

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.

---

Case IPR2018-00892  
Patent 9,326,945 B2

---

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

SNEDDEN, *Administrative Patent Judge.*

DECISION

Granting Petitioner's Motion to Correct a Typographical or Clerical Mistake  
*37 C.F.R. § 42.104(c)*

## I. INTRODUCTION

On November 20, 2018, we authorized Petitioner to file a motion to correct a clerical error pursuant to 37 C.F.R. § 42.104(c). Paper 30. On November 26, 2018, Petitioner filed a Motion to Correct a Typographical or Clerical Mistake. Paper 31 (“Mot.”). Petitioner includes declarations from Dr. Kinam Park (Ex. 1044; “Second Suppl. Park Decl.”) and Karen L. Carroll (Ex. 1045; “Carroll Decl.”) in support of the Motion. Petitioner also provides a list of proposed corrections to fix alleged typographical errors contained within citations to Rudnic (Ex. 1010) in the Petition (Paper 2; “Pet.”) and in the Declaration of Dr. Park in support of the Petition (Ex. 1002; “Park Declaration”). Mot, Appendix A.

Petitioner proposes to correct certain citations referring to the Rudnic reference (Ex. 1010) as Chapter 10 of the fourth edition of the textbook *Modern Pharmaceutics*, published in 2002, rather than the third edition, published in 1996. *Id.* In its Motion, Petitioner explains that the

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).

*Id.* at 3–4 (emphases omitted). Petitioner contends that correcting the citations of Rudnic in the Petition and Park Declaration are clerical and non-substantive, and that the corrections thereof would not prejudice Patent Owner. Mot. 4–5. In particular, Petitioner contends that the proposed changes do not affect the substantive teachings of Rudnic and that “the error did not prevent Patent Owners from addressing the substantive teachings of Rudnic in the Preliminary Response.” *Id.*

On December 3, 2018, Patent Owners filed an Opposition to Petitioner’s Motion to Correct a Typographical or Clerical Mistake. Paper 35 (“Opp.”). In its Opposition, Patent Owners contend that the “citation of the fourth edition in the Petition and Park Declaration was not the result of a typographical mistake—it was a substantive mistake.” Opp. 4. In this regard, Patent Owners contend that “Exhibit 1010 contained the cover and publication information for the fourth edition[,]” and as such, “[t]his is not a case where Petitioner intended to cite to the third edition of the text, mistyped the number, and clearly supplied the third edition in the exhibit.” *Id.* Patent Owners also contend that “Petitioner’s failure to adequately identify its reference has impaired Patent Owners’ ability to challenge the status of the Rudnic reference as a prior-art printed publication and to substantively respond to it.” *Id.* at 5.

Upon consideration of the documents and the parties’ arguments, and for the reasons stated below, Petitioner’s motion is granted.

## II. ANALYSIS

An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104. A complete petition gives notice to the Patent Owner of

the basis for relief by laying out the petitioner's grounds and supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763 (Aug. 14, 2012). Where a party files an incomplete petition, no filing date is accorded. 37 C.F.R. § 42.106.

The Board's rules, however, make allowance for the correction of certain clerical mistakes. Thus, 37 C.F.R. § 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.

This rule allows errors to be corrected in certain situations, without sacrificing the notice function of the petition in informing the patent owner of the "grounds and supporting evidence" for the petition. We have previously noted that this rule is remedial in nature and therefore is entitled to a liberal interpretation. *ABB Inc. v. ROY-G-BIV Corp.*, Case IPR2013-00063, Paper No. 21 (Decision – Motion to Correct Petition), at 7 (*citing Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967)).

Based on our review of the facts as set forth in the declarations of Dr. Park and Ms. Carroll, we have determined that Petitioner has carried its burden of establishing that a clerical error led to the misidentification of Ex. 1010 as Chapter 10 of the fourth edition of the textbook *Modern Pharmaceuticals*, published in 2002, rather than the third edition, published in 1996. Here, we credit the testimony of Ms. Carroll and find credible explanation as to how the wrong header pages were associated with Ex. 1010. Ex. 1045 ¶¶ 3–6. We further credit the testimony of Dr. Park that his original declaration (Ex. 1002) is based on the Chapter 10 found in the third edition of *Modern Pharmaceuticals*.

We are not persuaded by Patent Owner's arguments as to why the motion should be denied. Patent Owners had sufficient notice of the portions of Ex. 1010 relied upon in the challenges to the claims of the '945 patent, and was not prejudiced in that Patent Owners responded to the asserted grounds in its Patent Owner Preliminary Response. Paper 18, 16 and 23. Furthermore, we do not agree with Patent Owners that its ability to challenge the status of the Rudnic reference as a prior-art printed publication has been impaired. Patent Owner will have the opportunity to address that issue in its Patent Owner Response due January 15, 2019, should it wish to do so. Paper 25. The correction would not require Patent Owners to analyze or respond to any new testimony from Dr. Park or any new arguments in the Petition. Rather, we find that correcting this error only serves to clarify the record by correctly identifying the substantive portion of Ex. 1010 as Chapter 10 of the third edition of the textbook *Modern Pharmaceuticals*, published in 1996.

Under the specific facts before us, we conclude that the errors related to the proper citation of Ex. 1010 identified in the Petition and Park Declaration are amenable to correction under § 42.104(c). Accordingly, the Motion is granted with no change in the filing date accorded to the Petition. 37 C.F.R. § 42.104(c).

### III. ORDER

For the reasons given:

**ORDERED** that that Petitioner's Motion to Correct a Typographical or Clerical Mistake (Paper 31) is *granted*.

**FURTHER ORDERED** that the sentence in footnote 7 on page 28 of the Petition is corrected as follows:

# 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.