

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUBICON COMMUNICATIONS, LP

Petitioner,

v.

LEGO A/S

Patent Owner.

Case IPR2016-01187

Patent 8,894,066

**PETITIONER'S MOTION TO CORRECT
CLERICAL MISTAKE UNDER 37 CFR §42.104(C)**

Petitioner Rubicon Communications, LP (“Rubicon”) moves to correct a clerical mistake pursuant to 37 C.F.R. § 42.104(c) that resulted in the inadvertent omission of Smallworks LLC as a real-party-in interest. The Board authorized this motion in correspondence dated November 16, 2016.

This motion is accompanied by a declaration of the attorney who drafted the petition (“Thompson Decl.” (Ex. 1023) and a letter from Petitioner’s counsel to Patent Owner’s Counsel on June 27, 2016 (“Beard letter”) (Ex. 2010).

I. Applicable Rules and Law

37 CFR §42.104 states in part:

In addition to the requirements of §§ 42.6, 42.8, 42.22, and 42.24, the petition must set forth:

(a) *Grounds for standing*. The petitioner must certify that the patent for which review is sought is available for *inter partes* review and that the petitioner is not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in the petition.

(b) *Identification of challenge*. Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

(1) The claim;

(2) The specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and the patents or printed publications relied upon for each ground;

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;

(4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon; and

(5) The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.

...

Regarding correction of a mistake, 37 CFR §42.104 states:

(c) 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.

37 CFR §42.5 states in part:

(a) The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.

(b) The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.

(c) *Times.*

(1) *Setting times.* The Board may set times by order. Times set by rule are default and may be modified by order. Any

modification of times will take any applicable statutory pendency goal into account.

(2) *Extension of time.* A request for an extension of time must be supported by a showing of good cause.

(3) *Late action.* A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.

...

35 U.S.C. § 312(a) states:

A petition filed under section 311 may be considered only if-

(1) the petition is accompanied by payment of the fee established by the Director under section 311;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including-

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

Section 312(a) sets forth requirements that must be satisfied for the Board to give consideration to a petition; however, a lapse in compliance with those requirements does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified. *Lumentum*

Holdings, Inc. v. Capella Photonics, Inc., IPR2015-00739 (PTAB March 4, 2016) (Paper 38, page 5). In addition, jurisdiction is not lost merely because a petition does not identify “all real parties in interest,” as required by §312(a)(2). *See id.*

II. Statement of Material Facts

1. The petition seeks *inter partes* review of claims 1-8 of U.S. Patent No. 8,894,066 (the “‘066 Patent”).
2. On May 29, 2015, prior to the filing of the petition, Patent Owner sued Petitioner Rubicon Communications LP in the U.S. District Court, District of Connecticut, Civil Action No. 3:15-cv-00823 (the “Lawsuit”), alleging that Petitioner Rubicon Communications, LP infringes on claims of the ‘066 Patent (Thompson Decl., Para. 4). The Patent Owner subsequently sought leave of court in order to amend its complaint to add Smallworks LLC as a named defendant (Thompson Decl., Para. 4).
3. The law firm of Meyertons Hood Kivlin Kowert & Goetzel, P.C. represents Rubicon Communications LP and Smallworks LLC in the Lawsuit as well as in this matter.
4. Counsel for Patent Owner in this proceeding represents Patent Owner in the Lawsuit as well.

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