

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNITED SERVICES AUTOMOBILE ASSOCIATION,  
Petitioner,

v.

NADER ASGHARI-KAMRANI and KAMRAN ASGHARI-KAMRANI,  
Patent Owner.

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Cases CBM2016-00063 and CBM2016-00064  
Patent 8,266,432 B2<sup>1</sup>

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Before JONI Y. CHANG, JUSTIN T. ARBES, and  
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

DECISION

Motion to File a Request for a Certificate of Correction  
*37 C.F.R. §§ 42.20 and 1.323*

On July 27, 2016, Patent Owner filed a Motion to File a Request for a Certificate of Correction, seeking to correct U.S. Patent No. 8,266,432 B2

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<sup>1</sup> This Order addresses the same issues in the above-identified covered business method patent review (“CBM”) proceedings. Therefore, we exercise our discretion to issue one Order to be entered in both cases.

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(Ex. 1001, “the ’432 patent”) with respect to the benefit claim of prior-filed applications. Paper 8<sup>2</sup> (“Mot.”). Petitioner opposes. Paper 9 (“Opp.”). For the reasons articulated below, Patent Owner’s Motion is *granted*, authorizing Patent Owner to file a request for a certificate of correction and to file a petition to accept an unintentionally delayed benefit claim.

We observe that the Director has the authority to issue a certificate of correction of applicant’s mistake, pursuant to 35 U.S.C. § 255, which, in part, states:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination.

A patent owner may file a request for such a certificate under 37 C.F.R. § 1.323, which states:

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. § 255 at the request of the patentee or the patentee’s assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2), § 41.121(a)(3) or § 42.20 of this title.

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<sup>2</sup> All citations are to CBM2016-00063, as representative, unless otherwise noted.

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Additionally, a patent owner, who is seeking to add a benefit claim under 35 U.S.C. § 120 in a patent, must file a petition under 37 C.F.R. § 1.78(e) to accept an unintentionally delayed benefit claim. *See* § 1481.03 of the Manual of Patent Examining Procedure, 9<sup>th</sup> ed. Rev. 7 (2015). Such a petition must be accompanied by: (1) a statement that the entire delay between the date the benefit claim was due and the date the benefit claim was filed was unintentional; (2) the specific reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(d)(2); and (3) the required petition fee. *See* 37 C.F.R. § 1.78(e).

Here, the application that issued as the '432 patent has an actual filing date of September 15, 2008. Ex. 1001 at [22]. The '432 patent currently claims the benefit of the following two prior-filed nonprovisional applications:

(1) U.S. Patent Application No. 09/940,635 (Ex. 1016, “the first prior-filed application”), which was filed on August 29, 2001, and issued as U.S. Patent No. 7,356,837 B2 on April 8, 2008 (Ex. 1005 at [22], [45]); and

(2) U.S. Patent Application No. 11/239,046 (Ex. 1014, “the second prior-filed application”), which was filed on September 30, 2005, and issued as U.S. Patent No. 7,444,676 B1 on October 28, 2008 (Ex. 1015 at [22], [45]). Ex. 1001 at [63], 1:6–17.

On the present record, the front page of the '432 patent shows that the '432 patent is a *continuation* of the second prior-filed application, which is a *continuation* of the first prior-filed application. Ex. 1001 at [63], 1:6–17. However, Patent Owner indicates that it filed a petition under 37 C.F.R.

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§ 1.78(e), “to claim the two continuing applications as *Continuation-in-Part* applications.” Mot. 2 (emphasis added). According to Patent Owner, that petition is still pending. *Id.* A review of the patent file of the ’432 patent shows that Patent Owner also filed a request for a certificate of correction on February 22, 2016, seeking to correct the benefit claims in the ’432 patent as follows:

~~Continuation~~ Continuation-in-part of application No. 11/239,046, filed on Sep. 30, 2005, now Pat No. 7,444,676, which is a ~~continuation~~ continuation-in-part of application No. 09/940,635, filed on Aug. 29, 2001, now Pat. No. 7,356,837.

*See* Ex. 3001, 3 (annotations added).

In its Petition (Paper 2, “Pet.”), Petitioner argues that the ’432 patent does not have a proper benefit claim under 35 U.S.C. § 120 to either prior-filed application because there is no copendency between the ’432 patent and the first prior-filed application, and the second prior-filed application does not provide adequate written description support for the claims of the ’432 patent. Pet. 16–28. Additionally, each ground of unpatentability asserted by Petitioner is based on at least one intervening reference that has a filing date or publication date before the actual filing date of the ’432 patent, but after the filing date of the first prior-filed application. *Id.* at 3–4; Ex. 1032 at [22] (filed on December 12, 2005), [43] (published on May 4, 2006); CBM2016-00064, Ex. 1034 at [22] (filed on July 14, 2006), [54] (published on January 25, 2007).

Patent Owner now seeks to claim the benefit of a third prior-filed application, as an intermediate to the first prior-filed application. Mot. 2–3.

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In its Motion, Patent Owner contends that it recently discovered a second chain of benefit claim—namely, that the '432 patent allegedly is a *continuation-in-part* of U.S. Patent Application No. 11/333,400, filed on January 18, 2006, and issued as U.S. Patent No. 8,281,129 B1 (Ex. 3002), which is a *continuation-in-part* of U.S. Patent Application No. 09/940,635, filed on August 29, 2001, and issued as U.S. Patent No. 7,356,837 B2. Mot. 2–3. Essentially, the second chain claims the benefit of the first prior-filed application through the third prior-filed application (i.e., U.S. Patent Application No. 11/333,400), whereas the first chain uses the second prior-filed application as an intermediate. Hence, the alleged priority date of August 29, 2001, for the '432 patent would remain unchanged. *Id.*

Because the '432 patent does not include a specific reference, as required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(d)(2), for the second chain of benefit claim, Patent Owner requests authorization to file a request for a certificate of correction, pursuant to 37 C.F.R. § 1.323, and a petition under 37 C.F.R. § 1.78(e) to accept an unintentionally delayed submission of an amendment to add the specific reference for the second chain of benefit claim. Mot. 2–4. Patent Owner's failure to present the second chain of benefit claim is said to be a clerical error that occurred in good faith, and the entire delay is purportedly unintentional. *Id.* at 2.

In its Opposition, Petitioner advances several arguments. Opp. 1–5. First, Petitioner argues that Patent Owner seeks to correct an error that is not simply “a mistake of a clerical or typographical nature, or of minor character,” as required by 35 U.S.C. § 255. *Id.* at 1–2. In Petitioner's view,

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