

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.
Petitioner,

v.

BRISTOL-MYERS SQUIBB COMPANY and PFIZER INC.,
Patent Owners.

U.S. Patent No. 9,326,945 to Patel *et al.*

Inter Partes Review IPR2018-00892

Before SHERIDAN K SNEDDEN, ZHENYU YANG, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*

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

I. INTRODUCTION AND RELIEF REQUESTED

Pursuant to the Board’s November 20, 2018 Order (Paper No. 30), the Board authorized Petitioner to file a motion to correct inadvertent clerical/typographical errors in the Petition (Paper No. 2) and the Park Declaration (Ex. 1002) (“Park Decl.”) incorrectly referring to the Rudnic reference (Ex. 1010) as Chapter 10 of the fourth edition of the textbook *Modern Pharmaceutics*, rather than the third edition, and to file a separate motion (filed concurrently herewith) to submit supplemental information, that replaces Ex. 1010 with a clean copy of Rudnic (Ex. 1042) thereby removing extraneous markings, the incorrect cover page and publishing information to the fourth edition and replacing it with the correct cover page and publishing information for the third edition. Therefore, pursuant to 37 C.F.R. § 42.104(c), Petitioner requests that it be allowed to correct the typographical errors relating to Rudnic in both the Petition and the Park Decl. as proposed in APPENDIX A – PROPOSED CORRECTIONS attached hereto.

II. DISCUSSION OF AUTHORITY AND MATERIAL FACTS

The Board’s rules allow for correction of certain clerical and typographical mistakes. *See Amkor Technology, Inc. v. Tessera, Inc.*, Case IPR2013-00242, 2013 WL6907729, *2 (PTAB Aug. 29, 2013). Rule 42.104(c) provides:

A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the

filing date of the petition.

37 C.F.R. § 42.104(c). Rule 42.104(c) is remedial in nature and has been liberally interpreted to allow not only the correction of clerical or typographical mistakes contained in a petition, but also for related documents filed in support of a petition. *See, e.g., Amkor Technology, Inc.*, Case IPR2013-00242, 2013 WL6907729, at *3 (granting motion to correct citation to wrong reference in petition); *Emerson Elec. Co. v. Sipco, LLC*, Case IPR2017–00260, 2017 WL 1952720, at *1 (PTAB May 9, 2017) (granting motion to correct pinpoint citations in petition to corresponding exhibits); *Abb Inc. v. Roy-G-Biv Corp.*, Case IPR2013-00063, 2013 WL 6907728, at *6 (PTAB Jan. 16, 2013) (granting motion to correct the uploading of incorrect exhibits in support of petition by replacing with correct exhibits)¹; *Syntroleum Corp. v. Nest Oil Oyj*, Case IPR2013-00178, 2013 WL 5970108, at *3 (PTAB Jul. 22, 2013) (same).

Correction is especially appropriate here where no substantive changes are

¹ Petitioner understands that the Board has limited this motion to correcting the typographical errors in the Petition and the Park Decl. (*see* Order, Paper No. 30), but submits that 37 C.F.R. § 42.104(c) also provides for the correction of Rudnic (Ex. 1010) because the incorrect header portions (edition and publishing date) of Rudnic was due to a clerical error. Nevertheless, Petitioner limits this motion as ordered by the Board.

being proposed; therefore, the correction will not affect the notice function of the Petition in informing the Patent Owner or the Board of the grounds and supporting evidence for the petition. *See Amkor Technology, Inc.*, Case IPR2013-00242, 2013 WL6907729, at *3-4 (finding no prejudice to patent owner by allowing petitioner to correct the disclosure of subject matter to a particular claim where the patent owner had notice of the substantive portions of a prior art reference relied on in the petition and had an opportunity to respond in its preliminary response).

The Petition and the Park Decl. filed April 5, 2018 incorrectly refer to Rudnic (Ex. 1010) as Chapter 10 of the fourth edition of the textbook *Modern Pharmaceutics* published in 2002. (*See generally*, Second Supplemental Park Declaration (“Second Suppl. Park Decl.”) and Declaration of Karen L. Carroll (“Carroll Decl.”) submitted herewith). The citations should have instead referred to the third edition of *Modern Pharmaceutics* published in 1996 as the substantive portions of the Rudnic reference provided (*i.e.*, Chapter 10) with the Petition were actually from the third edition of *Modern Pharmaceutics* rather than the fourth edition. (*Id.*) This clerical error occurred due to a third-party prior art search providing Petitioner with a copy of Chapter 10 of *Modern Pharmaceutics* from the third edition consisting of pages 333-359, without including a cover page, publication date information, or table of contents, but misidentifying that chapter

as coming from the fourth edition. (See Carroll Decl., ¶¶ 2-5; Second Suppl. Park Decl., ¶¶ 5-6). In reliance on the incorrect citation, Petitioner obtained the publication date information and cover from the fourth edition, combined those missing pages with Chapter 10 from the third edition, and filed that compilation as Ex. 1010.. (See Carroll Decl., ¶ 6; Second Suppl. Park Decl., ¶ 4). Accordingly, the substantive portions of Rudnic (i.e., Chapter 10), including all pinpoint page citations thereto, cited and discussed within the Petition and the Park Decl. correctly refer to Chapter 10 from the third edition submitted within Ex. 1010. (See Second Suppl. Park Decl., ¶ 5). Petitioner was unaware, however, of these errors until Patent Owners submitted a table of contents purporting to be from the fourth edition of *Modern Pharmaceuticals* (Ex. 2019) with Patent Owners’ Preliminary Response (Paper No. 18). (See Carroll Decl., ¶ 7). Thereafter, Petitioner investigated further by obtaining a complete copy of the fourth edition of *Modern Pharmaceuticals*, comparing Chapter 10 from both editions, thereby discovering the error necessitating this motion. (See Carroll Decl., ¶ 8).

Patent Owners will suffer no prejudice by the requested correction. First, the error did not prevent Patent Owners from addressing the substantive teachings of Rudnic in the Preliminary Response. (Prel. Resp., Paper No. 18, p. 16 and 23; Decision, Paper No. 24, p. 8). Second, Patent Owners have already admitted that “all prior art references relied on in Grounds 1–4 [including Rudnic] qualify as

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