

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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**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO  
TERMINATE**

## **I. INTRODUCTION**

Petitioner Guardian Alliance Technologies, Inc. files this opposition to PO's Motion to Terminate (Paper 10).<sup>1</sup> First, PO's argument ignores the plain language of 37 C.F.R. § 42.104(c) and the litany of proceedings relying thereon to grant petitioners leave to correct clerical mistakes—even those pertaining to the basis of the petition itself. Second, even if the Board denies Petitioner's co-pending motion (Paper 11) to substitute the 2009 video (relied upon and extensively cited in the Petition) for the 2012 video inadvertently uploaded as Ex-1002, Ground 2 of the Petition—which does not rely on the 2009 video—remains. Thus, precluding the Board from terminating this proceeding on procedural grounds.

## **II. DISCUSSION**

### **A. 37 CFR § 42.104(c) Explicitly Allows for Correction of a Petition After Statutory Deadline While Maintaining the Original Filing Date**

PO incorrectly argues that the Petition was incomplete prior to the bar date due to Petitioner's clerical error in uploading the 2012 Video as Ex-1002 in place of

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<sup>1</sup> PO's eleven purportedly material facts (Paper 10, pp. 1-2) are: (1) irrelevant to the issues presented; and/or (2) inaccurate and, thus, disputed. As one example, Fact No. 5 states: "Mr. Talley sought permission to serve IPR documents on October 10, 2019, but did not identify GAT as petitioner." (*Id.*). As the full email thread shows, PO's counsel of record consented to e-service of the IPR Petition. (Ex. 1031).

“the 2009 Video.” Clerical errors do not render petitions incomplete, nor do they require a change in the filing date. *Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178 (PTAB July 22, 2013) (Paper 21 at p. 4). 37 C.F.R. § 42.104(c).

PO’s Lead Counsel knows this because he has moved to correct an error in a petition after the statutory bar date, while maintaining the original, pre-statutory-deadline filing date. See, *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063 (PTAB Jan. 16, 2013) (Paper 21, at p. 10) (petitioner given leave to later file the petition—inadvertently omitted from the original filing—without changing the filing date because holding otherwise “would make the language [of 37 C.F.R. § 42.104(c) that] ‘[t]he grant of such a motion does not change the filing date of the petition’ superfluous.”) The Board has subsequently cited *ABB* in providing similar relief from clerical errors. See, e.g., *Cordelia Lighting, Inc. v. Cooper Lighting, LLC*, IPR2017-01860 (PTAB October 24, 2017) (Paper 13). The Board has also allowed correction of a petition to include items that were neither served nor filed prior to the statutory bar date, even after the filing of a POPR. See *Netflix, Inc. v. Copy Protection LLC*, IPR2015-00921 (PTAB July 30, 2015) (Paper 19); *Actifio, Inc. v. Delphix Corp.*, IPR2015-00014, slip op. (PTAB Jan. 9, 2015) (Paper 9); and *FedEx Corp. v. IpVenture, Inc.*, IPR2014-00833, slip op. (PTAB Nov. 3, 2014) (Paper 12).

PO cites *Nuna Nuna Baby Essentials, Inc. v. Britax Child Safety, Inc.*, IPR2018-01683 (PTAB Dec. 18, 2018) (Paper 11). However, its reliance on *Nuna*

is misplaced. In *Nuna*, the petitioner was alerted in a “Notice of Filing Date” that it had failed to submit any exhibits with its petition and given five business days to correct the error. *Id.* at 1-2. It was not until after the five days had passed that the petitioner finally sought to file the missing exhibits. *Id.* So, the petitioner also filed a Motion to Excuse Late Filing, which the Board specifically denied because the time had expired. *Id.* at 4. As such, the error in *Nuna* is not analogous to the clerical error addressed in Petitioner’s co-pending Motion to Correct. Here, the Notice of Filing Date (Paper 3) only alerted Petitioner that Ex. 1010, as filed with the Petition, had been incorrectly labeled as Ex. 1003 and afforded Petitioner five business days to correct the specifically noted defect. (*Id.* at p. 2). Petitioner timely corrected the exhibit as acknowledged by the Board. (Paper 6).

The other significant difference between the instant case and *Nuna* is that in *Nuna* it was the petitioner (not the patent owner) that filed the motion to dismiss its own petition, unopposed by the patent owner. *Nuna Baby Essentials*, IPR2018-01683 (Paper 13). Here, Petitioner opposes Patent Owner’s request for dismissal.

**B. The Petition’s Reliance on the Correct Version of the Background Solutions Reference and the Additional Ground for Invalidity Raised in this Petition Preclude Termination of this Proceeding**

As PO’s Motion points out, the purpose of requiring service within the one-year statutory period is to provide a patent owner with timely notice that its patent is subject to an IPR proceeding. Paper 10 at 3 (citing *Tech. Inc. v. Yodlee, Inc.*,

IPR2016-00275 (PTAB June 9, 2016) (Paper 15 at p. 9)). Petitioner asserts its October 10th filing and service on PO provided adequate notice that the '188 Patent was subject to an IPR proceeding, the bases for the Petition, and—through the Petition's specific citations to verbatim excerpts of all of the references upon which it relies, specifically the printed publication Petitioner intended to upload as Ex. 1002—the multiple grounds for invalidity. (Paper 11 at p. 1).

Notwithstanding its notice of the specific grounds and citations and excerpts relied upon, PO attempts to conflate Petitioner's clerical error into a substantive, complete substitution of a prior art reference for a non-prior art reference as occurred in *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01180 (PTAB Dec. 6, 2018) (Paper 14) and *Wavetamer Gyros, LLC v. Seakeeper, Inc.*, IPR2017-01931 (PTAB Jan. 9, 2018). In *Ivantis*, the Board reasoned that, “Not only was the incorrect reference filed as an exhibit, but because this error permeate[d] the [p]etition . . . we do not consider the magnitude and scope of the errors clerical or typographical.” (*Ivantis*, Paper 14 at p. 15, emphasis added). Similarly in *Wavetamer*, “[w]e agree with Patent Owner that citing the incorrect reference in a [p]etition is not an error that is correctable under 37 C.F.R. § 42.104(c).” (*Wavetamer*, Paper 8 at 2, emphasis added). Here, Petitioner cited the substance of the 2009 video throughout Ground 1 of the Petition. Petitioner never referred in the Petition to the 2012 video, erroneously uploaded as Ex.1002.

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