

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRIME TIME TOYS LLC, PRIME TIME TOYS LTD., and
EASEBON SERVICES LTD.,
Petitioners,

v.

SPIN MASTER, INC.,
Patent Owner.

IPR2023-01461
Patent 8,596,255 B2

**PETITIONERS' MOTION TO CORRECT EXHIBITS 1016 AND 1017
UNDER 37 C.F.R. § 42.104(c)**

EXHIBIT LIST

<u>EXHIBIT NO.</u>	<u>DESCRIPTION</u>
1001	U.S. Patent No. 8,596,255
1002	Publication Declaration of Nathaniel E. Frank-White and ThinkGeek Spitballs Internet Archive Webpage (“Spitballs”)
1003	Bulgarian Patent No. BG110343 and translation (“Peev”)
1004	Transcript of Hearing in ITC Case 337-TA-1325
1005	“Airsoft Guns: A Double-Edged Sword,” Bleacher Report (2008), available at https://bleacherreport.com/articles/46402-airsoft-guns-a-double-edged-sword
1006	U.S. Patent No. 4,834,059 to Moorhouse
1007	ThinkGeek Form 10-Q (https://www.sec.gov/Archives/edgar/data/1096199/000114420409057449/v165221_10q.htm).
1008	ThinkGeek: The nerd company at a crossroads - The Washington Post https://www.washingtonpost.com/lifestyle/magazine/thinkgeek-the-nerd-company-at-a-crossroads/2013/12/11/c7d579ba-4b12-11e3-9890-a1e0997fb0c0_story.html
1009	“Not your kid brother's toy gun” – CNET (2006), available at https://www.cnet.com/culture/not-your-kid-brothers-toy-gun/
1010	“Tech: Desk Toys,” Wall Street Journal (2006), available at https://www.wsj.com/articles/SB116684498725258456
1011	“USB Airsoft Turret,” Inventgeek (2006), available at www.inventgeek.com/usb-airsoft-turret/

<u>EXHIBIT NO.</u>	<u>DESCRIPTION</u>
1012	“R/C Missile Launcher – Unstoppable Cube Welfare,” The Green Head (2006), available at https://www.thegreenhead.com/2006/05/rc-missilelauncher-unstoppable-cube.php
1013	3.31.2023 Deposition Transcript of Ronald Brawer
1014	U.S. Patent No. 6,386,293 to Bartlett
1015	Order No. 28: Construing Certain Terms of the Asserted Claims
1016	Declaration of Joel Delman
1017	Declaration of Maureen Reitman, Ph.D.
1018	Prosecution History of the ‘255 Patent
1019	California Senate Office of research, May 2005 (Revised)
1020	“Not Your Dad’s BB Gun,” Washington Post (2004), available at https://www.washingtonpost.com/archive/lifestyle/2004/11/26/not-yourdads-bb-gun/6ccffa5e-a5bb-45e2-9a5c-a17de827267c/
1021	10.25.2022 Infringement Contentions Chart US8640863 for Prime Time Toys (excerpted)
1022	Korean Patent Publication No. KR 20-2010-0004855 (“Kim”)
1023	“Spitballs Grow up to 200 times their original Size,” YouTube (2010), available at https://www.youtube.com/watch?v=n-Wje1G1wBA
1024	Screenshot of “Spitballs Grow up to 200 times their original Size,” YouTube (2010)
1025	U.S. Patent No. 8,371,282
1026	Translation of Bulgarian Patent Law Section 46(c)(2)

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<u>EXHIBIT NO.</u>	<u>DESCRIPTION</u>
1027	Declaration of Velislav N. Dramov
1028	Bulgarian Patent Office Bulletin Issue No. 7 dated July 31, 2009 and English translation
1029	Declaration of Kenneth P. George
1030	Declaration of Matthieu Hausig

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.104(c), Petitioners respectfully move to correct: (1) the exhibits to Exhibit 1016 (the Declaration of Joel Delman); and (2) the appendices to Exhibit 1017 (the Declaration of Dr. Maureen Reitman). Authorization to file this Motion to Correct was granted by the Board via e-mail on September 10, 2024.

When filed on October 3, 2023, the Delman Declaration (Ex. 1016) and Reitman Declaration (Ex. 1017) referenced various attachments. Petitioners intended that the Delman Declaration include Exhibits A-D as attachments, which Exhibits are Mr. Delman's CV, a list of his patents and published applications, a list of cases he testified in, and a list of his articles and publications. *See, e.g.*, Exhibit 1016, ¶¶ 12, 22, 25, 26. However, as explained herein, due to a clerical error by our office, Exhibits A-D were inadvertently omitted from his declaration at the time it was filed.

Similarly, Dr. Reitman's Declaration refers to various appendices that include her CV, excerpts from textbooks, scientific publications, and various U.S. patents. *See, e.g.*, Exhibit 1017, fns. 1-92. Petitioners intended that the Reitman Declaration include these appendices as attachments. However, due to the same clerical error that occurred with respect to the Delman Declaration, these appendices were inadvertently omitted from her declaration at the time it was filed.

As explained in the Declaration of Kenneth P. George (Ex. 1029), Petitioners' lead counsel, and in the Declaration of Matthieu Hausig, Senior Counsel at Mr. George's firm (Ex. 1030), Petitioners did not become aware of the clerical errors and missing exhibits/appendices until late August 2024. Ex. 1029, ¶¶ 17-19. These declarations explain the nature of clerical error and how it occurred.

Corrected versions of Exhibits 1016 and 1017 are attached to the Hausig Declaration (Ex. 1030) as Attachment A and Attachment B, respectively. Ex. 1030, ¶ 16. The corrected version of Mr. Delman's Declaration (Ex. 1016) simply attaches copies of the omitted Exhibits A-D that are referenced therein. Ex. 1029, ¶ 22. Similarly, the corrected version of Dr. Reitman's Declaration (Ex. 1017) attaches copies of the omitted appendices that are referenced therein. *Id.* No substantive changes have been made to the text and opinions included in the Delman and Reitman Declarations. The corrected versions merely add the unintentionally omitted exhibits and appendices.

Patent Owner had these exhibits and appendices, and the corrections to the Delman Declaration and the Reitman Declaration do not raise any new matter or issue. Indeed, Petitioners filed complete declarations from Mr. Delman and Dr. Reitman in related IPR proceedings before this Board and served those declarations on Patent Owner's counsel. *See* IPR2023-01339, Exs. 1016 and 1017;

IPR2023-01348, Exs. 1016 and 1017; Ex. 1029, ¶ 6; Ex. 1030, ¶ 7. Importantly, the Delman and Reitman Declarations submitted in those related IPR proceedings *included as attachments* the same exhibits and appendices that Petitioners seek to add to Exhibits 1016 and 1017 in this IPR. Ex. 1029, ¶ 22.

Petitioners served the corrected versions of the Delman and Reitman Declarations on Patent Owner on August 30, 2024, and Patent Owner has stated that it does not oppose the present Motion, subject to Petitioners' representations of the clerical errors involved. Ex. 1029, ¶¶ 22-23.

As such, Petitioners respectfully request that this Motion be granted pursuant to 37 C.F.R. § 42.104(c) and that the corrected versions of Exhibits 1016 and 1017 be entered into the record in place of the prior versions that were filed.

II. LEGAL PRINCIPLES

Under 37 C.F.R. § 42.104(c): “A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.” This rule permitting correction of clerical errors “is remedial in nature and is therefore entitled to a liberal interpretation.” *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21 at 7 (Jan. 16, 2013). Adopting the definition of “clerical error” from the Federal Circuit in the context of customs law, the Board has found that a clerical error is one made by “those upon whom ‘no duty devolves . . . to exercise discretion or

judgment.”” *Zhongshan Broad Ocean Motor Co. v. Nidec Motor Corp.*, IPR2014-01122, Paper 20 at 12-13 (Jan. 21, 2015) (*quoting Ford Motor Co. v. U.S.*, 157 F.3d 849, 860 (Fed. Cir. 1998)) (ellipsis in original; internal quotation omitted).

III. BACKGROUND

This IPR (challenging US Patent No. 8,596,255, the “‘255 Patent”) is related to two other IPRs: IPR2023-01339 (challenging US Patent No. 8,640,683, the “‘683 Patent”) and IPR2023-01348 (challenging US Patent No. 8,371,282, the “‘282 Patent”). All three IPRs are requested by Petitioners and defended by the same Patent Owner. Petition (Paper 2) at 9-10. The three IPRs are related in that the ‘255 Patent is a continuation-in-part of the ‘282 Patent, and the ‘683 Patent is a division of the ‘282 Patent. *Id.* at 3, 9. Petitioners submitted the IPR petitions in IPR2023-01339 and IPR2023-01348 on August 23, 2023, and in the present IPR on October 3, 2023. In all three cases, the IPR petitions were submitted with the Delman Declaration (Ex. 1016) and the Reitman Declaration (Ex. 1017).

A. Delman Declaration (Exhibit 1016)

In all three IPRs, the Delman Declaration refers to Exhibits A-D. *See, e.g.*, Ex. 1016 in IPR2023-01461, ¶¶ 12, 22, 25, 26. Exhibit A is Mr. Delman’s CV, Exhibit B is a list of his patents and published applications, Exhibit C is a list of cases that he has testified in, and Exhibit D is a list of his articles and publications.

In the related IPRs (IPR2023-01339 and IPR2023-01348), Exhibits A-D ***were***

attached to the Delman Declaration that was *filed and served* on Patent Owner.

Ex. 1030, ¶ 7. Thus, Patent Owner has long had these Exhibits.

In this IPR, the Delman Declaration (Ex. 1016) referred to the same Exhibits A-D that were filed and served in the related IPRs. Ex. 1030, ¶¶ 9, 12. However, due to a clerical error (discussed below), Exhibits A-D were unintentionally omitted as attachments.

B. Reitman Declaration (Exhibit 1017)

The same thing happened with respect to the Reitman Declaration. In all three IPRs, the Reitman Declaration refers to various Appendices that consist of her CV, excerpts from textbooks, scientific publications, and various U.S. patents. *See, e.g.*, Ex. 1017 in IPR2023-01461, fns. 1-92. Table 1 below lists the Appendices that *were attached, filed, and served* on Patent Owner in the *related IPRs*.

Table 1

IPR2023-01339 (the ‘683 Patent)	IPR2023-01348 (the ‘282 Patent)
Reitman Declaration	Reitman Declaration
Not Applicable	A cover page simply stating “APPENDICES”
Appendix A (CV)	Appendix A (CV)

Appendix Baranwal (textbook excerpt)	Appendix Baranwal (textbook excerpt)
Appendix Buchholz (textbook excerpt)	Appendix Buchholz (textbook excerpt)
Appendix Callister (textbook excerpt)	Appendix Callister (textbook excerpt)
Appendix Kiatkamjornwong (scientific publication)	Appendix Kiatkamjornwong (scientific publication)
Appendix Odian (textbook excerpt)	Appendix Odian (textbook excerpt)
Appendix Po (scientific publication)	Appendix Po (scientific publication)
Appendix Zohuriaan- Mehr (scientific publication)	Appendix Zohuriaan- Mehr (scientific publication)
Appendix US Patent 3,997,484A	Appendix US Patent 3,997,484A
Appendix US Patent 4,506,062	Appendix US Patent 4,506,062
Not Applicable	Appendix 282 Patent
Appendix 683 Patent	Appendix 683 Patent

In this IPR, the Reitman Declaration (Ex. 1017) referred to the same Appendices (listed in Table 1) that were filed and served in the related IPRs. Ex.

1030, ¶¶ 9, 12. However, due to the same clerical error that occurred with respect to Exhibit 1016, these Appendices were unintentionally omitted as attachments.

IV. ARGUMENT

a. The Corrected Delman Declaration (Ex. 1016)

In the present Motion, Petitioners respectfully request that corrections be made to Mr. Delman's Declaration (Ex. 1016) in this IPR by adding as attachments the following exhibits to his Declaration: (1) Mr. Delman's curriculum vitae (Exhibit A); (2) a list of Mr. Delman's patents and published applications (Exhibit B); (3) a list of cases that Mr. Delman has testified in (Exhibit C); and (4) a list of Mr. Delman's articles and publications (Exhibit D). These Exhibits are identical to Exhibits A-D that were attached to Mr. Delman's Declarations filed and served in the prior two related IPRs. Ex. 1030, ¶ 9.

A corrected version of Exhibit 1016 is attached to the Hausig Declaration (Ex. 1030) as Attachment A. Patent Owner will not be prejudiced by these corrections since *it already had the same Exhibits* from the first two IPRs, and other than adding copies of these Exhibits as attachments, *no changes* have been made *to the text or opinions* set forth in Mr. Delman's Declaration.

b. The Corrected Reitman Declaration (Ex. 1017)

Likewise, Petitioners respectfully request that corrections be made to Dr. Reitman's Declaration (Ex. 1017) in this IPR by adding as attachments the

following Appendices to her Declaration: (1) Appendix A, Dr. Reitman's curriculum vitae; (2) Appendix Baranwal (a textbook excerpt); (3) Appendix Buchholz (a textbook excerpt); (4) Appendix Callister (a textbook excerpt); (5) Appendix Kiatkamjornwong (a scientific publication); (6) Appendix Oadian (a textbook excerpt); (7) Appendix Po (a scientific publication); (8) Appendix Zohuriaan-Mehr (a scientific publication); (9) Appendix US Patent No. 3,997,484 A; and (10) Appendix US Patent No. 4,506,062. These Appendices were all attached to Dr. Reitman's Declarations filed and served in the prior two related IPRs. Ex. 1030, ¶ 9.

A corrected version of Exhibit 1017 is attached to the Hausig Declaration (Ex. 1030) as Attachment B. Patent Owner will not be prejudiced by these corrections since *it already had the same Appendices* from the first two IPRs, and other than adding copies of these Appendices as attachments, *no changes* have been made *to the text or opinions* set forth in Dr. Reitman's Declaration.

c. The Exhibits And Appendices Were Omitted Due To Clerical Errors

Mr. George (lead counsel in all three IPRs) states in his Declaration (Ex. 1029) that it was his intention to submit in this IPR: (1) the Delman Declaration (Ex. 1016) accompanied by Exhibits A-D as attachments thereto; and (2) the

Reitman Declaration (Ex. 1017) accompanied by the Appendices listed as items (1)–(10) in Section IV-b above as attachments thereto. Ex. 1029, ¶¶ 13-14.

As explained in the Hausig Declaration (Ex. 1030), the omissions of Exhibits A-D from the Delman Declaration and the omissions of the Appendices from the Reitman Declaration were caused by clerical errors.

Mr. Hausig (Petitioners’ counsel who filed Exhibits 1016 and 1017) explains that he was tasked with electronically submitting the IPR petitions to P-TACTS under Mr. George’s direction. Ex. 1030, ¶ 12. Accordingly, “[he] created combined PDF versions of the Delman and Reitman Declarations for this IPR that included as attachments the relevant exhibits and appendices.” *Id.*, ¶ 13.

However, “[d]ue to a misconfiguration that [he] did not notice at the time, the combined PDF files that [he] created to include the Delman Declaration and exhibits, and the Reitman Declaration and appendices were not saved in the correct location on [his] computer.” *Id.*, ¶ 14. In addition, “[b]ecause the combined declarations were opened automatically as PDFs when [he] created them, the Delman and Reitman Declarations appeared to include as attachments their respective exhibits and appendices.” *Id.*, ¶ 15. Consequently, “when the Delman and Reitman Declarations were filed as Exhibits 1016 and 1017 in this IPR, [he] unintentionally uploaded and filed versions of the declarations that did not include the attached exhibits and appendices.” *Id.*

Thus, although Mr. Hausig created electronic files of Exhibits 1016 and 1017 that included as attachments all the relevant Exhibits and Appendices for this IPR, the configuration error led these files to be saved in the wrong location on Mr. Hausig's computer, which led Mr. Hausig to inadvertently select versions of Exhibits 1016 and 1017 that did not include these attachments.

In these electronic filing processes, Mr. Hausig was not allowed to "exercise discretion or judgment" to omit Exhibits A-D from the Delman Declaration or to omit the Appendices from the Reitman Declaration. Ex. 1029, ¶ 12. Therefore, the mistakes made by Mr. Hausig due to computer processing errors qualify as "clerical errors" under *Zhongshan*. See also, *Apple Inc. v. Chestnut Hill Sound, Inc.*, IPR2015-01465, Paper 12 at 2-3 (Nov. 6, 2015) (granting petitioner's motion to correct clerical error to file missing exhibits); *Arthrex, Inc. v. Bonutti Skeletal Innovations, LLC*, IPR2013-00631, Paper 15 at 4-6 (Mar. 3, 2014) (determining that a subordinate attorney's failure to include all pages of two exhibits was a "clerical mistake" and allowing the moving party to correct the inadvertent mistake); *Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178, Paper 21 at 4-5 (Jul. 22, 2013) (permitting petitioner to correct error of uploading incorrect exhibit with petition).

Further, as noted above, Patent Owner does not oppose this Motion or correction of Exhibits 1016 and 1017 in this IPR. Ex. 1029, ¶ 23. Nor would

Patent Owner be prejudiced by these corrections since in the prior two related IPRs, Petitioners served Patent Owner with the relevant exhibits and appendices that are being added to Exhibits 1016 and 1017 in this IPR. Ex. 1029, ¶ 6; Ex. 1030, ¶¶ 7, 9. Thus, no new matters or issues are raised by these corrections.

V. RELIEF REQUESTED

For the reasons discussed above, Petitioners respectfully request that Exhibits 1016 and 1017 in IPR2023-01461 be expunged from the record and that Petitioners be allowed to file Attachments A and B accompanying the Hausig Declaration (Ex. 1030) as Corrected Exhibits 1016 and 1017 in their place, respectively.

Dated: September 11, 2024 Respectfully submitted,

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By: /Kenneth P. George/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), I hereby certify that on September 11, 2024, a true copy of this PETITIONERS' MOTION TO CORRECT EXHIBITS 1016 AND 1017 UNDER 37 C.F.R. § 42.104(c) was served via email on the Patent Owner at the following correspondence addresses of record.

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