

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATTENDS HEALTHCARE PRODUCTS, INC.,
Petitioner,

v.

PAUL HARTMANN AG,
Patent Owner.

Case No. IPR2020-01479
U.S. Pat. No. 8,771,249

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO FILE CORRECTED PETITION**

I. Introduction

The Board gave Petitioner leave to file a motion to correct errors under 37 C.F.R. § 42.104(c), which authorizes correcting clerical and typographical mistakes. In its motion, Petitioner seeks to correct a number of errors, many of which it failed to identify until after it was granted leave to file its motion. Patent Owner opposes the proposed changes, which include changing claim limitations that were not previously addressed and changing support for alleged claim mapping, because they are substantive and not merely clerical or typographical.

II. Petitioner’s Proposed Corrections Are Not Within the Scope of 37 C.F.R. § 42.104(c), Because They Are Not Mere Clerical or Typographical Corrections

“A motion may be filed that seeks to correct a clerical or typographical mistake in the petition.” 37 C.F.R. § 42.104(c). “The standard for excusing a filing error under 37 C.F.R. § 42.104(c) is not mere unintentionality or inadvertence, but instead requires a showing that a ‘clerical or typographical mistake’ occurred.”

Zhongshan Broad Ocean Motor Co. v. Nidec Motor Corp., IPR2014-01122, Paper 20 at 12 (PTAB Jan. 21, 2015). Section 42.104(c) cannot be used to correct substantive mistakes. *See Int’l Bus. Mach. Corp. v. Intell. Ventures II LLC*, IPR2014-00660, Paper 17 at 2–3 (PTAB July 31, 2014) (finding that petitioner’s request to correct an inadvertently omitted claim element was substantive and not within the scope of Section 42.104(c)).

Clerical errors are ones made by “those upon whom ‘no duty devolves . . . to exercise discretion or judgment.’” *Zhongshan Broad Ocean Motor Co.*, IPR2014-01122, Paper 20 at 12 (citing *Ford Motor Co. v. United States*, 157 F.3d 849, 860 (Fed. Cir. 1998)). For example, uploading the incorrect version of a reference may be a clerical mistake. *Netflix Inc. v. Copy Prot. LLC*, IPR2015-00921, Paper 19 at 3–4 (PTAB July 30, 2015). In contrast, “if the error had [] been due in some measure to [a] party [with a duty] ‘to exercise original thought or judgment’ in the matter—then making a correction would amount to more than correcting a ‘clerical error.’” *See Zhongshan Broad Ocean Motor Co.*, IPR2014-01122, Paper 20 at 13 (quoting *Ford Motor Co.*, 157 F.3d at 860) (determining that petitioner’s failure to prepare and file a required affidavit was not a clerical mistake). Typographical mistakes are minor errors that do not affect the substance of arguments. *See Mylan Pharms. Inc. v. Sanofi-Aventis Deutschland GMBH*, IPR2018-01675, Paper 21 at 2–3 (PTAB Feb. 20, 2019).

Here, Petitioner seeks to “(1) shift certain cross-references from Section VIII.B.2 to Section VIII.B.3; (2) explicitly address Limitations 31, 32, 45, 47, and 48 in Ground 1 as was intended (*see* Petition at iii, 4, and 20) by citing to existing Ground 1 arguments and evidence; [and] (3) shift Limitations 46[a]-[b]’s dependency and pin-cite.” Paper 9 at 1. Petitioner argues that leave for correction should be granted because these errors are clerical. *Id.* Patent Owner disagrees.

Apart from correcting the signature block, the errors Petitioner seeks to correct are substantive. For example, Petitioner acknowledges that “Limitations 31, 32, 45, 47, and 48 were not referenced in Ground 1’s explanation.” Paper 9 at 3; *see also* Ex. 1050 at 50, 54, 57, 63. Thus, this correction is not simply a matter of “the location of certain discussion within the Petition and not the content of that discussion” as Petitioner contends. *Id.* These claims were omitted from Ground 1. Adding omitted claims or claim elements is a substantive, not clerical, change. *See Int’l Bus. Mach. Corp.*, IPR2014-00660, Paper 17 at 2. Likewise, changing the identified support for any mapping of claims is substantive even if called a “shift.”

Petitioner’s reliance on *Sand Revolution II, LLC v. Cont’l Intermodal Grp. — Trucking LLC*, IPR2019-01393, Paper 11 (PTAB Jan. 15, 2020) does not compel a different conclusion. Paper 9 at 3. In that case, only one claim was omitted, not five as here, and the error was fixed well before the Preliminary Response was due so Patent Owner had notice of the error and an opportunity to address it in the Preliminary Response. Likewise, Petitioner’s reliance on *NetApp, Inc. v. Intell. Ventures II LLC*, IPR2017-00276, Paper 12 (PTAB May 5, 2017) is misplaced. Paper 9 at 2. In *NetApp*, petitioner was permitted to correct cross-references that were not updated where there were “in-text descriptions of the referenced sections.” *NetApp*, IPR2017-00276, Paper 12 at 2. Here, no in-text descriptions exist to clearly indicate the mistakes that Petitioner seeks to correct.

Further, Petitioner's counsel acknowledged that these errors resulted from strategic decisions regarding how to structure the Petition and did not contend that they were made by a staff member's failure to follow instructions. Ex. 1051 at ¶¶ 10-13 (explaining how the cross-references were "inadvertently not updated"); *but see Zhongshan Broad Ocean Motor Co.*, IPR2014-01122, Paper 20 at 12 (explaining that "[t]he standard for excusing a filing error under 37 C.F.R. § 42.104(c) is not mere . . . inadvertence"). Thus, the errors were made by someone who had a duty to exercise original thought or judgment and correcting them "would amount to more than correcting a 'clerical error.'" *Zhongshan Broad Ocean Motor Co.*, IPR2014-01122, Paper 20 at 13.

Petitioner argues that it was diligent because it sought to correct these errors soon after learning of them. Paper 9 at 4. But a petition seeking *inter partes* review should be complete at the time it is filed in connection with the asserted grounds of unpatentability and the evidence and analysis offered in support thereof. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22, 42.104(b). Here, Petitioner failed to diligently review its Petition before filing, shortly after filing, or promptly after it allegedly became aware of errors. While Petitioner may argue that its request is timely, it cannot argue that it acted diligently when it waited to learn of any errors in the Petition from Patent Owner and then still failed to identify additional errors until it was working on its motion. Paper 9 at 1 n.1.

Here, because Patent Owner has already filed its Preliminary Response and does not have an opportunity to address the proposed corrections, it would be prejudiced if Petitioner is allowed to correct the Petition. Petitioner argues that Patent Owner would not be prejudiced because it recognized the first error and cure in a different petition and because Patent Owner would have to address similar claims to those it seeks to add to Ground I if the Petition is instituted. Paper 9 at 4-5. These arguments are not logical. Petitioner seeks to make numerous substantive changes to the Petition that Patent Owner did not have the opportunity to consider or address in its Preliminary Response. As a result, Patent Owner would be prejudiced by the changes.

Finally, Petitioner argues in a footnote that if Rule 104(c) is inapplicable, “the Board can also grant the requested relief under Rule 42.5.” Paper 9 at 1 n.2. But Petitioner did not seek leave to file a motion for relief under Rule 42.5 and has not established relief would be warranted under Rule 42.5.

III. Conclusion

Petitioner’s request to file a corrected petition should be denied.

Respectfully submitted,

Dated: January 11, 2021

By: /Joshua L. Goldberg/
Joshua L. Goldberg
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I, William Esper, certify that on January 11, 2021 a copy of **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO FILE CORRECTED PETITION** was served upon the below-listed counsel by electronic mail:

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Petitioner has consented to service by electronic mail.

Dated: January 11, 2021

By: /William Esper/
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