

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WAVETAMER GYROS, LLC,
Petitioner,

v.

SEAKEEPER, INC.,
Patent Owner.

Cases IPR2017-01931 and IPR2017-01996¹
Patents 8,117,930 B2 and 7,546,782 B2

Before LORA M. GREEN, MICHAEL W. KIM, and PATRICK R. SCANLON,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

MOTION TO DISMISS THE PETITIONS AND AUTHORIZE
FILING OF CORRECTED PETITIONS

¹ This paper addresses issues that are the same in the identified cases. The word-for-word identical paper is filed in each proceeding identified in the heading. References to exhibits refer to Exhibits in IPR2017-01931.

I. Introduction

Petitioner has requested *inter partes* review of U.S. 8,117,930 (the '930 patent, Exhibit 1001) (IPR2017-01931) and U.S. 7,546,782 (the '782 patent, Exhibit 1042) (IPR2017-01996). In both petitions, Petitioner's counsel mistakenly cited U.S. 6,973,847 (the Adams patent, Exhibit 1006) rather than identical text in U.S. Patent Pub. No. 2004/0244513 (the Adams publication, Exhibit 1043). The Adams publication is prior art under 35 U.S.C. §102(b). The Adams patent is not prior art.

The Board authorized Petitioner to move to dismiss the original petitions and seek approval to file corrected petitions. Patent Owner has filed a preliminary response in IPR2017-01931 but the Board has not issued an institution decision. A preliminary response has not been filed in IPR2017-01996.

Petitioner seeks only to correct citations in the petitions and expert declarations by substituting the Adams publication for the Adams patent. No substantive changes will be made. The invalidity grounds as well as the evidence and arguments supporting the grounds will remain the same.

There is no prejudice to the Patent Owner. On the other hand, if the Board prohibits Petitioner from correcting the mistake, Petitioner will be seriously harmed. Indeed, considering that the Adams reference is the primary reference for all grounds in the '930 petition and constitutes the primary reference for the

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strongest grounds in the ‘782 petition, and the potential estoppel effects, failure to correct the petitions is potentially devastating to the Petitioner.

II. Statement of Material Facts

Petitioner was formed for the purpose of developing and marketing gyroscopic boat stabilizers that will compete with the boat stabilizers made by Patent Owner. On August 10, 2017, Petitioner filed the petition requesting an *inter partes* review of U.S. Patent No. 8,117,930. On August 25, 2017, Petitioner filed a second petition requesting an *inter partes* review of U.S. Patent No. 7,546,782.

The Adams patent is cited in all grounds for challenge in IPR2017-01931 regarding the ‘930 patent and in the strongest grounds for challenge in IPR2017-01996 regarding the ‘782 patent. The application that led to the Adams patent was filed on June 4, 2003 and published on December 9, 2004 as Publication No. 2004/0244513 (the Adams publication). The Adams publication is prior art with respect to the ‘930 and ‘782 patents under 35. U.S.C. 102(b).

In the petitions for *inter partes* review, Petitioner’s counsel mistakenly cites the Adams patent rather than the Adams publication. The expert’s declarations likewise cite the Adams patent rather than the Adams publication. The mistake was inadvertent. [Bennett Decl., ¶¶ 2-6, 9; Woolard Decl., ¶¶ 2-6, 8.]

On November 17, 2017, Patent Owner filed its Preliminary Response in IPR2017-01931, which pointed out the error in the petition and declaration, and

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requested the Board to deny the petition for *inter partes* review. Petitioner filed this motion expeditiously after the discovery of the error. [Bennett Decl., ¶ 7.]

III. Requested Relief

Petitioner seeks an order dismissing the petitions in IPR2017-01931 and IPR2017-01996 and authorizing Petitioner to file corrected petitions substituting the Adams publication for the Adams patent in the petitions.

IV. Argument

1. The Motion To Dismiss Should Be Granted to Allow the Correction of An Inadvertent Mistake In the Petitions.

The Board has discretion to “take up petitions or motions for decisions in any order” and to “grant, deny, or dismiss any petition or motion.” 37 C.F.R. §42.71(a); *see also, Samsung Electronics, Co., Ltd. Et al v. Nvidia Corp.*, IPR2015-01270 (Paper No. 11, December 8, 2015). Further, the Rules governing IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. §42.1(b).

During the early stages of their analysis of the case, Petitioner’s counsel, Mr. Bennett and Ms. Woolard, were provided printed copies of the Adams patent along with several other references and requested by another attorney, Mr. Coats, to provide an initial opinion regarding the validity of the ‘930 and ‘782 patents.

[Bennett Decl., ¶ 2; Woolard Decl., ¶ 2.] Petitioner’s counsel recognized that the

Adams patent was not prior art, but that the Adams publication qualified as prior art under 35 U.S.C. §102(b). [Bennett Decl., ¶ 4; Woolard Decl., ¶ 3.] The publication data is printed on the face of the Adams patent. Ms. Woolard highlighted the publication date in a printed copy of the Adams patent and verified that the text of the Adams publication was the same as the text of the Adams patent. [Woolard Decl., ¶ 3.] Petitioner's counsel continued with their initial evaluation using the printed copies of the Adams patent. [Bennett Decl., ¶ 4; Woolard Decl., ¶ 3.]

In January, Mr. Coats requested Petitioner's counsel to perform a patent search and conduct some additional analysis. [Bennett Decl., ¶ 5.] On February 6, Mr. Bennett and Ms. Woolard conducted a patent search for relevant art related to interleaved fins and continued their analysis of the '930 and '782 patents in light of the new references. [*Id.*; Woolard Decl., ¶ 4.] They were not concerned at this time with prior art in the field of boat stabilizers because they expected to use the Adams publication in any invalidity challenges to show the basic elements of a boat stabilizer. [*Id.*] Their attention was focused on finding prior art showing interleaved fins that could be combined with the Adams publication to make strong invalidity arguments. [*Id.*]

Mr. Bennett began drafting the petitions in late February 2017, approximately ten (10) weeks after the initial evaluation. [Bennett Decl., ¶ 6.]

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