

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CONMED CORPORATION and LINVATEC CORPORATION  
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS LLC  
Patent Owner

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Case IPR2013-00624  
Patent 6,500,195 B2

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Before MICHAEL R. ZECHER, BENJAMIN D. M. WOOD, and  
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION  
Patent Owner's Request for Rehearing  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

Bonutti Skeletal Innovations LLC (“Patent Owner”) requests rehearing (Paper 19, “Reh’g Req.”) of the Board’s decision to grant ConMed Corporation and Linvatec Corporation’s (collectively “Petitioner”) renewed motion to correct the filing date accorded to the petition (“Pet.”). Paper 18, “Dec.” In that decision, the Board determined that Petitioner satisfied the statutory and regulatory requirements for filing a complete petition on September 25, 2013, but for clicking the “Submit” button in the Patent Review Processing System (“PRPS”). Dec. 7. However, based on the specific circumstances of this case, the Board concluded that Petitioner’s inadvertent delay in clicking the “Submit” button until October 2, 2013, was a clerical error. *Id.* As a result, the Board accorded the petition a filing date of September 25, 2013. *Id.* at 8.

In its request for rehearing, Patent Owner presents the following arguments: (1) Petitioner’s renewed motion and supporting evidence do not demonstrate that Petitioner made a clerical error under 37 C.F.R. § 42.104(c); (2) the Board abused its discretion by substituting its own facts for Petitioner’s testimony in finding a clerical error; (3) failing to “Submit” a petition is not a clerical error that is correctable under 37 C.F.R. § 42.104(c); and (4) the statutory requirements for filing a petition under 35 U.S.C. §§ 312(a) and 315(b) cannot be waived. Reh’g Req. 2-12. For the reasons set forth below, Patent Owner’s request for rehearing is granted to the extent we modify our prior decision by exercising our discretion under 37 C.F.R. § 42.5(b) to waive a parameter for electronic filing, but is DENIED in all other respects.

## II. ANALYSIS

When rehearing an interlocutory decision, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). A party requesting rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). Given the similarities that exist between the issues that Patent Owner raises in its request for rehearing, we group the issues into two subsets and address them in turn.

With respect to the first and second issues set forth above, Patent Owner indicates that Petitioner's motion and supporting declaration of Ms. Melanie Hayes (Ex. 1016) fail to establish that a clerical error was made when filing the petition and, therefore, Petitioner is not entitled to relief under 37 C.F.R. § 42.104(c). Reh'g Req. 2. We carefully considered Ms. Hayes's testimony and accorded it little weight as it relates to her recollection of events on September 25, 2013, and October 2, 2013. First, as Petitioner and Ms. Hayes both have acknowledged, Ms. Hayes's previous recollection of her interaction with PRPS on October 2, 2013, (Ex. 1010) was incorrect. *See* Paper 14, 3; Dec. 8. Second, her recollection of clicking the "Submit" button in PRPS on September 25, 2013, (Ex. 1016 ¶ 5) is

inconsistent with other evidence of record. Contrary to Ms. Hayes's testimony, Petitioner received a petition filing receipt from PRPS on October 2, 2013, (Ex. 1021) indicating that Petitioner clicked the "Submit" button on that date. *See* Dec. 5-7. Given the inconsistencies or errors in the first and second declarations of Ms. Hayes, we gave little weight to her testimony when determining the nature of the actions that Petitioner took in connection with the petition on September 25, 2013, and October 2, 2013.

After balancing Ms. Hayes's testimony against the petition filing receipt dated October 2, 2013, we maintain that the weight of evidence supports our finding that Petitioner clicked the "Submit" button in PRPS on October 2, 2013.<sup>1</sup> Patent Owner does not persuade us that the testimony of Ms. Hayes outweighs the documentary evidence indicating that Petitioner clicked the "Submit" button on that date.

To the extent that Patent Owner argues that Petitioner is not entitled to relief under 37 C.F.R. § 42.104(c) because it did not admit to making a clerical error, we disagree. As the Board has stated, this rule "is remedial in nature and is therefore entitled to a liberal interpretation." *ABB, Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21 at 7 (Jan. 16, 2013). When, as here, the record supports a finding that a clerical error occurred, the Board may grant appropriate relief under 37 C.F.R. § 42.104(c) whether the party making the error admits to it or not. As explained below, we also grant relief under 37 C.F.R. § 42.5(b) by exercising our discretion, based on the

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<sup>1</sup> It should be beyond dispute that Petitioner's delay in clicking the "Submit" button was inadvertent, as there is ample evidence in the record to demonstrate that Petitioner intended to complete the electronic filing process on September 25, 2013, and that it believed it had done so successfully.

specific circumstances of this case, to waive the regulatory requirement that electronic filing is completed only upon clicking the “Submit” button in PRPS.

With respect to the third and fourth issues set forth above, we maintain our initial position that the petition satisfied the requirements for a complete petition under 35 U.S.C. § 312(a) on September 25, 2013. As we indicated in our decision (Dec. 6-7), PRPS indicates that the petition was uploaded on September 25, 2013. PRPS Case Viewer (IPR2013-00624); *see, e.g.*, Ex. 1018. The petition identifies the following: (1) all real parties in interest (Pet. 4); (2) each claim challenged (*id.* at 3-5); (3) the grounds on which the challenge to each claim is based (*id.* at 15-28); and (4) the evidence that supports those challenges—namely Exhibits 1001-1009 (Paper 2). PRPS received payment from Petitioner on September 25, 2013, (Ex. 1017) which is confirmed by Petitioner’s American Express Statement (Ex. 1019). Finally, there is no dispute that Petitioner served Patent Owner with copies of the petition and exhibits on September 25, 2013, by “EXPRESS MAIL.” Pet. (last page).

Notably, Patent Owner contends that a petition is not filed electronically, as required under 37 C.F.R. § 42.6(b)(1), unless the “Submit” button in PRPS is clicked. Reh’g Req. 6-7. We agree with Patent Owner in that regard; however, we may exercise our discretion to waive or suspend a requirement set forth in parts 1, 41, and 42 of the Code of Federal Regulations under 37 C.F.R. § 42.5(b). Based on the specific circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.5(b) to waive or suspend a parameter for electronic filing established by the Board and published on the website of the Office. Namely, we waive the parameter

that indicates a petitioner must click the “Submit” button in PRPS to file documents properly. *See* Dec. 5-7. As a consequence, and because the petition satisfied the requirements for a complete petition under 35 U.S.C. § 312(a) on September 25, 2013, we consider the petition to have been filed effectively as of that date.

### III. CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion when concluding that the petition should be accorded a filing date of September 25, 2013. Nonetheless, we clarify that our basis for doing so rests, at least in part, upon exercising our discretion under 37 C.F.R. § 42.5(b) to waive or suspend a parameter for electronic filing under 37 C.F.R. § 42.6(b)(1). Accordingly, Patent Owner’s request for rehearing is granted to the extent we modify our prior decision to invoke 37 C.F.R. § 42.5(b), but is DENIED in all other respects.

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For PETITIONER:

Matthew J. Moore  
Michael B. Eisenberg  
Latham & Watkins LLP  
[matthew.moore@lw.com](mailto:matthew.moore@lw.com)  
[michael.eisenberg@lw.com](mailto:michael.eisenberg@lw.com)

For PATENT OWNER:

Cary Kappel  
William Gehris  
Davidson, Davidson, & Kappel, LLC  
[ckappel@ddkpatent.com](mailto:ckappel@ddkpatent.com)  
[wgehris@ddkpatent.com](mailto:wgehris@ddkpatent.com)