

IPR2018-01557
Patent 6,760,590

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC Corporation and HTC America, Inc.,
Petitioners

v.

INVT SPE LLC,
Patent Owner

Case IPR2018-01557
U.S. Patent No. 6,760,590

**PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION TO
CORRECT CLERICAL ERRORS**

Petitioners' Motion to Correct a Typographical or Clerical Error evidences Petitioners' improper attempt to use Patent Owners' Preliminary Response as a roadmap to correct numerous substantive deficiencies in their Petition. Specifically, the Motion addresses three errors: (1) an alleged "clerical" error related to Petitioners' failure to include a substantive legal argument in their Petition, (2) Petitioners' failure to timely address this Board's order that Petitioners correct deficiencies in their Petition, and (3) a clerical error whereby "1988" was typed as "1998." Patent Owner does not oppose Petitioners' third requested relief. However, the remainder of Petitioners' motion should be denied.

I. Petitioners' Failure to Include an Entire Substantive Legal Argument is Not a "Clerical Error."

In their Petition, Petitioners' failed to include any argument that the asserted *Gils* reference was "publicly available," a legally required substantive element of proof. *See* Paper 1 at 20; *Apotex Inc. v. Celgene Corp.*, Case No. IPR2018-00685, Paper 8 at 27-28 (Sep. 27, 2018) (denying institution); *Envirologix Inc., v. Ionian Technologies, Inc.*, Case No. IPR2018-00405, Paper 12 at 14 (July 30, 2018).

In the instant motion, Petitioners allege this failure was a "clerical error." Paper 9 at 3. The failure to include a substantive legal argument—here, the argument that *Gils* was "publicly available"—is not a "clerical error." Rather, a clerical error is an error made by someone "upon whom 'no duty devolves . . . to

exercise discretion or judgment,” not by someone who exercises discretion such as a party’s lawyers. *Zhongshan Board Ocean Motor Cor. Ltd. v. Nidec Motor Corp.*, Case IPR2014-01123, Paper 20 at 5 (PTAB Jan. 21, 2015) (denying motion to correct clerical error where error made by attorney).

Here, Petitioners’ motion fails to identify who made the error, but alleges Petitioners “inadvertently failed to copy” text from one Petition to another. Paper 9 at 2. Responsibility for preparation of the legal substance of a petition unquestionably falls on the shoulders of attorneys, and the Board has routinely found such errors do *not* constitute clerical errors. *See, e.g., Mobotix Corp. v. E-Watch, Inc.*, Case IPR2013-00335, Paper 35 at 2 (PTAB Apr. 15, 2014) (denying motion because omitting “pinpoint citations” from reply brief was not a “clerical error” and their addition would result in a “substantive” change, even where cites were included in accompanying expert declaration); *International Business Machines Corp. v. Intellectual Ventures II LLC*, Case IPR2014-00660, Paper 17 at 2 (July 31, 2014) (denying motion where omission of evidence addressing claim limitation was “substantive ... rather than clerical or typographical”).

Indeed, the substantive nature of Petitioners’ error is shown by the nature and scope of what Petitioners seek to add to the Petition—two full paragraphs and a footnote directed to the public availability of an alleged reference, *Gils*, as well as citation to the Declaration of Ximena Solano, which is nearly 1,800 words

alone, as well as numerous other declarations, screen captures of websites, and copies of correspondence that number in the thousands of words. Paper 9 at 3.

Because the error Petitioners seek to correct is substantive, and not “clerical,” Petitioners’ motion must be denied.

II. Petitioners’ Response to the Board’s Order

Petitioners have not established good cause for their failure to timely respond to the Board’s order (Paper 3). Rather, Petitioners admit that their failure to respond was due “in part” to a failure to download the Notice. Paper 9 at 3. Petitioners also appear to attempt to deflect blame for this error onto the Board, where Petitioners note that the order to correct was “embedded” by the Board in the Notice of Filing Date Accorded to Petition. *Id.*

The responsibility to timely correct the deficiency in the Petition was solely Petitioners. Petitioners failed to meet that responsibility. It is thus at the Board’s discretion how to enforce its order. Patent Owner requests that such enforcement result in denial of institution. *DealerSocket, Inc. v. AutoAlert LLC*, Case CBM2014-00142, Paper 10 at 10 (P.T.A.B. Sep. 8, 2014) (“The Board did not choose to allow correction by Petitioner at will, anytime . . .”).

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Dated: December 28, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on December 28, 2018, a copy of PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION TO CORRECT CLERICAL ERRORS was served in its entirety by electronic mail on Petitioners' counsel at the following address indicated in their Mandatory Notices:

LegalTm-HTC-INV-T-IPRs@sheppardmullin.com

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