

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDEX CORPORATION,
Petitioner,

v.

IPVENTURE, INC.,
Patent Owner.

Case IPR2014-00833
Patent 8,725,165 B2

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and
J. JOHN LEE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION
Motion to Correct a Clerical Mistake in the Petition
37 C.F.R. § 42.104(c)

Petitioner, FedEx Corporation (“FedEx”), filed a Petition requesting an *inter partes* review of claims 1–30 of U.S. Patent No. 8,725,165 B2 on May 30, 2014. Paper 2 (“Pet.”). The Petition refers to Exhibit 1007 as U.S. Patent Application Publication No. 2002/0000916 A1 (“Richards Application”). Pet. 3. However, Exhibit 1007 as filed is a copy of the corresponding issued patent, U.S. Patent No. 6,492,904 B2 (“Richards Patent”), not the cited Richards Application. Ex. 1007. A conference call was held on October 17, 2014, at approximately 4:00 PM between:

1. Jeffrey Berkowitz and Michael V. Young, Sr., counsel for FedEx;
2. C. Douglass Thomas, counsel for Patent Owner, IpVenture, Inc. (“IpVenture”); and
3. Judges Kristen L. Droesch, Michael R. Zecher, and J. John Lee.

On the call, FedEx requested authorization to file a motion to file a corrected version of Exhibit 1007. IpVenture indicated it would not oppose the motion. Consequently, we authorized FedEx to file a Motion to Correct a Clerical Mistake in the Petition under 37 C.F.R. § 42.104(c) for the sole purpose of substituting a corrected Exhibit 1007. On October 20, 2014, FedEx filed such a motion styled as a “Stipulated Motion to File Replacement Exhibit 1007.” Paper 9 (“Motion”).

FedEx has the burden to establish it is entitled to the relief requested. 37 C.F.R. § 42.20(c). In doing so, FedEx is required to set forth a “full statement of the reasons for the relief requested,” including a detailed explanation of the significance of the material facts and evidence. 37 C.F.R. § 42.22(a)(2). Under 37 C.F.R. § 42.104(c), a petitioner may move to correct “a clerical or typographical mistake in the petition.” For the reasons discussed below, we deny FedEx’s Motion without prejudice.

Here, the only basis alleged to support the Motion is the conclusory statement that “[a] clerical error, however, lead [sic] to the filing of [the Richards Patent].” Paper 9. The Motion does not explain what the alleged clerical error was or the circumstances of the error. Nor does the Motion address whether the requested relief would have “any substantial substantive effect, including any effect on the patent owner’s ability to file a preliminary response.” *See* Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents; Final Rule, 77 Fed. Reg. 48,680, 48,699 (Aug. 14, 2012) (response to comment 34). While the statement of the reasons for the relief requested need not be extensive or exquisitely detailed, more is required than a conclusory statement that merely asserts the pertinent rule’s requirements are met.

However, we recognize that IpVenture has indicated it would not oppose the relief sought by FedEx, and that the relief requested may produce a clearer record. Accordingly, we authorize FedEx to file a second Motion to Correct a Clerical Mistake in the Petition under 37 C.F.R. § 42.104(c) to afford FedEx the opportunity to address sufficiently the facts and circumstances of the alleged clerical error and any substantial substantive effects of the requested relief.

ORDER

It is

ORDERED that FedEx’s Stipulated Motion to File Replacement Exhibit 1007 is DENIED without prejudice; and

FURTHER ORDERED that FedEx shall have until October 30, 2014, to file a second Motion to Correct a Clerical Mistake in the Petition under 37

C.F.R. § 42.104(c). Such motion shall include a full statement of the reasons for the relief requested as required under 37 C.F.R. § 42.22(a)(2), and may include one or more declarations in support of the motion.

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