

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMART MODULAR TECHNOLOGIES INC.
Petitioner

v.

NETLIST, INC.
Patent Owner

Case Number IPR2014-01373
Patent 8,001,434

Before LINDA M. GAUDETTE, BRYAN F. MOORE, GEORGIANNA W.
BRADEN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

A conference call in the above proceeding was held on September 17, 2014. Counsel for Petitioner and Patent Owner participated in the call with Judges Gaudette, Moore, and Braden. The purpose of the call was to discuss a request by Petitioner to correct the filing date of the Petition.

A document purporting to be a petition challenging claims of U.S. Patent No. 8,001,434 (“the ’434 Patent”) was uploaded August 23, 2014. The document actually uploaded was not a petition; rather, it was an exhibit to a petition. Petitioner asserts it realized this fact on August 25, 2014. On that day Petitioner filed a petition (Paper 4) and a letter signed by a Patent Agent for Petitioner (Paper 5), requesting that, because the error was unintentional, we consider August 23, 2014 the correct filing date.

On the call, Patent Owner stated that it opposed the request to the extent that a motion had not been filed. We note that requests for relief by the Patent Trial and Appeal Board (“Board”) should be filed as motions. 37 C.F.R. § 42.20(a). Additionally, such motions generally require authorization by the Board before filing. 37 C.F.R. § 42.20(b). Finally, “[t]he Office expects that lead counsel will, and back-up counsel may . . . sign all papers submitted in the proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (August 14, 2012). Nonetheless, we will treat Petitioner’s explanation of the request as a request for authorization to file a motion to correct a clerical error.

An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104. This is a statutory requirement. *See* 35 U.S.C. § 312 (a). The purpose is to give adequate notice to the patent owner of the basis for relief by laying out the petitioner’s grounds and supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763 (Aug. 14,

2012). Where a party files an incomplete petition no filing date is accorded. 37 C.F.R. § 42.106.

Our rules, however, make allowance for correction of certain clerical mistakes. Thus, 37 C.F.R. § 42.104(c) provides:

A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

This provision allows errors to be corrected in certain situations, without sacrificing the notice function of the petition in informing the patent owner of the “grounds and supporting evidence” for the petition.

It appears from discussion on the call that the correct Petition was served on the record owner of the ’434 Patent. Nonetheless, the Panel will need to consider the details of the alleged “clerical” error, as this is a requirement of our rules. Therefore, Petitioner is authorized to file a motion seeking to “correct a clerical or typographical mistake in the petition” pursuant to 37 C.F.R. § 42.104(c). The motion should include an affidavit[s] from the person[s] with knowledge of the details of the error. Patent Owner is authorized to file an opposition in the event it believes such a motion should not be granted. No reply is authorized at this time.

We remind Petitioner that the authorization of this motion does *not* extend the five day deadline to correct the other defects noted in the Notice of Filing Date Accorded to Petition dated September 16, 2014.

Accordingly, it is

ORDERED that, pursuant to 37 C.F.R. § 42.104(c), Petitioner is authorized to file, by September 24, 2014, a motion to correct the petition, limited to five pages; and

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FURTHER ORDERED that Patent Owner is authorized to file, by September 30, 2014, an opposition to Petitioner's motion to correct, limited to five pages.

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