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Entered: January 15, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

2WIRE, INC.,
Petitioner,

v.

TQ DELTA LLC,
Patent Owner.

Case IPR2015–00239 (Patent 7,471,721)
Case IPR2015–00240 (Patent 8,090,008)
Case IPR2015–00241 (Patent 8,073,041)
Case IPR2015–00242 (Patent 8,218,610)
Case IPR2015–00243 (Patent 8,355,427)
Case IPR2015–00247 (Patent 7,292,627)

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and TREVOR M. JEFFERSON, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION
Motion to Correct Filing Date
37 C.F.R. § 42.5

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BACKGROUND

On December 5, 2014, we authorized Petitioner to file in each of the instant proceedings a motion to correct the filing date accorded to the Petition (Paper 2) from November 6, 2014 to November 7, 2014. *See* Paper 6.¹ On December 12, 2014, Petitioner filed a motion to correct the filing date. Paper 8 (“Mot.”). On December 19, 2014, Patent Owner filed an opposition. Paper 9 (“Opp.”).

In its Motion, Petitioner states that it uploaded the Petition and accompanying exhibits to the Patent Review Processing System (PRPS) on November 6, 2014. Mot. 1–2. Petitioner further states that it served Patent Owner by USPS Express Mail and submitted the fee for the Petition on November 6, 2014. *Id.* at 2. According to Petitioner, the “Submit” button was not pressed until November 7, 2014 “due to either a technical issue (i.e., browser incompatibility) or inadvertent clerical error.” *Id.* at 1. Petitioner provides the declarations of lead counsel Mr. John D. Zele and backup counsel Mr. Adam Brooke to substantiate these statements. *See* Exs. 1023, 1024. Petitioner, accordingly, contends that it would be “unjust to bar review because of this single technicality.” *Id.* at 4.

DISCUSSION

Petitioner has the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). The petition is a request to institute an *inter partes* review. 37 C.F.R. § 42.104. The purpose of a petition is to give adequate notice to a patent owner of the basis for relief by laying out the grounds of unpatentability

¹ The papers filed in the above-identified cases are substantially similar. For convenience, we refer to those filed in IPR2015-00241.

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proposed by a petitioner, as well as any supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762 (Aug. 14, 2012). A petition for *inter partes* review will not be accorded a filing date until the petition satisfies the following requirements: (1) the petition complies with 37 C.F.R. § 42.104; (2) the petitioner effects service of the petition on the correspondence address of record as provided in 37 C.F.R. § 42.105(a); and (3) the petition is accompanied by the fee to institute required by 37 C.F.R. § 42.15(a). 37 C.F.R. § 42.106(a); *see also* 35 U.S.C. § 312(a) (specifying requirements for a petition to be considered).

The manner of filing a petition is governed, in part, by 37 C.F.R. § 42.6(b)(1), which states that “[u]nless otherwise authorized, submissions are to be made to the Board electronically via the Internet according to the parameters established by the Board and published on the [website] of the Office.” 37 C.F.R. § 42.6(b)(1). The Board’s website states the following:

A8. How can I check whether I filed a document properly?

After you upload a document in the proper format (i.e., PDF or MPEG for exhibits and PDF for all other documents) and click “Submit,” you will receive an acknowledgement on the screen in PRPS and filing receipt via email if the document is filed properly. If you do not receive an acknowledgement on the screen or a filing receipt via email, the document most likely has not been uploaded properly and you should contact the Board at (571) 272-7822. You may also check whether the document is listed in the file contents of the proceeding.

<http://www.uspto.gov/ip/boards/bpai/prps.jsp#heading-5> (emphasis added). These instructions provide that in order to electronically file a petition with the Board, a petitioner must click “Submit” after uploading the documents. Only then will the

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petitioner receive a petition filing receipt indicating that the petition was filed properly.

On the record before us, Petitioner has satisfied all the statutory and regulatory requirements for filing the Petition on November 6, 2014, but for clicking the “Submit” button. *See* Mot. 1–2. Petitioner (1) uploaded all of the documents to the PRPS on November 6, 2014 (Ex. 1024 ¶ 3), (2) paid the requisite Petition fees and received a receipt of payment (Ex. 1026; Ex. 1024 ¶ 4), and (3) served Patent Owner with all of the documents (Ex. 1025, Ex. 1024 ¶ 2).

Mr. Brooke attests to not recalling “whether there were further prompts on the [PRPS] screen indicating additional actions to be taken, or whether there were no further prompts.” Ex. 1024 ¶ 5. Upon learning that the Petition may not have been correctly filed, Mr. Brooke promptly took action to ensure the proper filing of the petitions. Ex. 1024 ¶¶ 7–8. After speaking with Board technical personnel, Mr. Brooke then subsequently clicked on the “Submit” button on November 7, 2014. *Id.* ¶¶ 9–10.

We have reviewed PRPS electronic records, which confirm that all documents were uploaded on November 6, 2014, and that the “Submit” button was clicked on November 7, 2014. Based on the evidence before us, we determine that Petitioner’s failure to click on the “Submit” button is a clerical error and that it would be appropriate under the circumstances to correct the filing date according to the Petition to November 6, 2014. *See generally Conmed Corp. et al. v. Bonutti Skeletal Innovations LLC*, IPR2013–00624, slip op. at 5 (PTAB Feb. 21, 2014) (Paper 18) (“*Conmed*”) (holding that the petitioner’s inadvertent delay in clicking

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on the “Submit” button was a clerical error); *see also SCHOTT Gemtron Corp. v. SSW Holding Corp.*, IPR2014-00367, slip op. at 2–3 (PTAB Sept. 22, 2014) (Paper 30) (granting motion to correct filing date); *ABB Inc. v. Roy-G-Biv Corp.*, IPR2013-00063, slip op. at 6–9 (PTAB Jan. 16, 2013) (Paper 21) (holding that error in failing to upload the correct documents qualified as a clerical error under 37 C.F.R. § 42.104(c)).

Patent Owner does not dispute the facts before us. Rather, Patent Owner argues that (1) granting the motion would erase the Board’s rules for filing petitions; (2) Petitioner’s request is tantamount to a one day extension of the filing deadline under 35 U.S.C. § 315(b); (3) the Board has held that the requirements for filing an IPR are strictly applied (*see Zoll Lifecor Corp. v. Phillips Elect.*, IPR2013-00607 (PTAB March 20, 2014) (Paper 13) (“Zoll”)); (4) there are no extenuating circumstances dictating that the Board use its discretion in granting Petitioner’s motion; (5) the fact that the Petition was served on Patent Owner on November 6, 2014 is irrelevant; (6) Patent Owner is prejudiced because the Petition is time-barred if Petitioner’s motion is not granted; and (7) the *Conmed* decision relied on by Petitioner is not precedential. Opp. 1–5. We are not persuaded by these arguments.

First, we are not persuaded by Patent Owner’s argument that granting Petitioner’s motion would erase the Board’s rules for filing petitions. Opp. 2. Petitioner satisfied all of the statutory and regulatory requirements for filing a petition, but for the regulatory requirement of clicking the “Submit” button. The Board’s rules provide that “*unless otherwise authorized*, submissions are to be

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made” electronically according to the parameters published on the Board’s website. 37 C.F.R. § 42.6(b)(1) (emphasis added). Further, the Board may “determine a proper course of conduct in a proceeding for any situation not specifically covered by” the rules, and may waive requirements in the rules. 37 C.F.R. § 42.5; *see also* 37 C.F.R. § 42.104(c) (clerical or typographical mistakes “in the petition” may be corrected). As discussed above, we determine that the failure to click on the “Submit” button, while all other requirements have been satisfied, is a clerical error. Accordingly, we do not agree with Patent Owner that granting Petitioner’s motion would erase the Board’s rules for filing petitions.

Second, we do not agree with Patent Owner that Petitioner’s request is tantamount to a request for a one-day extension of the statutory filing deadline. Opp. 2–3. As discussed above, we determine that Petitioner satisfied all of the statutory and regulatory requirements for filing a petition, but for the regulatory requirement of clicking the “Submit” button.

Regarding the third and seventh arguments, we are not persuaded by Patent Owner’s assertions regarding previous holdings by the Board. Opp. 3–5.

Although we agree with Patent Owner that neither *Zoll* nor *Conmed* are precedential and neither is controlling, both cases can be examined for guidance and useful insight. In *Zoll*, the Board held that the petition was incomplete for failing to identify the real party-in-interest under 35 U.S.C. § 312(a) and even curing this statutory deficiency would not render the petition timely. *Zoll* at 12. We are not persuaded by Patent Owner that the facts and holding in *Zoll* provide us with useful guidance in determining whether Petitioner’s motion should be granted

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because the facts presented in *Zoll* are substantially different from those here. In *Conmed*, Petitioner had failed to click on the “Submit” button and the Board held that the failure to click on the “Submit” button was a clerical error. *Conmed* at 6–7. These facts are similar to those here and, therefore, *Conmed* provides useful insight in our determination of granting Petitioner’s motion.

Fourth, we are also not persuaded by Patent Owner that there are not any extenuating circumstances for the Board to grant Petitioner’s motion. Opp. 4. Petitioner argues that the Petition was filed but for selecting the “Submit” button. Mot. 2–3. As discussed above, we agree with Petitioner that this is an appropriate circumstance for us to use our discretion. Patent Owner does not provide any further evidence or rationale to illustrate Petitioner’s circumstance as inappropriate, beyond restating that Petitioner’s filing date was November 7, 2014.

Fifth, we are not persuaded that the fact that Patent Owner was served on November 6, 2014, is irrelevant, as argued by Patent Owner. Opp. 4–5. This evidence was presented by Petitioner in order to demonstrate that Petitioner satisfied all the statutory and regulatory requirements for filing the petition on November 6, 2014, but for clicking the “Submit” button. Although not dispositive, we find this evidence useful in determining to grant Petitioner’s motion.

Sixth, we are not persuaded by Patent Owner that Patent Owner is unduly prejudiced by granting Petitioner’s motion. Opp. 5. Again, Petitioner satisfied all of the statutory and regulatory requirements for filing a petition, but for the regulatory requirement of clicking the “Submit” button. Patent Owner received the

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Petition and accompanying exhibits, filed its mandatory notice information (Paper 4), and is able to file a Preliminary Response to the Petition.

Accordingly, we grant Petitioner’s motion to correct the filing date based on Petitioner’s clerical error of failing to click on the “Submit” button.

ORDER

It is, therefore,

ORDERED that Petitioner’s motion to correct the filing date accorded to the petition in each of the instant proceedings is GRANTED; and

ORDERED that the petition in each of the instant proceedings is accorded a filing date of November 6, 2014.

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