Filed: April 13, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTIF FOODWORKS, INC.,
Petitioner,

v.

IMPOSSIBLE FOODS, INC.,
Patent Owner.

Case IPR2023-00209
Patent No. 10,039,306

PATENT OWNER IMPOSSIBLE FOODS'
MOTION PURSUANT TO 37 C.F.R. §1.323

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I. INTRODUCTION

Impossible Foods seeks to correct an omission in its priority claims. The Board authorized briefing from both parties "on the issues of the proper handling of Patent Owner's request for leave to file a petition for a certificate of correction [under 37 C.F.R. §1.323] and the effect of any such certificate should it be issued during the pendency of any trial that might be instituted in these proceedings." EX2014.

II. BACKGROUND

Petitioner Motif FoodWorks, Inc., filed petitions challenging claims of four Impossible-owned patents—U.S. Patent 9,943,096 (the "'096 patent"), U.S. Patent 11,224,241 (the "'241 patent"), U.S. Patent 11,013,250 (the "'250 patent") and U.S. Patent 10,039,306 (the "'306 patent)—in IPR2023-00206, IPR2023-00207, IPR2023-00208, and IPR2023-00209, respectively. Each of the challenged patents claims benefit of U.S. Application 13/941,211 (the "'211 application"), filed July 12, 2013. *See generally* EX1001, (63). The '211 application itself claims priority to U.S. Provisional Application 61/671,069 (the "'069 provisional," EX2012), filed July 12, 2012. The '211 application also claims priority as a continuation-in-part to International Application PCT/US2012/046560 ("Brown," EX1012), filed July 12, 2012, which claims priority to U.S. Provisional Application 61/572,205 (the "'205 provisional"), filed July 12, 2011. *See, e.g.*, IPR2023-00206, Paper 8 at 10.

Priority to the ’069 provisional, Brown, and the ’205 provisional was unintentionally omitted from the priority chain of the families stemming from the ’211 application, including each of the challenged patents as well as patents and pending applications in the family chain. Concurrent with the filing of its preliminary responses, Impossible took measures to correct this unintentional omission through the filing of a petition and certification of correction with the Office for those patents within the affected families that are currently not subject to an *inter partes* review proceeding—specifically, U.S. Patent 9,700,067 (the “’067 patent”), which is a parent to the ’096 and ’241 patents, and U.S. Patent 10,172,381 (the “’381 patent”), which is a child to the ’306 patent and parent to the ’250 patent. *See* EX2001.

For these patents, Impossible submitted a request for a certificate of correction to the Office to correct the priority chain recited on the patents’ title page and specification to make specific reference to the ’069 provisional, Brown, and the ’205 provisional. *Id.* Impossible also submitted a petition to accept the unintentionally delayed claims for benefit of the prior-filed applications under 37 C.F.R. §§1.78(c) and 1.78(e), as well as a petition for expedited review under §1.182. *Id.* Impossible has also filed requests for a certificate of correction and petitions to accept the unintentionally delayed claims for priority in each of the children claiming priority through the chain, including U.S. Application

15/624,505, U.S. Application 15/624,513, U.S. Application 15/839,994, U.S. Application 15/912,763, U.S. Application 15/913,018, U.S. Application 16/238,769, U.S. Application 15/624,50517/081,922, U.S. Application 17/081,908, U.S. Application 17/081,938, and U.S. Application 17/531,442. Impossible now seeks to submit identical requests for a certificate of correction and petitions to accept the unintentionally delayed claims for priority in each of the challenged patents currently subject to an IPR.

III. SUFFICIENT BASIS EXISTS FOR PERMITTING IMPOSSIBLE TO FILE REQUESTS WITH THE OFFICE

The Board's email first requests briefing on "the proper handling of Patent Owner's request for leave to file a petition for a certificate of correction." EX2014. Impossible respectfully submits that, under the applicable regulations and Federal Circuit case law, there is no reasonable basis for precluding the relief Impossible seeks. The proper handling by the Board of Impossible's request is to permit Impossible to file a petition to correct the priority claims of the challenged patents with the Office.

First, while the Board authorized Impossible to file the present motion pursuant to 37 C.F.R. §1.323 to brief the requested issues, the requirements of §1.323 do not apply at this stage of the proceeding. Specifically, §1.323 states:

> The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in §1.20(a). ***If***

> ***the request relates to a patent involved in an interference or 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 35 U.S.C. §41.121(a)(2), §41.121(a)(3) or §42.20.

37 C.F.R. §1.323 (emphasis added); *see also* M.P.E.P. § 1485 ("If the patent is involved in an interference or a trial before the Patent Trial and Appeal Board, a certificate of correction . . . will not be issued unless a corresponding motion . . . has been granted by the administrative patent judge.").

The challenged patents at issue in these IPR proceedings currently are at a preliminary stage and thus are not involved in a "trial" before the Board. *See* 37 C.F.R. §42.2 (defining "trial" as "a contested case instituted by the Board based upon a petition. A trial begins with a written decision notifying the petitioner and patent owner of the institution of the trial."). Accordingly, any certificate of correction that Impossible would seek with respect to the challenged patents would not need to be accompanied by a motion granted under §42.20, and thus, the Board need not cede exclusive jurisdiction to the Office in order to decide Impossible's request for correction. *See ipDataTel, LLC v. ICN Acquisition, LLC*, IPR2018-01822, Paper 19 at 15 (Apr. 22, 2019) (finding patent owner's filing a request for a certificate of correction without a granted §42.20 motion proper under §1.323 because the request was filed before a decision on institution); *Simpson Strong-Tie Co. Inc. v. Columbia Insurance co.*, PGR2021-00109, Paper 6 at 2 (Dec. 2, 2021) ("Because trial in this proceeding has not been instituted, Patent Owner is not

required to file a motion with the Board prior to requesting its certificate of correction."). Nevertheless, while it is Impossible's position that exclusive jurisdiction has not yet passed to the Board under §1.323, in an abundance of caution, Impossible notified the Board and Petitioner prior to taking any action in filing requests for correction in the challenged patents, requests that would be substantially identical to those already filed for affected family members that are not subject to an IPR. *See* EX2014.

Impossible, however, recognizes that the Board may, in its discretion, exercise exclusive jurisdiction over the challenged patents at this stage of the proceeding, but it is not obligated to do so. *See* 37 C.F.R. §42.3; *ipDataTel*, Paper 19 at 15-16 ("We recognize our Rules allow us to assert exclusive jurisdiction over a patent during the pre-institution phase of an *inter partes* review proceeding . . . . Nothing in our Rules, however, obligates us to do so."). To the extent Petitioner requests that the Board exercise exclusive jurisdiction to prevent the relief Impossible seeks, it is not necessary because sufficient basis exists for Impossible's filing of requests for correction with respect to the challenged patents.

As the Federal Circuit has explained, it is "the Director—not the Board—[who] will evaluate the merits of the patentee's petition, including whether the mistake is of 'minor character' or 'occurred in good faith.'" *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019) (citing 35 U.S.C. §255); *see*

also Edwards Lifesciences Corp. v. Evalve, Inc., IPR2019-01285, Paper 19 at 7-8 (Jan. 9, 2020). Thus, in cases where a patent owner seeks leave to file a motion under 37 C.F.R. §42.20 to satisfy the requirements of §1.323, the Board need only "determine whether there is *sufficient basis* supporting Patent Owner's position that the mistake *may* be correctable" to grant such a motion. *Honeywell*, 939 F.3d at 1349 (original emphasis); *see also id.* at 1350 (holding Board had abused its discretion in denying leave to file a motion by requiring patent owner to "show that the requirements of [§]255 have been met" (alteration omitted)).

Impossible submits that this standard is met here. Impossible intends to submit a request for a certificate of correction correcting the title page and specification of each of the challenged patents in the same manner as that shown in the already-filed requests for correction. *See* EX2001. Accompanying the request will also be a petition to accept the unintentionally delayed benefit claims, which will be identical to those already filed in the related patents and applications. As with those petitions, applicant will represent that the omission of the priority claims to the '069 provisional, Brown, and the '205 provisional initially occurred in the filing of the '067 patent and the '306 patent and was inadvertently carried through later-filed applications, including the '096, '241, and '250 patents, and that applicant first became aware of the omissions upon review of these IPR petitions. *Id.*

Further, as noted in the already-filed petitions, the correction sought would not change the statutory framework under which the challenged patents were examined, and thus further examination would not be required, making correction appropriate. *See* M.P.E.P. 1481.03 (stating petitions under 37 C.F.R. §1.78 with a certificate of correction may be appropriate when "[a]dding or correcting a claim to a prior application having a filing date before March 16, 2013 to a patent that was examined . . . under the first to invent provisions of pre-AIA law"); EX1002, 1266 (noting examination of the '096 patent under pre-AIA framework); EX1148, 3281 (noting same for the '306 patent); EX1149, 768 (noting same for the '250 patent); EX1150, 1141 (noting same for the '241 patent).

Thus, as demonstrated by the requests and petitions already filed for the patents and applications within the same family as the challenged patents, there is a sufficient basis supporting Impossible's position that the priority claim may be correctable. Moreover, permitting Impossible to seek correction for the challenged patents would ensure consistency with the correction of the uninvolved patents and applications. Accordingly, there is no reasonable basis for the Board to preclude Impossible from seeking the identified corrections with the Director.

IV. THE NET IMPACT ON THE PROCEEDINGS IS MINIMAL

The Board's email also requested briefing on "the effect of any such certificate should it be issued during the pendency of any trial that might be

instituted in these proceedings." EX2014. Impossible submits that, should its requests be granted during the pendency of any trial that might be instituted, the net impact on the proceedings would be minimal.

Impossible seeks to correct the priority claims of all four challenged patents to make specific reference to the '069 provisional, Brown, and the '205 provisional. For two of the patents, the '250 and '306 patents, it is not believed that the granting of a petition and certificate will affect any of the issues raised in the proceedings. Neither of the petitions in these proceedings relies on Brown as part of an asserted ground. *See* IPR2023-00208 Pet., 10; IPR2023-00209 Pet., 12. Further, the references that are asserted as part of a ground all predate the earliest priority date, July 12, 2011, that Impossible seeks to correct. *See* EX1013 (Conrad) (1989 publication); EX1017 (Mottram) (1998 publication); EX1014 (Crane) (May 2011 filing); EX1019 (Proulx) (2006 publication); EX1125 (Rovaart) (1975 publication); EX1016 (Boye) (2010 publication); EX1140 (Cho) (2008 publication). Thus, none of the grounds asserted in the petitions challenging the '250 and '306 patents will be affected.

For the remaining two patents, the '096 and '241 patents, the petitions apply Brown in some, but not all, of the grounds raised. In particular, for the '096 patent, the petition applies Brown in three of the ten grounds raised. *See* IPR2023-00206 Pet., 13-14 (applying Brown under 35 U.S.C. §102 for Ground 1 and applying

Giacino and MacLeod in combination with Brown under §103 for Grounds 2A and 2B). For the '241 patent, the petition applies Brown in three of the eleven grounds raised. *See* IPR2023-00207 Pet., 22 (applying Brown under §103 for Grounds 1A-1C in combination with Giacino, Ronai, and Rolan). Granting of a petition and request for a certificate of correction would disqualify Brown as prior art and thus provide a basis for rejecting these grounds, in addition to the merit-based arguments already outlined by Impossible in its preliminary responses. *See, e.g.*, *Edwards*, IPR2019-01285, Paper 19 at 5-8 (denying institution in view of granted certificate of correction to correct filing date of priority document); *Parsons Xtreme Golf v. Taylor Made Golf Co.*, IPR2018-00657, Paper 14 at 11 (Aug. 14, 2018) (rejecting ground based on corrected priority claim disqualifying asserted reference as prior art).

The remaining grounds raised in the petition apply references that predate the earliest priority date that Impossible seeks to correct, and thus would not be affected by the corrected priority claim. *See* EX1015 (Giacino) (1970 publication); EX1013 (Conrad) (1989 publication); EX1014 (Crane) (May 2011 filing); EX1019 (Proulx) (2006 publication); EX1020 (Perret) (1968 publication); EX1024 (MacLeod) (1981 publication); EX1125 (Rovaart) (1975 publication); EX1132 (Ronai) (1979 publication); EX1021 (Rolan) (2008 publication). Moreover, Impossible notes that the grounds relying on Brown are cumulative to the other

grounds raised in the petitions—that is, the claims challenged by a ground that applies Brown (specifically, claims 1-12 and 14-24 of the ’096 patent and claims 1-23 of the ’241 patent) are also challenged by a ground that does not apply Brown. *See* IPR2023-00206 Pet., 13-14; IPR2023-00207 Pet., 22. Thus, the set of claims challenged by the petitions in IPR2023-00206 and IPR2023-00207 would also not be affected by the corrected priority claim.

Accordingly, given the above, Impossible submits that the net effect of a certificate correcting the priority claim of the challenged patents issued during the pendency of any trial that might be instituted would be minimal.

V. CONCLUSION

For the reasons above, Impossible respectfully requests that the Board permit Impossible to file a petition and a certification of correction to correct the priority claims for each of the above-identified patents currently subject to an IPR.

Respectfully submitted,

Date: April 13, 2023

/Michael T. Rosato/
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CERTIFICATE OF SERVICE

I certify that this paper and EX2014 were served on this 13th day of April, 2023, on the Petitioner at the following electronic service addresses:

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