

**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

CBM2016-00064

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

**MOTION BY PATENT OWNERS PURSUANT TO 37 CFR 41.121
TO FILE CERTIFICATE OF CORRECTION UNDER 37 C.F.R. 1.323**

Comes now the Patent Owner in the above identified CBM and pursuant to the granting of a Request by the Patent Trial and Appeal Board on July 26, 2016 to file a Motion, files this Motion to permit the filing of a Certificate of Correction in the involved patent, No. 8,266,432, together with a Petition to Accept An Unintentionally Delayed Claim For Benefit.

The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No. 50-5922, making reference to Attorney Docket No. LL2890046.

Statement of Material Facts.

Patent 8,266,432, the involved patent, was issued with a claim for the benefit under 35 USC §120 to a first chain of applications, namely continuing application 11/239,046 filed on Sept. 30, 2005, now patent 7,444,676 (the first parent patent), which is a continuing application of application 09/940,635, filed on Aug. 29, 2001, now patent 7,356,837 (the grandparent patent). On February 27, 2016, prior to the filing of the instant CBM case, a Petition was filed in the Patent and Trademark Office to claim the two continuing applications as Continuation-in-Part applications. That Petition is still pending.

Three weeks ago, on or about July 6, 2016, while preparing the Patent Owner's Preliminary Statement in the CBM, it was discovered that a second chain of claiming benefit under Section 120 existed for the involved patent, No. 8,266,432. This chain involved a patent application 11/333,400 filed on Jan. 18, 2006, which is a continuation-in-part of the application of the grandparent patent, now patent 8,281,129 (the second parent application), and which was then copending with the application of the involved patent. The failure to claim the benefit under this second chain was a mistake of a clerical nature, which occurred in good faith, and which was completely unintentional. The Motion to file a Certificate of Correction is to claim the benefit of this second chain of applications. The decision to grant a Certificate of Correction is with the Certificate of Correction Branch of the PTO.

In addition, neither the application nor the patent contained a specific reference to the earlier filed applications as required by the statute, 35 USC §120 in order to claim a benefit of the earlier filed application, but the statute further states that the Director may accept an unintentionally delayed submission of an amendment to add such a statement.

Statement of the Reasons for the Relief Requested.

The reasons for the requested relief is so that Patent Owner will be able to add a claim priority of an earlier filed non-provisional patent application. Pursuant to 37 CFR 1.323, since the patent is involved in a trial before the PTAB, a substantive motion must first be filed with the PTAB under 37 CFR 41.121(a)(1)(ii), to change benefit. The priority date of Aug. 29, 2001 for the U.S. patent No. 8,266,432 remains unchanged.

There are two parts to permit the claim of priority. The first part is to have a Certificate of Correction issued which will show the chain of priority. The second part is to file a Petition for a delayed claiming of the benefits under 35 USC §120 pursuant to 37 CFR §1.78(e).

The patent statute, 35 USC §255, recognizes that valuable patent rights can be lost by the clerical error of not promptly claiming the benefit of earlier filed non-provisional patent application with which there is copendency, and specifically provides for the Director to issue a certificate of correction. In 37 CFR 1.323, the PTO Rules expressly provide the procedure for correcting the mistake by the issuance of a Certificate of Correction of Applicant's mistake. The MPEP in Section 1481 explains the requirements and the details for applying for such a Certificate of Correction. So long as the correction does not involve changes which would constitute new matter or require reexamination, a Certificate of Correction is usually issued by the Certificate of Corrections Branch of the PTO.

It has been held that the determination of the priority date (e.g., the effective filing date) is purely a question of law if the facts underlying that determination are undisputed. See *Broadcast Innovation, L.L.C. v. Charter Commc'n, Inc.*, 420 F.3d 1364, 1366 (Fed. Cir. 2005),

and that the PTO provides a procedure for making the appropriate claim. *DU PONT DE NEMOURS AND COMPANY V. Macdermid PRINTING*, 420 F.3d 1364, 1366 (Fed. Cir. 2008).

With the approval of the Certificate of Correction and the granting of a Petition to the PTO to accept an unintentionally delayed claim for the benefit of the prior filed nonprovisional applications, the instant CBM proceeding will be much simpler by adding one more chain of priority.

Accordingly, the granting of this motion is respectfully requested.

Respectfully submitted,

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By: /Harold L Novick/

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July 27, 2016
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.*, the undersigned hereby certifies that a Copy of the foregoing was served on Petitioner on July 27, 2016, by filing delivering a copy via EMAIL to the attorneys of record for the Petitioner at:

CBM36137-0007CP2@fr.com

PTABInbound@fr.com

Dated: July 27, 2016

Respectfully submitted,

/Harold L Novick/

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