. Phillips Elect.*, IPR2013-00607 (PTAB March 20, 2014) (Paper 13) (“Zoll”)); (4) there are no extenuating circumstances dictating that the Board use its discretion in granting Petitioner’s motion; (5) the fact that the Petition was served on Patent Owner on November 6, 2014 is irrelevant; (6) Patent Owner is prejudiced because the Petition is time-barred if Petitioner’s motion is not granted; and (7) the *Conmed* decision relied on by Petitioner is not precedential. Opp. 1–5. We are not persuaded by these arguments.

First, we are not persuaded by Patent Owner’s argument that granting Petitioner’s motion would erase the Board’s rules for filing petitions. Opp. 2. Petitioner satisfied all of the statutory and regulatory requirements for filing a petition, but for the regulatory requirement of clicking the “Submit” button. The Board’s rules provide that “*unless otherwise authorized*, submissions are to be

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made” electronically according to the parameters published on the Board’s website. 37 C.F.R. § 42.6(b)(1) (emphasis added). Further, the Board may “determine a proper course of conduct in a proceeding for any situation not specifically covered by” the rules, and may waive requirements in the rules. 37 C.F.R. § 42.5; *see also* 37 C.F.R. § 42.104(c) (clerical or typographical mistakes “in the petition” may be corrected). As discussed above, we determine that the failure to click on the “Submit” button, while all other requirements have been satisfied, is a clerical error. Accordingly, we do not agree with Patent Owner that granting Petitioner’s motion would erase the Board’s rules for filing petitions.

Second, we do not agree with Patent Owner that Petitioner’s request is tantamount to a request for a one-day extension of the statutory filing deadline. Opp. 2–3. As discussed above, we determine that Petitioner satisfied all of the statutory and regulatory requirements for filing a petition, but for the regulatory requirement of clicking the “Submit” button.

Regarding the third and seventh arguments, we are not persuaded by Patent Owner’s assertions regarding previous holdings by the Board. Opp. 3–5. Although we agree with Patent Owner that neither *Zoll* nor *Conmed* are precedential and neither is controlling, both cases can be examined for guidance and useful insight. In *Zoll*, the Board held that the petition was incomplete for failing to identify the real party-in-interest under 35 U.S.C. § 312(a) and even curing this statutory deficiency would not render the petition timely. *Zoll* at 12. We are not persuaded by Patent Owner that the facts and holding in *Zoll* provide us with useful guidance in determining whether Petitioner’s motion should be granted

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because the facts presented in *Zoll* are substantially different from those here. In *Conmed*, Petitioner had failed to click on the “Submit” button and the Board held that the failure to click on the “Submit” button was a clerical error. *Conmed* at 6–7. These facts are similar to those here and, therefore, *Conmed* provides useful insight in our determination of granting Petitioner’s motion.

Fourth, we are also not persuaded by Patent Owner that there are not any extenuating circumstances for the Board to grant Petitioner’s motion. Opp. 4. Petitioner argues that the Petition was filed but for selecting the “Submit” button. Mot. 2–3. As discussed above, we agree with Petitioner that this is an appropriate circumstance for us to use our discretion. Patent Owner does not provide any further evidence or rationale to illustrate Petitioner’s circumstance as inappropriate, beyond restating that Petitioner’s filing date was November 7, 2014.

Fifth, we are not persuaded that the fact that Patent Owner was served on November 6, 2014, is irrelevant, as argued by Patent Owner. Opp. 4–5. This evidence was presented by Petitioner in order to demonstrate that Petitioner satisfied all the statutory and regulatory requirements for filing the petition on November 6, 2014, but for clicking the “Submit” button. Although not dispositive, we find this evidence useful in determining to grant Petitioner’s motion.

Sixth, we are not persuaded by Patent Owner that Patent Owner is unduly prejudiced by granting Petitioner’s motion. Opp. 5. Again, Petitioner satisfied all of the statutory and regulatory requirements for filing a petition, but for the regulatory requirement of clicking the “Submit” button. Patent Owner received the

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Petition and accompanying exhibits, filed its mandatory notice information (Paper 4), and is able to file a Preliminary Response to the Petition.

Accordingly, we grant Petitioner’s motion to correct the filing date based on Petitioner’s clerical error of failing to click on the “Submit” button.

#### ORDER

It is, therefore,

ORDERED that Petitioner’s motion to correct the filing date accorded to the petition in each of the instant proceedings is GRANTED; and

ORDERED that the petition in each of the instant proceedings is accorded a filing date of November 6, 2014.

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Case IPR2015-00242 (Patent 8,218,610)  
Case IPR2015-00243 (Patent 8,355,427)  
Case IPR2015-00247 (Patent 7,292,627)

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ORACLE CORPORATION AND APPLE INC.  
Petitioners

v.

MAZ ENCRYPTION TECHNOLOGIES LLC  
Patent Owner

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Case IPR2014-00472  
Patent 7,096,358

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Before GLENN J. PERRY, PATRICK R. SCANLON, and  
PETER P. CHEN, *Administrative Patent Judges*

PERRY, *Administrative Patent Judge*

DECISION ON MOTION  
To Establish a Filing Date of March 1, 2014  
37 C.F.R. § 42.5

Petitioners filed a motion (Paper 6) asking that we recognize March 1, 2014 as the filing date of this *inter partes* review. Following a conference

call on April 4, 2014, we issued an Order (Paper 7) authorizing Patent Owner to file an opposition to that motion, which opposition (Paper 8) was filed on April 30, 2014.

Petitioners recount in the motion that attempts to finalize uploads of documents to the PRPS system on the evening of Saturday, March 1, 2014, were frustrated by a malfunction of the PRPS system. Patent Owner's opposition argues that Petitioners have not fully established the facts surrounding the events of March 1, 2014 (Saturday) and aftermath.

Our internal investigation confirms that PRPS access on March 1, 2014 was indeed compromised. Our internal records are consistent with Petitioners' representations. Petitioners followed Board instructions during the aftermath of the March 1, 2014 events, curing the incompleteness by the first business day following March 1, 2014, which was Monday, March 3, 2014.

We therefore grant Petitioners' motion and establish March 1, 2014 as the filing date of this *inter partes* review. We do not reach the argument made by Patent Owner that 35 U.S.C. § 21(b) does not apply to Petitioners in this *inter partes* review.

#### ORDER

In view of the foregoing it is:

ORDERED that it is hereby established that March 1, 2014 is the filing date of this *inter partes* review.

Case IPR2014-00472

Patent 7,096,358

PETITIONERS:

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CONMED CORPORATION and LINVATEC CORPORATION  
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS LLC  
Patent Owner

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Case IPR2013-00624  
Patent 6,500,195 B2

Before MICHAEL R. ZECHER, BENJAMIN D. M. WOOD, and  
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Renewed Motion to Correct the Filing Date Accorded to the Petition  
*37 C.F.R. §§ 42.20 and 42.106*

On February 10, 2014, ConMed Corporation and Linvatec Corporation (collectively “Petitioner”) filed a renewed motion to correct the filing date accorded to the petition in this proceeding. Paper 15 (“2nd Mot.”). On February 12, 2014, Patent Owner filed an opposition. Paper 17 (“2nd Opp.”). For the reasons set forth below, the Board grants Petitioner’s renewed motion to correct the filing date accorded to the petition.

### BACKGROUND INFORMATION

A petition for *inter partes* review (Paper 1, “Pet.”), along with Exhibits 1001-1009 (Paper 2), were uploaded to the Patent Review Processing System (“PRPS”) on September 25, 2013. PRPS currently lists the filing date for the petition and exhibits as September 25, 2013. PRPS Case Viewer (IPR2013-00624); *see, e.g.*, Ex. 1018. The filing fee of \$23,000.00 was paid and marked “Cleared” with a date of September 25, 2013. Ex. 1017; Exhibit 1019. The petition bears a certificate of service indicating that the petition and exhibits were served on Patent Owner by “EXPRESS MAIL” on September 25, 2013. Pet. (Certificate of Service, last page).

Nevertheless, Petitioner did not receive a filing receipt until October 2, 2013. Ex. 1021. Further, a “Notice of Filing Date Accorded to Petition” was entered into PRPS and emailed to Petitioner’s counsel on October 7, 2013, indicating that the petition was accorded a filing date of October 2, 2013. Paper 4 at 1. Initially, Petitioner did not dispute the October 2 filing date, apparently because it did not “notice” it in the October 7 email. 2nd Mot. 4.

On December 12, 2013, Patent Owner timely filed a preliminary response asserting that, based on the accorded October 2 filing date, the petition was barred under 35 U.S.C. § 315(b). Paper 9 at 2-4. Counsel for Petitioner then requested a conference call, which was held on December 18, 2013. During that conference call, Petitioner indicated that the petition was accorded the wrong filing date of October 2, 2013. Paper 10 at 2. Petitioner alleged that the petition was uploaded to PRPS on September 25, 2013, by lead counsel, with the help of back-up counsel and an unnamed paralegal, and was accompanied by payment of the appropriate fee. *Id.* As a result, Petitioner asserted that the petition should be accorded a filing date of September 25, 2013. *Id.* Based on Petitioner's representations, the Board authorized Petitioner to file a motion to correct the filing date accorded to the petition. *Id.* at 3. Petitioner was instructed to address fully and completely the nature of the actions that it took in connection with the petition during the period between September 25 and October 2, 2013. *Id.*

Petitioner filed its first motion to correct the filing date accorded to the petition on December 24, 2013. Paper 11 ("1st Mot."). In its first motion, Petitioner noted that the "sole basis upon which PTAB appears to have adopted [the October 2, 2013] filing date comprises 'internal records indicat[ing] that Petitioner interacted with PRPS on October 2, 2013.'" 1st Mot. 8 (quoting Paper 10 at 3). But according to Petitioner, its "sole interaction with PRPS on October 2, 2013, comprised the filing of replacement exhibits with the appropriate labels under 37 C.F.R. § 42.63(d)(1)." *Id.* (citing the first declaration of Melanie Hayes, Ex. 1010

¶ 14). Petitioner argued that merely filing replacement exhibits should not be a basis for according the petition a filing date of October 2, 2013. *Id.*

Patent Owner opposed Petitioner's first motion asserting that "Petitioner's explanation of what occurred on October 2, 2013 is flatly contradicted by the record." Paper 13 ("1st Opp.") at 1. Patent Owner noted in this regard that Petitioner's Exhibit 1011, a PRPS screenshot, "clearly shows a date of October 9, 2013 for submission of the replacement exhibits." 1st Opp. 3; *see* Ex. 1011. Patent Owner also noted that the Board's notice informing Petitioner that the exhibit labels were missing was dated October 7, 2013. *Id.* (citing Paper 4 at 2). Finally, Patent Owner pointed out that Petitioner's filing on October 9, 2013, (formerly Paper 5—now Paper 16) states "Petitioner hereby resubmits Exhibits 1001-1009 on this date." *Id.* (citing Paper 5 at 1).

During a conference call on February 6, 2014, Petitioner conceded that the first declaration of Melanie Hayes (Ex. 1010), which was filed in conjunction with Petitioner's first motion, erroneously stated that it filed the replacement exhibits on October 2, 2013. Paper 14 at 3. Despite the error, the Board granted Petitioner another opportunity to address fully and completely the nature of the actions that it took in connection with the petition between September 25 and October 2, 2013. *Id.* In particular, the Board instructed Petitioner to address specifically its interaction with PRPS when completing the submission of its petition on October 2, 2013. *Id.* at 3-4. In Petitioner's renewed motion to correct the filing date accorded to the petition, Petitioner asserts that on October 2, 2013, it "only logged into PRPS to view the exhibits," but acknowledged the possibility that it "inadvertently hit the wrong key when viewing the exhibits." 2nd Mot. 3-4.

## DISCUSSION

Petitioner has the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). An *inter partes* review begins with the filing of a petition. 37 C.F.R. § 42.104. The purpose of a petition is to give adequate notice to a patent owner of the basis for relief by laying out the grounds of unpatentability proposed by a petitioner, as well as any supporting evidence. See Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762 (Aug. 14, 2012). A petition for *inter partes* review will not be accorded a filing date until the petition satisfies the following requirements: (1) the petition complies with 37 C.F.R. § 42.104; (2) the petitioner effects service of the petition on the correspondence address of record as provided in 37 C.F.R. § 42.105(a); and (3) the petition is accompanied by the fee to institute required by 37 C.F.R. § 42.15(a). 37 C.F.R. § 42.106(a); *see also* 35 U.S.C. § 312(a) (specifying requirements for a petition to be considered).

The manner of filing a petition is governed, in part, by 37 C.F.R. § 42.6(b)(1), which states that “[u]nless otherwise authorized, submissions are to be made to the Board electronically via the Internet *according to the parameters established by the Board and published on the [website] of the Office.*” 37 C.F.R. § 42.6(b)(1) (emphasis added). The Board’s website states the following:

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*the screen or a filing receipt via email, the document most likely has not been uploaded properly and you should contact the Board at (571) 272-7822. You may also check whether the document is listed in the file contents of the proceeding.*

<http://www.uspto.gov/ip/boards/bpai/prps.jsp#heading-5> (emphasis added).

These instructions provide that in order to electronically file a petition with the Board, a petitioner must click “Submit” after uploading the documents. Only then will the petitioner receive a petition filing receipt indicating that the petition was filed properly.

In its renewed motion to correct the filing date accorded to the petition, Petitioner indicates that it received a petition filing receipt from PRPS on October 2, 2013, not on September 25, 2013. 2nd Mot. 4; Ex. 1021. Although Petitioner received the petition filing receipt on October 2, 2013, the provisional filing date in the receipt was blank. *Id.* We appreciate that, because the provisional filing date on the petition filing receipt was blank, a reasonable person might have understood that it did not affect whether Petitioner satisfied the statutory and regulatory requirements for a complete petition on September 25, 2013.

Patent Owner contends that it remains unclear what was filed on September 25, 2013, and what occurred on October 2, 2013. 2nd Opp. 1-4. PRPS indicates that the petition was uploaded on September 25, 2013. PRPS Case Viewer (IPR2013-00624); *see, e.g.*, Ex. 1018. The petition identifies the following: (1) all real parties in interest (Pet. 4); (2) each claim challenged (*id.* at 3-5); (3) the grounds on which the challenge to each claim is based (*id.* at 15-28); and (4) the evidence that supports those challenges—namely Exhibits 1001-1009 (Paper 2). PRPS received payment from Petitioner on September 25, 2013 (Ex. 1017), which is confirmed by

Petitioner's American Express Statement (Ex. 1019). Finally, there is no dispute that Petitioner served Patent Owner with copies of the petition and exhibits on September 25, 2013, by "EXPRESS MAIL." Pet. (last page).

With respect to what occurred on October 2, 2013, it appears that Petitioner received a filing receipt for the petition in response to clicking the "Submit" button in PRPS on that date, rather than on September 25, 2013, when the petition was uploaded. *See* Ex. 1021. As discussed above, the Board's website states that a petition filing receipt indicating proper filing will not be sent until the "Submit" button is clicked. As such, Petitioner satisfied all the statutory and regulatory requirements for filing the petition on September 25, 2013, but for clicking the "Submit" button. However, we conclude that, based on the specific circumstances of this case, Petitioner's inadvertent delay in clicking the "Submit" button until October 2, 2013, was a clerical error. *See Abb Inc. v. Roy-G-Biv Corp.*, Paper 21 at 6-9 (holding that error in failing to upload the correct documents qualifies as clerical error under 37 C.F.R. § 42.104(c); *see also Apple Inc. v. Whitserve, LLC*, Paper 16 at 7 (granting a petition a filing date under 37 C.F.R. § 42.106(a) even though the petitioner failed to upload certain exhibits to support the petition).

Finally, although we grant Petitioner's renewed motion to correct the filing date accorded to the petition, we are troubled by how this matter was handled by Petitioner's counsel. First, by failing to "notice" on October 7, 2013, that the Board had accorded the petition a filing date of October 2, 2013, Petitioner delayed by over two months the resolution of this issue. Earlier resolution would have, among other things, been helpful in that counsel's recollection of events surrounding the filing would have

been clearer. Second, and more troubling, is Petitioner's misstatement that its "sole interaction" with PRPS on October 2, 2013, was filing replacement exhibits. Even a casual review of the record in this proceeding shows that Petitioner filed the replacement exhibits on October 9, 2013. We accept the representation by Petitioner's counsel that this misstatement was an error, as well as counsel's apology for the error. *See* Ex. 1024 ¶ 10.

Nonetheless, we remind Petitioner's counsel of its responsibilities under the United States Patent and Trademark Office Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.* Competent representation requires "thoroughness and preparation reasonably necessary for the representation." 37 C.F.R. § 11.101. In addition, "[a] practitioner shall act with reasonable diligence and promptness in representing a client." 37 C.F.R. § 11.103. At the very least, the responsibilities of Petitioner's counsel include reviewing documents uploaded during this proceeding and, if necessary, notifying the Board of a mistake, inconsistency, or error in a timely manner. Going forward, we expect Petitioner's counsel to review each document uploaded during this proceeding thoroughly, such that, if another mistake, inconsistency, or error arises, it can notify the Board promptly.

#### ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner's renewed motion to correct the filing date accorded to the petition in this proceeding is GRANTED; and

ORDERED that the petition is accorded a filing date of September 25, 2013.

Case IPR2013-00624

Patent 6,500,195 B2

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