UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDIAN ALLIANCE TECHNOLOGIES, INC.
Petitioner

v.

TYLER MILLER,
Patent Owner

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

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO CEDE JURISDICTION FOR CORRECTION OF PRIORITY CLAIM

I. INTRODUCTION

Petitioner Guardian Alliance Technologies, Inc. opposes Patent Owner's ("PO") Motion to Cede Jurisdiction for Correction of Priority Claim (Paper 9). The Board should refrain from ceding its jurisdiction in this case because, after filing of an IPR proceeding, the Board is vested with the exclusive jurisdiction to manage its resources, including the manner in which matters involving the same patent are to proceed. Because PO did not seek correction until after the commencement of this proceeding, any granted correction will not apply retroactively, meaning it will not apply to this proceeding. As such, the Board should deny PO's Motion to Cede Jurisdiction.

II. DISCUSSION

A. Following Commencement of an IPR, the Board Has the Exclusive Authority to Manage Its Resources and Proceedings

During pendency of an *inter partes* review, the Director has authority to determine the manner in which the *inter partes* review, and any other proceedings, including review of a request for certificate of correction is to proceed. 35 U.S.C. § 315(d). This authority has been delegated to the Board. *See* 37 C.F.R. § 42.3 (the Board may exercise exclusive jurisdiction within the Office over every involved patent during the proceeding); *id.* at § 42.122 (stating that where another matter involving the patent is before the Office, "the Board may during the pendency of the

inter partes review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter"). The Board has jurisdiction beginning with the filing of an IPR petition. *See* 37 C.F.R. § 42.3 (Board has jurisdiction during "proceeding"); and *id.* at § 42.2 (defining "proceeding" as "begin[ning] with the filing of a petition for instituting a trial"). Therefore, once an IPR petition has been filed, the Board may exercise jurisdiction over a request for a certificate of correction, and may stay the request,[1] "thereby avoiding potentially conflicting outcomes between proceedings before different authorities with the Office, such as a decision by the Certificates of Correction Branch on a request for a certificate of correction and a decision by the Board in an *inter partes* review." *Emerson Electric Co. v. SIPCO, LLC*, IPR2016-00984 (PTAB Jan. 24, 2020) (Paper 52 at 22).

[1] In particular, the Board determines "whether there is sufficient basis supporting Patent Owner's position that the mistake may be correctable." *Honeywell International, Inc. v. Arkema, Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019) (internal citations omitted). Thus, *Honeywell* did not hold that the patent owner should be summarily given a Certificate of Correction, just that the patent owner could ask for leave to request correction. *Id.*

B. The Board Should Refrain from Ceding Its Exclusive Jurisdiction Because the Requested Correction Will Not Apply to this Proceeding

Petitioner has a very compelling reason for asking the Board not to cede jurisdiction: any correction obtained by PO has no retroactive effect on this proceeding. In *Emerson Electric Co. v. SIPCO, LLC*, IPR2016-00984 (PTAB Jan. 24, 2020) (Paper 52 at 17-21), the Board determined that a certificate of correction (35 U.S.C. § 255) does not have retroactive effect upon already commenced proceedings. The operative portion of § 255 states: "Such patent, together with the certificate, shall have the same effect and operation in law on the trial of the actions for causes thereafter arising as if the same had been originally issued in such corrected form" (emphasis added).

The Board further found that affording a certificate of correction only prospective application is consistent with the interpretation of §§ 254 and 256, "the sister provisions of § 255," pointing to *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280 (Fed. Cir. 2000). Accordingly, as PO did not even begin the process of seeking correction until after Petitioner commenced this IPR, any correction will not apply to this proceeding. For this reason alone, the Board should deny PO's motion to cede jurisdiction.

C. PO's Delay In Seeking Correction Significantly Prejudices Petitioner

Notwithstanding that any correction obtained by PO will not apply to this

proceeding, PO's two-plus month delay in seeking to correct the priority claim of the '188 Patent prejudices Petitioner. PO was made aware of the priority issue no later than August 8, 2019 when OKC served its invalidity and non-infringement contentions (Ex. 1032, at p. 2). It is somewhat surprising that PO now argues that "neither GAT nor OKC identified any specific regulation involving the ADS, and the issue was not understood until October 11, 2019" by PO until "reviewing the IPR Petition." (Paper 9, at p. 4). It's unclear exactly what information in the Petition made PO realize the existence of the priority defect only upon reading the Petition as the invalidity contentions OKC served on PO describe the defect in detail:

> In their Infringement Contentions, Plaintiffs allege they are entitled to claim priority to U.S. Provisional Application 61/472,556 ("the '556 Provisional Application"), which was filed April 6, 2011. However, the '188 Patent does not actually claim priority to the '556 Provisional Application (*see,* OKC-0000001). The Application Data Sheet (OKC-0000508-0000512) submitted with the '707 Application claims the benefit of only the '648 Application, not the '556 Provisional Application. (OKC-0000509). The USPTO's acknowledgement of receipt of the '707 Application, mailed June 3, 2015, also states that the '707 Application claimed priority only to the '648 Application. (OKC-0000408). During prosecution of the '707 Application, Miller did not file a Supplemental Application Data Sheet (or anything else) to establish his priority claim to the '556 Provisional Application as required by USPTO Regulations. Thus, the priority date for the '188 Patent is no earlier than April 6, 2012, not April 6, 2011, as alleged in Plaintiffs' Infringement Contentions.

(*Compare* Ex. 1032, at p. 2 *with* Paper 1, the Petition, at p. 6, which includes less detail relating to the priority defect issue.)

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