

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HTC CORPORATION, HTC AMERICA, INC., SAMSUNG
ELECTRONICS CO. LTD, SAMSUNG ELECTRONICS
AMERICA, INC., and AMAZON.COM, INC.,
Petitioner,

v.

MEMORY INTEGRITY, LLC,
Patent Owner.

Cases IPR2015-00161, IPR2015-00163, IPR2015-00172
Patent 7,296,121 B2

Before JENNIFER S. BISK, NEIL T. POWELL, and KERRY BEGLEY,
Administrative Patent Judges.

BEGLEY, *Administrative Patent Judge.*

ORDER
Motion to Correct Exhibit 1007
37 C.F.R. § 42.104(c)

On March 26, 2015, Petitioner filed, with prior authorization from the
Board, a Motion to Correct Exhibit 1007 Pursuant to 37 C.F.R. § 42.104(c)
in IPR2015-00161, IPR2015-00163, and IPR2015-00172. Paper 14

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(“Mot.”).¹ Petitioner accompanied the motion with three supporting declarations (Exhibits A–C) and a copy of the exhibit to be substituted for Exhibit 1007 (Exhibit D). On April 2, 2015, Patent Owner filed an Opposition in each case. Paper 15 (“Opp.”). For the reasons explained below, we grant Petitioner’s motion and afford Patent Owner an opportunity to file additional briefing responsive to the corrected exhibit.

BACKGROUND

On October 28, 2014, Petitioner filed four Petitions challenging twenty-five claims of U.S. Patent No. 7,296,121 B2 (“the ’121 patent”), each of which includes an asserted ground relying on JOSÉ DUATO ET AL., INTERCONNECTION NETWORKS (1997) (“Duato”), along with other prior art. *E.g.*, Pet. 48–50. In each of the three cases in which Petitioner filed the present motion, the Petition relies on chapter 4 of Duato for an asserted obviousness ground challenging either or both dependent claims 9 and 10 of the ’121 patent. *Id.*; IPR2015-00163 Pet. 39–41; IPR2015-00172 Pet. 52–55. Each of these Petitions and the supporting declaration of Robert Horst, Ph.D. (Ex. 1014) refer to chapter 4 of Duato and include citations to and quotations from pages 117 and 119 within the chapter. Pet. 49–50; IPR2015-00163 Pet. 40–41; IPR2015-00172 Pet. 53–55; Ex. 1014 (Decl. of Dr. Robert Horst) ¶¶ B-18–B-22, C-44–C-49, D-20–D-25.

Duato is a book consisting of several chapters and several hundred pages. *See* Ex. 1007; Ex. D. Petitioner filed and served as Exhibit 1007 selected portions of Duato, which totaled approximately 140 pages and

¹ The filings relevant to Petitioner’s motion in the three cases are identical or nearly identical. Therefore, we exercise our discretion to issue one order addressing the motions. We treat IPR2015-00161 as representative, and all citations are to this case unless otherwise noted.

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included the cover, title, and copyright page. *See* Ex. 1007. Exhibit 1007 does not include chapter 4 (pages 115–174) of Duato. *Id.*; Ex. D.

On February 13, 2015, Patent Owner, in its Preliminary Responses, raised the issue of Petitioner’s omission of chapter 4 of Duato from Exhibit 1007 as an argument supporting denial of the relevant asserted grounds. *E.g.*, Prelim. Resp. 39–40; *see* Ex. A ¶ 7; Ex. B ¶ 6; Ex. C ¶ 6.

Petitioner’s motion now seeks to correct Exhibit 1007 to include chapter 4 of Duato. Mot. 1; *see* Ex. D. Petitioner’s supporting declarations from an associate, paralegal, and legal secretary at the law firm representing Petitioner, who were involved in the preparation and filing of Exhibit 1007, explain that the omission of the chapter resulted from an accidental error—either in transcribing the pages of Duato to be scanned and prepared as Exhibit 1007 or in scanning the pages of Duato to prepare Exhibit 1007. *See* Ex. A ¶¶ 1–2, 6; Ex. B ¶¶ 1–2, 4; Ex. C ¶¶ 1–2, 5; *see generally* Exs. A–C.

ANALYSIS

The Board’s rules allow for the correction of clerical mistakes in a petition. Specifically, 37 C.F.R. § 42.104(c) provides:

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.

“[W]hen determining whether to grant a motion to correct a petition, the Board will consider any substantial substantive effect, including any effect on the patent owner’s ability to file a preliminary response.” Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents; Final Rule, 77 Fed. Reg. 48,680, 48,699 (Aug. 14, 2012).

Here, Petitioner argues the omission of chapter 4 from Exhibit 1007 falls under 37 C.F.R. § 42.104(c) because it is a “clerical . . . mistake.” *See* Mot. 1–8; Ex. D. Patent Owner does not dispute this assertion. We find, based on the detailed and credible explanation in the three declarations submitted by Petitioner, that the omission of chapter 4 of Duato from Exhibit 1007 resulted from an inadvertent mistake—either in transcribing the pages of Duato to be scanned and prepared as Exhibit 1007 or in scanning the pages of Duato to prepare Exhibit 1007. *See* Ex. A ¶¶ 1–2, 6; Ex. B ¶¶ 1–2, 4; Ex. C ¶¶ 1–2, 5; *see generally* Exs. A–C. This accidental error in preparing, and therefore filing, an incomplete Exhibit 1007 is a “clerical . . . mistake,” subject to correction under 37 C.F.R. § 42.104(c). *See, e.g., Syntroleum Corp. v. Nestle Oil OYJ*, Case IPR2013-00178 (Paper 21) (PTAB July 22, 2013) (concluding that inadvertent submission of incorrect exhibit was a clerical mistake under 37 C.F.R. § 42.104(c)); *ABB Inc. v. Roy-G-Biv Corp.*, Case IPR2013-00063 (Paper 21) (PTAB Jan. 16, 2013) (same).

In determining whether to grant Petitioner’s motion, we consider the substantive effect of allowing Petitioner to correct Exhibit 1007. Petitioner argues that any assertion of prejudice by Patent Owner is mitigated by Patent Owner’s decision to mention the omitted chapter for the first time in its Preliminary Responses and not to pursue available means to obtain the omitted chapter, for example, by asking Petitioner for the chapter or by obtaining a physical copy of Duato, a publicly accessible textbook, based on the title, author, and copyright information included in Exhibit 1007 as filed and served. *See* Mot. 8–10. Petitioner further argues that any prejudice to

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Patent Owner can be obviated by granting Patent Owner a reasonable amount of additional briefing (e.g., 3–5 pages) on chapter 4 of Duato. *Id.*

Patent Owner, however, argues it had no obligation either to inform Petitioner of the error before filing Preliminary Responses or to obtain a copy of Duato. *Opp.* 7–8. Rather, Patent Owner asserts that Petitioner, not Patent Owner, has a statutory duty to notify Patent Owner of the asserted grounds and supporting evidence in the Petition, and allowing Petitioner to correct Exhibit 1007 would undermine this required notice. *Id.* at 4, 7–8. Patent Owner also contends that granting Petitioner’s motion would have a “substantive, prejudicial effect on Patent Owner” and its statutory right to address chapter 4 of Duato in its Preliminary Responses, which already have been filed. *Id.* at 4. In addition, Patent Owner argues that Petitioner’s proposal to allow Patent Owner additional briefing is inadequate to address this prejudice, because the approaching deadline for an institution decision in each case will not allow Patent Owner three months, the time generally permitted for filing a preliminary response, to respond to the relevant asserted ground. *Id.* at 4–5. Further, additional briefing would “forc[e] Patent Owner to incur additional effort and expense.” *Id.*

Having considered each party’s arguments and the evidence before us, we determine that the circumstances warrant granting Petitioner’s motion to correct Exhibit 1007. As explained above, Petitioner has proffered strong evidence that its omission of chapter 4 of Duato from Exhibit 1007 was an inadvertent clerical error, resulting from Petitioner’s effort to file only relevant portions of Duato, a voluminous book. Other relevant facts minimize any potential prejudice to Patent Owner in granting Petitioner’s motion. For example, omitted chapter 4 of Duato relates only to Petitioner’s

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