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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.
Petitioner

v.

UNIVERSAL SECURE REGISTRY LLC
Patent Owner

IPR2018-00067
Patent 8,577,813

**PETITIONER'S MOTION TO CORRECT A
CLERICAL MISTAKE UNDER 37 C.F.R. § 42.104(c)**

Petitioner Unified Patents Inc. (“Petitioner”) files this motion respectfully requesting correction of a clerical mistake in the Petition filed in this proceeding.

I. FACTS RELEVANT TO THIS MOTION

1. On October 16, 2017, Petitioner filed its Petition for *Inter Partes* Review of U.S. Patent No. 8,577,813 (the “813 Patent”). Paper 2, *Petition*.

2. Ground 1 of the Petition challenges certain claims, including independent Claim 1, as obvious over the combination of U.S. Patent 6,016,476 by Maes *et al.* (“Maes”), U.S. Patent 5,870,723 by Pare *et al.* (“Pare”), and U.S. Patent Publication 2004/0107170 A1 by Labrou *et al.* (“Labrou”). *Petition*, at 4, 7.

3. Ground 2 of the Petition refers to the combination of *Maes*, *Pare*, and *Labrou* cited in Ground 1 and cites an additional reference, WO 2001/024123 by Burger *et al.* (“Burger”). *Id.* at 5, 45. Petitioner cites *Burger* in Ground 2 for its teachings of the limitations of Claims 6 and 18. *Id.* at 45-47. Claim 6 depends from Claim 1. EX1001, Claims 1 & 6.

4. Claims 7-10 depend from Claim 6, either directly or indirectly. *Id.* at claims 6-10. Claims 7-9 contain limitations that Petitioner contends are taught by the primary reference, *Maes*, which was introduced in Ground 1 of the Petition and which is also relied upon as the primary reference in the combination proposed for Ground 2. *Petition*, at 30-33 (Sec. IV.A.v-Sec. IV.A.vii); *id.*, at 45-47. Claim 10 contains

limitations that Petitioner contends are taught or rendered obvious by *Labrou* and that Petitioner contends would have been obvious to incorporate into the system of *Maes*, both of which are introduced in Ground 1 of the Petition. *Id.* at 33-34 (Sec. IV.A.viii). The combination proposed in Ground 2 also relies on *Maes* and *Labrou*, but relies exclusively on *Burger* for the limitations added by dependent Claim 6. *Id.* at 45-47.

5. Between September 2017 and October 2, 2017, in the process of copying and pasting into a draft petition, associate Michelle Callaghan mistakenly transcribed prior art mappings and arguments for *Maes* related to Claims 7-9 and for *Labrou* related to Claim 10 into Ground 1 of the draft petition, instead of including these mappings and arguments in Ground 2 of the draft petition where they were intended to be inserted. *See Callaghan Decl.* (EX1020) at ¶¶2-5. Ms. Callaghan transmitted the draft petition with the mistake to Jason Mudd for review on October 2, 2017. *See id.* at ¶5. Mr. Mudd provided comments for Ms. Callaghan to incorporate into the draft petition but failed to notice the mistake. *Id.* at ¶6.

6. On multiple dates between October 2, 2017, and the filing date of October 16, 2017, various individuals reviewed the petition without noticing Ms. Callaghan's error. *See id.*

7. On February 7, 2018, Ms. Callaghan first identified the mistake upon reading the Preliminary Response filed by Patent Owner Universal Secure Registry LLC ("PO"), which contended that Ground 2 contained the grounds for obviousness

of Claim 6 (the limitations for which *Burger* was cited), while Ground 1 had incorrectly included Claims 7-10, which depend directly or indirectly from Claim 6. *See id.* at ¶7; *see also* Paper 6, *Preliminary Response* at 23-24.

8. Petitioner contacted PO via e-mail on February 16, 2018 to indicate that Petitioner intended to seek authorization to file a motion to correct the mistake, and PO requested to schedule a telephonic meet and confer with Petitioner, which was held on February 21, 2018. PO informed Petitioner on February 22, 2018 that PO intended to oppose the motion. On February 23, 2018, the parties agreed upon the content of a joint e-mail that was sent to the Board in which Petitioner requested authorization to file this motion. The Board held a conference call on February 27, 2018, and the Board granted Petitioner authorization to file this motion (Paper 8).

II. RELIEF REQUESTED

Claims 7-10 were mistakenly entered under Ground 1 instead of Ground 2 in the Petition. Parts *v-viii* of Section V.A (Ground 1) of the Petition were intended to be written under Section V.B (Ground 2) of the Petition, after the grounds for Claim 6, from which each of Claims 7-10 depend, either directly or indirectly. Petitioner respectfully requests that it be allowed to correct its Petition by shifting the discussion for Claims 7-10 from Ground 1 into Ground 2, which contains the discussion for Claim 6. No text containing the discussion for Claims 7-10 is being altered except for adjusting the heading numbering. Per the Board's request, a

redlined proposed Corrected Petition tracking the proposed corrections has been filed as EX1021. The proposed edits minimize the changes necessary to correct the mistake and include the following:

- i) correcting the chart on pages 3-4 to remove Claims 7-10 from Ground 1 and include them in Ground 2;
- ii) correcting the headings on pages 7 and 45 of the Petition to move Claims 7-10 from Ground 1 to Ground 2;
- iii) moving Parts *v*, *vi*, *vii*, and *viii* (Claims 7-10) of Section V.A (Ground 1) to Section V.B (Ground 2) under the new numbered headings of Parts *ii*, *iii*, *iv*, and *v*, respectively, and re-numbering the heading for claim 18 as Part *vi*; and
- iv) updating the Table of Contents, as well as some internal cross-references to update section heading numbers.

III. ARGUMENT IN SUPPORT OF RELIEF REQUESTED

The proposed changes should be applied because they relate to a non-substantive, clerical transcription error made by a subordinate attorney that was not identified prior to filing, and Petitioner promptly sought to correct its mistake after discovering it from review of the Preliminary Response. *See* 37 C.F.R. § 42.104(c) (“A motion may be filed that seeks to correct a clerical or typographical mistake in the petition.”). The proposed changes rely on the exact same text applying *Maes* to dependent Claims 7-9 and applying *Labrou* to dependent Claim 10. That is,

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