

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VARIAN MEDICAL SYSTEMS, INC.,
Petitioner,

v.

BEST MEDICAL INTERNATIONAL, INC.,
Patent Owner.

IPR2020-00075
Patent 6,038,283

Before KARL D. EASTHOM, WILLIAM V. SAINDON,
and JOHN A. HUDALLA, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION

Denying Motion to Correct Petition

37 C.F.R. § 42.104(c)

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

As authorized by our Order of November 13, 2019 (Paper 4), Petitioner filed a Motion to Correct a Clerical Error and Show Proper Service of the Petition on November 18, 2019 (Paper 5, “Motion” or “Mot.”). With the Motion, Petitioner filed a proposed substitute Petition (Ex. 1037) challenging claims 1, 6, 10, and 22–24 of U.S. Patent No. 6,038,283 A, Ex. 1001 (the “283 patent”). Patent Owner opposed the Motion on November 25, 2019 (Paper 8, “Opposition” or “Opp.”).¹

While filing all of its initial papers on October 18, 2019, Petitioner did not file an actual petition and instead mistakenly filed a copy (Paper 2) of its Power of Attorney (Paper 1). *See* Mot. 4–5; Ex. 1038 ¶ 8. The duplicate Power of Attorney (Paper 2) was incorrectly designated as a “[p]etition” in PTAB’s filing system. *See* Ex. 1038 ¶ 8.

Petitioner argues that mistakenly filing a duplicate Power of Attorney in lieu of a petition represents a “clerical . . . mistake in the petition” under 37 C.F.R. 42.104(c). *See id.* at 4–5. As such, Petitioner moves “to correct a clerical . . . mistake in the petition” by filing the substitute Petition (Ex. 1037). *Id.* (quoting 37 C.F.R. § 42.104(c)).

Notwithstanding having originally filed a Power of Attorney as its petition, Petitioner also requests that the Board accord a filing date of October 18, 2019 to the substitute Petition (Ex. 1037) that Petitioner filed on November 18, 2019 with its Motion. *See id.* (noting that § 42.104(c) specifies “[t]he grant of such a motion does not change the filing date of the petition”).

¹ Paper 8 is a substitute Opposition. By e-mail, we authorized Patent Owner to file the substitute Opposition after Patent Owner filed an earlier Opposition (Paper 7) exceeding the authorized page limit in the Order. *See* Ex. 2009; Paper 8, ii.

On October 18, 2018, exactly a year prior to Petitioner’s mistaken filing of the duplicate Power of Attorney, Patent Owner served Petitioner with a complaint alleging infringement of the ’283 patent in *Best Medical International, Inc. v. Varian Medical Systems, Inc., and Varian Medical Systems International AG*, Case 1:18-cv-01599 (D. Del.). See Ex. 1037, 17; Paper 3, 2. Accordingly, October 18, 2019 constitutes the “1 year” deadline imposed by 35 U.S.C. § 315(b). Therefore, absent the relief Petitioner seeks in its Motion, § 315(b) bars the substitute Petition filed on November 18, 2019. Indeed, the parties agreed during a teleconference that a filing date for a petition after October 18, 2019 would run afoul of the one-year statutory bar under 35 U.S.C. § 315(b). Order 2 (citing Paper 3); *accord* Opp. 1.

For the reasons set forth below, we determine that filing the duplicate Power of Attorney does not constitute a “clerical or typographical mistake in the petition” under 37 C.F.R. § 42.104(c). We also determine that Petitioner failed to file a petition according to statutory requirements in 35 U.S.C. §§ 311, 312(3) within the statutory period mandated by 35 U.S.C. § 315(b). Accordingly, we deny Petitioner’s Motion and deny institution of an *inter partes* review of the ’283 patent.

No material factual dispute exists on this record. On October 18, 2019, during the evening of the statutory deadline under § 315(b), Petitioner’s legal assistant began uploading documents supporting a petition challenging claims of the ’283 patent. See Motion 1–2; Ex. 1038 ¶¶ 5–6; Opp. 3. Petitioner’s counsel e-mailed the final PDF version of the petition to the legal assistant 11 minutes before the statutory deadline expired, namely, on “October 18, 2019 at 11:49 PM EDT.” Ex. 1038 ¶ 7. Then, the legal assistant mistakenly uploaded the wrong document, a duplicate Power of

Attorney (Paper 2), believing she instead had uploaded the petition. *See* Ex. 1038 ¶¶ 8–10. She then “received a [p]etition receipt dated October 18, 2019 23:51:04” even though she had uploaded a duplicate Power of Attorney. *See id.* ¶ 9; Paper 2 (duplicate Power of Attorney as purported petition). Three days later, “Petitioner first became aware that a duplicative Power of Attorney had been uploaded as the [p]etition paper.” Mot. 2 (citing Ex. 1039 ¶ 9).

In summary, according to Petitioner, “all documents in IPR2020-00075 were filed on October 18, 2019, but for a clerical error that resulted in the accidental filing of a duplicative Power of Attorney document as Paper 2 *instead of the correct [p]etition document.*” Mot. 4 (citing Ex. 1038 ¶ 12) (emphasis added). Petitioner’s legal assistant testifies “[i]n retrospect . . . I appear to have committed a clerical error as a result of identifying the incorrect document within the shared drive folder that contained both the correct [p]etition . . . and the Power of Attorney.” Ex. 1038 ¶ 12. In other words, Petitioner effectively concedes that it did not file a petition (i.e., “the correct petition document”) prior to the § 315(b) deadline. *See* Mot. 4.

Patent Owner responds in Opposition that 37 C.F.R. § 42.104(c) does not apply here. Opp. 1, 4. Patent Owner characterizes Petitioner’s efforts to file a petition as “wait[ing] until the last day to attempt to institute an [*inter partes* review] on” the ’283 patent, and asserts that this “procrastination resulted in fatal flaws.” *Id.* at 1. Patent Owner also asserts that Petitioner did not file a petition prior to the “1 year” deadline imposed by § 315(b), and “the Board lacks the authority to waive the statutory time-bar.” *Id.* at 10; *see also id.* at 2–5.

An *inter partes* review proceeding begins with the filing of a petition. *See* 35 U.S.C. §§ 311, 312, 314. This filing provides adequate notice to a patent owner of the basis for relief by laying out a petitioner’s grounds and supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012) (“Trial Practice Guide”) (“Proceedings begin with the filing of a petition. The petition lays out the petitioner’s grounds for review and supporting evidence, on a claim-by-claim basis, for instituting the requested proceeding.”). The Trial Practice Guide explains “[g]enerally, the standards required *for a petition are those set by statute* for the proceeding requested.” *Id.* (citing 35 U.S.C. § 312(a)) (emphasis added).

Under 35 U.S.C § 312(a), “[a] *petition filed under section 311 may be considered only if*” it meets certain conditions. 35 U.S.C. § 312(a) (emphasis added). Particularly, under § 312(a)(3), the petition must “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.”

By filing the duplicate Power of Attorney instead of a petition on October 18, 2018, Petitioner failed to satisfy the statutory requirements listed under 35 U.S.C. § 312(a)(3). And as noted above, under § 312(a), “[a] petition filed under section 311 may be considered *only if*” (emphasis added) it satisfies those statutory requirements. Accordingly, Petitioner failed to file a petition satisfying the requirements of §§ 311, 312(a)(3) before the 1 year deadline imposed by § 315(b).

Nevertheless, as noted above, Petitioner seeks relief under 37 C.F.R. § 42.104(c). Under § 42.104(c), as Petitioner argues, “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition”

and “[t]he grant of such a motion does not change the filing date of the petition.” Mot. 4 (quoting 37 C.F.R. § 42.104(c)). As also noted above, Petitioner argues “all documents in IPR2020-00075 were filed on October 18, 2019, but for a clerical error that resulted in the accidental filing of a duplicative Power of Attorney document as Paper 2 instead of the correct [p]etition document.” *Id.* (citing Ex. 1038 ¶ 12). Petitioner further relies on nonprecedential Board decisions, such as *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21 at 6–7 (PTAB Jan. 16, 2013) (single judge decision on motion holding the filing of the *wrong* petition constitutes a correctible clerical error under Rule 104(c)). *See id.* at 4–5.²

Patent Owner contends that § 42.104(c) does not apply here, because Petitioner does not show a mistake in a *filed petition*. *See* Opp. 4–5. We agree. As Patent Owner argues, 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**” and “[t]he grant of such a motion **does not change the filing date of the petition.**” *See id.* at 4 (quoting 37 C.F.R. § 42.104(c)) (emphasis by Patent Owner). With reference to this language in the regulation, Patent Owner persuasively explains why 37 C.F.R. § 42.104(c) does not apply here:

² In addition to *ROY-G-BIV*, Petitioner cites the following two Board cases: *Cordelia Lighting, Inc. v. Cooper Lighting, LLC*, IPR2017-01860, Paper 13 (PTAB Oct. 24, 2017); and *Smart Modular Techs. Inc. v. Netlist, Inc.*, IPR2014-01373, Paper 9 (PTAB Sept. 17, 2014), Paper 12 (PTAB Sept. 22, 2014), Paper 13 (PTAB Sept. 24, 2014). *See id.* *Cordelia Lighting* relies on *ROY-G-BIV* as persuasive authority based on similar factual records. *Cordelia Lighting*, Paper 13 at 6. *Smart Modular* did not reach a decision on 37 C.F.R. § 42.104(c), but denied institution for other reasons. *See Smart Modular*, Paper 12 (motion to correct clerical error); *id.*, Paper 16 (decision denying institution without addressing the motion).

[Petitioner]’s problems are not found “*in the petition,*” as the rule requires. *See* [37 C.F.R. § 42.104(c)]. Instead, [Petitioner]’s problems result from a failure to file the petition in the first place. This distinction is even noted in the rule – by overtly stating that granting such a motion “does not change *the filing date* of the petition.” *Id.*, *see also* 35 U.S.C. §§ 311, 312, 314, 315.

Opp. 4 (quoting 37 C.F.R. § 42.104(c)) (emphasis by Patent Owner). Under the particular facts of this case involving no timely filed petition, we decline to apply the correction provision of § 42.104(c) petition.

The Motion provides a string citation to *ROY-G-BIV* and other nonprecedential Board cases (*see supra* note 2) to support Petitioner’s argument that “[s]imilar clerical errors that resulted in the inadvertent filing of an incorrect document as the ‘Petition’ have been found correctable in other proceedings.” *See* Mot. 4–5. Nonprecedential Board cases do not bind Board panels, and Petitioner does not show persuasively that 37 C.F.R. § 42.104(c) applies to the different facts at issue here. Unlike *ROY-G-BIV*, the Petitioner in the present case did not file any petition on time.

For the reasons discussed above, Petitioner fails to satisfy its burden of proof on the Motion to correct a clerical or typographical mistake in a petition. Accordingly, we deny Petitioner’s Motion. As also discussed above, Petitioner filed the substitute Petition (Exhibit 1037) on November 18, 2019, after the 1 year deadline of October 18, 2019 imposed by § 315(b). Therefore, § 315(b) bars the substitute Petition. Accordingly, we deny institution.

ORDER

In light of the foregoing, we

ORDER that Petitioner’s Motion is *denied*; and

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FURTHER ORDER that institution based on the substitute Petition
(Ex. 1037) is *denied* and no trial is instituted.

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