

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDIAN ALLIANCE TECHNOLOGIES, INC.,
Petitioner,

v.

TYLER MILLER,
Patent Owner.

Case IPR2020-00031
Patent 10,043,188 B2

Before SALLY C. MEDLEY, DAVID C. MCKONE and JOHN R. KENNY,
Administrative Patent Judges.

MCKONE, *Administrative Patent Judge.*

ORDER

Patent Owner's Motion to Cede Jurisdiction for Correction of Priority Claim
37 C.F.R. §§ 1.323, 42.20

I. BACKGROUND

The challenged patent (US 10,043,188, Ex. 1001, “the ’188 patent”) recites “[t]his application claims priority to and the benefit of previously filed and co-pending provisional Patent Application No. 61/472,556, entitled Background Investigation Web Services, filed on Apr. 6, 2011, which is hereby incorporated by reference for all purposes.” Ex. 1001, 1:6–10. The face of the patent does not reflect this benefit claim. *Id.* at [63]. Tyler Miller (“Patent Owner”) requests that we cede exclusive jurisdiction over the ’188 patent so that it can petition the Director to make a correction to the ’188 patent’s priority claim. Paper 9 (“Mot.”). Guardian Alliance Technologies, Inc. (“Petitioner”) opposes. Paper 13 (“Opp.”).

According to Patent Owner, due to a clerical error, an Application Data Sheet (ADS) filed on May 26, 2015, in the application that matured into the ’188 patent did not recite Patent Owner’s intended priority claim. Mot. 2. Rather, Patent Owner argues, it intended to recite the priority claim that is shown in the ADS for pending U.S. Patent Application No. 16/024,622 in the ADS for the application that matured into the ’188 patent. *Id.* (citing Ex. 2017). Patent Owner represents that it was not aware of the potential defect with the ADS for the ’188 patent before filing the Petition (Paper 1, “Pet.”) and that any failure to claim the benefit of the provisional application was unintentional. *Id.*

The sought correction of the ’188 patent could bear on whether art cited in the Petition (Ex. 1004, the POBITS reference) is prior art to the ’188 patent. Pet. 6; Mot. 3–4.

II. ANALYSIS

According to our rules, “[t]he Board may exercise exclusive jurisdiction within the Office over every involved application and patent during [a] proceeding, as the Board may order.” 37 C.F.R. § 42.3(a). For a party seeking to correct a patent,

[t]he Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee’s assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2), § 41.121(a)(3) or § 42.20 of this title.

37 C.F.R. § 1.323. The import of these rules is that, “[w]hen a patentee seeks to correct a patent that is subject to a post-issuance review proceeding, the patentee must first file a motion with the Board seeking authorization to petition the Director for a Certificate of Correction, asking the Board to temporarily cede its exclusive jurisdiction over the proceedings.” *Honeywell Int’l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1348 (Fed. Cir. 2019). According to the Federal Circuit,

a patent owner subject to a post-issuance review proceeding must take three steps in order to file a petition for a Certificate of Correction: (1) seek authorization from the Board to file a motion, 37 C.F.R. § 42.20(b); (2) if authorization is granted, file a motion with the Board, asking the Board to cede its exclusive jurisdiction so that the patentee can seek a Certificate of Correction from the Director, 37 C.F.R. § 1.323; MPEP § 1485; and (3) if the motion is granted, petition the Director for a Certificate of Correction under 35 U.S.C. § 255.

Id. at 1349. As to the first step in *Honeywell*, we granted authorization to file the instant Motion in a teleconference with the parties on February 6,

2020. Ex. 1026 (transcript of the teleconference). Patent Owner files the instant Motion pursuant to the second step outlined in *Honeywell*.

According to the Federal Circuit, “the Director—not the Board—will evaluate the merits of the patentee’s petition, including whether the mistake is of ‘minor character’ or ‘occurred in good faith.’” *Id.* (quoting 35 U.S.C. § 255). The statute gives this authority to the Director, and the Director has not delegated that authority to the Board. *Id.* Rather, it is our purview to “review[] motions for leave to seek a Certificate of Correction from the Director to determine whether there is *sufficient basis* supporting Patent Owner’s position that the mistake *may* be correctable.” *Id.* (internal quotation marks and citation omitted). Specifically, it would be an abuse of discretion for us to require Patent Owner to prove to us that the requirements of Section 255 have been met. *Id.* at 1350.

According to the MPEP,

[w]here a benefit claim based upon 35 U.S.C. 119(e) to a prior provisional application is to be asserted or corrected in a patent via a certificate of correction, the following conditions must be satisfied:

- A. all requirements set forth in 37 CFR 1.78(a)(1) and (a)(2) must have been met in the application which became the patent to be corrected;
- B. it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 211 et seq.); and
- C. a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(c) must be filed, including the petition fee as set forth in 37 CFR 1.17(m).

MPEP § 1481.03(II). Rule 1.78(c), in turn, provides:

(c) Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

- (1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;
- (2) The petition fee as set forth in § 1.17(m); and
- (3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

37 C.F.R. § 1.78(c). Patent Owner submits the petition it intends to file, along with a corrected ADS, that purport to meet these requirements.

Exs. 2011; 2015.

Petitioner opposes Patent Owner's Motion. Specifically, Petitioner argues that, because Patent Owner did not seek correction until after this proceeding started, any correction would not apply to this proceeding. Opp. 1, 3. Petitioner also argues that it would be prejudiced because "had [Patent Owner] sought correction in the two months between service of the

invalidity contentions^[1] and the filing of the IPR Petition, Petitioner would have thought twice before drafting and submitting Ground 2 of the Petition, which relies on Ex. 1004 as the primary reference,” and “could have raised alternative grounds in its Petition if [Patent Owner] had timely sought correction.” *Id.* at 4–5.

As to the first argument, if any correction would not apply to this proceeding (an issue we do not decide now), then Petitioner should have no objection to Patent Owner seeking correction, as it will have no bearing on this proceeding. As to the second argument, it is unclear whether it is applicable here because Patent Owner did not seek correction before the Petition was filed and Petitioner contends that any correction now will not affect this proceeding. In any case, Petitioner was aware of Patent Owner’s benefit claim and the potential defect therein, as Petitioner raised the issue in its Petition (Pet. 6), and should not be surprised that Patent Owner would seek correction. Assuming Petitioner is incorrect, and correction of the ’188 patent (should it happen) is applicable to this proceeding, nothing prevented Petitioner from raising such “alternative grounds” in the Petition in anticipation of Patent Owner’s correction attempt.

Petitioner also argues that, were we to allow Patent Owner to seek correction, we would risk two different authorities within the USPTO (the Board and the Certificates of Correction Branch) rendering conflicting

¹ Petitioner contends that its real party-in-interest, Oklahoma City, served on Patent Owner, in co-pending district court litigation on August 8, 2019, invalidity contentions that discussed the priority date of the ’188 patent and that should have alerted Patent Owner to the need for the correction it now seeks. *Opp.* 4 (quoting Ex. 1032, 2).

outcomes. Opp. 2. As noted above, the Director has not delegated to us the authority to render a decision on the merits of Patent Owner's desired certificate of correction. *See Honeywell*, 939. F3d at 1349–50. Thus, only one authority within the USPTO will render a decision on the appropriateness of the correction.

As noted above, Petitioner also argues that Patent Owner was made aware of the potential defect in its benefit claim in co-pending district court litigation, more than two months prior to Patent Owner's current Motion to seek correction. Opp. 3–4. According to Petitioner, “[i]t’s unclear exactly what information in the Petition made [Patent Owner] realize the existence of the priority defect only upon reading the Petition as the invalidity contentions [Oklahoma City] served on [Patent Owner] describe the defect in detail.” *Id.* at 4 (quoting Ex. 1032, 2). To the extent Petitioner is challenging the “good faith” or “unintentionally delayed” nature of Patent Owner's correction attempt, that too is an issue that has not been delegated to us to decide. *See Honeywell*, 939. F3d at 1349.

We have analyzed the petition Patent Owner seeks to file (Exs. 2011, 2015) and conclude that “there is *sufficient basis* supporting Patent Owner's position that the mistake *may* be correctable.” *Honeywell*, 939 F.3d at 1349. Petitioner's arguments in opposition, Opp. 1–5, are either unpersuasive or go to the merits of Patent Owner's petition, which we do not have the authority to resolve, *Honeywell*, 939 F.3d at 1349. Accordingly, we cede exclusive jurisdiction over the '188 patent and grant Patent Owner permission to file a petition to the Director to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application. *See* 37 C.F.R. § 1.78(c).

III. Order

For the foregoing reasons,

It is ORDERED that Patent Owner's Motion to Cede Jurisdiction for Correction of Priority Claim (Paper 9) is granted; and

It is FURTHER ORDERED that Patent Owner has permission to file with the Director, for the '188 patent, a petition, pursuant to 37 C.F.R. § 1.78(c), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application.

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