

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SWEEGEN, INC.,
Petitioner,

v.

PURECIRCLE SDN BHD AND PURECIRCLE USA INC.,
Patent Owners.

PGR2020-00070
Patent 10,485,257 B2

Before SUSAN L. C. MITCHELL, JENNIFER MEYER CHAGNON, and
JAMIE T. WISZ, *Administrative Patent Judges*.

WISZ, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion to Correct Clerical Mistakes
37 C.F.R. § 42.104(c)

I. INTRODUCTION

Petitioner filed a Motion to Correct Clerical Mistakes under 37 C.F.R. § 42.104(c) on September 8, 2020. Paper 7 (“Mot.”). In the Motion, Petitioner requests permission to file Supplemental Declarations of Enrique Arevalo and Kim Friis Olsson “to correct clerical errors within the lab report submitted as part of the Declaration of Enrique Arevalo (Ex. 1010) and incorporated into the Declaration of Kim Friis Olsson (Ex. 1007).” *Id.* at 1. Patent Owner filed a response on September 14, 2020. Paper 8 (“Opp.”). Patent Owner opposes the motion arguing, *inter alia*, that “the proposed changes will have a substantial impact on these proceedings.” *Id.* at 1. For the following reasons, we deny the Motion.

II. THE PARTIES’ CONTENTIONS

1. *Petitioner’s Contentions*

According to Petitioner, in support of the Petition, they “commissioned Conagen and Spectrus to replicate Example 14 of PCT Publication No. WO 2011/153378 (‘Kishore’) for the purpose of demonstrating that the disclosed procedure would have necessarily produced Reb X (also known as ‘Reb M’).” Mot. 1 (citing Ex. 1007 ¶ 238). Spectrus’s testing results were documented in a report (the “Spectrus Report”), which was created by Enrique Arevalo of Spectrus using a software package called RStudio. *Id.* at 2. The Spectrus Report was attached as an exhibit to Enrique Arevalo’s Declaration (Ex. 1010) and the resulting concentrations of Reb A, Reb D, and Reb M were reported in both graph and table form. *Id.* (citing Ex. 1010, 10–14). The Petition and Spectrus Report were filed on June 22, 2020. *Id.* at 1.

According to Petitioner, on approximately July 14, 2020, one of Conagen's employees "noticed that the data for the 'experimental' yeast strain in Tables 5–7 and Figures 7 and 9 of the Spectrus Report did not match" and Enrique Arevalo subsequently "determine[d] that the executable code creating Tables 5–7 inadvertently linked the tables to the incorrect data cells within RStudio." Mot. 2 (citing Mot. Ex. A ¶¶ 8–9). Petitioner describes the error as follows:

Specifically, the data presented in Table 6 of the original Spectrus Report actually corresponded to the Reb A concentration and should have been in Table 5; the data presented in Table 7 of the original Spectrus Report actually corresponded to the Reb D concentration and should have been in Table 6; and data presented in the last three columns of Table 5 of the original Spectrus Report actually corresponded to the Reb M concentration and should have been in Table 7 (although shifted over one column). *Compare* Ex. 1010 and Proposed Exhibit 1043; *see also* Ex. B (redline).

Id. at 2–3.

Petitioner further contends that Enrique Arevalo corrected this error on July 16, 2020 but that Petitioner's expert, Kim Friis Olsson, who had incorporated Table 7 into his declaration, was on vacation and unavailable to review the corrected Spectrus Report until early August. Mot. 3. According to Petitioner, Kim Friis Olsson reviewed the corrected Spectrus Report on August 5, 2020, and Petitioner presented the proposed supplemental declarations to Patent Owner on August 12, 2020. *Id.*

Petitioner contends that they should be allowed to submit the Supplemental Declarations of Enrique Arevalo and Kim Friis Olsson because "the error was a clerical mistake limited to three isolated tables of the Spectrus Report." Mot. 4. Petitioner also asserts that, although there was a "slight delay between learning of the error and bringing the error to

the Board’s attention, this delay was the result of Kim Friis Olsson being on vacation and Petitioner seeking Patent Owner’s consent to submit the corrected report and supplemental declarations.” *Id.* Petitioner further contends that Patent Owner “will not be procedurally prejudiced by allowing Petitioner to submit the supplemental declarations” because Patent Owner still has “a nearly three-month window in which to prepare its preliminary response as of the date it was informed of the clerical error.” *Id.* Lastly, Petitioner asserts that the proposed corrections will not have any impact on the proceedings because Grounds 1–4 do not rely on the Spectrus Report and the tables being corrected represent a redundant presentation of the data. *Id.* at 5.

2. Patent Owner’s Contentions

Patent Owner contends that “the proposed changes will have a substantial impact on these proceedings” and “are far more substantive than changes that have been rejected by the Board in other cases.” Opp. 1. Patent Owner also contends that Petitioner unreasonably delayed informing them of these errors and that the proposed changes will cause prejudice. *Id.*

III. ANALYSIS

An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104 (2018). The purpose 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/TrialPracticeGuideConsolidated>, at 42. 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 sacrificing the notice function 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 consider each of these factors below.

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.*

With regard to the first factor, we find that the nature of the error is substantial because Petitioner seeks to change the data in three tables. Although Petitioner characterizes the data as simply being presented in the wrong tables, corrected Table 7 appears to include a column of new data for “Sample 72_M” that is not included in any of the original tables. *Compare* Ex. 1010, 9–10, *with* Proposed Exhibit 1043, 9–10; *see also* Mot. Ex. B, 9–11.

In addition, although Petitioner asserts that the original bar graphs included the correct data, it would not have been apparent from reviewing the original Spectrus Report which data—the bar graphs or tables—was

actually correct.¹ Furthermore, Petitioner's expert, Kim Friis Olsson, relies on and reproduces the incorrect Table 7 in his original Declaration. *See* Ex. 1007, 112.

Therefore, we determine that, even if the errors in the original Spectrus Report resulted from a clerical error, the proposed changes to the Spectrus Report and the proposed supplemental declarations are not mere clerical errors that may be corrected under Rule 104(c). Rather, the proposed changes present substantive new evidence.

Accordingly, we find that this factor weighs strongly in Patent Owner's favor.

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

Petitioner learned of the error on July 14, 2020 and corrected it on July 16, 2020. Mot. 2. Petitioner's expert was on vacation and unable to review the error until August 5, 2020. *Id.* at 2–3. Petitioner alerted Patent Owner to the error on August 12, 2020. *Id.* at 3. Petitioner contacted the Board on August 24, 2020.

Although there does appear to have been some delay in bringing the error to the Board's attention after learning of the error, we do not find this delay to be entirely unreasonable in this case, and therefore, we find that this factor is neutral.

¹ The bar graphs in Figures 8 and 9 of the original Spectrus Report were also mislabeled as "Reb A, Reb D, Red M" instead of "Reb D, Reb M," which causes further confusion. *See* Mot. Ex. B, 7.

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

As discussed above, Petitioner's proposed changes are substantive in nature; therefore, it would be prejudicial to Patent Owner to have to change their arguments at this point to account for the new data. A petition seeking *inter partes* review should be complete at the time it is filed in connection with the asserted grounds of unpatentability and the evidence and analysis offered in support thereof. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22, 42.104(b). Although clerical or typographical errors can be corrected under 37 C.F.R. § 42.104(c), this rule does not give a petitioner recourse to make substantial alterations to the petition or the evidence supporting the petition.

Accordingly, we find this factor weighs strongly in Patent Owner's favor.

4. *Whether the proposed corrections have any impact on the proceeding.*

According to Petitioner, the purpose of the testing presented in the Spectrus Report was to "demonstrat[e] that the disclosed procedure would have necessarily produced [Reb M]," in support of Petitioner's assertion that the claims of the challenged patent are anticipated by Kishore. Mot. 1, 5. Petitioner's proposed corrections would more than double the amount of Reb M that was shown to be produced in the experiment, thereby improving Petitioner's anticipation argument. *See* Opp. 3; Mot. Ex. B, 11. Therefore, the proposed changes substantially affect Petitioner's arguments and could have an impact on the proceedings.

Accordingly, we find this factor weighs strongly in Patent Owner's favor.

5. *Conclusion*

Considering the factors discussed above, we find that they weigh in favor of denying Petitioner's Motion to Correct Clerical Mistakes. For these reasons, Petitioner's Motion is *denied*.

ORDER

Accordingly, it is:

ORDERED that Petitioner's Motion to Correct Clerical Mistakes under 37 C.F.R. § 42.104(c) (Paper 7) is *denied*.

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