

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DYNAENERGETICS EUROPE GMBH and
DYNAENERGETICS US, INC.,
Petitioner,

v.

QINETIQ LIMITED,
Patent Owner.

Case PGR2023-00003
Patent 11,215,039 B2

Before WILLIAM V. SAINDON, WILLIAM A. CAPP, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

Opinion for the Board filed by CAPP, *Administrative Patent Judge*

Opinion Concurring filed by *Administrative Patent Judge* CAPP

Opinion Concurring filed by *Administrative Patent Judge* SAINDON

Opinion Dissenting filed by *Administrative Patent Judge* DEFRANCO
CAPP, *Administrative Patent Judge*.

DECISION
Denying Motion to Dismiss
37 C.F.R. § 42.206

This matter is before the Board on Patent Owner's Motion to Dismiss requesting dismissal of Petitioner Dynaenergetics' Petition for Post-Grant Review. Paper 6. Petitioner opposes the motion. Paper 7.

I. SUMMARY OF SALIENT FACTS

Petitioner filed its petition with the Board on October 4, 2022, which was the last possible day in the 9-month statutory period to timely file a petition for post-grant review. 35 U.S.C. § 321(c); Paper 1. The Certificate of Service on the last page of the petition identifies Foley & Lardner LLP, 300 K Street N.W., Suite 600, Washington, DC 20007 as the current known correspondence address for Patent Owner. Paper 1. The Certificate of Service is signed by Lisa J. Moyles who is elsewhere identified in the petition as Lead Counsel for Petitioner. *Id.* p. 1. In the Certificate of Service, attorney Moyles certifies that a copy of the petition and supporting materials was served on QinetiQ at the aforementioned address by Express Mail. *Id.* After receiving the papers filed by Petitioner, the Office issued a Notice of Filing Date Accorded to petition. Paper 4. The Notice accorded a filing date to the petition of October 4, 2022.

In its motion to dismiss, Patent Owner represents, and Petitioner does not dispute, that Foley & Lardner is not and has never been counsel for Patent Owner. Paper 6, p. 2. Patent Owner further represents, and Petitioner does not dispute, that the petition was not served on Patent Owner's counsel of record, Kenealy Vaidya LLP, at its currently known address at 3050 K Street NW, Suite 302 on or before October 4, 2022. Ex. 2001 (Kenealy Decl.) ¶ 15.

Petitioner discovered that it had directed service to the wrong law firm and wrong address on or about October 12, 2022, after which it sought to provide service to Patent Owner's counsel by both email and FedEx. Paper 7, p. 1. There appears to be general agreement between the parties that Patent Owner's counsel received copies of the Petition and supporting materials on or before October 13, 2022. Paper 6, 2–3; Paper 7, 1. On October 12, Petitioner's counsel sent an email to the Trials division of the Office. Ex. 1018. The email attaches what purports to be a Corrected Certificate of Service of the Petition. *Id.* at2. The email attachment purports to certify that the petition for post-grant review was served on Kenealy Vaidya LLP, 3050 K Street, N.W., Suite 302, Washington D.C. 20007. *Id.* The transmittal email represents that service copies of the petition associated with attempted service on October 4, 2022, was returned as being delivered to an incorrect address. *Id.*

Furthermore, in the transmittal email, counsel requested guidance as to whether it should file the accompanying Corrected Certificate of Service with the Board. *Id.* Petitioner did not, however, actually file the Corrected Certificate of Service.

Patent Owner is the moving party in this motion proceeding. However, having reviewed the respective briefs of the parties, we deem it expedient to treat Petitioner's opposition to the motion as a cross-motion to have a filing date of October 4, 2022, accorded to the petition, based on the filing date of the petition and the original, albeit defective, certificate of service, which defect is cured by Exhibit 1018 in a manner that causes effective service to relate back to October 4, 2022.

II. LEGAL CONTENTIONS OF THE PARTIES.

Patent Owner basically argues that, by virtue of using an incorrect address on a certificate of service, Petitioner's Petition is "incomplete" as of its time of filing and that the alleged "deficiency in the petition" was not timely corrected in accordance with 37 C.F.R. § 42.206. Paper 6, pp. 4–5. According to Patent Owner, a petition is not "complete" unless and until service of the petition is effected on the correspondence address of record. *Id.* at 5. Thus, Patent Owner interprets Section 42.206(a)(2) to mean that a filing date is not accorded to a petition until service is effected at the correspondence address of record of the patent owner. *Id.* Essentially, Patent Owner takes the position that subsection (a)(2) operates as a condition precedent that must be satisfied on or before expiration of the statutory filing deadline of 35 U.S.C. § 321(c) to be accorded a filing date.

In its opposition, Petitioner argues that the date of service does not affect the filing date. Paper 7, p. 2. Petitioner argues that applicable provisions of the governing statutes are silent on the issue of whether service of a petition must be effected within the 9 month period for filing the petition under Section 321(c). *Id.* at 5–7. Petitioner, furthermore, argues that in the event its Petition is deemed "incomplete" by virtue of the incorrect service, such incompleteness is a matter of rule, not statute, and the Board should exercise its power to waive rule violations under 37 C.F.R. § 42.5. *Id.* at 5.

III. DECISION

For reasons expressed hereinbelow in the accompanying concurrences, Patent Owner's motion is DENIED.

ORDER

In consideration of the foregoing, it is hereby ORDERED that:

1. Patent Owner QinetiQ's motion to dismiss is DENIED; and
2. The Trials division is directed to allow the filing of the Corrected Certificate of Service represented by page 2 of Exhibit 1018 and to allow the filing thereof to relate back to October 4, 2022, and accord the petition with a filing date of October 4, 2022.

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Opinion Concurring filed by *Administrative Patent Judge CAPP*

I concur in the outcome of denying Patent Owner's Motion to Dismiss, but for a different reason than that of my colleague Judge Saindon, who also writes a concurring opinion. Petitioner filed its Petition on October 4, 2022, thereby satisfying the 9-month filing deadline of 35 U.S.C. § 321(c). Petitioner satisfied the substantive content requirement of § 322(a)(3). Petitioner, in a reasonably timely manner, provided Patent Owner with a copy of the Petition, satisfying the service requirement of § 322(a)(5).

The statutory provision regarding the post-grant review filing deadline provides as follows:

(c) Filing Deadline. — A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).

35 U.S.C. § 321(c). The provision regarding the requirements of a petition provides as follows:

(a) Requirements of Petition. — A petition filed under section 321 may be considered only if —

- (1) the petition is accompanied by payment of the fee established by the Director under section 321;
- (2) the petition identifies all real parties in interest;
- (3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including —
 - (A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and
 - (B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on other factual evidence or on expert opinions;
- (4) the petition provides such other information as the Director may require by regulation; and
- (5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

35 U.S.C. § 322(a). Thus, the governing statutory provisions include: (1) a deadline to “file” the petition; and (2) a requirement that, for the petition to be considered, copies of documents, including the petition, must be provided to the patent owner. Although subsection (5) above lists what is to be

provided, it does not explicitly specify when it must be provided. The subsection identifies providing copies as a requirement for the petition “to be considered.” It does not, however, explicitly state that copies must be provided before expiration of the statutory filing deadline for the petition “to be considered.”

Turning now to our rules, set forth in Title 37 of the Code of Federal Regulations, the rule regarding the content of a petition begins by incorporating the requirements of 37 C.F.R. §§ 42.6, 42.8, 42.22, and 42.24. *See* 37 C.F.R. § 42.204.

Section 42.6 basically covers the format of papers filed with the office, permissible modes of filing, and service. Among other things, this section provides that service of a paper on each opposing party be accomplished “simultaneously” with the filing thereof. *See* 37 C.F.R. § 42.6(e)(2). Section 42.6 requires that each document, other than an exhibit, must include a certificate of service at the end of that document. 37 C.F.R. § 42.6(e)(4). The certificate of service must state the date and manner of service. *Id.* at subsection (iii)(A). Section 42.6 is silent with respect to correcting inadvertent mistakes in providing service or any timing criteria for making such corrections.

Section 42.8 deals with mandatory notices that must be filed by each of the petitioner and the patent owner. Such mandatory notices must include information as to where service may be made. 37 C.F.R. § 42.8(b)(4).

Section 42.22 deals with the content of petitions and motions. Although Section 42.6 requires that each document include a certificate of service, Section 42.22 does not explicitly state that the certificate of service is considered part of the “content” of the petition. *See* 37 C.F.R. § 42.22.

Section 42.24 deals with word counts and page limits. *See* 37 C.F.R. § 42.24.

Section 42.204, which governs the content of a petition, states that the petition *must* set forth:

- (a) grounds for standing; and
- (b) statements of the relief requested.

37 C.F.R. § 42.204. Furthermore, subsection (c) provides that a motion may be filed to correct a clerical or typographical mistake “in the petition” without changing the filing date of the petition.

Section 42.205 deals with service of the petition and augments Section 42.6 by requiring that the petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. 37 C.F.R. § 42.205. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service. *Id.* Subsection (b) further provides that, upon agreement of the parties, service may be made electronically. Service may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®. *Id.*

Section 42.206 provides that a petition for post-grant review will not be accorded a filing date “until” the petition satisfies all of the following requirements:

- (1) compliance with Section 42.204 *supra* regarding the contents of a petition;
- (2) effects service of the petition in accordance with Section 42.205 *supra*; and
- (3) is accompanied by the appropriate filing fee.

37 C.F.R. § 42.206. Subsection (b) deals with a petition that is deemed “incomplete.” If a petition is deemed “incomplete,” no filing date will be accorded to the petition. Moreover, the Office “will” dismiss the “request” if the “deficiency” — “in the petition” — is not corrected within a specified period. *Id.*

Patent Owner’s motion to dismiss is predicated on the underlying premise that: (1) the petition; and (2) acts of service of the petition, constitute one singular occurrence which is denominated as the “petition.” Under this assumption, a defect in service is deemed to be a defect in the petition, thereby rendering the petition incomplete. Alternatively, Patent Owner’s motion can be thought of as interpreting the word “until” in Section 42.206 in terms of items that must be fully and finally completed as conditions precedent before a filing date is accorded. Under this view, correcting a typographical error in the certificate of service after the date that the petition (accompanied by the defective certificate of service) was originally filed does not relate back to the original filing date.

Although the governing statutes and rules are not models of clarity on this particular issue, I think the better approach is to treat: (1) filing of a petition; and (2) service of a petition, as separate and distinct events. Thus, the better interpretation of 35 U.S.C. §§ 321 and 322 is that providing copies under Section 322(a)(5) is a separate and distinct act or event from the filing of the petition. In this regard, it is helpful to understand what a certificate of service is and means. A certificate of service is a representation to the Board that an act has been performed, namely, the act of providing copies of the petition to the patent owner. It does not logically make sense to include the

act of providing documents as if it were an integral component of the content of the documents themselves.

Continuing with the foregoing thought, the Board has separate and distinct rules governing the “content” of a petition and “service” of the petition. *See* 37 C.F.R. §§ 204, 205. Patent Owner’s case hinges on its interpretation that, in order for a petition to be considered “complete” for purposes of according a filing date within the meaning of 37 C.F.R. § 206(a), the timing of effective service of the petition in accordance with 37 C.F.R. § 205(a) operates as a condition precedent to the according of a filing date. Under this interpretation, if service is attempted in an otherwise timely manner, but such service turns out to be defective in some way, such as a typographical error that causes service to be attempted at the wrong address, correcting the defect in service does not preserve the original filing date of the petition. Stated differently, effective service of a petition pursuant to Section 42.206(a)(2) can never be treated as a condition subsequent for purposes of rendering a petition “complete.” Under this interpretation, which is essentially the position taken by the dissent, the provisions of 37 C.F.R. § 206(b) take over, the petition is deemed incomplete, and, under the facts presented in the instant case, it is too late for Petitioner to provide a correction to “complete” the petition.

Section 42.206(a)(2), when read in isolation, is arguably susceptible to the interpretation urged by Patent Owner and more-or-less adopted by the dissent. However, considering the statutory and regulatory scheme as a whole, I think the better interpretation is to allow some amount of latitude that accounts for the realistic possibility that humans, from time-to-time, make inadvertent mistakes. In my view, Petitioner’s petition should be

deemed “complete” as of October 4, and that any technical defect in the service papers were susceptible to being cured by prompt remedial action, which occurred here, thereby satisfying Section 42.206(a)(2). Such cure should be allowed to relate back to the original filing date such that the petition may be accorded a filing date of October 4. This is the gist of the following representation made to the public by the Office on its web site:

Once the Office reviews the petition and determines whether the petition is complete and the appropriate fees have been paid, the Office will send a notice to the petitioner and patent owner. The submission date of the compliant petition will be accorded as the filing date. If the petition complies with all of the statutory requirements (see 35 U.S.C. §§ 135, 312, and 322), the original submission date of the petition will be accorded as the filing date . . . In the situation where a petition complies with all of the statutory requirements but contains only regulatory defects, the Office will accord the filing date of the original submission and notify the petitioner of the defects. The regulatory defects must then be corrected within the time period set forth in the notice.

PTAB E2E frequently asked questions; D1. WHEN WILL MY PETITION BE ACCORDED A FILING DATE?¹ Here, it appears that Petitioner corrected a regulatory defect on its own without waiting for receipt of notice of the regulatory defect from the Office.

In my view, a mere regulatory defect, such as occurred here with the certificate of service, may be corrected as a matter of course either by the party on its own or following notice by the Office without resort to excusing late action pursuant to 37 C.F.R. § 42.5(c)(3). Under this view, correcting a mere regulatory defect does not and should not depend on the exercise of discretion by the panel of judges assigned to the case. Rather, it is a routine

¹ <https://www.uspto.gov/patents/ptab/ptab-e2e-frequently-asked-questions>.

matter of Office administration. Consequently, and consistent with representations the Office has made to the public,² the petition here should be deemed “complete” as of October 4, and the provisions of 37 C.F.R. § 42.206(b) do not come into play.

I next address the requirement in our rules that provides that service of a paper on each opposing party be accomplished “simultaneously” with the filing thereof. *See* 37 C.F.R. § 42.6(e)(2). Here, a certificate of service, albeit an incorrect one, was filed simultaneously with the petition. The question then is whether an inadvertent error in the certificate of service and, of course, the corresponding mailing label on the envelope that is deposited with a carrier, should be treated as a non-amendable defect that, in cases such as this, prove fatal to proceeding with post-grant review on the merits. For essentially the same reasons stated hereinabove, I answer that question is in the negative. Generally speaking, the law is better served by allowing legal disputes to be decided on their substantive merits rather than by procedural technicalities. Here, the mistake in service was detected and corrected in a reasonably prompt manner. Despite Patent Owner’s representations to the contrary, I am not persuaded that Patent Owner will encounter any prejudice by an approximately one-week delay in receiving notice of filing of the petition.

To the extent that Petitioner’s inadvertent error in providing service of the petition causes the petition to not be served “simultaneously” with the

² *See supra* note 1.

filing of the petition, under the facts of this case, such inadvertent error is an amendable defect which was corrected in a reasonably timely manner.³

My colleague's concurrence takes a slightly different approach in maintaining that there is a technical violation of our rules, but that the violation may be excused under 37 C.F.R. § 42.5(c)(3).⁴ While I agree that such an approach leads to the correct result of allowing the post-grant review to proceed on the merits rather than being dismissed on a procedural technicality, such an approach is unnecessary under the reasoning set forth hereinabove.

The dissent maintains that the timing of service is a statutory requirement and that inadvertent defects in service cannot be cured after the statutory filing deadline. The dissent reads more into 35 U.S.C. §§ 321 and 322 than what the statutes actually say. The dissent uses its interpretation of the Office's rules to read requirements into the statutes that are not explicitly stated therein. I disagree with this approach to statutory interpretation. To me, the better view is that the timing of service is regulatory, not statutory and, as such, allows for curing of certain defects under appropriate circumstances. This view upholds the salutary purpose Congress had in mind in creating post-grant review.

³ Our ruling in this case should be limited to the facts before us and not generalized to other fact patterns that are not currently before us.

⁴ A similar result would occur if strict adherence to the service deadline is waived by the Board, in exercise of its discretion, under Rules 42.5(a) and (b).

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Opinion Concurring filed by *Administrative Patent Judge* SAINDON

I concur in the outcome of denying Patent Owner's Motion to Dismiss. I agree with my colleague's concurrence that Petitioner has satisfied the statutory requirements for filing its post-grant review. Petitioner's Petition (Paper 1) was filed on October 4, 2022, satisfying 35 U.S.C. § 321(c) (9-month filing deadline) and at least § 322(a)(3) (substantive content requirement). Further, Petitioner served Patent Owner a copy of the Petition on October 12, 2022, satisfying § 322(a)(5) (service requirement). The statutory requirements were met.

In my view, however, Petitioner did not satisfy completely 37 C.F.R. § 42.206(a)(2) (complete petition requirement) until October 12, 2002,

which places Petitioner in violation of § 42.206(b) (requiring a complete petition package before “the expiration of the statutory deadline,” which was October 4, 2022). In particular, § 42.206(a)(2) requires service effected “on the correspondence address of record,” which Petitioner did not do because it sent the copy to the wrong address. Thus, contrary to my colleague’s concurrence, it is my view that Petitioner’s Petition has a regulatory defect that must be cured in view of the language in § 42.206(b). Contrary to the dissent, however, I believe this defect is one for which we could, and should, allow correction.

The USPTO has represented to the public that the “Board generally will accord a filing date and accept minor deficiencies that do not impact the Board’s ability to determine whether to institute the review or the patent owner’s ability to file a preliminary response.” 77 FR 48679, 48701 (2012) (USPTO response to comments for clarification on minor vs. material omissions in petition filings). Examples of material omissions that may impact the Board’s ability to make an institution decision or patent owner’s ability to file a meaningful response include “citing to an incorrect portion of a reference” and “omission of a challenged claim,” i.e., mistakes that affect the substantive portions of the petition. Thus, in my view, the Federal Register notice indicates that the USPTO intended to excuse errors when the error does not change when the particular challenge under 35 U.S.C. §§ 101, 102, 103, or 112 was raised. Similarly, the USPTO has represented that if “a petition complies with all of the statutory requirements but contains only regulatory defects, the Office will accord the filing date of the original submission.” PTAB E2E Frequently Asked Questions, *D1. When will my*

*petition be accorded a filing date?*⁵ In addition, the regulations provide for excuse of late actions under 37 C.F.R. § 42.5(c)(3) (excusing late actions “on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice”).

Further, although the language in 37 C.F.R. § 42.206(b) sets the correction period such that it cannot exceed the 9-month statutory deadline, this language, in my view, does not set a rigid rule that can never be excused. First, nothing in that requirement is due to a statute (which we cannot waive). The statute mentions the 9-month deadline in § 321(c) only for the *filing* of the petition. The act of filing is something that takes place between a petitioner and the USPTO. Service is different from filing. As to service, the statute does not link the service requirement with the filing date; it merely requires service prior to our *consideration* of a petition, which we have yet to do. 35 U.S.C. § 322(a). The linking of a filing date and service date only comes into play under 37 C.F.R. § 42.206(a) (“A petition to institute a post-grant review will not be accorded a filing date until the petition satisfies all of the following requirements”). Thus, while I agree with the dissent that there is a statutory requirement *for service*, I disagree that there is a statutory requirement *to effect service before the statutory filing date for the petition*. It is my view that the statute is silent

⁵ <https://www.uspto.gov/patents/ptab/ptab-e2e-frequently-asked-questions>

I respectfully disagree with the dissent’s position that any of our FAQs state that the timing of service is a statutory requirement, but do not further elaborate.

there, and the specific timing requirements of service are a regulatory requirement.⁶

The regulations add the USPTO's conditions for the filing of the petition, stating that the USPTO will not accord a filing date until the fee is received and service is effected. 37 C.F.R. § 42.206(a). The penalty for not curing any defect is set in § 42.206(b), and the time to cure is capped by “the statutory deadline in which to file a petition for post-grant review.” In the present case, service to the entity identified in 37 C.F.R. § 42.206(a)(2) was defective, but in my view, should be excused under § 42.5(c)(3) in the interests of justice. The nature of the defect is minor. Petitioner acted to correct the defect as soon as Petitioner became aware of it. Patent Owner cannot identify any actual prejudice from being served a week late. Patent Owner attempts to invoke prejudice by complaining about having to prepare for the proceeding (Paper 6, 8–9), but Patent Owner would have had to do that anyway. Patent Owner could have asked for a time extension if the week made any difference, but never sought to do so. On the other hand, dismissing a petition due to a clerical issue having no meaningful effect on Patent Owner or the Board would be punishment well exceeding the

⁶ To clarify my position relative to the dissent, *see* Dissenting Op. 28–30, I use the word “petition” in this paragraph to mean the document that has content requirements under 37 C.F.R. § 42.204 (e.g., Paper 1), not some broader concept that requires other things such as fees and service. In my view, the statute and the regulations do not use the term “petition” consistently, and therefore I believe we must read each section based on context and intent. *Compare, e.g.,* 37 C.F.R. § 42.205 (entitled “Service of petition”) *with* § 42.206(a) (entitled “Complete petition” and requiring service and fees). Accordingly, I view 35 U.S.C. § 322(a) as setting forth the conditions needed for a petition to be considered under § 324(a), not for determining the filing date of the petition under § 321(c).

violation. It would serve to right no wrong in this proceeding, nor would it serve to prevent further violations in the future—clerical errors will always happen, by both parties and the Board, no matter the number of eyes reviewing a document or the size of the penalty.

In summary, my view is that the statutory requirements of a post-grant review were met but the regulatory requirement for the timing of the service was not met. However, the interests of justice standard to excuse that minor regulatory defect is met because the defect is due to a clerical error, Petitioner immediately sought to correct the error, Patent Owner identifies no prejudice, there is no impact on our ability to determine whether to institute review, and the proposed punishment is too extreme compared to the violation.

I concur in the denial of the motion.

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Dissenting Opinion, filed by *Administrative Patent Judge* DEFRANCO.

I respectfully dissent from the majority decision denying Patent Owner’s motion to dismiss the petition. The majority decision is premised on the mistaken belief that service of a petition for post-grant review (PGR) is merely a regulatory requirement. *It is not*. Per the Office’s prior interpretation of the governing statute—35 U.S.C. § 322(a)—proof of service is a *statutory requirement* that must be complied with before the petition can be accorded a filing date. *See* Ex. 3001 at 13–15, FAQ D1, D3.⁷

⁷ USPTO, “P-TACTS—PATENT TRIAL AND APPEAL CASE TRACKING SYSTEM: Frequently Asked Questions (FAQs),” v. 2 (Oct. 7, 2022), at https://www.uspto.gov/sites/default/files/documents/p-tacts_faqs_20221007.pdf (Ex. 3001, “P-TACTS FAQs”).

As for *when* that filing date will be accorded, the Office interprets § 322(a) to mean that “[t]he submission date of the *compliant* petition will be accorded as the filing date,” in other words, the filing date is the date on which the PGR petition complies with *all* statutory requirements, including submission of the requisite documentation, fee, and proof of service on *patent owner*. *Id.* at 13, FAQ D1 (citing 35 U.S.C. § 322(a)).

Not only does the majority disregard the Office’s interpretation that timely service is a statutory requirement, it also fails to acknowledge that the Office, in enforcing it, expressly warned Petitioner that, upon submission of a new certificate of service showing correction of the error in the originally filed certificate, the PGR petition would receive a new filing date of October 12, 2022, effectively placing the PGR petition outside the statutory window for post-grant review. *See* Ex. 3003. Thus, in keeping with the Office’s interpretation of the statute and its warning to Petitioner, I would find that Petitioner failed to comply with the statutory service requirement before expiration of the 9-month statutory filing deadline for post-grant review of the ’039 patent. As such, I would dismiss the PGR petition as time-barred.

BACKGROUND⁸

On October 4, 2022, Petitioner uploaded its PGR petition to the Office’s electronic filing system (P-TACTS) and paid the requisite filing fee. Paper 7 (“Pet. Opp.”) at 1. Petitioner also appended a certificate of service to the PGR petition, certifying that, on that same day, a copy of the petition and supporting materials was served “on the Patent Owner by Express Mail

⁸ I state the facts anew because I believe the majority’s “Summary of Salient Facts” omits some key facts central to a fair and thorough analysis.

. . . at the current known correspondence address for the Patent Owner.”

Ex. 3002 (emphasis added).

On October 12, 2022, a week after the statutory period for filing the PGR petition had expired, Petitioner discovered that the certificate of service submitted with the PGR petition was in error and that copies of the PGR petition and supporting evidence had, in fact, not been delivered to Patent Owner or its legal representative, but had been returned because Petitioner had “appended a certificate of service from another proceeding” to the PGR petition and “served a law firm other than the correspondence address of record” for Patent Owner.⁹ Pet. Opp. 1.

Upon discovering the erroneous service on October 12, 2022, Petitioner executed overnight service on Patent Owner’s actual designated legal representative, the Kenealy Vaidya firm. Pet. Opp. 1, 8 (citing Ex. 1018). On that same day, Petitioner notified the Office of the originally deficient service and inquired about filing a “Corrected Certificate of Service” showing that, rather than October 4, 2022, the PGR petition and supporting materials were actually served October 12, 2022. Ex. 1018 at 2.

In response to that inquiry, the Office authorized Petitioner to file the corrected certificate of service, but warned that its submission would require that the PGR petition receive a new filing date of October 12, 2022. *See* Ex. 3003 (“You may file the corrected certificate of service today [October 12, 2022] if you are okay with getting today as the filing date.”). Petitioner, however, expressly declined the Office’s authorization to file a corrected

⁹ It is undisputed that the legal representative actually served on October 4, 2022 has no affiliation with either Patent Owner or its designated representative as listed in the Office’s records for the ’039 patent, namely, the law firm of Kenealy Vaidya LLP. *See* Ex. 2001 ¶¶ 2–10; Ex. 2002, 1.

certificate of service, responding that “it was not okay” with the Office according the PGR petition a new filing date and would “wait for a panel to be assigned and revisit the issue of whether anything further should be filed on the record.” Ex. 3004.

Importantly, at the time of Petitioner’s inquiry, no filing date had been accorded the PGR petition. So, absent Petitioner’s correction of the original certificate of service, the Office had no choice but to accord the PGR petition a filing date of October 4, 2022, which was the only date on record with the Office regarding Petitioner’s proof of service of the PGR petition and supporting materials. *See* Paper 4. Indeed, the record reflects that Petitioner has yet to file a corrected certificate of service, despite knowing that the original certificate of service includes an inaccurate certification.

THE MAJORITY DECISION AND ASSOCIATED CONCURRENCES¹⁰

The majority decision hinges on finding that proof and timing of service are regulatory requirements. Notably, after restating the relevant provisions of the governing statute, the first concurrence concludes that, because the statute “does not explicitly specify when [service] must be provided,” the failure of a petitioner to timely effect service of the petition and supporting materials on the patent owner amounts to a “mere regulatory defect.” First Concurring Op. 8, 12. The second concurrence appears to agree. *See* Second Concurring Op. 18 (“[T]he specific timing requirements of service are a *regulatory* requirement.”). The positions of the concurrence

¹⁰ Because my respected colleagues write separate concurrences, I will refer to Judge Capp’s as the “first concurrence” or “First Concurring Opinion,” and Judge Saindon’s as the “second concurrence” or “Second Concurring Opinion.”

comport with Petitioner’s view that, because “the statute does not address how service may affect the filing date,” “the specific service requirements at issue are regulatory, not statutory.” *See* Pet. Opp. 4–5. I disagree for the reasons discussed below.

Also, I note that the first concurrence is under the mistaken impression that Petitioner somehow “cured” the originally deficient and inaccurate certificate of service with its later submission of a corrected certificate of service. *See* First Concurring Op. 12 (“[A]ny technical defect in the service papers were susceptible to being cured by prompt remedial action, which occurred here, thereby . . . [s]uch cure should be allowed to relate back to the original filing date such that the petition may be accorded a filing date of October 4.”). That, however, was not the case here. No remedial action was taken by Petitioner because, despite the Office’s authorization, Petitioner deliberately chose *not to file* the “Corrected Certificate of Service” that was the subject of its October 12, 2022 inquiry to the Office. *Compare* Ex. 3003 (“You may file the corrected certificate of service today [October 12, 2022] if you are okay with getting today as the filing date.”), *with* Ex. 3004 (“We will wait . . . and revisit the issue of whether anything further should be filed on the record.”). As such, the first concurrence has no basis to state that Petitioner has cured the admittedly deficient and inaccurate certificate of service currently entered in this case.

Petitioner obviously knew that filing the corrected certificate of service would place the PGR petition outside the 9-month statutory window for seeking post-grant review of the ’039 patent. So, it intentionally avoided filing the corrected certificate of service, thereby placing the burden on

Patent Owner to raise the issue of improper service and seek dismissal of the PGR petition.

ANALYSIS

A threshold consideration for any PGR petition is whether it is timely filed. To that end, 35 U.S.C. § 321(c) provides, in relevant part, that “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent.” As the ’039 patent issued on January 4, 2022, the statutory deadline for filing the PGR petition was October 4, 2022.

In assessing whether a PGR petition is timely filed within the 9-month statutory window, the Office must first determine the petition’s appropriate filing date. In doing so, the Office follows the strict guidelines provided in its official P-TACTS FAQs publication. Ex. 3001.¹¹ There, the Office explains the statutory and regulatory requirements for filing a petition and according it a filing date. *Id.* at 13–17.

More specifically, in interpreting the relevant statute—35 U.S.C. § 322(a)—the Office identifies “certain statutory requirements . . . that must be met for a petition to be accorded a filing date” and provides “a list of the top 5 things the [Office] will be looking for in . . . post-grant review (PGR) petitions.” *Id.* at 14, FAQ D3 (citing 35 U.S.C. § 322(a)). Among the listed “statutory requirements” is “[e]vidence (e.g., certificate of service) that a copy of the petition was provided to the patent owner.” *Id.* So, clearly, service on the patent owner is a statutory requirement.

¹¹ The Office’s interpretation of the governing statute and regulations, as provided in this official publication, inevitably were vetted by the offices of the Director, the Solicitor, and the Board’s Chief Administrative Judge.

As for the timing of service, the two concurrences profess that the statute does not specify when service must be effected. *See* First Concurring Op. 7–8 (“Although [§ 322(a)] lists what is to be provided, it does not explicitly specify when it must be provided.”); Second Concurring Op. 17 (“The statute mentions the 9-month deadline in § 321(c) only for the *filing* of the petition . . . As to service, the statute does not link the service requirement with the filing date.”). I respectfully disagree.

Per the Office’s prior interpretation of § 322(a), compliance with the statutory requirements is linked directly to the filing date of a PGR petition—“[t]he submission date of the *compliant* petition will be accorded as the filing date.” Ex. 3001 at 13, FAQ D1 (citing 35 U.S.C. § 322(a)) (emphasis added). The Office even provides a specific example tying statutory compliance to the filing date accorded a petition: “for fee deficiencies, the Office will accord the later submission date when all appropriate fees have been paid because the fees are required by statute.” *Id.* at 13–14. A deficiency in service should be treated no differently than a deficiency in fee payment, as both are statutory requirements. Conversely, the Office explains that “no filing date will be accorded if a statutory requirement is not satisfied.” *Id.* at 14, FAQ D1. Thus, in interpreting § 322(a), the Office links statutory compliance expressly to the filing date accorded a petition because, without a filing date, the petition cannot be considered.

That interpretation is consistent with the plain language of § 322(a), which defines the requirements of a PGR petition and immediately follows the provision in § 321(c) of a statutory deadline for filing a PGR petition:

REQUIREMENTS OF *PETITION*—A petition filed under section 321 *may be considered only if*—

- (1) the petition is accompanied by the proper filing fee,
- (2) the petition identifies the real parties-in-interest;¹²
- (3) the petition identifies certain information, including claims challenged, grounds asserted, and evidence relied upon; and,
- (4) “the petitioner provides copies” of the petition and other documents identified above “to the patent owner or, if applicable, the designated representative of the patent owner.”

35 U.S.C. § 322(a) (emphasis added). The statutory language “*may be considered only if*” supports the Office’s interpretation of § 322(a) that complying with the listed requirements directly impacts the filing date that a petition may receive. Per the plain language of the statute, only *when* the petition fully complies with the statutory requirements can the Office consider the petition. And, absent compliance with the statutory requirements, the Office cannot consider the petition. That means

¹² I recognize that Board precedent interpreted similar language in § 312(a), i.e., the requirement to name all real parties-in-interest, as needing *not* be fully satisfied when the petition was filed. *See Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, No. IPR2015-00739, 2016 WL 2736005, at *3 (PTAB Mar. 4, 2016) (precedential). That case is distinguishable for two reasons. *First*, it was undisputed that the petition in *Lumentum*, “*when filed, identified all real parties in interest, and, therefore . . . was complete,*” but only changed after the petition was already filed. *See id.* *1, *3 (emphasis added). As such, the petitioner in that case was permitted to *add* a real party in interest. That is not the case here, where the PGR petition admittedly lacked statutory compliance in the first instance, i.e., when filed on the statutory deadline of October 4, 2022. *Second*, the petition in *Lumentum* was for *inter partes* review (IPR), which is more open-ended in terms of permitting other parties to challenge the subject patent should one party be time-barred. In that case, rectification of one party’s lapse in statutory compliance may be justified in the context of the challenge as a whole. That is not the case with PGRs, where expiration of the 9-month window effectively forecloses *all* parties from challenging the patent under that particular method of administrative review.

consideration of a petition hinges on the date of statutory compliance, which fully supports the Office’s interpretation of § 322(a) as requiring that the filing date be the same as “[t]he submission date of the compliant petition.” Ex. 3001 at 13, FAQ D1.

Notably, the Office’s interpretation of the statute as requiring that a PGR petition be statutorily compliant before the end of the 9-month statutory window is reflected in the Office’s regulation that permits correction of a statutorily deficient petition only “within *the earlier of* either one-month from the notice if an incomplete petition, or *the expiration of the statutory deadline* in which to file a petition for post-grant review.” 37 C.F.R. § 42.206(b) (emphases added). That regulatory interpretation of the combined effect of §§ 321(c) and 322(a) is entitled to *Chevron* deference. *See Chevron U.S.A, Inc. v. Nat’l Resources Def. Council, Inc.*, 467 U.S. 837, 843–844 (1984).

The first concurrence maintains that the service requirement under § 322(a) is “a separate and distinct act or event from the filing of the petition” under § 321(c). First Concurring Op. 10. The second concurrence takes a similar approach—“The statute mentions the 9-month deadline in § 321(c) only for the *filing* of the petition. . . . Service is different from filing. As to service, the statute does not link the service requirement with the filing date; it merely requires service prior to our *consideration* of a petition, which we have yet to do.” Second Concurring Op. 17. Under the concurrences’ logic, then, the filing of a petition under § 321(c) relates solely to the “content” of the petition itself, without regard to any of the other statutory requirements of § 322(a). First Concurring Op. 11; Second Concurring Op. 18 n.6. I respectfully disagree. The concurrences read the

relevant statutory provisions in isolation and take an overly narrow view of what is meant by the term “petition” as used therein.

When §§ 321(c) and 322(a) are read together, the term “petition” means a *statutorily compliant* petition, that is, one that includes submission of: (1) the appropriate fee; (2) the requisite information and supporting documentation; and (3) evidence that copies of the requisite documentation were served on the *correct* patent owner. Indeed, the statute makes that clear by articulating the “REQUIREMENTS OF *PETITION*” as a pre-condition to the Office’s consideration—“A petition filed under section 321 may be considered only if—” 35 U.S.C. § 322(a) (emphasis added). In other words, while § 321(c) sets a 9-month deadline for filing a PGR petition, § 322(a) defines the minimal requirements of the PGR petition that must be met before that deadline. Thus, the “petition” filed in § 321(c) necessarily means a *statutorily compliant* petition that includes the correct documentation, fee, and proof of service.¹³

The Office currently operates in accordance with that very interpretation of the statute. Only upon submission of a *statutorily compliant* petition does the Office accord a filing date and begin its consideration of whether the *statutorily compliant* petition complies with the Office’s *regulatory* requirements. More specifically, the Office outlines the process as follows:

¹³ Indeed, complying with the statutory service requirement within the 9-month statutory period serves the important function of notifying a patent owner that its patent is under attack and giving the patent owner some repose upon expiration of the statutory period (at least with respect to administrative attacks under 35 U.S.C. §§ 101 and 112).

First, there are certain statutory requirements in 35 U.S.C. § [. . .] 322(a) that must be met for a petition to be accorded a filing date. . . . *If any statutory requirement is not met, the petition is incomplete.* The paralegal may call the individual who filed the petition and explain the deficiency. The paralegal will enter a Notice of Incomplete Petition and the individual who filed the petition will receive notification by email. The deficiency may be corrected within one month and the petition will be accorded the filing date of the NEW submission.

Second, there are certain there are certain regulatory requirements in Part 42 of Title 37, Code of Federal Regulations, that must be met (e.g., word limits, page limits, font size, signature, identification of lead and back-up counsel). If any regulatory requirement is not met, the petition is defective. . . . While the petition will be accorded the filing date of the ORIGINAL submission, the defect must be corrected within one week.”

Ex. 3001 at 14–15, FAQ D3 (emphases added).

As shown above, by stating that “[i]f any statutory requirement is not met, *the petition is incomplete*,” the Office interprets the term “petition” as used in §§ 321(a) and 322(c) to be one that complies with the statutory requirements. And, only upon receiving a statutorily compliant petition will the Director begin her consideration of a petition for *regulatory* compliance. Thus, contrary to the suggestion of the concurrence, the Director’s consideration does not begin with the threshold analysis under § 324(a), but rather begins immediately upon the statutorily compliant petition being accorded a filing date. *See* Second Concurring Op. 18 n.6.

Here, Petitioner admits that the certificate of service submitted to the Office on October 4, 2022 does not accurately identify Patent Owner or its designated legal representative. That being the case, Petitioner admits it failed to provide Patent Owner with copies of the requisite documentation on

October 4, 2022, as indicated on the certificate of service. Pet. Opp. 1, 6. Instead, an entity other than Patent Owner was served with that documentation. Thus, it is undisputed that Petitioner failed to comply by October 4, 2022, with the statutory requirement of submitting “[e]vidence (e.g., certificate of service) that a copy of the petition was provided *to the patent owner.*” Ex. 3001 at 14, FAQ D3 (emphasis added). And because October 4, 2022 was the last day to seek post-grant review of the ’039 patent, Petitioner’s failure to comply with a statutory requirement by that date dooms the PGR petition because a statutory requirement cannot be waived, as both Petitioner and the concurrence acknowledge. *See* Pet. Opp. 6; Second Concurring Op. 17.

I note that Petitioner cites a series of cases in arguing that the service requirement is “waivable.” Pet. Opp. 6–10. But that argument is predicated on the ill-conceived notion that erroneous service of a PGR petition is a regulatory violation, not a statutory violation. As discussed above, that is not the case and stands in stark contrast to the Office’s express interpretation of § 322(a) that service on the patent owner is a statutory requirement. And because both Petitioner and the concurrence acknowledge that a statutory requirement is *not* waivable, any further discussion of waiver is irrelevant. *See id.* at 6; *see also Terremark N. Am. LLC v. Joao Control & Monitoring Sys., LLC*, IPR2015-01482, Paper 10 at 7 (PTAB Dec. 28, 2015) (“The Board has discretion to waive *non-statutory* requirements per 37 C.F.R. § 42.5(b).” (emphasis added)); *Cultec, Inc. v. StormTech LLC*, 2017 WL 3034535, *5 (PTAB July 17, 2017) (same).

In any event, although the majority is silent in regard to the cases cited by Petitioner, I feel compelled to address them, as I find Petitioner has

mischaracterized their facts. For instance, Petitioner cites *TIZ Inc. v. Smith*, 2022 WL 946110 (PTAB Mar. 23, 2022) as supporting its contention that service is a regulatory requirement rather than a statutory requirement. Pet. Opp. 6. But Petitioner misreads *TIZ*. Nowhere does that case say that service itself is not a statutory requirement. Rather, the panel in *TIZ* held that the *specific method* of service identified in 37 C.F.R. § 42.205, i.e., “by Priority Mail Express®”—is “regulatory, not statutory,” and, thus, that regulatory requirement of a particular method of service can be waived in favor of a sufficiently equivalent method, such as by Federal Express. *TIZ*, *5–6. I wholly agree with that holding. But, unlike *TIZ*, the error in service here centers, not on the particular method by which Petitioner effected service, but rather on the indisputable fact that Petitioner failed to effect service at all on Patent Owner by the statutory deadline of October 4, 2022.

Petitioner also relies on *Synopsis Inc. v. Mentor Graphics Corp.*, 2013 WL 5653111 (PTAB Apr. 11, 2013) as supporting the proposition that “harmless, non-substantive errors like service of a petition *do not affect a petition’s filing date.*” Pet. Opp. 7–8. But, again, Petitioner misconstrues the Board’s holding in that case. Contrary to Petitioner’s suggestion, the error in service was not caused by the petitioner’s failure, but rather was caused by the patent owner’s failure to update the correspondence address in the Office’s records for the subject patent. And because the address on the petitioner’s certificate of service in that case matched the correspondence address of record at the time of filing the petition, the panel concluded that the petitioner’s service complied with the statutory requirement.¹⁴ *Synopsis*,

¹⁴ In *Synopsis*, the panel also found that the petition complied with the statutory requirement because “[n]othing in the statute states that the date the

*2. Only for that reason did the *Synopsis* panel leave the original filing date intact. But, unlike *Synopsis*, it is undisputed here that Petitioner’s own failure to include an accurate correspondence address for Patent Owner on the certificate of service is what led to the statutory violation, which, per the Office’s interpretation of § 322(a), directly affects the filing date. Thus, Petitioner’s reliance on *Synopsis* is inapposite.

I also find disingenuous Petitioner’s assertion that the facts presented here are “similar” to those in *Micron Tech., Inc. v. e.Digital Corp.*, IPR2015-00519, Paper 14 (PTAB Mar. 24, 2015). There, the panel waived the regulatory requirement that service be effected “at the correspondence address of record for the subject patent” because the petitioner complied with the corresponding statutory requirement by “provid[ing] copies of the required documents to a designated representative of Patent Owner in a timely manner,” namely, by providing copies to the patent owner’s litigation counsel, who was “participating in the proceeding” and “actually received the [p]etition prior to the expiration of the one-year bar.” *Id.* at 4–5. Unlike that case, however, there’s no evidence of record here that Petitioner ever sent a copy of the Petition to either Patent Owner or its designated legal representative by the October 4, 2022 statutory deadline, despite being “engaged in business discussions [with Patent Owner] regarding the ’039 patent” in the period preceding submission of the PGR petition. Opp. 1.

patent owner *receives* copies is determinative of the filing date.” *Synopsis*, *2 (emphasis added). But, here, the dispute centers not on receipt of the PGR petition by Patent Owner, which I agree is not a statutory requirement, but rather on when Petitioner *sent* a copy of the PGR petition to the correct patent owner.

Also troubling is Petitioner’s characterization of its statutory violation as “harmless error” akin to that found in *Arthrex, Inc. v. Bonutti Skeletal Innovations, LLC*, IPR2013-00632, Paper 15 (PTAB Mar. 3, 2014). In that case, however, there was no statutory violation because the petitioner indisputably provided copies of the petition and supporting materials to the patent owner in a timely fashion, and only omitted “original foreign-language versions” of that evidence. *Id.* at 5. In contrast, Petitioner here failed to comply with the statutory requirement by failing to provide *any* of the required documents—the PGR petition or supporting materials—to Patent Owner by the statutory deadline, and, thus, the PGR petition is not subject to correction without also changing the filing date, which in this case would be well past expiry of the 9-month statutory deadline. *See* Ex. 3001 at 13–14, FAQ D1, D3.

CONCLUSION

For all of the above reasons, I respectfully dissent. Because proof of service on the *correct* patent owner is a statutory requirement, and it is undisputed that Petitioner failed to comply with that statutory requirement before expiration of the 9-month statutory period for seeking post-grant review of the ’039 patent, the PGR petition is time barred and should be dismissed.

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