

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZHONGSHAN BROAD OCEAN MOTOR CO., LTD.  
Petitioner

v.

NIDEC MOTOR CORPORATION  
Patent Owner

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Case IPR2014-01121  
Patent 7,626,349

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**PETITIONER'S MOTION TO SUBMIT A CORRECTED  
EXHIBIT AND MAINTAIN FILING DATE  
PURSUANT TO 37 C.F.R. §42.104(c)**

## I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner moves to (1) submit a corrected Exhibit 1005 (an English translation of Japanese Patent Publication JP 2003-348885 which includes an affidavit attesting to the accuracy of the English translation and is provided herewith); (2) expunge the version of Exhibit 1005 currently on file; and (3) maintain the July 3, 2014 filing date.

## II. STATEMENT OF MATERIAL FACTS

1. On September 25, 2013, Patent Owner Nidec Motor Corporation filed the patent infringement suit, *Nidec Motor Corporation v. Broad Ocean Motor LLC et al.*, Civil Action No. 4:13-CV-01895-JCH (E.D. Mo.) (the “Litigation”) which asserted U.S. Patent No. 7,626,349 (Ex. 1001) against Petitioner.

2. As part of developing its defenses against the Litigation, Petitioner identified Japanese Patent Publication JP 2003-348885 and obtained an English translation thereof. See Ex. 1012, Rees Declaration at ¶5.

3. On July 3, 2014, Petitioner filed a petition for *inter partes* review of U.S. Patent No. 7,626,349. The Petition identified Nathan J. Rees (Reg. No. 63,820) as Lead Counsel and Daniel A. Prati (Reg. No. 65,869) as Back-Up Counsel. See Paper No. 1 at p. 2.

4. Along with its petition, Petitioner submitted Exhibit 1003 (JP 2003-348885 in Japanese), Exhibit 1004 (an English Abstract of JP 2003-348885), and

Exhibit 1005 (an English translation of JP 2003-348885). Then Lead Counsel Rees intended to file an attesting affidavit with the translation. Ex. 1012, Rees Decl. at ¶6. The failure to do so was unintentional and inadvertent. Ex. 1012, Rees Decl. at ¶14.

5. The English language translation of JP 2003-348885 was obtained by Petitioner's litigation counsel Charles S. Baker in furtherance of Petitioner's defense of the Litigation. Because the English translation of JP 2003-348885 was obtained for use in the Litigation, then Lead Counsel Rees assumed that an affidavit attesting to the accuracy of the translation had been obtained from the translator at the time of translation and had been included as part of Exhibit 1005. See Ex. 1012, Rees Decl. at ¶6.

6. On July 25, 2014, the Patent Office issued the Notice Of Filing Date Accorded To Petition which identified, as a defect, that the Exhibits lacked a label with the petitioner's name and exhibit number. See Paper No. 4 at p. 2.

7. On July 28, 2014, Petitioner filed its Response To Notice Of Filing Date Accorded To Petition, and therein noted that "the first page of each [corrected] Exhibit has been labeled with the Petitioner's name and Exhibit number in accordance with the Notice." See Paper No. 6 at p. 2.

8. During the course of placing the label on the first page of Exhibit 1005, then Lead Counsel Rees did not notice that an affidavit attesting to

the accuracy of the English translation of JP 2003-348885 was not included as the last page of Exhibit 1005. See Ex. 1012, Rees Decl. at ¶¶10-11. This oversight was also unintentional and inadvertent. See Ex. 1012, Rees Decl. at ¶14.

9. On July 31, 2014, the Patent Office accepted the corrected petition filed on July 28, 2014. See Paper No. 8.

10. On October 3, 2014, Petitioner moved to have Messrs. Rees and Prati of Fulbright & Jaworski L.L.P. withdrawn as its counsel in this proceeding. See Paper No. 9. Petitioner is now represented in this proceeding by Steven F. Meyer (Reg. No. 36,513) and Charles S. Baker (*pro hac vice*) of Locke Lord LLP as lead counsel and back-up counsel, respectively. See Paper No. 15. Messrs. Rees and Prati are not associated with Locke Lord LLP. See Ex. 1012, Rees Decl. at ¶2.

11. In its Preliminary Response filed on October 24, 2014, the Patent Owner argued that Exhibit 1005 did not satisfy the requirements of 37 C.F.R. §42.63(b) because there was no attesting affidavit accompanying the English translation of JP 2003-348885.

12. Unable to locate an attesting affidavit, replacement Lead Counsel Meyer arranged to obtain the attached affidavit from the translator who prepared the English translation of JP 2003-348885 that was filed with the original petition on July 3, 2014 as Exhibit 1005.

### III. DISCUSSION

Section 42.104(c) permits the correction of clerical errors without changing the filing date of the petition. See 37 C.F.R. §42.104(c). Because 37 C.F.R. §42.104(c) is remedial in nature, it is entitled to a “liberal interpretation”. *Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178, Paper No. 21 (Decision -- Motion to Correct Petition) at p. 4. For instance, in *Arthrex, Inc. v. Bonutti Skeletal Innovations, LLC*, IPR2013-00631, Paper No. 15 (Decision), the petitioner was allowed to correct its petition by filing two originally omitted foreign language patents, which is a more substantive omission than that presented here.

Petitioner submits that the omission of an attesting affidavit from Exhibit 1005 as originally filed on July 3, 2014 was a clerical error that is correctable under 37 C.F.R. §42.104(c). The error arose when counsel for Petitioner believed that an attesting affidavit had been obtained for evidentiary purposes in the Litigation and had been included at the end of Exhibit 1005. See Ex. 1012, Rees Decl. at ¶6. Counsel for Petitioner at that time was unaware that no such attesting affidavit had been included with Exhibit 1005. See Ex. 1012, Rees Decl. at ¶14.

This clerical error was not noticed when a corrected version of Exhibit 1005 was filed on July 28, 2014. See Ex. 1012, Rees Decl. at ¶¶10-11. The correction to Exhibit 1005 was limited to placing a label with the Petitioner’s name and

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