

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MACRONIX INTERNATIONAL CO., LTD., MACRONIX ASIA LIMITED,
MACRONIX (HONG KONG) CO., LTD. and MACRONIX AMERICA, INC.
Petitioners

v.

SPANSION LLC
Patent Owner

Case: IPR2014-00108

**MOTION TO EXPUNGE AND REPLACE DECLARATION OF DHAVAL
J. BRAHMBHATT (EXHIBIT 1002)
FOR
PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 7,151,027**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450
Submitted Electronically via the Patent Review Processing System

MOTION TO EXPUNGE AND REPLACE DECLARATION OF DHAVAL J. BRAHMBHATT (EXHIBIT 1002)

Petitioners Macronix International Co., Ltd., Macronix Asia Limited, Macronix (Hong Kong) Co., Ltd., and Macronix America, Inc. herewith file this Motion pursuant to § 42.104(c).

This motion is accompanied by the Declaration of Andrew R. Sommer (Exhibit 1010), and a Corrected Declaration of Dhaval J. Brahmbhatt (Corrected Exhibit 1002).

No fee is believed to be required for consideration of this motion. The Office is authorized to charge any fee deficiency, or credit any overpayment, to Deposit Acct. No. 50-1814.

Applicable Rule

37 C.F.R. § 42.104(c) states:

A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

Facts Relevant to this Motion

1. On November 8, 2013, Petitioners filed concurrent *inter partes* review proceedings against five of Patent Owner's patents: U.S. Patent No. 6,459,635 (IPR2014-00104), U.S. Patent No. 6,731,536 (IPR2014-00105), U.S. Patent No. 6,900,124 (IPR2014-00106), U.S. Patent No. 7,018,922 (IPR2014-00107) and U.S. Patent No. 7,151,027 (IPR2014-00108). Each

of these IPRs have been given the filing date of November 8, 2013.

2. Andrew Sommer, a partner at Winston & Strawn LLP, supervised the preparation and filing of the original Petition (Paper 1, the “’108 Petition”) and the preparation and filing the original Declaration of Dhaval J. Brahmbhatt (Exhibit 1002, MX124-1002, the “Original Brahmbhatt Declaration”) in the present proceeding. Exhibit 1010, ¶ 2.
3. Due to a final formatting change in the Original Brahmbhatt Declaration, a blank, but numbered, paragraph was deleted from the declaration. The deletion of this paragraph caused an automatic software renumbering of the paragraphs below the deletion. The automated renumbering resulted in errors in some of the citations to the Original Brahmbhatt Declaration contained in the ’108 Petition. Exhibit 1010, ¶ 5.
3. The changes in the paragraph numbers in the Original Brahmbhatt Declaration were inadvertently not reflected in some of the citations to the Original Brahmbhatt Declaration contained in the ’108 Petition, which caused the clerical errors being corrected hereby. Exhibit 1010, ¶ 6.
4. Lead counsel for the Patent Owner, J. Steven Baughman has indicated that Patent Owner does not oppose this motion.
5. Maria Vignone, Paralegal Operations Manager for the Patent Trial and

Appeal Board indicated in an email dated February 10, 2014, that Petitioner may file a replacement Declaration for Exhibit 1002, with a motion to expunge the original copy.

6. Additional supporting facts are discussed in context below.

Relief Requested

By this motion, Petitioners requests the following relief:

- Petitioners asks that Exhibit 1002 be expunged and replaced with the Corrected Declaration of Dhaval J. Brahmbhatt filed concurrently as Corrected Exhibit 1002.
- Petitioners ask that the filing date of November 8, 2013 be maintained for IPR2014-00108.

Discussion

Six inter partes review requests regarding Patent Owner's patents were being prepared for Petitioners in parallel for filing on or near November 8, 2013. IPR2014-00103 is directed to U.S. Patent No. 6,369,416. IPR2014-00104 is directed to U.S. Patent No. 6,459,635. IPR2014-00105 is directed to U.S. Patent No. 6,731,536. IPR2014-00106 is directed to U.S. Patent No. 6,900,124. IPR2014-00107 is directed to U.S. Patent No. 7,018,922. IPR2014-00108 is directed to U.S. Patent No. 7,151,027. IPR2014-00104-108 were all filed on November 8, 2013. IPR2014-00103 was filed on November 12, 2013.

During the week of November 4, 2013, the final editing and formatting of all the IPR petitions, including the '108 Petition and the Original Brahmbhatt Declaration was being performed and reviewed. Exhibit 1010, ¶ 4. As part of this final formatting process, a blank, but numbered, paragraph was deleted from the Original Brahmbhatt Declaration. The deletion of this paragraph caused an automatic software renumbering of the paragraphs below the deletion. Exhibit 1010, ¶ 5.

The inadvertent renumbering of the affected paragraphs in the Original Brahmbhatt Declaration was not noticed and thus not reflected in the final version of the '108 Petition. Exhibit 1010, ¶ 6. The '108 Petition and the Original Brahmbhatt Declaration containing the errors were filed on November 8, 2013.

The errors in the citations were clerical in nature as they were caused by automated software renumbering of paragraphs in the Original Brahmbhatt Declaration.

As noted by the Board “[i]n analyzing the availability of correction under 37 C.F.R. § 42.104, the Board starts with the proposition that the rule is remedial in nature and is therefore entitled to a liberal interpretation. *See, e.g., Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967) (“[W]e are guided by the familiar canon of statutory construction that remedial legislation should be construed broadly to

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