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.

IPR2024-01350
Patent 10,719,848

PETITIONER'S MOTION SEEKING RELIEF REGARDING PATENT OWNER'S CERTIFICATE OF CORRECTION

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Pursuant to the Board's December 9, 2014 e-mail (EX1033), Petitioner files this motion in relation to the request for certificate of correction ("CoC Request") (EX1034) and related matters (EX1035; EX1036) filed by Patent Owner ("PO").

Petitioner notes the "Transactions" tab on Patent Center for U.S. Patent No. 10,719,848 shows "Petition Decision – Granted" and "Petition Decision – Dismissed" activity on December 12, 2024 but no documents are available at the time of this filing. To the extent PO's CoC Request has been granted, Petitioner requests the Board stay issuance of the certificate of correction in the '848 patent pending an institution decision here and order reconsideration of such a certificate.[1]

I. BACKGROUND

On November 22, 2024, without prior notice, PO filed a CoC Request seeking to amend the specification to newly claim the benefit of certain prior-filed applications. PO asserted in an accompanying petition to accept unintentionally delayed benefit claims ("Supporting Petition") that it intended for the specification to include the benefit claim that it currently recites (i.e., it intended for what is recited

[1] Under its duty of candor and good faith, PO should be keeping the relevant USPTO branches, the Board, and Petitioner apprised of all developments related to the CoC Request, including notifying the relevant USPTO Branches regarding the ongoing briefing at the Board related to the CoC Request.

without any correction), but that Petitioner's IPR put it on notice that there were "arguments against the benefit claim of the present application." EX1035 at 1-2; *see also id.* at 10-11 (¶¶5-6, PO attorney declaration stating that the specification's priority claim was intentionally drafted but a correction should be allowed because the attorney was unaware of a potential argument regarding priority).

II. RELIEF REQUESTED

Petitioner moves the Board to (1) exercise exclusive jurisdiction over, and stay, PO's CoC Request and related matters; and (2) order that PO shall not file any papers with the USPTO with respect to the '848 patent while the above-identified IPR is pending without the Board's prior authorization, except for papers filed directly with the Board in the above-identified IPR that do not require authorization. To the extent Petitioner PO's CoC Request was granted in the period between when Petitioner sought relief from the Board and the filing of this motion, Petitioner requests the Board stay issuance of the certificate of correction in the '848 patent pending an institution decision here and order reconsideration of such a certificate.

PO filed substantively identical requests in related patent applications: U.S. Application Nos. 14/175,811, 16/660,633, 17/199,355, 18/076,327, 18/741,696, and 18/892,291 ("Related Applications"). Petitioner requests that PO also be ordered to submit all briefing related to these issues to the USPTO's Certificate of Correction ("CoC") Branch and Petitions Branch under PO's duties of candor and good faith.

III. THE BOARD HAS AUTHORITY TO EXERCISE EXCLUSIVE JURISDICTION

During pendency of an *inter partes* review ("IPR") proceeding involving a patent, the Director has authority to determine the manner in which the IPR, and any other matters involving the patent, are to proceed including whether to stay another proceeding/matter before the Office involving the patent. *See* 35 U.S.C. § 315(d). This authority has been delegated to the Board. *See* 37 C.F.R. § 42.3(a) ("The Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order."); *see also* 37 C.F.R. § 42.122(a). The Board's discretion to exercise exclusive jurisdiction over other matters/proceedings before the Office involving the patent begins with the filing of a petition for IPR. *See* § 42.3(a) (providing Board authority to exercise exclusive jurisdiction "during the proceeding"), § 42.2 (defining "proceeding" as a "trial or preliminary proceeding," and "preliminary proceeding" as "begin[ning] with the filing of a petition for instituting trial").

Therefore, once an IPR petition is filed, even pre-institution the Board may exercise jurisdiction over a request for a certificate of correction and any related papers for the involved patent, and may stay the request. *See Emerson Electric Co. v. Sipco, LLC*, IPR2016-00984 ("*Emerson*"), Paper 52 at 22 (Jan. 24, 2020); *Emerson*, Paper 10 at 3-4 (July 27, 2016); *Alarm.com Inc. v. Vivint, Inc.*, IPR2016-00116, Paper 9 at 3-5, 8-9 (Jan. 28, 2016); *see also ipDataTel, LLC v. ICN*

Acquisition, LLC, IPR2018-01822, Paper 19 at 15-16 (Apr. 22, 2019) (discussing Rule 42.3 and noting petitioner did not ask Board to exercise exclusive jurisdiction).

Here, Petitioner filed its IPR Petition (Paper 1) challenging claims of the '848 patent on August 26, 2024. Paper 3 at 1. PO filed its CoC Request along with the Supporting Petition and petition for expedited review for making corrections to the '848 patent on November 22, 2024, after the filing of the IPR Petition. *See* EX1037; EX1034, 3; EX1035, 4; EX1036, 2. Accordingly, the Board has the authority to exercise exclusive jurisdiction over, and stay, the CoC Request and related matters. 35 U.S.C. § 315(d); 37 C.F.R. §§ 42.3, 42.122.

IV. THE BOARD SHOULD EXERCISE EXCLUSIVE JURISDICTION OVER, AND STAY, THE CoC REQUEST AND RELATED MATTERS INVOLVING THE PATENT-AT-ISSUE IN THE IPR

PO's CoC Request and related matters should be stayed pending a decision on institution of this IPR. The USPTO's Certificate of Correction Branch and/or Petitions Branch (collectively, "USPTO Branches") would benefit from considering Petitioner's positions regarding why PO's CoC Request and Supporting Petition should be dismissed, prior to adjudicating them. Those USPTO Branches would further benefit from any guidance the Board may provide in its decision on institution of the IPR. A stay would also promote efficiency and good patent policy.

A. PO Admittedly Made a Deliberate Choice With Its Original Benefit Claims, and Cannot Now Claim the Delay Was "Unintentional"

By way of background, the IPR Petition noted that to the extent U.S.

provisional application no. 60/574,836 ("'836 provisional application") could arguably provide support for the challenged claims of the '848 patent, its 2004 filing date cannot be relied upon by PO. Paper 1 at 32-33.[2] This is because the '848 patent's priority chain does not include continuity of disclosure of the '836 provisional application back to 2004 as required for written description support. *Id.* In response, PO now seeks to update its benefit claims to add another patent application that was not part of the '848 patent's original priority chain, namely U.S. patent application no. 12/283,353 ("the '353 application"). *Compare* EX1001, cover (Related U.S. application data section), 1:6-17, *with* EX1034, 1-2; EX1035, 2. But PO fails to demonstrate that its delay in correcting its benefit claims was unintentional. To the contrary, PO effectively concedes the delay was intentional.

Unintentional Delay Standard

"Section 711.03(c) of the [MPEP] discusses the 'unintentional' delay standard with respect to petitions to revive an abandoned application, but its discussion of the 'unintentional' delay is generally applicable to any petition under the 'unintentional' delay standard." *See Clarification of the Practice for Requiring Additional*

[2] This is independent of Petitioner's argument that the priority applications including the '836 provisional application, even if considered, do not provide written description support for the claims. Paper 1 at 12-13.

Information in Petitions Filed in Patent Applications and Patents Based on Unintentional Delay, 85 FR 12222, 12223 (March 2, 2020). The unintentional delay standard cannot be met under 37 C.F.R. § 1.78(e) if the entire delay is not unintentional. *Id.* (citing MPEP 711.03(c)); *In re Rembrandt*, 899 F.3d 1254, 1273-74 (Fed. Cir. 2018) (applying PTO's unintentional delay standard in abandonment context).

A delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay. *See* MPEP 711.03(c), subsection II.C. Similarly, an intentional delay resulting from a deliberate course of action is not affected by the discovery of new information or evidence, or other change in circumstances. *See* MPEP 711.03(c), subsection II.D; *see also id.*, subsection II.C ("Likewise, a change in circumstances that occurred subsequent to [the passing of the window to timely submit a priority benefit claim] does not render 'unintentional' the delay resulting from a previous deliberate decision to [submit a different priority claim]. These matters simply confuse the question of **whether** there was a deliberate decision . . . with **why** there was a deliberate decision . . ." (emphases added)).

PO Fails to Demonstrate Unintentional Delay

In the present case, PO's own statements and those of its prosecution attorney demonstrate that the current priority benefit claim of the '848 patent was deliberately and carefully chosen. The only reason PO provides for correcting the priority benefit

claim at this juncture is to address arguments contained in the IPR Petition. Thus, PO cannot claim that the delay in correcting the priority benefit claims in the '848 patent was unintentional.

For example, with reference to Exhibit A of PO's filing (EX1035, 5) which purports to show the U.S. family of the '848 patent (*id.*, 1), PO states the following regarding the current priority benefit claims in U.S. application no. 16/660,615 ("'615 application") which issued as the '848 patent: "the . . . . '615 . . . application[] only included a single priority claim path before the '811 application," and "[t]hat path was to U.S. Patent Apps. Nos. 13/914,870 to 12/954,604 to 11/139,330 to 60/574,836." EX1035, 3; *see also id.*, 9-10 (¶3, PO's prosecution attorney confirming the same). PO's prosecution attorney provides a detailed explanation regarding the intentional and deliberate course of action PO undertook:

> [I]t had also been **my intention**, **and always my belief**, that the applications filed after the ['836] Provisional **would also be entitled to rely on the Provisional for additional written description support** based on its incorporation-by-reference into each of those applications. **The priority chain for the . . . '615 . . . Application[] was proposed by me based on this understanding**, and priority was **not additionally perfected to other applications in the same family** that also expressly incorporate the Provisional by reference.

EX1035, 10 (¶5, emphasis added); *see also id.*, 12 (¶7).

PO and its prosecution attorney further explain 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. *Id.*, 1-2 ("Applicant first became aware of arguments against the benefit claim of the present application after detailed analysis of the [IPR Petition] . . . ."); *id.*, 3 ("Applicant became aware of unintentional omissions in the benefit claim of the ['615 application] after detailed analysis of the [IPR Petition]."); *see also id.*, 10-11 (¶¶4, 6). For instance, PO's prosecution attorney states that he "would have proposed a [different] priority chain" had he been aware of the arguments in the IPR petition. *Id.*, 10-11 (¶6).

PO and its prosecution attorney's statements demonstrate that a deliberate choice regarding the priority benefit claim was made at the time of filing and the discovery of new information or evidence (e.g., in light of the IPR Petition) cannot serve as a basis for correcting the defective priority benefit claims at this time. MPEP 711.03(c), subsections II.C through D. Accordingly, the Supporting Petition should not be granted (and thereby the CoC Request should be rendered moot).

The Petitions Branch should further scrutinize the extended nature of PO's delay given the lack of "explanation of the circumstances surrounding the delay that establishes that the entire delay was unintentional" given it "create[d] uncertainty and unpredictability relating to patent rights," as demonstrated by the issues raised in the IPR Petition. 85 FR 12222, 12223. Granting the Supporting Petition here would also allow PO to impermissibly alter the continuity of disclosure in its priority claim such that the '836 provisional would be part of the '848 patent's disclosure as

early as 2008. *See, e.g.*, Paper 1 at 32-33; EX1035, 10-12 (¶¶6-7). USPTO procedure expressly provides that the Supporting Petition should not be granted "where the grant of the petition would alter the continuity chain in a way that may impact patentability, e.g., the altered chain would require evaluation of whether the continuity of disclosure requirement is satisfied." MPEP 1481.03, subsection II.

The Board Should Stay the CoC Request and Related Matters

The Board should stay PO's CoC Request and related matters pending its decision on institution to "avoid[] potentially conflicting outcomes between proceedings before different authorities within the Office, such as a decision by the Certificates of Correction Branch on a request for a certificate of correction and a decision by the Board in an *inter partes* review." *Emerson*, Paper 52 at 22. Indeed, given the plain admissions regarding its deliberate choice to pursue the current priority benefit claims until it became aware of its defective nature in the IPR Petition, PO should not be afforded the opportunity to attempt to fix its priority benefit claims prior to institution. Allowing the CoC Request and related matters to proceed could potentially create a moving target for Petitioner. *Id.* at 22-23 ("A stay or prohibition of filing a certificate of correction also prevents a moving target during an [IPR] for the parties and for the Board, which must issue a final determination within one year of instituting trial.") Petitioner relied on the priority benefit claims and painstakingly analyzed them in preparing its IPR Petition, and it should not be

penalized for identifying defects in the priority chain that PO should have reviewed and identified upon issuance of its patent (or at a minimum, before asserting the patent in litigation). *Id.* at 23 ("A lack of diligence by the patentee in correcting patent errors has potentially negative consequences for the public, who may allocate its affairs based on the patent as issued, unaware of any such error.").

V. THE BOARD SHOULD RESTRICT PO'S FILINGS

Petitioner moves the Board to order that PO shall not file any papers with the USPTO with respect to the '848 patent while this IPR is pending without the Board's prior authorization, except for papers filed directly with the Board that do not require prior Board authorization. The Board has ordered similar relief previously. *See, e.g.*, *Emerson*, Paper 10 at 4; *Alarm.com*, Paper 9 at 5-7, 9.

VI. PO SHOULD SUBMIT THE BRIEFING TO THE USPTO BRANCHES

The USPTO Branches would benefit from the briefing related to PO's CoC Request and Supporting Petition as they decide on them. *See Motif Foodworks v. Impossible Foods*, IPR2023-00206, Paper 15 at 7-8 (May 22, 2023); *Emerson*, Paper 20 at 3 (Dec. 15, 2016). Petitioner thus moves the Board to order PO to promptly submit all briefing related to the CoC Request and Supporting Petition to the CoC and Petitions Branches with respect to the '848 Patent and the Related Applications.

VII. CONCLUSION

Petitioner respectfully requests that the Board grant the requested relief.

Respectfully submitted,

Dated: December 16, 2024

By: /Naveen Modi/
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CERTIFICATE OF SERVICE

I hereby certify that on December 16, 2024, I caused a true and correct copy of the foregoing Petitioner's Motion to be served electronically on counsel for Patent Owner at the following addresses:

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By: /Naveen Modi/
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