

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP.,
Petitioner,

v.

ONO PHARMACEUTICAL CO., LTD. and TASUKU HONJO,
Patent Owner.

Case IPR2016-01217 (Patent 9,067,999)
Case IPR2016-01218 (Patent 9,067,999)
Case IPR2016-01219 (Patent 9,073,994)
Case IPR2016-01221 (Patent 9,073,994)¹

Before ERICA A. FRANKLIN, TINA E. HULSE, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Correct Clerical Errors
37 C.F.R. § 42.104(c)

¹ This order addresses issues that are common to all four cases. We, therefore, issue a single order that has been entered in each case. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that "the word-for-word identical paper is filed in each proceeding identified in the caption."

I. INTRODUCTION

Pursuant to authorization from the Board, Merck Sharp & Dohme Corp. (“Petitioner”) filed a motion to correct clerical errors in the Petition in each of the above-referenced proceedings. Paper 8 (“Mot.”).² Ono Pharmaceutical Co. Ltd. and Tasuko Honjo (collectively, “Patent Owner”) oppose Petitioner’s motions. Paper 9 (“Opp’n”).

Having considered the arguments of both sides, we grant Petitioner’s motions to correct the Petitions and extend the deadline for Patent Owner to file its Patent Owner Preliminary Responses to October 26, 2016, in each of the proceedings.

II. BACKGROUND

On June 29, 2016, Petitioner filed two petitions for *inter partes* review of U.S. Patent No. 9,067,999 (IPR2016-01217 and IPR2016-01218), and one petition for *inter partes* review of U.S. Patent No. 9,073,994 (“the ’994 patent”) (IPR2016-01219). On June 30, 2016, Petitioner filed another petition for *inter partes* review of the ’994 patent (IPR2016-01221).

On June 30, 2016, Petitioner sent Patent Owner an e-mail correspondence identifying certain alleged clerical errors in each of the four petitions filed. Ex. 1112, 1–4. On July 26, 2016, Petitioner sent another e-mail correspondence to Patent Owner, providing a table explaining why each identified error was clerical, and identifying several additional “typographical errors” discovered during the process of preparing the table. Ex. 1114, 1–14. On August 11, 2016, Petitioner sent Patent Owner redlined

² Because similar papers were filed in each proceeding, paper numbers refer to those filed in IPR2016-01217, unless stated otherwise.

IPR2016-01217 (Patent 9,067,999); IPR2016-01218 (Patent 9,067,999)
IPR2016-01219 (Patent 9,073,994); IPR2016-01221 (Patent 9,073,994)

versions of each petition, showing the proposed corrections to address the various errors. Ex. 1115.

III. ANALYSIS

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. The grant of such a motion does not change the filing date of the petition.” We also keep in mind that we construe our rules “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

In its motions, Petitioner explains why each item that it seeks to modify amounts to a typographical mistake. Mot. 2–3. Broadly speaking, most of the items addressed relate to the listing of claims in certain headings and in the body of the Petitions.³ *Id.* Petitioner asserts that it is evident from other portions of the Petition that those items represent typographical mistakes. *Id.* For example, Correction 2 in IPR2016-01217 inadvertently included claim 7 in the identification of ground (ii). *Id.* at 2 (citing Ex. 1111, 4). Petitioner explains, however, that the error is clear from other portions of the Petition that discuss claim 7 in the context of the references asserted in ground (iii) rather than ground (ii). *Id.* Similarly, Corrections 3–7 seek to correct the inadvertent omission of claims 24 and 25, which relate to lung cancers expressing PD-L1 or PD-L2. *Id.* at 2–3. Petitioner asserts that the typographical error is clear because all but one of the corrections falls under or refers to Section V.B.7, which expressly identifies claims 24 and 25 along with claims 19 and 20, which relate to essentially the same

³ Other proposed corrections include deleting the “Statement of Material Facts” from the Table of Contents (IPR2016-01217, Paper 9, 2) and correcting internal cross-references to sections that do not exist (IPR2016-01219, Paper 9, 3) or that are incorrect (IPR2016-01221, Paper 9, 3).

IPR2016-01217 (Patent 9,067,999); IPR2016-01218 (Patent 9,067,999)
IPR2016-01219 (Patent 9,073,994); IPR2016-01221 (Patent 9,073,994)

subject matter. *See* Ex. 1111, 51 (“WO557 Anticipates Claims 19-20 and 24-25”). Finally, Petitioner argues that there is no prejudice to Patent Owner because Patent Owner received prompt notice of the errors, and the errors are obvious from the Petition itself. Mot. 2.

In response, Patent Owner argues that Petitioner has not met its burden to show that the requested corrections are clerical or typographical, as opposed to substantive in nature, because altering the challenged claims is a core substantive issue. Opp’n 1–2. Moreover, Patent Owner asserts that Petitioner’s reference to other portions of the Petition fails to prove the errors are clerical, because there is no way to identify which of the contradictory lists is correct. *Id.* at 2. Patent Owner contends that allowing Petitioner to correct its errors would “encourage parties to file partially inadequate petitions, and effectively truncate the scant 3-months allotted to Patent Owners to prepare a preliminary response.” *Id.* Thus, as an alternative, Patent Owner requests that it be given an additional month to prepare its Preliminary Responses to compensate for the time lost before Petitioner sent the full set of correct petitions on July 26.

As an initial matter, we agree with the well-reasoned analysis in *ABB Inc. v. ROY-G-BIV Corp.* that Rule 104(c) is “remedial in nature and is therefore entitled to a liberal interpretation.” IPR2013-00063, slip op. at 7 (PTAB Jan. 16, 2013) (Paper 21) (citing *Tcherepnin v. Knight*, 389 U.S. 332, 336 (1967)). In this light, we determine that allowing Petitioner to correct the errors is appropriate under the facts and circumstances of these proceedings. Although we do not intend to encourage careless work, we are persuaded by Petitioner’s explanations as to why the errors were inadvertent typographical errors. Moreover, we find any prejudice to Patent Owner to

IPR2016-01217 (Patent 9,067,999); IPR2016-01218 (Patent 9,067,999)
IPR2016-01219 (Patent 9,073,994); IPR2016-01221 (Patent 9,073,994)

be relatively minor, as Petitioner promptly notified Patent Owner of the errors.

Given the number of proposed corrections to the Petitions, however, we also determine that additional time to respond to the Petitions is warranted. Because Petitioner provided Patent Owner with all of the proposed revisions on July 26, we extend the deadline by which Patent Owner may file its Preliminary Responses until October 26, 2016.

IV. CONCLUSION

For the reasons discussed above, we conclude that Petitioner has demonstrated that the proposed corrections in each of its Petitions are typographical in nature pursuant to 37 C.F.R. § 104(c).

V. ORDER

Accordingly, it is

ORDERED that Petitioner's Motion to Correct Clerical Errors is granted in each proceeding;

FURTHER ORDERED that Petitioner shall file by October 10, 2016 a Corrected Petition in each proceeding, limited to correcting the items identified in its Motions;

FURTHER ORDERED that the filing of the Corrected Petitions will not change the filing date accorded to the relevant Petition in each proceeding; and

FURTHER ORDERED that Patent Owner's Preliminary Response to each Petition shall be due on October 26, 2016.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.