

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., et al.,
Petitioner

v.

STRAIGHT PATH IP GROUP, INC.
(FORMERLY KNOWN AS INNOVATIVE
COMMUNICATIONS
TECHNOLOGIES, INC.)
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 6,009,469
Case IPR No.: IPR2015-00198

MOTION TO CORRECT CLERICAL ERROR PURSUANT TO
37 C.F.R. 42.104c

In accordance with the Board's Order (Paper 6) authorizing Petitioner to file a motion seeking to correct a clerical error, LG Electronics, Inc. ("LGE"), Toshiba Corp. ("Toshiba"), VIZIO, Inc. ("VIZIO"), and Hulu, LLC ("Hulu") (collectively "Petitioners") file this Motion to Correct a Clerical Error Pursuant to 37 CFR 42.104(c) to replace an exhibit inadvertently filed in IPR2015-00198 with the correct version of that exhibit, which was served on the Patent Owner November 5, 2014.

No fees are believed to be due with this filing. If any additional fees are due, the undersigned authorizes the Office to charge such fees to Deposit Account No. 06-0916.

Applicable Rule

Rule 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

Petitioner LGE together with LG Electronics U.S.A., Inc., and LG Electronics MobileComm U.S.A., Inc. were named in a complaint alleging infringement of three patents including U.S. Patent No. 6,009,469 (“the ’469 patent”), which complaint was served on Petitioner LGE on November 6, 2013. Petitioner Toshiba together with Toshiba America Information Systems, Inc. and Toshiba America, Inc. were named in a similar complaint alleging infringement of the same three patents, which complaint was served on Toshiba America Information Systems, Inc. and Toshiba America, Inc. on November 7 and November 6, 2013, respectively. Petitioner Toshiba agreed to waive service of process on July 14, 2014. Petitioner VIZIO was named in a similar complaint alleging infringement of the same three patents and was served with the complaint on November 7, 2013.¹

¹ On October 24, 2014, Petitioner Hulu, Inc. intervened in the action Straight Path IP Group, Inc. v. VIZIO, Inc. *et al.*, No. 1:13-cv-00934-AJT-IDD, pending in the Eastern District of Virginia. Patent Owner has not served a complaint on Petitioner Hulu.

On October 31, 2014, Petitioners filed a Petition for *Inter Partes* Review with respect to the '469 patent (“IPR2015-00198”). IPR2015-00198 was accorded a filing date of October 31, 2014. (Notice of Filing Date, Paper 3).

In the process of filing IPR2015-00198, a clerical error was made that resulted in an incorrect document being uploaded to the Patent Review Processing System (“PRPS”) as Exhibit 1002. (Jiron Decl. at ¶ 5). After discovering the error on November 4, 2014, the correct exhibit was served on the Patent Owner and provided to the Board on November 5, 2014. (Jiron Decl. at ¶ 7). The clerical error is limited to the document uploaded to PRPS as Exhibit 1002.

Attached is the correct Exhibit 1002 , which was intended to be uploaded as Exhibit 1002 to the petition for IPR2015-00198 and which was served on the Patent Owner November 5, 2014.

Relief Requested

Petitioners request the following relief:

- Petitioner asks that originally filed Exhibit 1002 be expunged from IPR2015-00198 and replaced with corrected Exhibit 1002.
- Petitioner asks that the filing date of October 31, 2014, be maintained for IPR2015-00198 in view of the correction of this clerical error.

Analysis

As noted above, an incorrect document was included as Exhibit 1002 when the Petition for IPR2015-00198 was loaded to PRPS on October 31, 2014. Exhibit 1002

was intended to be the Declaration of Dr. Bruce M. Maggs in support of IPR2015-00198 for the '469 patent. (Petition, Paper 1 at p. 7). As a result of an inadvertent clerical error, however, an incorrect declaration—*i.e.*, the Declaration of Dr. Bruce M. Maggs in support of IPR2015-00196 for U.S. Patent No. 6,131,121 (“the ’121 Patent”)—was uploaded instead. (Jiron Decl. at ¶¶ 4, 5). Specifically, the Declaration of Dr. Maggs in support of IPR2015-00196 for the ’121 Patent was inadvertently placed in the upload folder for the IPR2015-00198 petition, and therefore inadvertently submitted in support of that petition. As a result, the correct declaration—the Declaration of Dr. Maggs in support of the ’469 patent—was not submitted in support of the IPR2015-00198 petition at the time the petition was initially filed. A detailed description of the clerical error and Petitioners’ efforts to correct it follows.

On October 31, 2014, the same day IPR2015-00198 was filed, Counsel filed two additional petitions, IPR2015-00196 and IPR2015-00209. (Jiron Decl. at ¶ 4). The additional petitions challenge patents related to the ’469 patent and rely on many of the same prior art references and exhibits as the petition for IPR2015-00198. *Id.* Supporting declarations for all three petitions were submitted by Dr. Bruce M. Maggs. *Id.* In all three petitions, Dr. Maggs’ Declaration is listed as Exhibit 1002. *Id.*

On October 31, 2014, Counsels’ legal assistant, at Counsels’ direction, collected the three Declarations of Dr. Maggs for submission as Exhibit 1002 in the respective petitions and placed them, along with all other exhibits, into electronic directories. (Jiron Decl. at ¶ 5). During the creation of electronic directories to store the exhibits

for the three petitions, Exhibit 1002 for the IPR2015-00196 petition was inadvertently added into the folders for *both* the IPR2015-00196 and IPR2015-00198 petitions. *Id.* As a result, upon filing of the three petitions on October 31, 2014, the copy of Exhibit 1002 corresponding to the IPR2015-00196 petition, was then inadvertently submitted as an exhibit to the IPR2015-00198 petition. *Id.*

Counsel discovered the inadvertently filed exhibit late in the day on November 4, 2014. On November 5, 2014, Counsel emailed the Board requesting permission to expunge the incorrect version of Exhibit 1002 from IPR2015-00198 and replace it with the correct version of Exhibit 1002. (Jiron Decl. at ¶ 7). Counsel included in its correspondence to the Board a copy of the correct Exhibit 1002 for IPR2015-00198. *Id.* That same day, Counsel sent an email to the Patent Owner's litigation counsel, informing them of the inadvertently filed exhibit and serving the correct version of the exhibit. *Id.* Also on November 5, Counsel sent cover letters via Federal Express to both Patent Owner's litigation counsel and its counsel of record before the USPTO for the '469 patent enclosing hard copies of the correct Exhibit 1002 for IPR2015-00198. *Id.*

There is no prejudice to Patent Owner by granting this motion. First, Patent Owner was served with the correct version of the Dr. Maggs Declaration (Exhibit 1002) on November 5, 2014, just three business days after the petition for IPR2015-00198 was filed. Second, much earlier than November 5, 2014, Patent Owner had in its possession a virtually identical version of the Dr. Maggs Declaration corresponding to

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