

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SHOPIFY, INC.

Petitioner

v.

DDR HOLDINGS, LLC

Patent Owner

Case IPR2018-01008

Patent No. 9,639,876

**MOTION TO CORRECT MISTAKES IN PETITION UNDER  
37 C.F.R. § 42.104(c)**

## I. INTRODUCTION

Petitioner Shopify, Inc. (“Petitioner”) moves to correct errors in the petition for *inter partes* review (“IPR”) in IPR2018-01008, and seeks leave to file a replacement version of the originally-filed petition, which replacement has been concurrently filed as Exhibit 1023. The Board authorized the filing of this motion in an email dated August 1, 2018.

The proposed replacement petition corrects typographical errors in the Petitioner’s exhibit list, table of authorities, citations to the accompanying expert declaration, and the listing of claims being challenged under 37 C.F.R. § 42.104(b)(2). The original petition erroneously named incorrect claim numbers in the listing of claims being challenged and the element-by-element analysis, even though the substance of the analysis addressed the intended claim elements.

## II. FACTS AND CIRCUMSTANCES OF THE ERRORS

On May 3, 2018, Petitioner filed its original Petition (Paper No. 1) citing, under Ground 3 of Section IV.B, challenges to claims 1-5, 7-8, and 11-18 of U.S. Pat. No. 9,639,876 (the “876 Patent”). Shortly thereafter, Petitioner realized that Ground 3 of Section IV.B should cite to claims 1-5, 7-8, 11-15, and 17-18. Petitioner further identified incorrect paragraph citations to the associated expert declaration.

On May 4, 2018, counsel for Petitioner notified counsel for DDR Holdings, LLC (“Patent Owner”) of the errors and Petitioner’s intention to file a motion to correct them. On May 7, 2018, Petitioner provided a redline version of the petition to Patent Owner’s counsel. Patent Owner informed Petitioner on May 30, 2018, that they do not oppose this motion.

On August 1, 2018, Petitioner sent an email to trials@uspto.gov requesting authorization from the Board to file a motion to correct the errors in the originally filed Petition.

### **III. STATEMENT OF RELIEF REQUESTED**

Claims 1-5, 7-8, and 11-18 were mistakenly entered under Ground 3 of Section IV.B of the original Petition. Petitioner respectfully requests that it be allowed to correct its Petition by revising Ground 3 of Section IV.B to identify claims 1-5, 7-8, 11-15, and 17-18 as being obvious in view of prior art. The requested revision will allow Section IV.B to accurately reflect the element-by-element analysis of the Petition, and will not alter the substance of the Petition.

Petitioner requests permission to modify erroneous citations to the expert declaration. The proposed paragraph modifications would accurately reflect the expert analysis of the ’876 Patent.

Finally, Petitioner requests permission to correct errors in the Exhibit List and Table of Authorities of the Petition. The Exhibit List mistakenly includes

exhibits that, while properly included in related Petitions filed by Petitioner, do not apply to the Petition for Institution IPR2018-01008. Additionally, the Table of Authorities mistakenly includes irrelevant information, such as web addresses. A redlined proposed Corrected Petition tracking the proposed corrections has been filed as Ex. 1023.

#### **IV. ARGUMENT IN SUPPORT OF RELIEF REQUESTED**

The proposed changes should be applied because they relate to non-substantive, clerical transcription error that was not identified prior to filing, and Petitioner promptly sought to correct its mistakes after discovering them the day after filing. *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 seek to correct the Petition to accurately reflect the analysis discussed in the expert declaration. That is, Petitioner’s requested corrections seek to identify the claims of the ’876 Patent to which the analysis properly applies. The Petitioner is not seeking to make changes to the arguments applied to the prior art – the grounds for the challenged claims will rise or fall based on the analysis already present in the Petition. *See, e.g. Amkor Technology, Inc. v. Tessera Inc.*, IPR2013-00242, Paper 32, at 5-6 (PTAB Aug. 29, 2013) (allowing correction of copying and pasting error by subordinate attorney where no new analysis was added by correction).

Correction of these errors will not prejudice Patent Owner or destroy the notice function of the Petition. Petitioner notified Patent Owner of the errors and Petitioner's intent to file a motion to correct the day after filing the Petition, and promptly provided the Patent Owner with redline versions of the proposed corrections. Petitioner does not seek to alter substantive arguments, and Patent Owner has not yet submitted a response to the Petition. Patent Owner will retain its opportunity to address Petitioner's same substantive arguments regarding the art specifically applied to the challenged claims of the '876 Patent.

The original Petition was filed before the one-year time bar. The proposed corrections would not implicate the one-year time bar, as the grant of such motions under 37 C.F.R. § 104(c) does not change the filing date.

Given the clerical nature of the errors, lack of prejudice to the Patent Owner, and Petitioner's prompt efforts to correct the issues on their discovery, the proposed corrections are appropriate under Rule 104(c). *See, e.g., ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21, at 7 (PTAB Jan. 16, 2013) (Rule 104(c) is "remedial in nature" and should be "liberally applied") (citing *Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967)).

## V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board apply the above-proposed corrections to Petitioner's Petition for *Inter Partes*

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