

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,
Petitioner,

v.

MONTEREY RESEARCH, LLC,
Patent Owner.

IPR2021-00120 (Patent 7,572,727 B2)
IPR2021-00121 (Patent 7,977,797 B2)¹

Before KRISTEN L. DROESCH, JOHN F. HORVATH, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, Administrative Patent Judge.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

A. INTRODUCTION

With our authorization (Paper 9),² Petitioner moves under 37 C.F.R. § 42.104(c) for leave to file corrected versions of the Petition (Paper 1) and Declaration (Ex. 1002), seeking to correct a misstatement repeated in each. Paper 10 (“Mot.”). Petitioner asserts the replacement papers will remedy a clerical error where Petitioner used the word “bottom” rather than “top” in a passage repeated several times in the Petition and Declaration: “bottom . . . is smaller than . . . bottom” would change to “bottom . . . is smaller than . . . top.” Mot. 1; *see* Ex. 1031 (version of desired corrected Petition showing redline changes), 44, 57, 85; Ex. 1032 (version of desired corrected declaration showing redline changes) ¶¶ 88, 226, 242, 295. Patent Owner opposes the corrections. Paper 11 (“Opp.”).

B. DISCUSSION

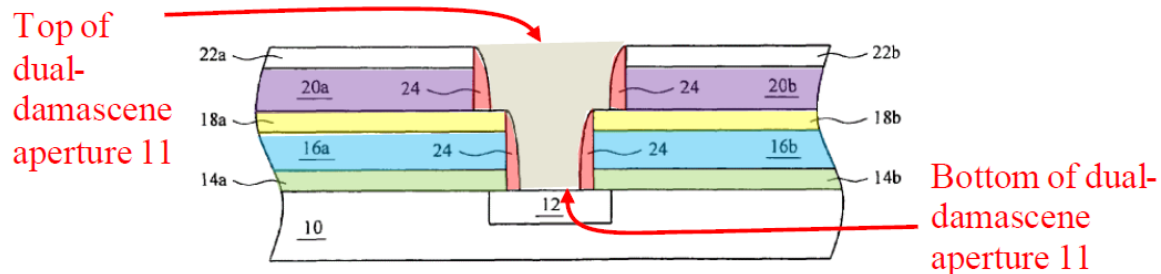
Under 37 C.F.R. § 42.104(c), “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition.” Petitioner asserts that repeating “bottom” rather than using “top” in certain passages describing the asserted combination was a readily apparent clerical error, where the remainder of the Petition supports the correct version. Mot. 1–4.

The passage in question relates to an aperture or opening through a stack of layers used to create a semiconductor device, known as a “dual damascene” structure. *See, e.g.*, Pet. 11–12 (describing dual-damascene structures), 25–26 (describing Peng’s³ dual-damascene structures and

² Citations refer to papers in IPR2021-00120; corresponding papers appear in the record of IPR2021-00121.

³ US 7,338,903 (Ex. 1003).

proposed modifications), 44 (mapping the claim limitations to Peng’s structures). The Petition includes annotated figures from the prior art, with annotations indicating the bottom and top of an aperture in a dual-damascene structure. As an example, the Petition includes the following figure:



Pet. 44 (annotating Ex. 1003, Fig. 2). The annotations include labels for the top and bottom of aperture 11 (shown in red). *Id.* Similar annotated figures appear in connection with the other instances of the phrase Petitioner seeks to replace. *See* Pet. 57 (mapping the claim language to a combination of Peng modified by Chien⁴ and Brase⁵), 84–85 (mapping the claim language to a combination of Lin⁶ modified by Chien).

Petitioner submits additionally that the Petition explains that the aperture’s bottom contacts part of the substrate, while the aperture’s top contacts metal interconnection layers. Mot. 3–4 (citing Pet. 30–31 (discussing Peng and Brase), 70 (discussing Lin)). Thus, in Petitioner’s view, the passages using “bottom” in place of “top” are plain mistakes. Mot. 4.

Patent Owner, on the other hand, asserts the error is substantive and therefore not correctable. Opp. 1–3. Because the instances identified above

⁴ US 6,365,504 (Ex. 1006).

⁵ US 6,576,550 (Ex. 1005).

⁶ US Pub. 2004/0124420 (Ex. 1004).

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that correctly reference the top and bottom of an aperture do not appear in the detailed mapping of claim language to prior-art disclosures, Patent Owner considers them unpersuasive. Opp. 2. In Patent Owner's view, Petitioner's mapping (of the "bottom" as "smaller than . . . bottom") was intentional and should not be corrected as "clerical." *Id.* at 3. Further, argues Patent Owner, Petitioner did not seek to correct the alleged error until identified by Patent Owner in the Preliminary Response, supporting Patent Owner's position that the Board should deny Petitioner's motion. *Id.* at 3–4. Patent Owner contends Petitioner's correction would prejudice Patent Owner because Patent Owner spent time making arguments based on the Petition. *Id.* at 4.

We agree with Petitioner that the error was evident from the content of the Petition. The reference to the "bottom" being "smaller than . . . bottom" is logically inconsistent and could not possibly be correct. Patent Owner agrees, as evidenced by the arguments made in its Preliminary Response. *See* Paper 8 (Prelim. Resp.), 19 (noting "the '***bottom of damascene aperature 11***' cannot be ***smaller than itself*** . . ."). We agree with Petitioner that the Petition demonstrates Petitioner's intended mapping, notwithstanding the clerical errors in the Petition and Declaration. *See* Mot. 2–4. As to prejudice, Patent Owner recognized the logical impossibility of the erroneous statement and, rather than working with Petitioner to confirm and correct the mistake, sought to exploit the mistake to its advantage. *See* Prelim. Resp. 19 (noting the impossibility of the bottom being smaller than itself). Moreover, Patent Owner had ample space in its Preliminary Response to make additional arguments assuming the mistake was the clerical error we find it to be, but chose not to raise such arguments. *See id.*

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at 5. Although Patent Owner would no doubt enjoy a windfall from Petitioner's mistakes, allowing correction does not prejudice Patent Owner by depriving it of that windfall. We do not agree with Patent Owner that allowing the correction unfairly prejudices Patent Owner by permitting a new Petition filed after the 1-year bar date. *See* Opp. 4. Rather, because the original Petition established Petitioner's contentions, the corrected Petition merely provides a cleaner record on which to evaluate institution.

Accordingly, Petitioner's motion to correct the petition and declaration is *granted*.⁷

C. ORDER

It is:

ORDERED that Petitioner's motion to file corrected petitions and declarations in IPR2021-00120 and IPR2021-00121 is *granted*.

⁷ In the pre-motion discussion, Petitioner indicated that, in IPR2021-00120, it seeks to additionally replace instances of "@@" with paragraph numbers of the supporting expert declaration. *See* Ex. 3001; *accord* Ex. 1031, 60, 67, 74, 75, 86, 88, 90, 91. Patent Owner does not oppose that request. *See* Ex. 3001. Petitioner's corrected Petition may include that change also.

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