

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

Apple Inc.  
Petitioner

v.

California Institute of Technology  
Patent Owner

---

Case IPR2017-00728

---

**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 IPR2017-00700, -00701, and -00728 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 corrected versions of these 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 1210 with the replacement copy attached as Appendix A to this motion;

(2) replace the Divsalar Reference originally filed as Exhibit 1217 with the replacement copy attached as Appendix B to this motion; and (3) replace the Siegel Declaration originally filed as Exhibit 1223 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 January 20, 2017, Petitioner filed three *inter partes* review petitions in IPR2017-00700, -00701, and -00728 directed to U.S. Patent No. 7,421,032. 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 1210, 1217, and 1223) were to be filed with the petitions. (Goldenberg Declaration, Ex. 1225, ¶¶6, 8-10.) 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. 1226, ¶¶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 the correct 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. 1226, ¶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 IPR2017-00700, -00701, and -00728 petitions, but merely corrects a clerical error. The replacement Frey Reference bears a date stamp of March 20, 2000 from the Cornell University Library. The replacement

Frey Reference also includes sequential page numbers beginning with page 1 to match the citations in the IPR2017-00700, -00701, and -00728 petitions.

**B. The Divsalar Exhibit**

Counsel for Petitioner cited to the Divsalar Reference in the IPR2017-00700, -00701, and -00728 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 Reference without adding sequential page numbers beginning with page 1 below the original page numbers of the exhibit. (Barbee Declaration, Ex. 1226, ¶6.) The addition of the sequential page numbers was needed for the Divsalar Reference to match the citations in the IPR2017-00700, -00701, and -00728 petitions. The replacement Divsalar Reference is identical to the inadvertently-filed exhibit except for the addition of the sequential page numbers and will not affect the substance of the IPR2017-00700, -00701, and -00728 petitions, but merely corrects a clerical error.

**C. The Siegel Declaration**

Petitioner obtained from Professor Paul. H. Siegel a declaration that includes an attachment called “Exhibit 1.” “Exhibit 1” to the Siegel Declaration was inadvertently omitted, however, when the associate assisting with the exhibits, Mr.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.