UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.
Petitioner

v.

California Institute of Technology
Patent Owner

Case IPR2017-00210

UNOPPOSED MOTION TO SUBMIT REPLACEMENT EXHIBITS PURSUANT TO 37 C.F.R. § 42.104(c)

Pursuant to 37 C.F.R. § 42.104(c), Petitioner Apple Inc. respectfully requests that the Patent Trial and Appeal Board ("Board") grant leave to the Petitioner to submit replacement Exhibits that address inadvertent clerical errors made when filing the following three exhibits in the IPR2017-00210, -00211, and -00219 petitions:

- Frey, B. J. and MacKay, D. J. C., "Irregular Turbocodes," *Proc. 37th Allerton Conf. on Comm., Control and Computing*, Monticello, Illinois, 1999 (the "Frey Reference").
- D. Divsalar, H. Jin, and R. J. McEliece, "Coding theorems for 'turbo-like' codes," *Proc. 36th Allerton Conf. on Comm., Control and Computing*, Allerton, Illinois, 1998 (the "Divsalar Reference").
- Declaration of Paul H. Siegel (the "Siegel Declaration").

Petitioner requested a telephonic hearing on this issue on February 21, 2017, which the Board held on February 24, 2017. At the February 24 hearing, the Board directed Petitioner to file this motion under 37 C.F.R. § 42.104(c) together with the replacement exhibits.

Accordingly, and for the reasons set forth more fully below, Petitioner respectfully requests that the Board: (1) replace the Frey Reference originally filed as Exhibit 1002 with the replacement copy attached as Appendix A to this motion;

(2) replace the Divsalar Reference originally filed as Exhibit 1003 with the replacement copy attached as Appendix B to this motion; and (3) replace the Siegel Declaration originally filed as Exhibit 1020 with the replacement copy attached as Appendix C to this motion. Patent Owner does not oppose this motion.

I. APPLICABLE RULE

Pursuant to 37 C.F.R. § 42.104(c), a party may file a motion "to correct a clerical or typographical mistake in a petition." The Board has explained that this rule is remedial in nature and subject to liberal interpretation. *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21 at 7 (PTAB Jan. 16, 2013) (citing *Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967)). The Board has regularly granted motions to correct inadvertent errors related to the filing of exhibits pursuant to § 42.104(c). *See, e.g.*, *Owens Corning v. Certainteed Corp.*, IPR2014-01397, Paper 10 at 2 (PTAB Dec. 17, 2014); *Syntroleum Corp. v. Neste Oil OYJ*, IPR2013-00178, Paper 21 at 5 (PTAB July 22, 2013).

II. FACTS RELEVANT TO THIS MOTION

On November 15, 2016, Petitioner filed three *inter partes* review petitions in IPR2017-00210, -00211, and -00219 directed to U.S. Patent No. 7,116,710. During the preparation and filing of these petitions, lead counsel Richard Goldenberg directed that the copies of the Frey Reference, Divsalar Reference, and

the Siegel Declaration (attached hereto as Appendices A, B, and C, respectively, to distinguish them from originally-filed Exhibits 1002, 1003, and 1020) were to be filed with the petitions. (Goldenberg Declaration, Ex. 1025, ¶¶6, 9, 10.) In carrying out these instructions, however, the associate assisting in uploading these exhibits, Jonathan E. Barbee, mistakenly directed legal staff to upload incorrect copies of the Frey Reference, the Divsalar Reference, and the Siegel Declaration. (Barbee Declaration, Ex. 1026, ¶¶4-7.) As explained below, this occurred due to clerical errors in the preparation of the exhibits to the petitions.

A. The Frey Reference

Counsel for Petitioner had several additional copies of the Frey Reference in the firm's document management database, including the inadvertently-filed exhibit, which lacks a table of contents and a date stamp. The associate assisting with uploading the exhibits, Mr. Barbee, unintentionally selected the wrong copy of the Frey Reference because the inadvertently-filed document had been circulated for a different purpose. (Barbee Declaration, Ex. 1026, ¶5.) The text of the replacement Frey Reference is identical to the text of the inadvertently-filed exhibit and will not affect the substance of the IPR2017-00210, -00211, and -00219 petitions, but merely corrects a clerical error.

The inadvertently-filed exhibit lacks page numbering corresponding to the Table of Contents of the publication in which the Frey Reference was published. The Table of Contents from that publication was filed as a separate exhibit with the IPR2017-00210, -00211, and -00219 petitions as Ex. 1015, Ex. 1115, and Ex. 1215, respectively. The Table of Contents bears the same date stamp as the replacement Frey Reference (*i.e.*, March 20, 2000 from the Cornell University Library) and indicates that the first page is page 241. The pagination of the inadvertently-filed Frey exhibit does not match the pagination identified in the Table of Contents in Ex. 1015, Ex. 1115, and Ex. 1215 because the inadvertently-filed Frey exhibit begins at page 1. In the replacement Frey Reference, the first page of the exhibit is page 241, which matches the pagination indicated in the Table of Contents of the publication in which the Frey Reference was published, as shown in Ex. 1015, Ex. 1115, and Ex. 1215.

B. The Divsalar Reference

Counsel for Petitioner cited to the Divsalar Reference in the IPR2017-00210, -00211, and -00219 petitions using sequential page numbering that designated the first page as page 1, whereas the inadvertently-filed exhibit bears only sequential page numbering that begins with page 201. The associate assisting in uploading the exhibits, Mr. Barbee, inadvertently directed legal staff to upload the Divsalar

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