

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 (Patent 8,182,530 B2)
Case IPR2016-00300 (Patent 8,182,530 B2)¹

Before LORA M. GREEN, RAMA G. ELLURU,
and ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

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

¹ This Decision addresses issues that are common to each of the above-referenced cases. We, therefore, issue a single Decision that has been entered in each case. The parties are not authorized to use this style caption unless otherwise instructed by the Board.

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On March 22, 2016, Petitioner filed motions under 37 C.F.R. § 42.104(c) to correct information related to the Real Party-in-Interest section of its Petition. Paper 9.² Petitioner's motions were accompanied by Replacement Petitions. Ex. 1043 of IPR2016-00299; Ex. 1045 of IPR2016-00300. On April 5, 2016, Patent Owner responded with papers styled as Patent Owner's Response to Petitioner's Motion to Correct Petition. Paper 11.

Petitioner contends that, in the course of preparing its petition, its counsel made a clerical error resulting in the identification of Edwards Lifesciences LLC as the parent of Edwards Lifesciences Corp. when, in fact, the Edwards Lifesciences Corp. is the parent entity. *See, e.g.*, Paper 9, at 2; Exs. 1044, 1045. Petitioner therefore requests permission to file a corrected Petition correctly identifying the relationship between the two parties entities identified as Real Parties-in-Interest.

Patent Owner questions whether, under *Japanese Foundation for Cancer Research v. Lee*, 773 F.3d 1300, 1307 (Fed. Cir. 2014), counsel's error is properly construed as a clerical error, but ultimately does not oppose the motion. Paper 11, at 2–3 & n.1. We do not find Patent Owner's case citation probative as it relates to whether the USPTO acted within its discretion to refuse to withdraw an erroneously-filed terminal disclaimer, as opposed to whether the content of that filing contained a clerical error. *See, e.g., Japanese Found.*, 773 F.3d at 1306 (“Here, the Foundation has not identified an error in the patent number or application that is apparent on its

² Except as otherwise indicated, we cite herein to the papers filed in IPR2016-00299.

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face—like a transposed number or the number of a related patent—which would entail redirecting the disclaimer to the correct target. It instead claims that the filing of the disclaimer was itself the ‘clerical or typographical error’”). Although Patent Owner suggests that the error here cannot be “clerical” because it was made by counsel rather than by a paralegal or office clerk (Paper 11, at 2), we note that the court in *Japanese Foundation* applied the term to a situation in which “patentee’s attorney of record mistakenly entered the serial number and filing date of an issued patent, rather than the application for which he had intended to file a disclaimer.” *Japanese Found.*, 773 F.3d at 1305, 1306 (citing *Carnegie Mellon Univ. v. Schwartz*, 105 F.3d 863 (3d Cir.1997)).

Patent Owner also opposes any attempt by Petitioner to correct the Petition to add Edwards Lifesciences PVT as an additional real party-in-interest. Paper 11, at 3. With respect to the motion at issue, however, Petitioner has not argued that any such omission exists, nor that the alleged omission should be corrected. Accordingly, we do not address this issue here.

In view of the above, we grant Petitioner’s motions.

ORDER

Accordingly, it is

ORDERED that Petitioner’s Motions to Correct Petition under 37 C.F.R. § 42.104(c) are *granted*;

FURTHER ORDERED that Exhibit 1043 (in IPR2016-00299) and Exhibit 1045 (in IPR2016-00300) shall be substituted for the respective original petitions uploaded on December 9, 2015, and granted a filing date

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of December 9, 2015. The original petitions shall be expunged from the record.

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