

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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IPR2020-01477 (Patent 8,152,788 B2)  
IPR2020-01478 (Patent 8,784,398 B2)  
IPR2020-01479 (Patent 8,771,249 B2)  
IPR2020-01480 (Patent 8,708,990 B2)<sup>1</sup>

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

POWELL, *Administrative Patent Judge*.

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

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<sup>1</sup> This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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## INTRODUCTION

In each of these proceedings, Petitioner filed a Petition. IPR2020-01477, Paper 1; IPR2020-01478, Paper 1; IPR2020-01479, Paper 1; IPR2020-01480, Paper 1 (collectively “the Petitions”). In response, in each proceeding, Patent Owner filed a Preliminary Response. IPR2020-01477, Paper 6 (“1477 Prelim. Resp.”); IPR2020-01478, Paper 6; IPR2020-01479, Paper 6; IPR2020-01480, Paper 6 (collectively “the Preliminary Responses”).

In a subsequent email to the Board (Ex. 3001), the parties noted two requests by Petitioner for each of these proceedings. Petitioner’s first request seeks leave to file “Motions under 37 C.F.R. § 42.104(c) to file corrected petitions in the ’1477, ’1478, ’1479, and ’1480 Proceedings to correct clerical errors” in the Petitions. Ex. 3001. Petitioner’s second request seeks leave to file “Replies under 37 C.F.R. § 42.108(c) to PO’s Preliminary Responses.” *Id.* The email indicated that “Patent Owner opposes any relief sought by Petitioner in this email.” *Id.*

On December 10, we held a phone conference with the parties regarding Petitioner’s requests. Weighing the parties’ arguments during the conference, we granted Petitioner’s request to file motions to correct the Petitions, and we denied Petitioner’s request to file replies to the Preliminary Responses. Below, we discuss each of Petitioner’s requests in detail, including the arguments presented by the parties during the conference and our decisions.

## REQUESTED LEAVE TO FILE MOTIONS TO CORRECT PETITIONS

Identifying specific changes it seeks to make in each of the Petitions, Petitioner seeks leave to file motions to correct alleged clerical errors in the Petitions. Ex. 3001. During the conference, noting that Rule 42.104(c) expressly authorizes the requested motions, Petitioner contended that the requested motions

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would not prejudice Patent Owner. Petitioner asserted that it only seeks to change portions of the Petitions that, in context, are clearly clerical errors.

Patent Owner responded that it would suffer prejudice from Petitioner's requested relief. Emphasizing that it already filed its Preliminary Responses, Patent Owner argued that Petitioner requests significant changes that would affect the Petitions' substance and the Preliminary Responses' arguments.

Weighing the parties' arguments, Petitioner persuades us that motions to correct the Petitions are warranted. As Petitioner notes, our rules expressly authorize such motions. 37 C.F.R. § 42.104(c). To the extent the Petitions contain clerical errors, we generally consider it helpful to correct those errors. Additionally, we do not believe that submission of the requested motions will unduly prejudice Patent Owner. Patent Owner's concerns regarding prejudice generally relate to harm Patent Owner might suffer if we grant the relief Petitioner will request in the motions, not to harm Patent Owner will suffer if Petitioner files the motions. We believe written arguments from both parties will help us evaluate whether the Petitions contain clerical errors that we should allow Petitioner to correct.

#### REQUESTED LEAVE TO FILE REPLIES TO PRELIMINARY RESPONSES

In each of these proceedings, Petitioner requests authorization to file a reply to the "[Patent Owner's] Section 314(a) arguments" in the Preliminary Responses. Ex. 3001. The Preliminary Responses' 314(a) arguments assert, for example, that the Petitions lack sufficient particularity and circumvent our word-count limit. *E.g.*, 1477 Prelim. Resp. 5–25. Petitioner contends that Patent Owner's 314(a) arguments were unforeseeable. Ex. 3001. During the conference, Petitioner reasoned that our rules and other Board proceedings demonstrate that its Petitions

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fully comply with our requirements, such that Petitioner allegedly could not have foreseen Patent Owner would argue the Petitions do not comply with our requirements. Petitioner also argued that filing replies providing additional context would help us evaluate the merits of Patent Owner's 314(a) arguments.

Patent Owner responded that authorizing replies to the Preliminary Responses is not warranted or helpful. Patent Owner contended its 314(a) arguments were not unforeseeable. Additionally, Patent Owner argued that we do not need additional information to assess the merits of the Preliminary Responses' 314(a) arguments. Patent Owner reasoned that the current record and relevant authority, including our rules, put us in a position to evaluate whether the Petitions meet our requirements regarding particularity and word count.

Weighing the parties' arguments, Petitioner does not persuade us that replies to the Preliminary Responses are warranted. Petitioner does not persuade us that Patent Owner's 314(a) arguments were unforeseeable merely because Petitioner believes other Board proceedings indicate such arguments would prove fruitless. Nor does Petitioner persuade us that the record lacks any information that would prove necessary or helpful for us to assess the merits of the Preliminary Responses' 314(a) arguments. Determining whether a given petition meets our requirements falls squarely within our bailiwick, and Petitioner has not identified any special considerations with respect to its Petitions or the Preliminary Responses' 314(a) arguments. On the whole, we do not find that Petitioner has shown good cause for filing replies to the Preliminary Responses. *See* 37 C.F.R. § 42.108(c).

#### CONCLUSION

In sum, as explained above and in the December 10 telephone conference with the parties, it is

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ORDERED that Petitioner's request for leave to file motions to correct the Petitions under 37 C.F.R. § 42.104(c) is *granted*;

FURTHER ORDERED that each motion is due December 28, 2020, and shall not exceed five pages;

FURTHER ORDERED that Patent Owner may respond to each of Petitioner's motions with an opposition, which is due January 11, 2021, and shall not exceed five pages; and

FURTHER ORDERED that Petitioner's request for leave to file replies to the Preliminary Responses is *denied*.

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