

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTION SYSTEMS & SOFTWARE, LLC,
Petitioner,

v.

HART INTERCIVIC, INC.,
Patent Owner.

PGR2020-00031
Patent 10,445,966 B1

Before CHARLES J. BOUDREAU, AMANDA F. WIEKER, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

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

I. SUMMARY

This Order addresses (1) Petitioner’s request to “add claims 26 and 27 to Ground 4 of the Petition” to address a Certificate of Correction that issued after we instituted post-grant review and (2) a request to increase the word limit for Petitioner’s Reply. Ex. 3003. For the reasons discussed here, we deny Petitioner’s request to “add claims 26 and 27 to Ground 4 of the Petition” because we decline to retroactively apply the Certificate of Correction in this proceeding. We, however, grant the requested increase of the word limit for Petitioner’s Reply by 750 words.

II. THE CERTIFICATE OF CORRECTION

A. *Background*

We instituted a post-grant review of claims 1–30 of the ’966 patent. Paper 6, 47. All claims were challenged under 35 U.S.C. §§ 102 or 103, except for claims 26 and 27. Paper 1, 3 (“Pet.”). The Petition only challenged claims 26 and 27 based on 35 U.S.C. § 101, for ineligible subject matter, and 35 U.S.C. § 112, for indefiniteness. *Id.*

With our authorization, Patent Owner filed a Motion for the Board to temporarily cede its exclusive jurisdiction over the patent for Patent Owner to request a Certificate of Correction for claim 26. Paper 10. In its Motion, Patent Owner argued that the requested correction would address a “typographical error” in claim 26 that is correctable under 35 U.S.C. § 255. Paper 10, 3 (Patent Owner’s Motion).

In opposition to the Motion, Petitioner argued that filing a Motion to Amend instead of requesting a correction would promote “judicial efficiency” and avoid “substantial prejudice” to Petitioner. Paper 11, 7. Specifically, Petitioner argued that granting the Motion to cede jurisdiction would allow Patent Owner to use a Certificate of Correction to avoid the

Petitioner's indefiniteness challenge. *Id.* at 6. In Petitioner's view, precluding Petitioner from fully challenging the corrected claim in this proceeding would be "severely prejudicial." *Id.* As an alternative, Petitioner proposed that Patent Owner file a Motion to Amend to give Petitioner "the opportunity to fully address the unpatentability of the 'corrected' claims in this already pending proceeding." *Id.* at 7.

Patent Owner, however, declined to file a Motion to Amend, stating that such an amendment would "complicate these proceedings with the extra briefing and potential new grounds." Paper 10, 10.

On November 10, 2020, the Board granted the Motion to cede its jurisdiction to allow Patent Owner to request the Certificate of Correction from the Director. Paper 12. In the Order, the Board reminded Patent Owner that the due date to file a Motion to Amend in this proceeding was November 25, 2020. *Id.* at 4.

On November 11, 2020, Patent Owner requested the Certificate of Correction from the Director. Ex. 2004 (Request for Certificate of Correction). The Certificate of Correction issued on December 15, 2020. Ex. 2015 (Certificate of Correction). Claim 26 originally recited, "The method of claim 25, wherein the data set wherein a candidate's name, the data set combined with additional information related to the voter's vote selection to assist in identifying the voter's vote selection." Ex. 1001, 11:23–26. The Certificate deleted "wherein the data set wherein" from claim 26 and inserted "wherein the data set includes." Ex. 2015.

In authorizing Patent Owner's Motion, we requested that the parties "address whether the proposed certificate of correction to the '966 patent, if issued, would have effect for only future cases or would have effect in this

proceeding.” Paper 9, 3. In particular, 35 U.S.C. § 255 governs certificates involving a correction of an applicant’s mistake:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. *Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.*

(emphasis added). Section 254, concerning mistakes by the Office, contains similar language about the certificate’s effect. Interpreting section 254, the Federal Circuit has held that, “by necessary implication,” certificates of correction are not effective for “causes arising” before their issuance. *Sw. Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1295 (Fed. Cir. 2000).

In its briefing on the issue, Patent Owner argued that this proceeding is not a “trial of actions for causes” under § 255. Paper 10, 6–8. In Patent Owner’s view, there are reasons to doubt whether the reasoning in *Southwest Software* applies to the Board’s proceedings:

it is unclear what the “action for cause” would be in the context of a PTAB trial, nor is it clear when such cause would “arise.” This is a substantial distinction. If PTAB trials are not “trial[s] of actions for causes,” then there is no basis to distinguish between proceedings arising before or after the Certificate of Correction, and the logic of *Southwest Software* and *H-W Tech.*¹ would thus not apply.

Id. at 7–8.

¹ *H-W Tech., L.C. v. Overstock.com, Inc.*, 758 F.3d 1329 (Fed. Cir. 2014).

Petitioner agrees with Patent Owner that the Certificate of Correction should apply retroactively here. *See, e.g.*, Paper 11, 8. Petitioner, though, argues that “[j]udicial efficiency will only be promoted if [Petitioner] is permitted to fully address the patentability of the ‘corrected’ claim under any statutory ground in this proceeding.” *Id.*

In an email to the Board on January 12, 2020, Petitioner made two requests related to the corrected claims:

(1) authorization to add claims 26 and 27² to Ground 4 of the Petition and to address the ‘corrected’ language of those claims for the first time in the Reply; and (2) an extension of no more than 1,000 words to Petitioner’s Reply limited to ‘corrected’ claims 26 and 27, such that any unused words of that 1,000 word extension could not be used in other sections of Petitioner’s Reply.

Ex. 3003. In Ground 4 of the Petition, Petitioner asserts that claim 25, from which claims 26 and 27 depend, is obvious over Nadaf and Heilper. Pet. 71.

On January 14, 2020, Judges Boudreau, Wieker, and Repko held a conference call with the parties to discuss Petitioner’s requests. Robert Evans and Michael Hartley were present for Petitioner, and Brian Oaks was present for Patent Owner.

In the conference call, both parties argued that the Certificate of Correction should be given effect in this proceeding. To address the effect of the correction, Petitioner argued that it should be allowed to present new arguments in its Reply about the obviousness of the subject matter of corrected claims 26 and 27. Petitioner explained that no new references would be needed because the obviousness challenge to corrected claims 26

² Claim 27 depends from corrected claim 26, but the language of claim 27 was unchanged by the Certificate of Correction. *See* Ex. 2015.

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