

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GUARDIAN ALLIANCE TECHNOLOGIES, INC.  
Petitioner

v.

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TYLER MILLER,  
Patent Owner

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Case No. IPR2020-00031  
Patent No. 10,043,188  
Issued: August 7, 2018  
Application No.: 14/721,707  
Filed: May 26, 2015  
Title: BACKGROUND INVESTIGATION MANAGEMENT SERVICE

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**MOTION TO CORRECT A CLERICAL MISTAKE IN THE PETITION  
UNDER 37 C.F.R. § 42.104(C)**

Petitioner Guardian Alliance Technologies, Inc. (“Petitioner”) files this Motion Under 37 C.F.R. § 42.104(c) pursuant to the Board’s authorization issued February 6, 2020 (Ex. 1026, at pp. 31-32). Petitioner seeks to substitute a 2009 video from third-party Background Solutions (*i.e.*, “the 2009 Video,” filed herewith as Ex. 1027) upon which its Petition actually relies, in place of an incorrectly marked and uploaded 2012 video also from Background Solutions.

On October 10, 2019, Petitioner filed an IPR petition for U.S. Patent 10,043,188 on two grounds. Only Ground 1 relies on “Background Solutions” (in combination with the LaPasta patent publication). The Petition defined “Background Solutions” as “[a] printed publication, which is a video demonstration entitled “Background Assistant” (Ex. 1002), which discloses Background Solutions, LLC’s background investigation system, *i.e.* Background Assistant™, demonstrated and displayed at trade seminars as early as mid-2009 and made publicly accessible on [www.backgroundsolutions.com](http://www.backgroundsolutions.com), no later than November 23, 2009.” (*Id.* at pp. 1, 4-5). Pages 25–52 of the Petition provide a detailed analysis of Ground 1, including a limitation-by-limitation chart comparing the challenged claims of the ’188 Patent to Background Solutions and LaPasta. The charts purposefully include time-stamped screenshots and narration from the 2009 Video. (*Id.*) Due to a clerical error, Petitioner inadvertently marked and uploaded the 2012 video from Background Solutions (“the 2012 Video”) as Ex. 1002.

37 C.F.R. § 42.104(c) allows filing a motion “that seeks to correct a clerical or typographical mistake in the petition.” Motions to correct are granted upon showing that an error in filing an incorrect exhibit was clerical in nature. *Netflix, Inc. v. Copy Protection LLC*, IPR2015-00921 (PTAB July 30, 2015) (Paper 19). The rule is remedial in nature and entitled to a liberal interpretation. *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063 (PTAB Jan. 16, 2013) (Paper 21). *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01180 (PTAB Dec. 6, 2018) (Paper 14 at p. 9) provides a list of non-exhaustive factors for consideration.

**Factor 1: The nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred, including how the error was discovered.**

The error Petitioner seeks to correct is clerical in nature. During the related district court litigation, *Miller Mendel, Inc. et al. v. The City of Oklahoma City*, Case No. 5:18-cv-00990-JWD (W.D. Okla.) (“Related Litigation”), the City of Oklahoma City (“OKC”)—Petitioner’s indemnitee and a named real party-in-interest—obtained from third party Background Solutions, LLC production of documents and files (the “Background Solutions Files”), which included both the 2009 and 2012 Videos. (Sigale Decl., Ex. 1028, at ¶ 4). The Background Solutions Files were, and continue to be, stored on Dunlap Codding’s (“DC”) document server in the “Background Solutions” subfolder in the “Third Party Production” subfolder for the Related Litigation (“RL Directory”). (*Id.* at ¶ 5).

On August 8, 2019, Patent Owner’s (“PO”) counsel was served with the Background Solutions Files, including the 2009 and 2012 Videos. (*Id.* at ¶ 6). OKC’s invalidity contentions and charts, also served on PO’s counsel that day, relied upon and made reference to the 2009 Video. (*Id.* at ¶ 9). The cover pages for each of the Background Solutions invalidity charts refer to the 2009 Video as “Background Solutions Demo” and identify it by Bates number BGS-000627. (*Id.* at ¶ 10). These invalidity charts contain virtually identical screenshots, timestamps, and narration transcript as detailed in the Petition at pp. 32–50. (*Id.* at ¶ 11). The invalidity contentions were not marked confidential under the protective order in the Related Litigation. (*Id.* at ¶ 12). PO’s counsel in the Related Litigation, Rylander & Associates PC, is the counsel-of-record for the ’188 Patent, as well as Backup Counsel in this proceeding. (*Id.* at ¶ 7).

While preparing the IPR Petition, DC relied upon the 2009 Video saved in the RL Directory. (*Id.* at ¶ 13). A separate directory was created on DC’s document server for this IPR proceeding (“IPR Directory”). (*Id.* at ¶ 14). While finalizing the exhibits for the Petition, DC staff transferred files from the RL Directory to the IPR Directory. (*Id.* at ¶ 15). When it came time to transfer a copy of the 2009 Video to the IPR Directory, the 2012 Video was accidentally transferred and erroneously labeled as “Ex. 1002.” (*Id.* at ¶ 16). (The 2009 Video and the 2012 Video were and remain the only video files in the RL Directory. (*Id.* at ¶ 17).) The Petition does not

recite, mention, or rely in any manner on the 2012 Video. On January 23, 2020, reading the PO's Preliminary Response, filed January 22nd, Petitioner's Counsel realized that it had erroneously marked and uploaded the 2012 Video as Ex. 1002. (*Id.* at ¶ 18).

**Factor 2: The length of time elapsed between learning of the error and bringing the motion to the Board's attention.**

Immediately upon discovering the error, Petitioner's counsel contacted PO's counsel to inform them of the error. (*Id.* at ¶ 19). Counsel met and conferred over the issue on January 29, 2020--PO's counsel's earliest availability. On February 4, 2020, following additional discussions between counsel, Petitioner submitted a joint email to the Board. (*Id.* at ¶¶ 20-22).

**Factor 3: Prejudice to the other party, if any, by allowing the proposed correction.**

The prejudice to PO if Petitioner is allowed to correct its clerical mistake is minor. PO and its counsel have been on notice since at least August 9, 2019 that Petitioner's invalidity case against the '188 Patent relies on the 2009 Video. (*Id.* at ¶¶ 9-11). PO's counsel in the Related Litigation is counsel-of-record for the '188 Patent and backup counsel in this IPR. (*Id.* at ¶ 7). In the context of service, the Board has found that failure to effect timely service on a patent owner can be cured by serving litigation counsel. *See, e.g. Micron Tech, Inc. v. eDigital Corp.*, IPR2015-00519 (PTAB Mar. 25, 2015) (Paper 14, at pp. 4-6). Further, the Petition itself makes

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