

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VERASONICS, INC.,  
Petitioner,

v.

SUPERSONIC IMAGINE, S.A.,  
Patent Owner.

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Case IPR2019-00799  
Patent 7,252,004 B2

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Before CHRISTOPHER L. CRUMBLEY, JON B. TORNQUIST, and  
SHELDON M. McGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

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

On May 10, 2019, a conference call was held among counsel for the parties and Judges Crumbley, Tornquist, and McGee to discuss Patent Owner's request to rescind the filing date accorded the Petition due to an alleged violation of the word count rule set forth in 37 C.F.R. § 42.24(a)(i). Patent Owner asserted Petitioner intentionally violated the word count rule by, *inter alia*, eliminating spaces in citations and failing to account adequately for words appearing in the Petition's signature block. According to Patent Owner, the Petition exceeds the word count limit of 14,000 set forth in our Rule 42.24(a)(i) by approximately 500 words.

Patent Owner requested the following relief from the Board:

- 1) requiring Petitioner to refile the Petition to address the alleged formatting violations and comply with Rule 42.24(a)(i); and
- 2) rescinding the Notice of Accorded Filing Date currently in this proceeding (Paper 3) dated March 22, 2019 in favor of a new Notice of Accorded Filing Date upon filing of the new Petition.

In response, Petitioner indicated that it does not believe it is in violation of Rule 42.24(a)(i) and stands by its word count of 13,937 as set forth in the Petition. Pet. 76. In Petitioner's view, because its word count does not exceed the 14,000 words allowed by Rule 42.24(a)(i), there is no violation of the rule to warrant the requested relief.

After considering the parties' arguments, we agree with Petitioner and hereby deny Patent Owner's request for relief. Patent Owner does not point us to, nor are we aware of, any Board rule that precludes the use of the

unconventional<sup>1</sup> formatting employed here by Petitioner, such as the absence of a space between the paragraph symbol and the paragraph numbers or the citation of an exhibit as “VRS-1003” instead of “Ex. 1003.” *See, e.g.*, Pet. 4 (referencing exhibit “VRS-1003, ¶44” and “VRS-1003, ¶¶31-35). Rather, as set forth on page 7 of our Revised Trial Practice Guide,<sup>2</sup> “[e]xcessive words in figures, drawings, or images, deleting spacing *between words*, or using excessive acronyms or abbreviations for word phrases, in order to circumvent the rules on word count, may lead to a party’s brief not being considered” so as to avoid “undue prejudice” to a party (emphasis added). Here, Patent Owner does not allege any instance of Petitioner deleting spacing between words. At worst, Petitioner has used unconventional citation format to reduce the number of spaces in its Petition, thereby lowering the word count reported by its word processing program. While this may have been a strategic choice in order to squeeze the Petition in under the word limit, and while we generally do not encourage such behavior, the formatting does not render the Petition unreadable or incomprehensible. *Cf. Pi-Net Int’l, Inc. v. JPMorgan Chase & Co.*, 600 Fed. Appx. 774 (Fed. Cir. 2015) (unpublished). We do not deem Petitioner’s lack of spacing between the paragraph symbol and the following numerals, or the

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<sup>1</sup> When using the “¶” symbol, “insert a space between [the symbol] and the numeral.” THE BLUEBOOK: A UNIFORM SYSTEM OF CITATION R. 6.2(c) at 74 (Columbia Law Review Ass’n et al. eds., 18<sup>th</sup> ed. 2005). While the Board generally follows Bluebook citation format, we are not aware of any rule that requires parties appearing before the Board to do so.

<sup>2</sup> [https://www.uspto.gov/sites/default/files/documents/2018\\_Revised\\_Trial\\_Practice\\_Guide.pdf](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf)

other citation formatting identified by the Patent Owner, as sufficiently “excessive” to warrant the requested relief.

With respect to Patent Owner’s allegation that Petitioner failed to account for the words appearing in the signature block, we agree with Patent Owner that such words should be reflected in the total word count because Rule 42.24(a) does not specifically exclude the signature block from the word count for petitions. 37 C.F.R. § 42.24(a) (“The word count or page limit does not include a table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing.”). In this case, by our calculation, the signature block contains seventy words. Pet. 75. Thus, even accounting for Petitioner’s omission from the word count of the words appearing in the signature block, the Petition stands at 14,007 words (i.e., 13,937 words appearing in the certified total (Pet. 76) + 70 words appearing in the signature block (*id.* at 75)). Patent Owner has not demonstrated how exceeding the word count limit by seven words rises to the level of “undue prejudice” to Patent Owner.

To the extent Patent Owner feels it has been prejudiced by Petitioner’s omission of spaces from its citations, Patent Owner may elect to use the same formatting in their Preliminary Response.

Accordingly, it is  
ORDERED that Patent Owner’s request for relief is *denied*; and  
ORDERED that the due date for the Patent Owner Preliminary  
Response stands at June 22, 2019.

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PETITIONER:

E. Russell Tarleton  
Thomas A. Shewmake  
SEED INTELLECTUAL PROPERTY LAW GROUP LLP  
RussT@seedip.com  
TomShewmake@seedip.com

Eric S. Walters  
Erica D. Wilson  
WALTERS WILSON LLP  
Eric@walterswilson.com  
EricaWilson@walterswilson.com

PATENT OWNER:

Dion M. Bregman  
Christopher Halliday  
Alexander B. Stein  
MORGAN, LEWIS & BOCKIUS LLP  
dion.bregman@morganlewis.com  
christopher.halliday@morganlewis.com  
alexander.stein@morganlewis.com