

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EDWARDS LIFESCIENCES CORPORATION,  
Petitioner,

v.

ENDOHEART AG,  
Patent Owner.

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Case IPR2016-00299  
Patent 8,182,530 B2

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**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO  
CORRECT PETITION**

*37 C.F.R. § 42.104(c)*

Patent Owner respectfully files this response to Petitioner's motion under 37 C.F.R. § 42.104(c), filed March 22, 2016, to correct an alleged "clerical error" in the Petition.

## **I. Authorization For This Paper**

In its order dated March 8, 2016, the Board authorized Patent Owner to file this paper responding to Petitioner's motion under 37 C.F.R. § 42.104(c). Paper 7.

## **II. Relationship Between Named Entities**

In its motion, Petitioner asserts that "Edwards' *counsel* made a clerical error by inadvertently mis-transcribing that Edwards Lifesciences, LLC is the parent company of Edwards Lifesciences Corporation." Mot. at 2 (emphasis added). Although Patent Owner questions whether Federal Circuit precedent supports an interpretation of "clerical error" that would excuse a mistake by a "Senior Attorney" (Ruby J. Natnithithadha) and signed by a "Partner" (W. Todd Baker), rather than by a paralegal or office clerk<sup>1</sup>, Patent Owner does not oppose

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<sup>1</sup> *Japanese Found. for Cancer Research v. Lee*, 773 F.3d 1300, 1307 (Fed. Cir. 2014) (interpreting the identical phrase "*clerical error*" in 35 U.S.C. § 255 as "relating to an office clerk or office work" and "when a subordinate acts contrary to binding instructions," and thus denying correction where an erroneous filing was signed by the "attorney of record" because "it would be impossible for a subordinate who lacks the duty of exercising judgment to file a valid terminal disclaimer on his own"). *Cf.*

entry of the Replacement Petition (Ex. 1043) into the public record. Patent Owner believes that the public interest is better served by having an accurate and complete record of Petitioner's corporate relationships.

### III. Failure to Name Edwards Lifesciences PVT

In its motion, Petitioner maintains there are “*two* real parties-in-interest,” namely, Edwards Lifesciences Corporation and Edwards Lifesciences LLC. Mot. at 2 (emphasis added). Petitioner does not allege that its omission of a *third* real party-in-interest was a clerical error, nor that the omission should be corrected. (In its preliminary response, Patent Owner has presented evidence and argument to satisfy its burden of production that Edwards Lifesciences PVT is an unnamed real party-in-interest in this proceeding. *See* Ex. 2008; Ex. 2018-2024; Prelim. Resp. at 51-53.)

Patent Owner opposes any correction of the omission under 37 C.F.R. § 42.104(c).

Respectfully submitted,

Date: April 5, 2016

/s/ Edward M. Arons  
Edward M. Arons  
Reg. No. 44,511  
*Attorney for Patent Owner*  
*Endoheart AG*

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37 C.F.R. § 42.6(a)(3) (attorney signature requirements for inter partes reviews).

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the **PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO CORRECT PETITION** was served on the 5<sup>th</sup> day of April, 2016, via FEDEX EXPRESS® directed to counsel of record for the Petitioner:

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/s/ Edward M. Arons  
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