

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ATTENDS HEALTHCARE PRODUCTS, INC.,  
Petitioner,

v.

PAUL HARTMANN AG,  
Patent Owner.

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IPR2020-01479  
Patent 8,771,249 B2

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Before PATRICK R. SCANLON, HYUN J. JUNG, and  
NEIL T. POWELL, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

ORDER  
Granting Petitioner's Motion to File Corrected Petition  
*37 C.F.R. § 42.104(c)*

## INTRODUCTION

Petitioner filed a Petition for *inter partes* review of U.S. Patent No. 8,771,249 B2 (“the ’249 patent”). Paper 1 (“Pet.”). In response, Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Subsequently, Petitioner filed a Motion to File Corrected Petition. Paper 9 (“Motion” or “Mot.”). Patent Owner filed an Opposition to Petitioner’s Motion to File Corrected Petition. Paper 10 (“Opposition” or “Opp.”).

Petitioner seeks to correct the Petition under 37 C.F.R. § 42.104(c). Mot. 1. Specifically, 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; (3) shift Limitations 46[a]-[b]’s dependency and pin-cite; and (4) remove an errant “s” in the signature block. *See* EX1050 (redlined Petition showing the corrections).

*Id.* (footnote omitted). Petitioner indicates that these four desired changes correspond to four errors, which Petitioner identifies as “Error (1),” “Error (2),” “Error (3),” and “Error (4),” respectively. *Id.* at 1–4. Exhibit 1050 is a redlined version of the Petition, showing the changes Petitioner seeks to make in filing a corrected Petition.

## THE PARTIES’ ARGUMENTS

Petitioner argues numerous factors weigh in favor of allowing the changes it seeks. Mot. 1–5. First, Petitioner argues that all of the errors it seeks to correct are clerical in nature. *Id.* at 2–4. Regarding “Error (1),” Petitioner argues that certain cross-references to Section VIII.B.2 erroneously were left unchanged after a draft of the Petition was edited to split Section VIII.B.2 into Section VIII.B.2 and Section VIII.B.3. *Id.* at 2. Petitioner argues that the clerical nature of the error is

apparent because pages 86, 90, 93, and 94 refer specifically to certain claims that are not addressed in the section cited for support. *Id.*

Regarding “Error (2),” Petitioner argues that the omission of claims 31, 32, 45, 47, and 48 from parts of the Petition occurred when “similar explanations from the related ’1477 Proceeding were re-structured to address the ’249 Patent’s unique claim dependencies and was not caught in the Petition’s pre-filing review.” *Id.* at 3. Petitioner argues that the clerical nature of the omissions is apparent for multiple reasons. *Id.* Petitioner notes that multiple portions of the Petition expressly include claims 31, 32, 45, 47, and 48 as challenged in Ground 1. *Id.* Petitioner also argues that mapping of evidence to identical limitations in other claims within the discussion of Ground 1 also demonstrates the clerical nature of “Error (2).” *Id.*

Petitioner argues that “Error (3) is plainly clerical, as evidenced by claims 46 and 12 themselves and the Petition’s listing of their limitations. Petition at viii and xiv (Limitation 46[a] depends from ‘claim 45,’ not 44, and Limitations 46[a]-[b] are identical to Limitations 12[b]-[c], not 12[a]-[b]); EX1051, ¶¶4, 13.” Mot. 4.

Similarly, Petitioner argues that “Error (4) is also plainly clerical, as the mis-typed ‘s’ below the signature and above ‘*Counsel for Petitioner*’ clearly does not belong.” Mot. 4.

Petitioner also argues that it diligently acted to address the errors. *Id.* Petitioner explains that, within a week of reviewing the Preliminary Response and recognizing Error (1), it contacted Patent Owner about correcting the error. *Id.*

Additionally, Petitioner argues that the corrections it seeks would not prejudice Patent Owner. *Id.* at 4–5. Petitioner argues that Patent Owner “recognized Error (1) as an error (POPR at 11) and understood its cure, as evidenced by the POPR in the related ’1477 Proceeding (*see* ’1477 Proceeding’s

POPR at 11 (recognizing that a cross-reference associated with a claim should have been to the petition section addressing that claim)).” *Id.* at 4. Additionally, even without correction of Error 2, Petitioner argues that Patent Owner will have to address identical claim limitations in other challenged claims. *Id.* at 5. Petitioner also argues that Patent Owner’s Preliminary Response did not present any separate patentability arguments with respect to any of the dependent claims. *Id.*

Therefore, given that Error (2) relates only to dependent claims, Petitioner contends its correction does not prejudice Patent Owner. *Id.* Petitioner adds that the lack of a time bar affords it the option to simply file a new petition, but “that route is wasteful of Petitioner’s, [Patent Owner’s], and the Board’s resources.” *Id.*

Aside from “Error (4),” Patent Owner argues the errors identified by Petitioner are substantive, not clerical. Opp. 3. Regarding “Error (1)” and “Error (3),” Patent Owner argues that “changing the identified support for any mapping of claims is substantive even if called a ‘shift.’” *Id.* Regarding “Error (2),” Patent Owner asserts that “[a]dding omitted claims or claim elements is a substantive, not clerical, change.” *Id.* (citing *Int’l Bus. Mach. Corp.*, IPR2014-00660, Paper 17 at 2 (PTAB July 31, 2014) (Order)). In support of assertions that the identified errors were not clerical, Patent Owner likens the facts here to those in *Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.*, IPR2014-01122, Paper 20 at 13 (PTAB Jan. 21, 2015) (Decision instituting review). Opp. 4.

Patent Owner also disputes Petitioner’s other arguments. Patent Owner argues that Petitioner did not act diligently to correct the errors. Opp. 4. Additionally, Patent Owner argues that the proposed changes would prejudice it because Petitioner seeks to introduce substantive changes that Patent Owner did not have a chance to address in its Preliminary Response. *Id.*

## ANALYSIS

Regarding “Error (1),” we are persuaded that the identified portions of the Petition refer to Section VIII.B.2 instead of Section VIII.B.3 due to clerical error. As Petitioner notes, Petition pages 86, 90, 93, and 94 explicitly reference arguments regarding claims 5, 7, and 17. Given that arguments about claims 5, 7, and 17 appear in Section VIII.B.3, not in Section VIII.B.2, it is apparent that the reference to Section VIII.B.2 resulted from clerical error. *See* Pet. iii, 58–72. To the extent Patent Owner’s assertion that “*changing* the identified support for any mapping of claims is substantive” (Opp. 3 (emphasis added)) suggests that the underlying error could not be clerical, we do not necessarily agree with this suggestion.

Regarding “Error (2),” we are persuaded that clerical error caused the omission of the references to claims 31, 32, 45, 47, and 48 that Petitioner seeks to add to the Petition. *See* Ex. 1050, 54, 57, 63. The Petition repeatedly identifies claims 31, 32, 45, 47, and 48 as challenged in Ground 1. *See* Pet. iii, 4, 20. For example, Section VIII.A is headed “Ground 1 – Karami ’772 and Benning Render Obvious Claims 1-5, 7, 8, 11-27, 29-41, 43-54.” *Id.* at 20. Additionally, some of the challenged claims recite identical claim limitations. As examples, challenged claims 3 and 16 recite identical limitations, challenged claims 4 and 25 recite identical limitations, challenged claims 2 and 35 recite identical limitations, and challenged claims 13 and 41 recite identical limitations. *See* Ex. 1001, 16:23–34, 17:19–22, 17:56–60, 18:63–65. When addressing such identical claim limitations, the Petition follows a pattern of citing the same evidence and arguments to address the claim limitations. *See* Pet. 40–41. Given this pattern, and given that claims 14 and 31 recite identical claim limitations, we are persuaded that the omission of claim 31 from the discussion involving claim 14 on Petition page 39 resulted from

clerical error. For similar reasons, we are persuaded that the omission of discussion of claims 32, 45, 47, and 48 from Petition pages 39, 42, and 48 also resulted from clerical error. To the extent Patent Owner’s reference to a “substantive, not clerical, *change*” (Opp. 3 (emphasis added)) suggests that the underlying error could not be clerical, we do not necessarily agree with this suggestion.

For similar reasons, we are also persuaded that “Error (3)” was clerical in nature. In addressing “Limitations 46[a]-[b],” the Petition referenced “Limitation 44” and “Limitations 12[a]-[b].” Given that claim 46 depends from claim 45, not claim 44, it is apparent that the reference to “Limitation 44” is a clerical error. Additionally, limitation 46[a] corresponds to limitation 12[b], not to limitation 12[a]. *See* Ex. 1001, 16:63–64, 20:5–6; Pet. viii, xiv. Similarly, limitation 46[b] corresponds to limitation 12[c], not to limitation 12[b]. *See* Ex. 1001, 16:65–67, 20:6–8; Pet. viii, xiv. Accordingly, it is apparent that the references to “Limitation 44” and “Limitations 12[a]-[b]” when addressing limitations 46[a] and 46[b] resulted from clerical error.

We are also persuaded that “Error (4)” was clerical in nature. Aside from clerical error, there is no apparent reason for the presence of the “s” on the line immediately following the signature block on page 98 of the Petition.

We do not agree with Patent Owner’s suggestion that the facts here are akin to those in *Zhongshan*. In that proceeding, the petitioner failed to file a required affidavit. *Zhongshan* at 11–14. As *Zhongshan* explained, that proceeding did not involve

an instance in which an attesting affidavit had been obtained but was omitted from Petitioners’ filing because of a clerical failure to collate the affidavit with other material being filed. Rather, the mistake

resulted from a failure to obtain the attesting affidavit at all—until attention later was drawn to the error by Patent Owner.

*Id.* at 13. We do not find those facts comparable to the facts here.

Additionally, we do not find that entry of the corrections would prejudice Patent Owner. The record contains no persuasive indication that Patent Owner would have presented any different substantive arguments if the errors identified by Petitioner had been corrected before the Petition was filed. With respect to Error 1 and Error 3, we find Patent Owner reasonably could understand (and apparently did, at least in a related proceeding (*see* Mot. 5)) which sections Petitioner must have intended to cross reference. With respect to Error 2, we note that the Preliminary Response did not present patentability arguments separate from claim 1 for any of claims 12, 14, 15, and 23, which contain identical or nearly identical limitations to claims 31, 32, 45, 47, and 48. *See generally*, Prelim. Resp. Given this, and given that the Petition repeatedly expressly identifies claims 31, 32, 45, 47, and 48 as subject to the challenge of Ground 1 in the Petition, we find no indication that Error 2 deprived Patent Owner of an opportunity it otherwise would have taken to advance separate patentability arguments for these claims. Regarding Error 4, Patent Owner does not allege any prejudice from allowing its correction.

Finally, Patent Owner does not dispute Petitioner's assertion that the lack of a time bar would afford Petitioner the opportunity to simply file another petition with the errors corrected. *See generally*, Opp. Nor does Patent Owner dispute Petitioner's contention that this would waste resources for all involved.

For the foregoing reasons, Petitioner persuades us that errors it identifies are clerical errors warranting correction under 37 C.F.R. § 42.104(c).

ORDER

It is hereby:

ORDERED that Petitioner's Motion to File Corrected Petition is *granted*.



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