

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ERICSSON INC.  
Petitioner

v.

INTELLECTUAL VENTURES I LLC  
Patent Owner

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Case IPR2014-00527  
Patent 7,496,674 B2

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Before JOSIAH C. COCKS, WILLIAM A. CAPP, DAVID C. McKONE,  
*Administrative Patent Judges.*

COCKS, *Administrative Patent Judge.*

ORDER

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

### *1. Introduction*

On May 29, 2014, a conference call in IPR2014-00527, which involves U.S. Patent No. 7,496,674, was conducted between respective counsel for the parties and Judges Cocks, Capp, and McKone. Petitioner, Ericsson Inc. (“Ericsson”), was represented by Todd Baker. Patent Owner, Intellectual Ventures I LLC (“Intellectual Ventures”), was represented by Jonathan Sick. The call was requested by Intellectual Ventures to discuss potential deficiencies of the Petition filed by Ericsson on March 21, 2014.

Intellectual Ventures arranged for a court reporter to be on the call. Intellectual Ventures must file a transcript of the call as an exhibit when available.

### *2. Discussion*

During the call, Intellectual Ventures raised two issues in connection with perceived deficiencies of Ericsson’s Petition. First, Intellectual Ventures asserted that the claim charts contained in the Petition included impermissible arguments. Second, Intellectual Ventures urged that the margins of the claim charts did not comply with Board rules. At the outset, we observe that more than two months have passed since the filing of Ericsson’s Petition on March 21, 2014. It is not apparent why Intellectual Ventures did not raise its concerns as to the formatting of the Petition sooner. Nevertheless, we now consider the issues raised by Intellectual Ventures.

#### *a. Alleged Arguments in Claim Charts*

According to Intellectual Ventures, Ericsson’s Petition in IPR2014-00527 runs afoul of Board rules governing document formatting, *see* 37 C.F.R. § 42.6(a)(2)(iii), by including argument within a claim chart. As support for its position, Intellectual Ventures directed the panel to Paper 3 of IPR2014-00587,

which states that: “Claim charts may not include arguments, claim construction, statement of the law, or detailed explanations as to why a claim limitation is taught or rendered obvious by the prior art.” As examples of such alleged impermissible argument, Intellectual Ventures pointed to content of the Petition at pages 19 and 27.

We have reviewed the claim charts, including the portions of the charts found at page 19 and 27 of the Petition. We do not discern, however, that the claim charts include content that is prohibited. Although quotations from a prior art reference are permitted, and, in many cases, may be preferable, Board rules do not mandate such quotation to the exclusion of other qualified indications of how the prior art teaches the limitations of a claim. To that end, there is no prohibition on the use of a concise summary of the disclosure of a reference as an alternative to quotation from the reference in an element-by-element showing. That Ericsson’s claim charts include summary of the disclosure of the involved references beyond strict quotation does not, in our view, present improper content in the claim charts. We also do not discern that, in this case, the brief introductory or expository phrases that precede expression of the disclosure of a reference in connection with a claim element rise to the level of “argument” that must be excluded from a claim chart.

During the call, Intellectual Ventures expressed that the relief it seeks is an order from the Board requiring Ericsson to re-file its Petition omitting the alleged argument, and a three-to-four week extension of the due date for Intellectual Ventures to file its Patent Owner Preliminary Response. Because we do not conclude that the Petition contains impermissible argument, that requested relief is *denied*.

*b. Alleged Improper Margins*

Intellectual Ventures also contended that the claim charts of the Petition are formatted with margins that violate Board rules. Title 37 C.F.R. § 42.6(a)(2)(iv) specifies that the margins in a Petition “must be at least 2.5 centimeters (1 inch) on all sides.” Intellectual Ventures asserted that the left-hand and right-hand margins of the claim charts in Ericsson’s Petition are smaller than the required 1 inch. Ericsson did not dispute that the margins of its claim charts may not comply with the above-noted rule. In that regard, Ericsson expressed that the deviation from acceptable margins likely arose when the Petition was converted into a PDF file for uploading to the Board’s Patent Review Processing System (PRPS).

In reviewing the Petition, it is apparent that, in some cases, the claim charts do not comply strictly with the requirement of 1 inch margins on all sides. So as to comply with Board rules, Ericsson must re-file its Petition with claim charts having appropriate margins. In connection with the re-filing, Ericsson shall not add any substantive content to the Petition. The re-filed Petition is due no later than 5 pm Eastern Time on Friday, June 6, 2014.

*3. Order*

It is

ORDERED that Ericsson must refile its Petition with margins that comply with 37 C.F.R. § 42.6(a)(2)(iv) no later than 5 pm Eastern Time on Friday, June 6, 2014; and

FURTHER ORDERED that no extension of the due date for Intellectual Ventures’s Patent Owner Preliminary Response is provided. The due date for any such response remains July 8, 2014.

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