

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUM INDUSTRIAL TECHNOLOGY, INC.,
Petitioner,

v.

AMSTED RAIL COMPANY, INC.,
Patent Owner.

Case No. IPR2023-00538
Patent No. 9,365,223

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
CORRECT PETITION UNDER 37 C.F.R. §42.104(c)**

None of the changes Petitioner seeks to address through its motion amount to a “clerical error” within the meaning of Rule 104(c). Petitioner omitted an entire claim element from its analysis. Repeatedly. This is not a case where only dependent claims are moved between grounds without any changes to the text of the relevant portions due to an error in claim dependency. This is a case where the Petitioner fully, but erroneously, analyzed a claim in a ground for invalidity and is now asking the Board to excuse the error in legal analysis and allow it to resubmit the analysis of that claim in a different ground and with different prior art.

The clear text of Rule 104(c) establishes the “clerical” nature of the error for which correction is requested as a threshold issue to obtain relief under the rule. Prior PTAB cases establish that substantive changes to a petition cannot be clerical in nature and cannot be corrected by Rule 104(c) regardless of whether any prejudice exists on the non-moving party. Petitioner’s motion should be denied.

I. Argument. Rule 104(c) provides that “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition.” It is thus an explicit textual requirement of this Rule that the “mistake” that Petitioner seeks to correct is “clerical or typographical” in nature. The Board has established a list of non-exhaustive factors that it reviews in deciding whether a motion under Rule 104(c) should be granted: (1) the nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred, including how the error

was discovered; (2) the length of time elapsed between learning of the error and bringing the error to our attention; (3) prejudice to the other party, if any, by allowing the proposed corrections; and (4) whether the proposed corrections have any impact on the proceeding. *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01180, Paper 14 at 9 (PTAB Dec. 6, 2018). “Rule 104(c), however, does not give a petitioner recourse to make substantial alterations to the petition or the evidence supporting the petition under a theory of ‘correction.’” *Axis Commc’ns AB v. Avigilon Fortress Corp.*, IPR2019-00235, Paper 19 at 7 (PTAB June 4, 2019). Thus, notwithstanding any other factors, the Board has expressly held that the presence of a “clerical or typographical error” rather than an error of substance is a threshold issue to obtain relief under Rule 104(c). Further, it is not the genesis of the error that determines whether it is clerical, but the nature of the **changes** that are requested. *See SweeGen, Inc. v. PureCircle Sdn Bhd*, PGR2020-00070, Paper 9 at 6 (PTAB Sept. 22, 2020) (holding that “even if the errors ... resulted from a clerical error, **the proposed changes** ... are not mere clerical errors that may be corrected under Rule 104(c)”; *See also IBM Corp. v. Intellectual Ventures II LLC*, IPR2014-00660, Paper 17 at 2 (PTAB July 31, 2014) (“We are not persuaded that **the amendment** Petitioner seeks to make is the result of a typographical or clerical error.”). Because the addition of a claim element and changes to prior art mapping are substantive changes, the omission of that element is not a clerical error that can be corrected by this Rule.

A. The Omission of a Claim Element and a Prior Art Reference Is Not a

Clerical Error. Petitioner plainly omitted an element from its analysis of claim 5. *See* Paper 7 at 1, ¶5. In its requested relief, Petitioner proposes to move the discussion of claim 5 from Ground 4 (asserting only the Armitage reference) to Ground 5 (asserting Armitage in view of Lefebvre). *Id.* at 2-3. Not only does this add a prior art reference to the ground applicable to claim 5, it also shifts a broad swath of dependent claims from Ground 4 to Ground 5, dramatically altering the substance of those grounds. That claim 8 includes similar subject matter is of no moment, in part because it is listed in a separate ground from claim 5. Petitioner’s statement that “Patent Owner will have to address the arguments [with respect to claim 8] even if the Petition is not corrected” is simply not true, as the Preliminary Response need not respond to every claim, for any number of reasons. Patent Owner also represents to the Board that identical omissions were made in Petitioner’s Invalidity Contentions served more than three months ago in the underlying District Court litigation. Such a repeated error becomes an omission of substance. Indeed, not all mistakes or omissions qualify as non-substantive “clerical errors” as the Board’s case law cited herein demonstrates. The amendments correcting these omissions are substantive and Rule 104(c) does not apply.

The Board’s prior decisions confirm this view. For example, in *IBM Corp. v. Intellectual Ventures II LLC*, IPR2014-00660, Paper 17 at 2 (PTAB July 31, 2014),

IBM sought to add an omitted claim element from its claim chart for an anticipation ground. IBM also argued that the argument and evidence supporting the challenge to the omitted element was found elsewhere in the petition analyzing a different claim. *See id.* The Board was “not persuaded that the amendment Petitioner seeks to make is the result of a typographical or clerical error” and held that Rule 104(c) “does not apply.” *Id.* Other decisions have found similar errors to be substantive and therefore not clerical in nature and held that Rule 104(c) does not provide a remedy. *See Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2014-01149, Paper 31 at 12 (PTAB May 19, 2015) (holding that “an inadvertent mistake in preparing and supporting the original Petition” involving a short-hand for a claim element that was carried over from an expert declaration into the petition was not a clerical or typographical error); *Nitro Fluids, LLC v. Cameron Int’l Corp.*, IPR2019-00852, Paper 20 at 5 (a mistaken paragraph reference copied from an expert declaration was not proven to be a clerical or typographical error).

Petitioner’s cited case law only highlights the distinction between clerical and substantive corrections and further demonstrates that the changes they propose are not clerical. *See Unified Patents Inc. v. Universal Secure Registry LLC*, IPR2018-00067, Paper 11 at 3-4 (finding the inadvertent placement of dependent claims in the wrong ground to be correctable under Rule 104(c) when “does not modify the mappings of the claims to the art *in any way*”); *Merck Sharp & Dohme Corp. v. Ono*

Pharma. Co., Ltd., IPR2016-01217, Paper 10 (PTAB Oct. 3, 2016) (corrections regarding claims in incorrect grounds and omitted claims were clerical when identical subject matter in other claims was discussed *in the same ground*).

B. Judicial Efficiency Does Not Displace the Text of Rule 104(c) or Eliminate the Need to Protect Against Prejudice to Patent Owner. Patent Owner is unaware of any Board decision that accepts judicial efficiency arguments to justify substantive (i.e., non-clerical) corrections to a petition under Rule 104(c). It remains that Patent Owner has only a little more than one month to complete and file its Preliminary Response. Even when corrections are deemed clerical, the extent of the corrections that are required may necessitate an extension of Patent Owner's time to respond. *See Merck*, IPR2016-01217 at 5 ("Given the number of proposed corrections to the Petitions, however, we also determine that additional time to respond to the Petitions is warranted."). In the event the Board grants Petitioner's Motion, Patent Owner requests one month of additional time to prepare its preliminary response, which should apply to all related petitions. Petitioner does not address Rule 42.5 and a correction under that rule would in any case require a change in filing date. *See, e.g., Bright Pharma Caps, Inc. v. Capsugel USA, LLC*, IPR2015-01623, Paper 18 at 2-3.

II. Conclusion. Petitioner's Motion pursuant to 37 C.F.R. §42.104(c) should be denied.

Dated: April 7, 2023

Respectfully submitted,
/ Ryan N. Miller /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I certify that on this 7th day of April, 2023, a
copy of

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
CORRECT PETITION UNDER 37 C.F.R. §42.104(c)

was served by electronic mail on Petitioner's counsel, lead and back-up, as follows:

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Counsel for Petitioner has consented to service of all documents via electronic
email. *See* Petition, Paper 1 at 2.

Dated: April 7, 2023

By: / Ryan N. Miller /

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