

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

ANONYMOUS MEDIA RESEARCH HOLDINGS, LLC,
Patent Owner

Case IPR2024-01349
U.S. Patent 10,719,849

**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION SEEKING
RELIEF REGARDING REQUESTED CERTIFICATE OF
CORRECTIONS¹**

¹ The filing of this response was authorized on December 9, 2024. *See* Ex. 1033.

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I. Introduction

Patent Owner respectfully requests that Petitioner's motion be denied, including the request that the Board "exercise exclusive jurisdiction over, and stay, PO's CoC Request and related matters" and rule on the merits of the CoC Request.

Federal Circuit precedent dictates that it is the Director—not the Board—who evaluates the merits of such petitions for correction, including for patents challenged during trial in IPR proceedings. A patentee is not required to seek permission from the Board to file such petitions before trial is instituted. Even after institution, the Board's role is simply to determine whether there is sufficient basis supporting a patentee's position that the mistake *may be correctable* so that the petition can be submitted to the Director—not to decide the merits of the petition. That is a decision for the branches of the PTO designated by the Director. The Board should thus do what it has consistently done prior to institution—defer to those branches.

As an initial matter, there is no legitimate basis for the Board to exercise jurisdiction before institution. Patent Owner's preliminary response will not even rely on the requested corrections to argue that institution should be denied. Nor will Patent Owner seek to rely on any certificates of correction before the decision on institution issues. Given that the arguments in the preliminary response do not rely on those corrections to rebut the IPR Petition, it would be a waste of Board resources to grant Petitioner's requested relief before deciding whether to institute.

Although Patent Owner is not required to demonstrate to the Board that the mistake *may be correctable* (given that trial has not yet been instituted), that burden would clearly be met. Recognizing this, Petitioner's motion is premised on the Board ruling on the merits of the CoC Requests. However, Federal Circuit precedent explicitly prohibits the Board from doing so. Even if it did not, Patent Owner's CoC Request meets all requirements.

Petitioner's requests should also be denied because they would prevent Patent Owner from making corrections to other patents and applications in the family that are not involved in these or any other proceedings. Given that the patent term for the family is very close to expiration, it would especially prejudicial to prevent Patent Owner from seeking correction for the duration of these proceedings.

II. Background

The IPR Petition does not argue that the challenged patents do not properly claim priority back to the provisional application. The Petition instead argues that the challenged claims do not have adequate written description support in application no. 11/139,330 ("the '330 application") or the provisional application and are, therefore, at best entitled to the benefit of the Nov. 24, 2010 filing date of application no. 12/954,604 for written description support. Paper 1, 12-40. This is the sole basis for Petitioner's contention that the asserted references are prior art.

Patent Owner's preliminary response is due on December 27, 2024. In it,

Patent Owner will demonstrate that institution should be denied because Petitioner fails to show that the challenged claims lack written description support in the '330 application as alleged in the Petition—meaning Petitioner has not shown that any of the asserted references qualify as prior art. Patent Owner will not be relying on the corrections sought by the CoC Requests to argue that institution should be denied.

Patent Owner has sought a similar priority correction in other patents and pending applications. Paper 6, 3-4. However, those corrections can only be effective if the priority claim of the '896 patent is first corrected, as these other patents and applications claim priority through the '896 patent. Ex. 1035, 5 (priority tree).

On December 17, 2024, the PTO's Office of Petitions issued a decision on the '849 Patent CoC Request, dismissing the request but permitting Patent Owner to submit a renewed request after taking additional steps. Ex. 2101 (hereafter "Decision"). Similar decisions issued for the other CoC Requests the same day. Patent Owner has not yet filed renewed petitions, but has taken the step of submitting a Petition Under 37 C.F.R. § 1.137(a) and Petition to Expedite in application no. 13/914,870, as suggested by the Decision. Paper 9.

III. The Board Should Deny the Motion

A. The Board Should Decline to Exercise of Jurisdiction

Petitioner argues that the Board has authority to exercise jurisdiction before institution. Motion, 3-4. Petitioner misses the point. There is no question that the Board

can exercise jurisdiction before institution, the issue is whether the Board *should* do so here. See *ipDataTel, LLC v. ICN Acquisition, LLC*, IPR2018-01822, Paper 19 at 16 (PTAB Apr. 22, 2019) (explaining that “[n]othing in our Rules, however, obligates us to” exercise jurisdiction before institution).

The only decision cited by Petitioner where the Board exercised exclusive jurisdiction before institution is *Alarm.com Inc. v. Vivint*. However, the panel of judges there believed that it was within the purview of the Board to “mak[e] a determination whether or not the Requests satisfy 35 U.S.C. § 255 and 37 C.F.R. §§ 1.322 and 1.323.” *Alarm.com Inc. v. Vivint*, IPR2016-00116, Paper 9 at 4 (PTAB Jan. 28, 2016). In other words, the panel believed that the Board is authorized to, and should, decide the merits of such requests. The Federal Circuit has since made it clear that 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 (PTAB Jan. 9, 2020). Thus, the lone Board decision cited by Petitioner where exclusive jurisdiction was exercised before institution is invalid in light of *Honeywell*.

Beyond the lack of support for the Board exercising pre-institution jurisdiction, there are at least two additional reasons such jurisdiction should not be exerted here. For one, Patent Owner is **not** relying on any corrections as the basis for denying

institution, and will **not** seek to do so *even if renewed Requests for CoC are granted before institution*. The two grounds set forth in each petition for IPR are premised on the Board determining that: (1) the challenged claims lack adequate written description support in the '330 application or provisional application, which Petitioner relies on to qualify all of its asserted references as prior art; and (2) that all challenged claims would have been obvious. Patent Owner's preliminary response will demonstrate that Petitioner fails to carry its burden on both issues and, thus, denial is warranted. Given this, it would be a highly inefficient use of Board resources to take the steps requested by Petitioner before deciding whether institution is warranted in the first place.

Second, the Petitions Branch has already carefully analyzed the CoC Requests and has a thorough understanding of the basis for the requests. The Petitions Branch should be permitted to consider any renewed requests submitted by Patent Owner, as it already has intricate knowledge of these issues. Indeed, the Decision demonstrates that the Advising Attorney carefully analyzed the prosecution histories of applications in the family and has requested additional information based on that analysis. *See Ex. 2101*. Moreover, if the Petitions Branch determines that the renewed CoC requests do not meet the statutory requirements, the issues before the Board become moot.

B. The Board Should Reject Petitioner's Attempt to Prevent Correction.

Petitioner dedicates nearly half of its motion to arguing that Patent Owner's CoC Request has not met the requirements for correction, including that Patent Owner "fails

to demonstrate unintentional delay.” Motion, 4-9. However, 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*, 939 F.3d at 1349. Petitioner is thus asking the Board to disregard binding precedent by stepping into the shoes of the Director to rule on the merits of the CoC Request.

While one role of the Board is “to determine whether there is sufficient basis supporting Patent Owner’s position that the mistake may be correctable,” this role only applies *after* institution based on the filing of a motion. *See Motif Foodworks v. Impossible Foods*, IPR2023-00206, Paper 15 at 4 (May 22, 2023) (explaining that “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’”) (quoting *Honeywell*, 939 F.3d at 1349); *Simpson Strong-TieCo. Inc. v. Columbia Insurance co.*, PGR2021-00109, Paper 6 at 2 (PTAB 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.”); *See also ipDataTel*, IPR2018-01822, Paper 19 at 15. Given that trial has yet to be instituted, the Board has no required role in making any determinations regarding Patent Owner’s CoC Requests.

Even if trial were already instituted, Patent Owner’s petition and supporting declaration demonstrate a sufficient basis supporting its position that the mistake “may

be correctable.” *Honeywell*, 939 F.3d at 1349. Indeed, an Advisory Attorney in the Petitions Office has analyzed the petition and supporting declaration carefully and indicated that the standard for correction would be met if additional steps are taken. Ex. 2101. That the petition has not been fully denied is, in and of itself, sufficient to demonstrate to the Board that the mistake “may be correctable.”

Petitioner delves into a lengthy argument that the Board should determine that Patent Owner “fails to demonstrate unintentional delay.” However, “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.” *Motif Foodworks*, IPR2023-00206, Paper 15 at 6 (granting patent owner leave to file certificate of correction because there was a “sufficient basis supporting Patent Owner’s position that the mistake may be correctable” and declining to consider petitioner’s merits-based arguments). Moreover, Petitioner confusingly conflates unintentional *acts* with unintentional *delay*. The standard is whether the entire *delay* between the date the benefit claim was due and the date the benefit claim was filed was *unintentional*. See 37 C.F.R. § 1.78(e)(3). Apparently recognizing this, Petitioner argues that “PO’s desire to correct the priority benefit claims is solely based on the arguments contained in the IPR Petition regarding problems with PO’s current priority benefit claims.” Mot., 7-8. However, the fact that the impetus for the correction sought was first raised by Petitioner is irrelevant to

whether the requirements for correction have been met. As is true in life generally, a mistake made by one is often first recognized by another.

For the reasons above, the Board should deny Petitioner’s attempt to prevent Patent Owner from seeking correction with the Petitions and Correction Branches. *See e.g., Kaidi LLC v. Limoss US, LLC*, IPR2019-01184, Paper 8 at 3 (PTAB July 19, 2019) (explaining in an order entered prior to institution, “we are persuaded that Patent Owner may seek correction of the challenged patent’s priority date We recognize that these Branches are responsible for making such corrections.... [W]e are not persuaded that briefing is appropriate concerning the merits of the petitions.”); *Motif Foodworks*, IPR2023-00206, Paper 15 at 6 (granting leave to seek correction, as there was “sufficient basis supporting Patent Owner’s position that the mistake may be correctable,” and refusing to consider petitioner’s merits-based arguments).²

² Petitioner also requests that the Board exert jurisdiction over “related matters,” in addition to exerting jurisdiction over the ’849 patent. Petitioner did not seek, and the Board did not grant, permission to request relief as to “related matters.” Ex. 1033. To the extent the “related matters” refer to anything other than the ’848 and ’896 patents, Petitioner provides no basis for the Board exerting jurisdiction over patents and applications that are not directly challenged in the IPR petitions.

C. The Board Should Deny the Request for a Stay.

Petitioner requests that the Board stay the CoC Request and related matters pending its decision on institution. Motion, 9-10. Petitioner argues that a stay could help avoid “potentially conflicting outcomes” and that allowing a correction would be unfair because “Petitioner relied on the priority benefit claims” in preparing its IPR Petition. Both of these complaints are moot given that Patent Owner will not be relying on the CoC Requests as the basis for denying institution. Moreover, these same purported concerns have not stopped the Board from allowing the PTO to consider the merits of requests for correction both before and after institution. *See e.g., Kaidi LLC*, IPR2019-01184, Paper 8 at 3; *Motif Foodworks*, IPR2023-00206, Paper 15 at 6; *ipDataTel*, IPR2018-01822, Paper 19 at 16. The Board could also benefit from any additional findings or conclusions of the Petitions Branch in analyzing any renewed CoC Requests, even if it were appropriate for the Board to decide the merits.

Moreover, entering a stay would prevent Patent Owner from correcting numerous other issued patents and pending applications, because they claim priority through the '896 patent. It would be manifestly unfair to prevent Patent Owner from making corrections to the patents and applications not at issue in these or any other proceeding, particularly given the pending expiration of the family and the fact that Patent Owner will **not** rely on any the proposed corrections as the basis for denying institution. Further, Patent Owner offers a contingent stipulation below to eliminate the

only purported prejudice complained of by Petitioner, further weighing against a stay.

D. Patent Owner's Contingent Stipulation Moots the Alleged Prejudice

The Motion should be denied for the reasons above. However, if the Board is inclined to grant the Motion, Patent Owner is willing to enter a stipulation to eliminate the only purported prejudice that Petitioner raises in its Motion—namely that Petitioner prepared its Petition assuming that the challenge claims would only being entitled to rely on the provisional application for written description support as of Nov. 24, 2010 or later. Patent Owner stipulates that at no point in this proceeding—either before or after institution—will it advance the position that the provisional application may be relied on for written description support before Nov. 24, 2010.³ This stipulation is only effective if the Board determines it would grant the Motion absent such stipulation.

Dated: December 23, 2024

Respectfully submitted,

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³ Petitioner's request that Patent Owner be ordered to submit all briefing related to the CoC Request to the Petitions Branches is also moot. Motion, 10. Patent Owner will be submitting the briefing in any renewed CoCs and has already explicitly informed those branches of these IPRs. Petitioner's request for the Board to "restrict PO's filings" (*id.*) should be denied for the same reasons set forth in Section III.A-D.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on December 23, 2024, the foregoing document was served via electronic mail on the following attorneys of record at the indicated e-mail address, which Petitioner has consented to electronic service for:

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