

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NUNA BABY ESSENTIALS, INC.,  
Petitioner,

v.

BRITAX CHILD SAFETY, INC.,  
Patent Owner.

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Case IPR2018-01683  
Patent 9,586,504 B2

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Before SCOTT A. DANIELS, BART A. GERSTENBLITH, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Motion to Excuse Late Filing  
*37 C.F.R. §§ 42.5(c)(3), 42.7*

## INTRODUCTION

On October 4, 2018, Nuna Baby Essentials, Inc. (Petitioner) contacted the Board via email requesting a conference call to discuss leave to file a motion to excuse late filing of the exhibits to the Petition (Paper 3 (Pet.)). Britax Child Safety, Inc. (Patent Owner) opposed the request. A conference call was held on November 6, 2018, before Judges Daniels, Gerstenblith, and Dougal. On November 8, 2018, we entered an order authorizing Petitioner leave to file a motion to excuse late filing of the exhibits to the Petition. Paper 7. We also authorized Patent Owner to file an opposition. Petitioner filed the motion on November 13, 2018. Paper 8 (Mot.). Patent Owner filed an opposition on November 20, 2018. Paper 10 (Reply).

Upon consideration of the arguments presented and for the reasons discussed below, we deny Petitioner's motion to excuse the late filing.

## BACKGROUND

The Petition and two Powers of Attorney (Papers 1 & 2) were filed on September 10, 2018, without any exhibits to the Petition. Each Power of Attorney lists three attorneys as counsel for Petitioner: Gary Ma as Lead Counsel, and both Roger Taylor and Nathan North as Back-Up Counsel. Papers 1, 2. Valencia Daniel, a Litigation Legal Assistant with four years experience in filing and handling *inter partes* reviews, attests to filing the Petition in the Board's online End to End ("E2E") System under instruction and direction of counsel for Petitioner and "using the lead counsel's information." Ex. 1012 ¶ 3. The Litigation Legal Assistant states that during filing she found a typographical error, and that, after correcting the issue, re-uploaded and replaced the Petition and Powers of Attorney before

completing the filing. *Id.* The Litigation Legal Assistant states that she believed that the exhibits to the Petition had been filed. *Id.*

Lead Counsel states that he believed all documents had been correctly filed based on his receipt of two automated emails from the E2E System, a “Patent Review Petition Filing Receipt” (Ex. 1014) and a “Payment Receipt Notice” (Ex. 1015), as well as based on confirmation from the Litigation Legal Assistant. Ex. 1011 ¶ 5. The Litigation Legal Assistant states that Lead Counsel forwarded to her the two emails from the E2E System. Ex. 1012 ¶ 4.

Petitioner states, and Patent Owner does not contest, that the Petition, Power of Attorney, and Exhibits 1001–1010 were sent to Patent Owner via email and FedEx on September 10, 2018, with the FedEx package being received September 11, 2018. Mot. 1 (citing Ex. 1011 ¶¶ 3–7, Ex. 1012 ¶¶ 4–7); *see also* Exs. 1016–1019).

In accordance with our rules and guidelines,<sup>1</sup> a Notice of Filing Date was entered in the case a few weeks after the filing. Paper 4. The Notice,

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<sup>1</sup> *See* 37 C.F.R. § 42.107; *see also* PTAB E2E Frequently Asked Questions, <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions>, last visited Dec. 11, 2018, which includes the following:

D. Filing a Petition

D1. When will my petition be accorded a filing date?

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.

entered September 21, 2018, informed Petitioner that the case had been afforded a filing date and that “No exhibits have been filed.” *Id.* at 2. The Notice stated that “Petitioner must correct the defect(s) within FIVE BUSINESS DAYS [i.e., September 28, 2018] from this notice. Failure to correct the defect(s) may result in an order to show cause as to why the Board should institute the trial.” *Id.* Among other information provided, the Notice also gave Patent Owner three months to file a preliminary response to the Petition. *Id.*

Lead Counsel states that he received a “Filing Date Accorded Notice” email (Ex. 1013<sup>2</sup>) from the Board on September 21, 2018. Ex. 1011 ¶ 8. This email states: “The Petition has been verified and has been accorded a filing date,” though it does not specify what filing date the Petition has been assigned. Ex. 1013. Lead Counsel states that the email “provided no statements regarding the availability of a separate paper and did not identify

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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. Conversely, no filing date will be accorded if a statutory requirement is not satisfied. For example, 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. See, e.g., 35 U.S.C. § 312(a)(1).

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.

<sup>2</sup> This email was also addressed to Back-Up Counsel for Petitioner. Ex. 1013.

any mistakes in the petition filing.” Ex. 1011 ¶ 8. Lead Counsel states that he “understood the petition being ‘verified’ to mean that all documents had been uploaded correctly and that no more action was required from Petitioner at that time.” *Id.*

The Litigation Legal Assistant states that she “checked the docket” on October 2, 2018 “and discovered for the first time that the PTAB had entered a Notice of Filing Date Accorded” where she learned that the exhibits to the Petition were not on file. Ex. 1012 ¶ 9. The Litigation Legal Assistant states that she informed Petitioner’s counsel and then filed Exhibits 1001-1010. *Id.*; *see also* Ex. 1011 ¶ 9.

#### DISCUSSION

Petitioner filed the exhibits to the Petition on October 2, 2018, after the extended deadline to file these documents had passed. Petitioner now seeks for the Board to excuse the late filing. Mot. 1. As acknowledged by Petitioner (*id.* at 2), 37 C.F.R. § 42.5(c)(3) governs when it is appropriate to excuse a late action: “A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.”

Petitioner first argues that good cause exists because “[t]he Board has routinely allowed petitioners to correct mistakes in petition filings, including the failure to properly upload exhibits.” Mot. 3. This is consistent with what has happened here. Petitioner was given an opportunity to remedy the error. Paper 4, 2. Had Petitioner responded within allotted time, the error would have been corrected.

Though the Notice of Filing Date does not reference 37 C.F.R. § 42.104(c), which allows for the correction of a clerical error, the Notice

acted in accordance with the rule to allow Petitioner the opportunity to do so. The fact that other panels have allowed petitioners to correct clerical and typographical mistakes, also in accordance of the rule, however, does not establish good cause in and of itself. Nor do the other decisions establish good cause when, as is the situation here, an opportunity already has been provided to correct the error or mistake.

Petitioner also argues that good cause exists because Patent Owner was on notice of the basis for relief in the Petition and Patent Owner suffered no prejudice. Mot. 4. We agree that Patent Owner did not suffer substantial prejudice in this instance. Nonetheless, lack of prejudice does not demonstrate good cause for excusing a late filing, particularly when opportunity has been provided already to correct the error or mistake.

Petitioner argues that good cause exists because “Petitioner believed in good faith that it had filed the petition and all exhibits on Sept. 10, 2018.” *Id.* at 5. Though Petitioner may have had a good faith belief on the day of filing, this belief must be reconciled with the obligation of counsel to review the filing and the file. *See Conmed Corp. v. Bonutti Skeletal Innov. LLC*, IPR2013-00624, Paper 18 at 8 (PTAB Feb. 21, 2014) (“At the very least, the responsibilities of Petitioner’s counsel include reviewing documents uploaded during this proceeding and, if necessary, notifying the Board of a mistake, inconsistency, or error in a timely manner.”). There is no evidence concerning whether counsel for Petitioner checked to ensure that the filing had been properly completed in the E2E System at or around the time of filing or for almost three weeks thereafter. As noted by Patent Owner, in this case even a cursory review of the file would have alerted counsel for Petitioner that no exhibits were on file. Reply 5.

This good faith belief must be further reconciled with the fact that the Board informed Petitioner of the error (Paper 4, 2) and Petitioner still took no action until after the deadline had expired. Lead Counsel's assumption that there was no need to check the file in response to the "Filing Date Accorded Notice" email (Ex. 1013) does not establish good cause to excuse the late filing. Ex. 1011 ¶ 8.

The "Notice of Filing Date" (Paper 4) is a standard notice provided in all *inter partes* review cases in accordance with our rules and guidelines. *See, e.g.*, 37 C.F.R. § 42.107; PTAB E2E Frequently Asked Questions, <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions>, last visited Dec. 11, 2018. Lead Counsel states that the email "provided no statements regarding the availability of a separate paper and did not identify any mistakes in the petition filing." Ex. 1011 ¶ 8. The email, however, also does not state the filing date given. That alone should have prompted counsel to review the file to ensure that the desired filing date matched the date given. Further, the email was also sent to each Back-Up Counsel. There is no evidence concerning either Back-Up Counsel's response to or understanding of the email. There is also no evidence concerning whether the Litigation Legal Assistant was made aware of this email. Ignorance of the PTAB's procedures and the breakdown or lack of sufficient internal procedures to substantively review notices from the Board does not establish good cause to excuse a late filing. If anything, unfamiliarity should encourage counsel to be extra vigilant.

Petitioner also argues that excusing the late filing is in the interests of justice. Mot. 8. Petitioner identifies two cases where prior panels of the

Board determined that it was in the interests of justice to accept a late filing. *Id.* (citing *Taylor Made Golf Co. v. Parsons Xtreme Golf, LLC*, IPR2018-00675, Paper 19 (PTAB Aug. 30, 2018); *Corelogic, Inc. v. Boundary Solutions, Inc.*, IPR2015-00219, Paper 32 (PTAB Oct. 27, 2015)). Both of these cases involve the late filing of a patent owner's preliminary response. The considerations of whether it is in the interests of justice to review a preliminary response, which could help to simplify and clarify issues, as well as help the Board decide whether to institute the case in the first place are not present here. Petitioner provides us with only a cursory analysis of the outcome of those cases and we determine that they do not provide justification that excusing the late filing on the facts in this case is in the interests of justice.

Petitioner also argues that it is in the interests of justice to excuse the late filing because Petitioner would be "severely prejudice[d] . . . because it would be statutorily barred from filing a new petition against the challenged patent." Mot. 8.

We agree with Patent Owner that this issue is of Petitioner's own making. Reply 8. Specifically, there is no automatic right to petition for an *inter partes* review. Congress set limits. One of those limits is the time bar under 35 U.S.C. § 315(b). A petitioner who files a petition shortly before the time bar should be well aware of the risks associated therewith. Accordingly, we do not believe that it would be in the interests of justice to excuse Petitioner for the late filing based on the facts presented.

For the reasons discussed above, we determine that Petitioner has not established good cause to excuse the late filing or that consideration on the



merits would be in the interests of justice. Accordingly, we do not excuse Petitioner's late filing of Exhibits 1001–1010.

We “may expunge any paper directed to a proceeding . . . that is not authorized under this part.” 37 C.F.R. § 42.7(a). Because we are not persuaded that Petitioner has established good cause to excuse the late filing and because Petitioner has not persuaded us that it is in the interests of justice to consider the exhibits on the merits, we determine that Exhibits 1001–1010 should be expunged.

#### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Excuse Late Filing (Paper 8) is *denied*; and

FURTHER ORDERED that Petitioner's Exhibits 1001–1010 be *expunged* from the record.

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