Trials@uspto.gov
571-272-7822

Paper 15
Entered: May 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTIF FOODWORKS, INC.,
Petitioner,

v.

IMPOSSIBLE FOODS, INC.,
Patent Owner.

IPR2023-00206 (Patent 9,943,096 B2)
IPR2023-00207 (Patent 11,224,241 B2)
IPR2023-00208 (Patent 11,013,250 B2)
IPR2023-00209 (Patent 10,039,306 B2)[1]

Before DONNA M. PRAISS, CHRISTOPHER M. KAISER, and JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion for Leave to
Seek a Certificate of Correction
37 C.F.R. § 1.323, 42.20

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[1] This Order addresses issues that are the same in all identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

Pursuant to our authorization (Ex. 2014), Patent Owner filed a Motion Pursuant to 37 C.F.R. § 1.323 for leave to request a certificate of correction for the challenged patent in each of the above-identified proceedings. Paper 9 ("Motion" or "Mot.," collectively "Motions").[2] Petitioner filed an Opposition. Paper 11 ("Opp.," collectively "Oppositions"). For the reasons that follow, Patent Owner's Motions are granted.

Background

U.S. Patent No. 9,943,096 ("the '096 patent," Ex. 1001) claims priority to U.S. Application No. 13/941,211 filed on July 12, 2013 ("the '211 application"). Ex. 1161, code (21). Specifically, the '096 patent states:

> This application is a continuation of U.S. application Ser. No. 14/797,006 filed on Jul. 10, 2015 which is a continuation of and claims priority to PCT/US2014/011347 which claims priority to U.S. application Ser. No. 13/941,211, filed Jul. 12, 2013, U.S. Application Ser. No. 61/908,634, filed Nov. 25, 2013, and to U.S. Application Ser. No. 61/751,816, filed Jan. 11, 2013, and is related to the following patent applications: Application Serial No. PCT/US12/46560; Application Serial No PCT/US12/46552; Application Ser. No. 61/876,676, filed Sep. 11, 2013; and Application Ser. No. 61/751,818, filed Jan. 11, 2013, all of which are incorporated herein by reference.

Ex. 1001, 1:7–18;[3] *see id.* at codes (60), (63).

The '211 application, in turn, claims priority to U.S. Provisional Application 61/671,069 filed on July 12, 2012 (Ex. 2012 "the '069

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[2] For expediency, we refer to the '096 patent and Paper numbers filed in IPR2023-00206. Similar Papers were filed in IPR2023-00207, IPR2023-00208, and IPR2023-00209, and, unless otherwise specified, our reasoning applies to all of the patents challenged in those proceedings.

[3] As corrected by a Certificate of Correction dated May 29, 2018. Ex. 1165.

provisional"), International Application PCT/US2012/046560 (Ex. 1012 "Brown"), and U.S. Provisional Application 61/572,205 filed on July 12, 2011 ("the '205 provisional"). Ex. 1161, code (60), (63).

Patent Owner asserts "[p]riority to the '069 provisional, Brown, and the '205 provisional was unintentionally omitted from the priority chain of" the '096 patent and other patents in the family stemming from the '211 application. Mot. 2. Accordingly, Patent Owner seeks to file a certificate of correction adding language to the priority statement above to specify that the '211 application claims the benefit of the '069 application, Brown, and the '205 provisional. *See* Ex. 2001 (Patent Owner's Request for Certificate of Correction). Patent Owner contends that, even though 37 C.F.R. § 1.323 does not apply here because this *inter partes* review proceeding is in the pre-institution phase and, thus, not involved in a "trial" before the Board, the applicable standard has been met. *Id.* at 6 (quoting *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019); citing *Edwards Lifesciences Corp. v. Evalve, Inc.*, IPR2019-01285, Paper 19 at 7–8 (Jan. 9, 2020)).

Patent Owner asserts that "[g]ranting 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 IPR2023-00206 and IPR2023-00207]." Mot. 9 (citing *Edwards*, IPR2019-01285, Paper 19 at 5–8; *Parsons Xtreme Gold v. Taylor Made Golf Co.*, IPR2018-00657, Paper 14 at 11 (Aug. 14, 2018)). Accordingly, the correction sought could bear on whether art cited in the Petition (Ex. 1012 "Brown") is prior art to the '096 patent. Pet. 13–14; Mot. 9; Opp. 9.

Discussion

35 U.S.C. § 255 provides, in relevant part, that a certificate of correction may be issued by the Director "[w]henever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith." According to the Federal Circuit, "the Director—not the Board—will evaluate the merits of the patentee's petition, including whether the mistake is of 'minor character' or 'occurred in good faith.'" *Honeywell,* 939 F.3d at 1349 (citing 35 U.S.C. § 255). That statute gives this authority to the Director, and the Director has not delegated this authority to the Board. *Id.* As the parties acknowledge, the Board's role on Patent Owner's Motion under 37 C.F.R. § 1.323 is simply "to determine whether there is sufficient basis supporting Patent Owner's position that the mistake may be correctable." *Id.* (internal quotation marks and citation omitted); Mot. 6; Opp. 2.

Patent Owner relies on the '096 patent's previously claimed priority to the '211 application, and the '211 application's claimed priority to the '069 provisional, Brown, and the '205 provisional, to support its assertion that the omission of the '069 provisional, Brown, and the '205 provisional in the '096 patent's priority claim before now was "unintentional." Mot. 2. Patent Owner directs us to the petition and certificate of correction filed for child applications claiming priority through the same chain and asserts that it "seeks to submit identical requests for certificate of correction and petitions to accept the unintentionally delayed claims for priority in each of the challenged patents currently subject to an IPR." *Id.* at 2–3. Patent Owner's

Request for Certificate of Correction in one of the mentioned child applications states "it is clear from the record that the revised priority claims are appropriate." Ex. 2001, 3; Mot. 2. According to Patent Owner, the omission "initially occurred in the filing . . . and was inadvertently carried through later-filed applications." Mot. 6. Patent Owner asserts "applicant first became aware of the omissions upon review of these IPR petitions." *Id.*

Petitioner argues that Patent Owner's Motion does not provide a "sufficient basis . . . that the mistake may be correctable" because (1) the existing priority claim is defective, (2) Patent Owner's "mistake" was not made in "good faith," (3) the delay between now and the filing of the Petition was not adequately explained to support being "unintentional," and (4) the disclosure of the prior-filed application must provide adequate support for the claimed subject matter of the later-filed application in order to be entitled to the benefit of an earlier-filed application. Opp. 2–7. Petitioner also asserts that it will be prejudiced if we grant Patent Owner's Motion because "Petitioner could not have known PO would attempt to 'correct' priority for the Challenged Patents." *Id.* at 9.

Petitioner provides redline comparisons between the disclosure of the '211 application and the disclosure of PCT/US2014/011347 ("PCT '347) to show that PCT '347 is not a continuation of the '211 application because they have different specifications and figures. Opp. 2–3 (citing *Applied Material, Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F.3d 1563, 1579 (Fed. Cir. 1996)); Ex. 1160 (PCT '347); Ex. 1161 (publication of the '211 application); Ex. 1162 (redline comparison of Ex. 1160 and Ex. 1161). According to Petitioner, Patent Owner's Motion seeks to "exploit

the defect by further extending the priority claim back from the '211 application to earlier-filed applications." *Id.* at 4.

After reviewing the arguments in the Motion and the Opposition, we conclude that "there is a sufficient basis supporting Patent Owner's position that the mistake may be correctable." *Honeywell*, 939 F.3d at 1349.

Because the '211 application is already part of the '096 patent's priority claim, and because the '211 application itself claims the benefit of the '069 application, Brown, and the '205 provisional, Patent Owner's assertion that the '069 provisional, Brown, and the '205 provisional were unintentionally omitted from the priority chain has a substantial basis. Ex. 1161, codes (60), (63). Petitioner does not argue that the '211 application is not entitled to claim priority to the omitted applications.

Petitioner's arguments directed to whether the omission was "unintentional" and made "in good faith" go to the merits of Patent Owner's requested correction, which is in the purview of the Director and not the Board. Accordingly, we cede exclusive jurisdiction over the '096 patent and grant Patent Owner permission to file a petition for a certificate of correction to the Director.

Although Petitioner's comparison of the '211 application and PCT '347 demonstrates that the disclosures of the '211 application and PCT '347 are not the same and, therefore, PCT '347 is not a continuation of the '211 application, both PCT '347 and the '211 application already appear in the '096 patent's existing priority claim. Ex. 1001, 1:9–10, code (63). Furthermore, Petitioner's argument that the disclosure of the prior-filed applications must provide adequate support for the claimed subject matter of

the later-filed application in order to be entitled to the benefit of an earlier-filed application goes to the merits of the challenges in the Petition and is separate from the issue whether the ’096 patent can claim priority to the omitted earlier-filed applications.

In that regard, Petitioner requests, in the event the Motion is granted, that it have the opportunity to brief the issue of whether the challenged claims are entitled to the benefit of the earlier-filed applications omitted from the ’096 patent’s priority claim. Opp. 10. We agree with Petitioner that it could not have known Patent Owner would seek to change the priority claims for each of the four challenged patents in these proceedings. Accordingly, we grant Petitioner’s request for additional briefing on this issue. In the interest of time, we authorize Petitioner and Patent Owner to file, simultaneously, a brief addressing the question of whether the challenged claims in each proceeding are entitled to the benefit of the filing dates of the ’069 provisional, Brown, and the ’205 provisional. Each brief shall be not more than fifteen (15) pages in length as suggested by Petitioner. *Id.* The parties shall have the opportunity to file a responsive brief of not more than five (5) pages in length.

Second, Petitioner requests that we instruct Patent Owner to include Petitioner’s Opposition and any Board order concerning the Motion with its petition to the Director. *Id.* In our view, Petitioner’s Opposition, including its exhibits, may be useful to the Director in determining whether it is appropriate to issue a certificate of correction. Therefore, we order Patent Owner to include a copy of Petitioner’s Opposition in addition to this Order with the petition for a certificate of correction submitted to the Director.

Order

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Motions are *granted*;

FURTHER ORDERED that Patent Owner shall file with the Director a Petition for a Certificate of Correction within five (5) business days of the entry of this Order, shall serve a copy of the Petition on Petitioner, and shall file a copy of the Petition as an exhibit in this proceeding;

FURTHER ORDERED that Patent Owner shall include a copy of Petitioner's Opposition and accompanying exhibits along with this Order with the Petition submitted to the Director;

FURTHER ORDERED that when a decision is rendered on Patent Owner's Petition for a Certificate of Correction, Patent Owner shall file, within five (5) business days of such decision, a copy of the document as an exhibit to this proceeding;

FURTHER ORDERED that within seven (7) business days of the entry of this Order, Petitioner is authorized to file a brief of no more than fifteen (15) pages in length to address the effect, if any, on the present proceedings of Patent Owner's requested corrections to the challenged patents, particularly whether the challenged claims are entitled to claim the benefit of the filing date of the '069 application, Brown, and the '205 provisional, as well as what the earliest effective filing date properly should be;

FURTHER ORDERED that within seven (7) business days of the entry of this Order, Patent Owner is authorized to file a brief of no more than

fifteen (15) pages in length to address the effect, if any, on the present proceedings of Patent Owner's requested corrections to the challenged patents, particularly whether the challenged claims are entitled to claim the benefit of the filing date of the '069 application, Brown, and the '205 provisional, as well as what the earliest effective filing date properly should be; and

FURTHER ORDERED that the parties are authorized to file a responsive brief of no more than five (5) pages in length within seven (7) business days following the filing of the briefs concerning the effect of Patent Owner's requested corrections.

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PETITIONER:

Joseph M. Paunovich
James Glass
Sandra Haberny
Razmig Messerian
Quincy Lu
QUINN EMANUEL URQUHART &
SULLIVAN, LLP
joepaunovich@quinnemanuel.com
jimglass@quinnemanuel.com
sandrahaberny@quinnemanuel.com
razmesserian@quinnemanuel.com
quincylu@quinnemanuel.com

PATENT OWNER:

Michael Rosato
Lorelei Westin
Wendy Devine
Matthew Reed
Tasha Thomas
WILSON SONSINI GOODRICH &
ROSATI
mrosato@wsgr.com
lwestin@wsgr.com
wdevine@wsgr.com
mreed@wsgr.com
tthomas@wsgr.com