

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION,

Petitioner,

v.

ENDOHEART AG,

Patent Owner.

Case IPR2016-00299

U.S. Patent No. 8,182,530

**PETITIONER'S MOTION UNDER 37 C.F.R. § 42.104(c)
TO CORRECT PETITION**

Petitioner, Edwards Lifesciences Corporation (“Edwards”), requests permission under 37 C.F.R. § 42.104(c) to file a corrected Petition to fix a clerical error in the Real Party-in-Interest section of the Mandatory Notices in its Petition. Pursuant to Rule 42.8(b)(1), Petitioner correctly identified Edwards Lifesciences Corporation and Edwards Lifesciences, LLC as the two real parties-in-interest. Petitioner, however, mis-transcribed the relationship between the two parties in the Mandatory Notices section of the Petition, information not required, per se, pursuant to the rules. Petitioner’s authorization to file this Motion was given by the Board and documented in the Order of March 8, 2016. *See* Paper 7.

I. Background

Edwards filed a Petition seeking *inter partes* review (“IPR”) of U.S. Patent No. 8,182,530 (the ‘530 patent) on December 9, 2015. In preparing its Petition, however, Edwards’ counsel made a clerical error by inadvertently mis-transcribing that Edwards Lifesciences, LLC is the parent company of Edwards Lifesciences Corporation. *See* IPR2016-00299, Paper 2 at 21.

Edwards first noticed this error on February 17, 2016 when Endoheart AG’s (“Endoheart’s”) counsel, Mr. Edward Arons, sent an email correspondence to Edwards’ counsel of record, identifying a discrepancy found in the Mandatory Notices section of the Petition regarding the relationship between the two Edwards

Lifesciences entities. Endoheart reserved the right to oppose Edwards filing a revised Petition correcting the clerical or typographical error.

Edwards includes with the revised Petition a Declaration of Ruby J. Natnithithadha (attached as Ex. 1044), attesting to the facts surrounding the clerical error, and a printout from SEC's website (attached as Ex. 1045) plainly showing that Edwards Lifesciences Corporation is the parent company of Edwards Lifesciences, LLC.

I. Edwards' Correction Will Not Substantively Effect the Requested Relief

When determining whether to grant a motion to correct a Petition under 37 C.F.R. § 42.104(c), the Board considers "any substantial substantive effect, including any effect on the patent owner's ability to file a preliminary response." 77 Fed. Reg. 48680, 48699. Further, the Board has previously noted that "this rule is remedial in nature and therefore is entitled to a liberal interpretation." *See ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21 at 7 (Jan. 16, 2013) (citing *Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967)). For the reasons provided next, Edwards respectfully submits that the requested change to its Petition, correcting the relationship between the two Edwards' entities identified in the Mandatory

Notices section of the Petition, will not have any “substantial substantive effect” on this proceeding.

37 CFR 42.8(a)(1) requires a Petitioner to file Mandatory Notices as part of its Petition, and Rule 42.8(b)(1) requires a notice identifying “each real party-in-interest for the party.” Importantly, Rule 42.8(b)(1) does not require a notice identifying the relationship between any two or more real parties-in-interest. As the requested correction regards information not required by Rule 42.8, it will have no impact on this proceeding. In particular, allowing Edwards to correctly identify that Edwards Lifesciences, LLC as a wholly owned entity of Edwards Lifesciences Corporation will not prejudice Endoheart or add any substantive information to this IPR required by law or regulation. The Petition, as-filed, including the clerical error sought to be corrected here, did not affect Endoheart's ability to file the Preliminary Response dated March 15, 2016. *See* Paper 8. Edwards submits that the requested relief would benefit the public by providing a more accurate public record.

Accordingly, Petitioner requests permission under 37 C.F.R. § 42.104(c) to file a Replacement Petition (attached hereto as Ex. 1043) for entry into the public record.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with this proceeding to Deposit Account 15-0030 (Customer ID No. 22850).

Respectfully submitted,
Oblon, McClelland, Maier &
Neustadt, LLP

Dated: March 22, 2016

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