UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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RIVERBED TECHNOLOGY, INC.,
Petitioner,

v.

SILVER PEAK SYSTEMS, INC.,
Patent Owner.
_____

Case IPR2014-00245
Patent 8,392,684 B2

Before DENISE M. POTHIER, JUSTIN T. ARBES, and HYUN J. JUNG,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

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

A conference call in the above proceeding was held on December 8, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Pothier, Arbes, and Jung. The call was scheduled by the Board to address a request for certificate of correction of the challenged patent, U.S. Patent No. 8,392,684 B2 ("the '684 patent"), filed by Patent Owner.

During a previous conference call on November 17, 2014, Patent Owner argued that there was a "printing error" in claim 14 of the '684 patent where the claim, as issued, depends from claim 9, but should depend from claim 8. Paper 25 at 2–3. Patent Owner stated that it attempted to correct the dependency error in proposed substitute claim 38 in its Motion to Amend. *See* Paper 16 at 5. Proposed substitute claim 38 is a substitute for claim 14 and depends from claim 32 (the proposed substitute for claim 8), not claim 33 (the proposed substitute for claim 9). *Id*. Petitioner argued in its Opposition that proposed substitute claim 38 is improper under 37 C.F.R. § 42.121(a)(2)(ii) because it does not include all of the limitations of corresponding claim 14. *See* Paper 23 at 4. We authorized the parties to file supplemental briefing on the alleged "printing error" and the propriety of proposed substitute claim 38, and the parties did so. *See* Paper 25 at 3–4; Papers 29, 30.

Subsequently, on November 18, 2014, Patent Owner filed a request for certificate of correction (Ex. 3001) in the underlying application file for the '684 patent, U.S. Patent Application No. 11/497,026. *See* 35 U.S.C. § 254; 37 C.F.R. § 1.322; MPEP §§ 1480, 1485. The request states that "[i]ssued claim 16 should depend from issued claim 8." The alleged "printing error" is in issued claim 14, however, not claim 16. Patent Owner then filed a second request for certificate of correction (Ex. 3002) on

December 5, 2014, stating that "[i]ssued claim 14 should depend from issued claim 8."

During the conference call on December 8, 2014, we questioned Patent Owner regarding an apparent inconsistency in the relief it seeks. Specifically, Patent Owner seeks the cancellation of claim 14 in its Motion to Amend, but also seeks to modify claim 14 in its request for certificate of correction. *See* Paper 16 at 1 ("Patent Owner moves to cancel claims 1–24"); Ex. 3002. Patent Owner argued that because claim 14 is still in effect unless and until the Motion to Amend is granted as part of a final written decision in this proceeding, Patent Owner should be permitted to correct the alleged "printing error" in original claim 14 now so that the dependency in proposed substitute claim 38 likewise would be correct. Petitioner did not oppose Patent Owner's position, arguing only that Patent Owner bears the burden of proof with respect to all proposed substitute claims in the Motion to Amend as written.

We also explained that, pursuant to 37 C.F.R. § 1.322(a)(3), if a request for certificate of correction "relates to a patent involved in . . . [a] trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under . . . § 42.20 of this title." Patent Owner's request for certificate of correction was not accompanied by a motion. Patent Owner argued during the conference call that its supplemental brief could be treated as a motion or, alternatively, that it could move orally during the call. Petitioner stated that it would not oppose a motion for authorization to file the request for certificate of correction, and acknowledged that it does not have any

evidence refuting Patent Owner's substantive allegation that original claim 14 contains a "printing error."

We have reviewed the parties' supplemental briefs, including Patent Owner's explanation as to why, based on the file history of the '684 patent, original claim 14 should depend from claim 8 rather than claim 9. *See* Paper 29 at 2–3. Under the particular factual circumstances of this proceeding, we are persuaded that Patent Owner's explanation is sufficient to justify the filing of its request for certificate of correction. Accordingly, we treat Patent Owner's supplemental brief as a motion, and grant the motion *nunc pro tunc*. We will address proposed substitute claim 38, as well as the other aspects of the parties' supplemental briefs addressing proposed substitute claim 38, in the final written decision.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's supplemental brief (Paper 29) is treated as a motion for authorization to file a request for certificate of correction under 37 C.F.R. §§ 1.322(a)(3) and 42.20, and granted *nunc pro tunc* with respect to the request for certificate of correction filed on December 5, 2014 (Ex. 3002);

FURTHER ORDERED that a copy of this Order be included in the file of U.S. Patent Application No. 11/497,026; and

FURTHER ORDERED that when a decision is rendered on Patent Owner's request for certificate of correction, Patent Owner shall file a copy of the document as an exhibit in this proceeding.

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