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Subject: RE: IPR2022-01291 - Petitioner's Unopposed Request to Correct the Petition Under 37 CFR § 42.104(c)
Date: Friday, September 22, 2023 9:07:39 AM

Counsel,

The Board intends to discuss Petitioner's request (below) during the anticipated conference call later this month per the Board's Order of September 5, 2023.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Nicholas Stephens <nstephens@fr.com>
Sent: Thursday, September 21, 2023 1:37 PM
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Subject: IPR2022-01291 - Petitioner's Unopposed Request to Correct the Petition Under 37 CFR § 42.104(c)

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Your Honors,

During the parties' recent meet and confer in relation to Patent Owner's requested authorizations for a motion to strike and to submit additional evidence with its Sur-Reply, Patent Owner contended that Section I.D of Petitioner's Reply "requests a substantive change to the petition to correct typographical errors," and argued that "such a request can only be made via motion under § 42.104(c)."

While the Reply cited cases that Petitioner believes demonstrates authority for the Board to correct a typographical error even in the absence of a motion under § 42.104(c), out of an abundance of caution, Petitioner respectfully requests authorization under § 42.104(c) to correct the Petitioner's typographical error as identified in Section I.D of the Reply. Specifically, in addressing limitations [20.0]-[20.8] in Ground 1B, the Petition at page 27 includes a mistaken cross-citation to limitations from independent claim 15 (i.e., [15.0]-[15.8]) rather than independent claim 1 (i.e., [1.0]-[1.7]).

Petitioner proposes to correct the Petition by replacing the citation to “[15.0] - [15.8]” with “Ground 1A, [1.0] - [1.7]” on page 27, consistent with the parallel limitations recited in claims 1 and 20. Petitioner proposes no other corrections to the body of the Petition. Clean and redlined versions of the proposed corrected Petition are attached for reference.

Petitioner submits that good cause exists for the correction given that the parties have consistently addressed corresponding limitations from claims 1 and 20 together in the POR and Reply. Petitioner’s intent to cross-cite limitations [1.0]-[1.7] rather than [15.0]-[15.8] is also evident from the Petition’s proper cross-citation to claim 1 in addressing claim 20 in Ground 2B (pages 41-42) and Petitioner’s proper cross-citation to claim 1 in addressing claim 20 in both grounds of the Petition in IPR2022-01465. The Board has also confirmed that § 42.104(c) permits corrections to petitions based on motions filed after institution. *See, e.g., Group III Int’l, Inc. v. Targus Int’l LLC*, IPR2021-00371, Paper 88 at pp. 9-13 (PTAB July 6, 2022).

The parties have conferred and Patent Owner indicates that it does **not oppose** Petitioner’s request.

Should the Board desire a conference call, the parties will provide their availability. The parties are also amenable to discussing this request at the conference call that we anticipate scheduling later this month pursuant to the Board’s Order of September 5, 2023 (Paper 43).

Best Regards,
Nick Stephens

Counsel for Petitioner Apple Inc.

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