

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMERSON ELECTRIC CO.,
Petitioner,

v.

SIPCO, LLC,
Patent Owner.

Case IPR2017-00216
Patent 8,013,732 B2

Before LYNNE E. PETTIGREW, STACEY G. WHITE, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding

37 C.F.R. § 42.5

As authorized by our Order (Paper 13), Patent Owner SIPCO, LLC, filed a Motion for Authorization to File a Certificate of Correction (Paper 14, “Motion”). Petitioner filed a Response in Opposition (Paper 17, “Resp.”) and Patent Owner filed a Reply in Support of its Motion (Paper 18, “Reply”). By its Motion, Patent Owner seeks authorization to correct what it purports to be a series of mistakes in the priority claim recited on the face of U.S. Patent No. 8,013,732 B2 (Ex. 1001, “the ’732 patent”). Patent Owner provides the following marked-up version of the priority claim to indicate the corrections it plans to seek.

. . . Pat. No. 6,437,692, which is a continuation-in-part of application No. 09/271,517, filed on Mar. 18, 1999, now abandoned, **which is and** a continuation-in-part of application No. 09/102,178, filed on Jun. 22, 1998, now Pat. No. 6,430,268, **which is and** a continuation-in-part of application No. 09/412,895, filed on Oct. 5, 1999, now Pat. No. 6,218,953, **which is and** a continuation-in-part of application No. 09/172,554, filed on Oct. 14, 1998, now Pat. No. 6,208,522

Mot. 1. Patent Owner asserts that this requested “correction accurately reflects what PO told the Office in the application data sheet submitted with the ‘732 patent (Ex. 2006, 3).” *Id.* Patent Owner has filed similar motions in two other related cases, IPR2017-00001, Paper 16 and IPR2017-00359, Paper 12. The parties agree that the proposed corrections would not impact the proceeding before us in this matter. Resp. 6, Reply 2.

Petitioner urges us to deny this relief, in part because “the PTO correctly printed the front cover and specification of the ‘732 patent. No PTO mistake exists.” Resp. 1. Petitioner asserts that the “as-filed specification and ADS (and Bibliographic Data Sheet prepared based on the ADS) had inconsistent priority claims” and that the Office resolved that ambiguity in favor of the as-filed specification. *Id.* As such, Petitioner

contends that Patent Owner is not now allowed to reject that resolution and choice to rely on the priority claim as recited in the ADS. *Id.* Petitioner also points out a number of inconsistencies and a lack of diligence that it argues should prevent Patent Owner from being allowed to make its requested correction. *Id.* at 2–6. The question before us, however, is not whether Patent Owner is entitled to a certificate of correction. We, instead, are tasked with determining whether to allow Patent Owner to file a request for a certificate of correction. The Petitions Branch is charged with reviewing any such request.

Petitioner also asserts that any attempt to modify the priority claim of the '732 patent would impact other proceedings before the Board and district court proceedings. *Id.* at 6–7. According to Petitioner, “[m]odifying the '732 patent’s priority claim is a necessary first step in attempting to bring consistency to the priority claims of the '780 patent, the '582 patent, the '692 patent, the '661 patent, and the '492 patent” and these patents, with the exception of the '582, are all at issue in other proceedings. *Id.* at 7. Patent Owner responds that “[c]orrecting a priority claim always has the potential to affect the validity of a patent, but such corrections are not precluded by pending litigation.” Reply 1. We agree with Patent Owner and as such, we are not persuaded that the potential interactions with the other proceedings should bar the Patent Owner from being able to seek a certificate of correction as to this patent.

Petitioner further contends that the modification sought here is a prerequisite to seeking a modified priority claim for U.S. Patent No. 8,754,780 (the “'780 patent”). Resp. 5–6. The '780 patent was the subject of IPR2016-00984. In that matter, a panel of the Board denied Patent

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Owner's Third Request for a Certificate of Correction and Petition to Accept an Unintentionally Delayed Priority Claim. IPR2016-00984, Paper 31.

Petitioner asserts that this request lays the groundwork to modifying the priority of the '780 patent and any such modification would be in contravention to the Board's Orders in IPR2016-00984. Resp. 2, 6. A Final Decision was issued in that case on October 25, 2017. IPR2016-00984, Paper 43. In that Final Decision, the Board lifted the prohibitions as to Patent Owner's ability to seek correction of the '780 Patent. IPR2016-00984, Paper 43 at 62. Thus, there is no issue with possible contravention of an order in IPR2016-00984.

We are persuaded that Patent Owner should be permitted to file a request to seek a certificate of correction of the '732 patent. We defer to the judgment of the Petitions Branch of the Office with respect to whether any such request should be granted.

Accordingly, it is:

ORDERED that Patent Owner is authorized to file a request for a certificate of correction for the '732 patent and, alternatively, to petition for a delayed priority claim and certificate of correction for a mistake by the applicant.

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