

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTIVISION BLIZZARD, INC.,
Petitioner,

v.

MILESTONE ENTERTAINMENT, LLC,
Patent Owner.

IPR2025-00713
Patent 11,501,607 B2

Before LINDA E. HORNER, JAMES A. TARTAL, and
SCOTT C. MOORE, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

ORDER
Granting Withdrawal of Ground from Petition
37 C.F.R. § 42.5(a)

I. INTRODUCTION

Activision Blizzard, Inc. (“Petitioner”) filed a Petition to institute *inter partes* review of claims 1, 2, 4, 6, 7, 11, 15, and 19 of U.S. Patent No. 11,501,607 B2 (Ex. 1001, “the ’607 patent”). Paper 1 (“Pet.”). Milestone Entertainment, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Specifically, Petitioner asserts that the challenged claims are unpatentable based on the following grounds (Pet. 4–5):

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1, 2, 7, 11, 15, 19	103(a)	Kelly ²
4, 6	103(a)	Kelly, Paulsen ³
1, 2, 4, 6, 7, 11, 15, 19	103(a)	Walker ⁴ , Schneier ⁵

Petitioner relies on the declaration testimony of Mr. Dwight Crevelt (Ex. 1003) in support of the asserted grounds.

Upon review of the Petition, the Board noted a defect in the third ground of unpatentability based on Walker and Schneier. Specifically, the

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. Because the challenged patent has an effective filing date before March 16, 2013, we refer to the pre-AIA version of § 103.

² Ex. 1005, US 8,172,683 B2, issued May 8, 2012, filed March 23, 2006 (“Kelly”). Petitioner asserts that Kelly qualifies as prior art under 35 U.S.C. §§ 102(a) and 102(e). Pet. 4 n.1.

³ Ex. 1007, US 2005/0153768 A1, published July 14, 2005, filed January 8, 2004 (“Paulsen”). Petitioner asserts that Paulsen qualifies as prior art under 35 U.S.C. § 102(e). Pet. 4 n.2.

⁴ Ex. 1006, US 2004/0002369 A1, published January 1, 2004, filed May 1, 2003 (“Walker”). Petitioner asserts that Walker qualifies as prior art under 35 U.S.C. §§ 102(a) and 102(e). Pet. 5 n.3.

⁵ Ex. 1008, US 5,970,143, issued October 19, 1999, filed August 8, 1996 (“Schneier”). Petitioner asserts that Schneier qualifies as prior art under 35 U.S.C. §§ 102(a) and 102(e). Pet. 5 n.4.

Petition and Mr. Crevelt's Declaration both fail to address the Walker and Schneier references in the analysis of limitation [1.e] directed to a "decision engine." Pet. 65 (addressing the Kelly reference instead of Walker/Schneier); Ex. 1003 ¶ 224 (same). The Board held a call with the parties on October 1, 2025, to discuss this defect.

During the call, Petitioner acknowledged the error and sought either leave to amend the third ground to correct the Petition under 37 C.F.R. § 42.104(c), or to withdraw the third ground from the Petition. Given the impending institution due date, we heard arguments from the parties on the merits of these options during our call. Patent Owner opposed correction of the Petition, but did not oppose withdrawal of the third ground. During the call, we granted Petitioner's unopposed motion to withdraw the third ground from the Petition. We denied, however, authorization for Petitioner to move to correct the Petition under 37 C.F.R. § 42.104(c). This Order memorializes our rulings.

II. ANALYSIS

A. Withdrawal of Third Ground

Because it is unopposed, we grant Petitioner's unopposed motion to withdraw this ground of unpatentability from the Petition.

B. Request to Correct Petition under 37 C.F.R. § 42.104(c)

An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104 (2018). The purpose of the petition filing is to give adequate notice to the patent owner of the basis for relief by laying out the petitioner's grounds and supporting evidence. See Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) ("Consolidated Trial

Practice Guide”), available at <https://www.uspto.gov/TrialPracticeGuide> Consolidated, at 42.

In an *inter partes* review, “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); see also 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”); 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art relied upon).

Our rules provide that “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition.” 37 C.F.R. § 42.104(c) (2018). This rule allows errors to be corrected in certain circumstances without changing the filing date of the petition. When deciding whether to allow correction, the Board has considered various non-exclusive factors such as:

- (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) (Institution Decision). We address each factor in turn.

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

The error omits any showing of where limitation [1.e] of claim 1 is found as to Walker and Schneier in either the Petition or Mr. Crevelt's Declaration. Pet. 65; Ex. 1003 ¶ 224. Petitioner explained that the error occurred because Petitioner looked at the wrong grounds when copying over the analysis from related petitions into this Petition. Neither party brought the error to the attention of the Board; rather, the Board discovered the error and brought it to Petitioner's attention.

Given that this error is more than a mere typographical error in that the Petition and Mr. Crevelt's declaration fail to put Patent Owner on notice in this proceeding of the basis for where each element of the claim is found in Walker and Schneier for the third ground, and given that Petitioner did not discover the error and seek to correct it earlier, this factor disfavors allowing Petitioner to correct the Petition at this stage of the proceeding.

2. the length of time elapsed between learning of the error and bringing the error to our attention

As noted above, Petitioner presumably discovered the error when it was contacted by the Board to arrange for the call with the parties to discuss the defect in the Petition. Thus, this factor is not relevant to our inquiry.

3. prejudice to the other party, if any, by allowing the proposed corrections

During our call, Petitioner asserted that Patent Owner would not be prejudiced because Patent Owner is aware of Petitioner's position as to Walker's asserted disclosure of a "decision engine" based on the analyses presented in *inter partes* review petitions filed against related patents. Citing IPR2025-00708, IPR2025-00711, and IPR2025-00712. Patent Owner

already has filed its Preliminary Response, and a decision on institution is due in a matter of weeks. There is currently no mapping in either the Petition or Mr. Crevelt's Declaration for limitation [1.e] as to Walker/Schneier. Any correction of the error would necessarily involve Petitioner changing the mapping currently presented in the Petition and substantively amending the Petition and Mr. Crevelt's Declaration with a new legal analysis. Such an amendment would unfairly prejudice Patent Owner at this stage because there is insufficient time remaining before the Board's institution decision for Patent Owner to evaluate and respond to these new assertions and evidence.

Further, such substantive amendments exceed errors of a typographical nature that are typically permitted correction under 37 C.F.R. § 42.104(c)(3), bearing in mind that correction under this rule preserves the original petition's filing date.

For these reasons, this factor disfavors allowing Petitioner to correct the Petition.

4. whether the proposed corrections have any impact on the proceeding

As to the third ground, the proposed corrections have a substantive impact on the proceeding. Without the proposed correction, the third ground of the Petition omits any showing of where limitation [1.e] of claim 1 is found in Walker and Schneier. Thus, the Petition fails to set forth a showing sufficient for institution on the third ground. Allowing correction of the Petition would cure this defect, leaving open the possibility that the Petition otherwise meets the showing necessary for institution as to this ground. For these reasons, this factor disfavors allowing Petitioner to correct the Petition at this late stage.

5. Conclusion

Considering the factors discussed above, we do not grant leave for Petitioner to seek to amend the third ground of its Petition under 37 C.F.R. § 42.104(c).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is not authorized to file a motion seeking leave to correct the Petition under 37 C.F.R. § 42.104(c); and

ORDERED that Petitioner's unopposed motion to withdraw the third ground from the Petition is GRANTED.

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