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Subject: PGR2025-00086 - urgent request to stay unauthorized COC request
Date: Tuesday, November 18, 2025 2:32:00 PM

Dr. Falk Pharma GmbH v. Ellodi Pharmaceuticals, L.P.

PGR2025-00086 – U.S. 12,290,598

Dear Director Squires,

Patent Owner filed a request for Certificate of Correction (COC) in the patent subject to the above-captioned PGR on October 14, 2025 without seeking the required authorization from the Board and without notifying Petitioner in violation of 37 C.F.R. § 42.3. See *Emerson Elec. Co. v. SIPCOT LLC*, IPR2016-00984, Paper 52 at 6, 10-11, 21-22 (PTAB 2020); 2019 Trial Practice Guide at 8-9. Patent Owner's request for COC did not notify the COC Branch that a PGR is pending.

Patent Owner must seek Board permission to file a COC during the pre-institution phase of a PGR so that the Board can ensure that the patent is consistently managed throughout the Office. *Emerson*, Paper 52 at 10-11, 21-22. When a Patent Owner seeks permission to file a COC during the pre-institution phase, the Board may waive the need to file a motion under 37 C.F.R. § 1.323, but the Board's authorization is still required. *Id.* at 21-22; *Google LLC v. Sonos, Inc.*, IPR2021-00475, Paper 6 at 2 (PTAB 2021).

Petitioner urgently requests that the Board exercise its exclusive jurisdiction over the patent to stay the pending request for COC until the COC Branch has been provided with:

- (1) A copy of the PGR petition; and
- (2) The following statement on Petitioner's position: It is Petitioner's position that the request for COC should be denied because a COC is unavailable for applicant errors that are not of minor character. See 35 U.S.C. § 255; MPEP § 1481. "A mistake is not considered to be of the 'minor' character required for the issuance of a certificate of correction if the requested change would materially affect the scope or meaning of the patent." MPEP § 1481. Here, Patent Owner seeks to materially affect the scope of the claims by changing the claimed hardness range from "4-48 N" to "8-48 N," therefore its request for COC should be denied.

See *Emerson*, Paper 52 at 6, 22 (staying unauthorized COC); *ASM IP Holding B.V. v. Kokusai Elec. Corp.*, IPR2019-00378, Paper 17 at 5-6 (PTAB 2019) (ordering Patent Owner to provide COC Branch with IPR petition and parties' positions); *Google*, Paper 6 at 3.

Petitioner's request is urgent in view of the immediate potential for the COC Branch to make a decision on Patent Owner's unauthorized COC request without a full understanding of the circumstances at issue. Patent Owner's reliance on *Edwards* (below) demonstrates the urgency of Petitioner's request because there the Board did not disturb a COC that was

granted upon an unauthorized request. See *Edwards Lifesciences Corp. v. Evalve, Inc.*, IPR2019-01285, Paper 19 at 5-8 (PTAB 2020). Here, Patent Owner's violation of the Board's rules should not be so rewarded. Patent Owner's reliance on *ipDatatel* (below) is readily distinguishable because that petitioner did not ask the Board to exercise its exclusive jurisdiction over the patent, whereas this Petitioner makes that request via this email. *ipDatatel, LLC v. ICN Acquisition, LLC*, IPR2018-01822, Paper 19 at 15-16 (PTAB 2019).

Patent Owner's Position: Patent Owner properly filed the pending request for Certificate of Correction and no motion was required because the '598 patent is not yet involved in a "trial." 37 C.F.R. § 1.323; *ipDatatel, LLC et al. v. ICN Acquisition, LLC*, IPR2018-01822, Paper 19 (PTAB April 22, 2019). 37 C.F.R. § 1.323 does not require authorization through motion practice prior to institution. § 1.323 requires a request to be accompanied by a motion **only** "[i]f the request relates to a patent involved in a[] ... **trial** before the Patent Trial and Appeal Board." (emphasis added). Because a decision on institution has yet to issue in PGR2025-00086, the '598 patent is not involved in a "trial" before the Board, and the request for Certificate of Correction did not invoke the requirement for motion practice to the Board. See *ipDatatel*, Paper 19 at 14-16. In other cases, the Board has rejected Petitioner's argument that, once an IPR petition is filed, the patent owner must receive Board authorization prior to filing a request for certificate of correction. *Edwards Lifesciences Corp. v. Evalve, Inc.*, IPR2019-01285, Paper 19 at 6-8 (PTAB Jan. 9, 2020). Because there is no trial, the Board is not obligated to exercise jurisdiction. See 37 C.F.R. § 42.3 "[t]he Board *may* exercise exclusive jurisdiction within the Office over every involved application and patent during [a] proceeding, as the Board may order." (emphasis added)

Further, as outlined in Patent Owner's request for Certificate of Correction, the correction is clerical or typographical in nature and supported by the prosecution history. It is clear that Patent Owner inadvertently introduced "4-48 N" instead of "8-48 N" in its claim amendments during prosecution, and the correction will not materially alter the scope of the patent as Petitioner suggests. Additionally, none of the authority Petitioner cites to allows it to present its statement against the correction to the COC Branch. Instead, the proper avenue for Petitioner to raise its concerns is in its response to Patent Owner's Brief Requesting Discretionary Denial. Patent Owner therefore opposes Petitioner's request.

The parties have met and conferred via email. As indicated in the above two paragraphs, Patent Owner opposes Petitioner's request. The parties are available for a teleconference to discuss this matter on Monday Nov. 24 from 12-5pm ET, and Tuesday Nov. 25 from 1-4pm ET.

Sincerely,
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