UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EMERSON ELECTRIC CO.,
Petitioner,

v.

SIPCO, LLC,
Patent Owner.

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Case IPR2016-00984
Patent 8,754,780

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**MOTION TO DENY PATENT OWNER'S REQUEST FOR
CERTIFCATE OF CORRECTION AND AMENDED PRIORITY CLAIM**

Petitioner asks the Board to deny Patent Owner's ("PO's") Petition to accept an Unintentionally Delayed Priority Claim and for Expedited Consideration and Request for Certificate of Correction (collectively, "the Petition"). Ex. 1022-1024.

A. Standard of Review

As an initial matter, the Petition <u>must</u> be denied because (1) it lacks the required corrected ADS, and (2) it improperly adds a new application to the '780 patent's incorporation-by-reference statement. *See* MPEP 211.02(a); Ex. 1023 at 38; '780 Patent at 1:45-46. Further, a petition to alter a priority claim may be granted only if "the entire delay between the date the benefit claim was due under 37 CFR 1.78 and the date the claim was filed was unintentional." MPEP 211.04; 37 CFR 1.78(e)(3). PO has not shown that the delay from August 3, 2013 (when the claim was due) until May 26, 2016 (when the Petition was filed) was unintentional, and the Petition must be denied. 37 CFR 1.78(d)(3)(ii).

B. PO Knew the Priority Claim and did not Timely Seek Correction.

Seeking to understate its erroneous priority claim, PO contends that a single, unsubstantiated "clerical error" explains "the entire delay between the issuance of the '780 Patent and the date the priority claim is submitted via the present *Petition*." Ex. 1022 at 2, 4. But the error here is not "clerical" in nature, and instead was propagated repeatedly by the responsible attorney's own hand. *See Captioncall v. Ultratec*, IPR2015-01889, Paper 54 at 4 (Aug. 1, 2016) (describing

a clerical error as "i.e., an error performed while performing a clerical function, e.g. filing papers.").

Further, even assuming *arguendo* that a clerk unintentionally made a priority *claim* to 13/173,499 (the patented '499 application) rather than to 13/222,216 (the then-pending '216 application), PO has not even attempted to explain the *delay* in correcting that claim to the '216 application, or its failure to recognize the error. For years, the claim to the '499 application was repeatedly at the forefront of prosecution, with PO acknowledging the claim to the Patent Office and the Patent Office advising PO to check for errors. Yet, PO did nothing to change the incorrect claim during prosecution, and now offers no explanation for its inactivity:

a. On April 2, 2013, in the original '780 patent application filing, PO's attorney, Mr. Weeks, filed an ADS where he typed "Continuation of 13173499" in the first line for domestic priority, and "Patented" in the second line. No mention was made of the *co-pending* '216 application. Ex. 1026 at 2.

b. On the same day, the same attorney filed an amendment to the specification. In it, he typed in bold letters a priority claim to "U.S. Patent Application No. 13/173,499." No mention was made of the '216 application. Ex. 1027 at 2.

c. On May 17, 2013, the USPTO's filing receipt repeated back the priority claim PO sought, stating in the *first line* of the review: "This application is a CON of 13/173,499…PAT 8212667." Again, the pending '216 application was not

mentioned. The USPTO even *advised the Applicant to review the data* and **"[i]f an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction**." Ex. 1028 (emphasis in original).

d. On July 1, 2013, the USPTO reminded the Applicant in <u>underlined</u>, CAPITAL letters to review the continuation claim on the ADS because it was relevant to the kind of examination that would be performed. Ex. 1029 at 3, ¶3.

e. On June 17, 2014, the '780 patent issued. On that same day, the same attorney filed a child application No. 14/306,412 (the '412 application) claiming priority to the '780 Patent and its chain. The attorney, Mr. Weeks, completed and filed an ADS that listed the priority claim to the '499 application, again with no priority claim to the '216 application. Ex. 1030 at 2-3. Critically, <u>that ADS laid out the '780 Patent ("Application Number 13/855452") filing date as "2013-04-02" and asserted it to be a "Continuation of 13/173499" with an "Issue Date" of "2012-07-03," i.e., without any co-pendency.</u> The break in co-pendency was conspicuous and written out by the attorney's own hand. This is not an error that was "clerical" in nature.

f. On June 17, 2014, the child '412 specification listed itself as "a continuation of [the '780 Patent]…, which is a continuation of [the '499 application"]. No mention was made of the '216 application. Ex. 1031.

g. The day after the child '412 application was filed, the Applicant filed an IDS

stating that it was "a continuation of [the '780 Patent], which is a continuation of [the '499 application]." Ex. 1032 at 1. This originally drafted statement of priority made no mention of the '216 application.

h.   On June 27, 2014, the Applicant received a Filing Receipt in the child '412 application listing the '499 application and not the '216 application in the priority chain. Again, the USPTO advised the Applicant in bold letters to review the claim and correct it if necessary. Ex. 1033.

Over and over, PO articulated a priority claim to the '499 application and not to the '216 application, and was reminded of that claim. Each time, PO did not change it. The repeated nature of this error is not clerical, as PO contends.

C. There is no Excuse for the Month Long Delay from the *Inter Partes* Request until PO Filed the Petition.

PO plainly cannot contend that it did not know of its priority claim after April 29, 2016, when the present petition for *Inter Partes* Review was both filed and served. Yet, PO continued its intentional delay for nearly a month thereafter without explanation. Not until May 26, 2016 did PO finally file the Petition.[1] Because the governing regulation provides that the "entire" delay must be

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[1] PO delayed another two weeks before filing a similar request in a further child application (the '412 application), again asserting that *even every day of that extra two week* delay was also "unintentional." Ex. 1034 at 2.

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