

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner

v.

NADER ASGHARI-KAMRANI and KAMRAN ASGHARI-KAMRANI,
Patent Owners

U.S. PATENT NO. 8,266,432

CBM2016-00063

**PATENT OWNERS' OPPOSITION TO PETITIONER'S
MOTION TO EXCLUDE EVIDENCE**

EXHIBIT

Exhibit 2015 EXPERT REPORT OF Q. TODD DICKENSON, ESQ.

Exhibit 2016 DECLARATION OF ATTORNEY MICHAEL P. FORTKORT

I. INTRODUCTION

Petitioner moved to exclude the Certificate of Correction (“COC”) submitted as Exhibit 2008 by Patent Owner (“PO”) and the expert arguments in Section VII, paragraphs 41 to 61, Declaration of Alfred Weaver, Exhibit 2010.

Petitioner’s Motion to Exclude (“Motion”) should be denied as Petitioner failed to meet its burden of proof to establish that it is entitled to the relief requested. Moreover, the Motion is nonsensical and baseless as discussed below.

II. ARGUMENTS

Petitioner’s Motion has at least two fundamental flaws. First, the COC is not evidence that is subject to exclusion. 35 U.S.C. 255 states, “Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising *as if the same had been originally issued in such corrected form*” (emphasis added). Thus, the COC is part of the ‘432 Patent itself. As such, the ‘432 Patent, including the COC, is being tried in this CBM proceeding for validity.

Petitioner’s argument at page 12 of the Motion regarding authorization to file the COC relies on the fact that the Director of the USPTO issued the COC. However, this fact is not relevant to whether the COC should be admitted or excluded because the corrections identified in the COC have the same effect as if

the '432 Patent had been originally issued in such corrected form. Thus, Petitioner's motion to exclude the COC is nonsensical.

Second, the Motion is flawed because the Board does not have jurisdiction to decide on various issues raised in the Motion. On pages 2-12 of the Motion, Petitioner challenges the Decision made by the Office of Petition at the USPTO. However, the issue of whether the petition for the COC should have been granted is outside the Board's jurisdiction. See the Board's Decision, paper 10, page 6, which is reproduced below.

Petitioner's argument, however, is misplaced here because, in the instant Decision, we are not deciding whether a request for a certificate of correction should be granted pursuant to 35 U.S.C. § 255, as Patent Owner merely is seeking authorization for filing such a request. Moreover, we are not the deciding official for a request for a certificate of correction. See 35 U.S.C. § 255; 37 C.F.R. §§ 1.323 and 1.78(e); MPEP §§ 1002.02(b) and 1003.

Hence, the Board confirmed that it has no jurisdiction to decide on the validity of the COC issued by the Director of the USPTO.

Because of the fundamental flaws identified above, Petitioner's arguments for excluding the COC and the corresponding arguments of Dr. Weaver should be denied.

For the above reasons, PO believes that detailed opposing arguments to Petitioner's arguments on pages 2-15 are unnecessary. Nevertheless, assuming

arguendo that the COC can be considered evidence subject to exclusion, PO submits that Petitioner's arguments in the Motion are incorrect for the reasons detailed below.

A. Exhibit 2008 Should be Admitted

1. Exhibit 2008 Should be Admitted under Rule 403

Petitioner alleged that the COC is unduly prejudicial because PO had ample notice of amending its priority claim based on PO's previous filing of a terminal disclaimer. Motion, p. 2 and f.n. 2. However, Mr. Fortkort, PO's prosecution counsel, who signed and filed the terminal disclaimer, declared that "I was not aware that a priority should have been claimed to the '400 application." See Mr. Fortkort Declaration, Exhibit 2016, para. 2. See also, Expert Report of Todd Dickinson, a former Director of the USPTO, Exhibit 2015, paras. 64, and 152-155.

In addition, Petitioner alleged that PO's correction of the '432 Patent's priority *ex post facto* is unfairly prejudicial. Motion, page 3. However, such attempts are authorized by statute. Further, Petitioner was given an opportunity to fully discuss the written description support issue based on this corrected claim of priority during this CBM proceeding. Moreover, the IPR 2015-00559, paper 44 (denying a PO's motion for filing a request for a Certificate of Correction) cited by Petitioner is not relevant to the facts and issues of this CBM. In that IPR, the PO attempted to correct the claim language, which would have changed the scope at a

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