

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

ELECTRONICS AND TELECOMMUNICATIONS
RESEARCH INSTITUTE,
Patent Owner.

IPR2020-00239 and IPR2020-00241¹
Patent 9,204,438B2

Before KRISTEN L. DROESCH, and SCOTT B. HOWARD,
Administrative Patent Judges.

DROESCH, *Administrative Patent Judge.*

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

¹ This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing.

On December 10, 2019, Petitioner filed Petitions for *inter partes* review in IPR2020-00239 and IPR2020-00241. IPR2020-00239, Paper 2 (“’239 Petition” or “’239 Pet.”); IPR2020-00241, Paper 2 (“’241 Petition” or “’241 Petition”). Pursuant to 37 C.F.R. § 42.24(d) Petitioner certified that the ’239 Petition contained 13,356 words and that the ’241 Petition contained 13,767 words. ’239 Pet. 88; ’241 Pet. 88.

A conference call was held on January 29, 2020, between counsel for the parties and Judge Droesch and Judge Howard. A court reporter also attended the conference call. Counsel for Patent Owner requested the conference call to discuss asserted word count violations in each of the Petitions. Patent Owner filed a copy of the transcript. IPR2020-00239, Ex. 2001; IPR2020-00241, Ex. 2001.

Patent Owner contends that each Petition includes more than 3500 words in images that were not counted toward the word count. Counsel for Patent Owner points to pages 19–24 and 41–44 of the ’239 Petition and pages 19–24 and 38–45 of the ’241 Petition as examples of images with excessive words. In support of its position that the Petition images include excessive words in violation of 37 C.F.R. § 42.24, counsel for Patent Owner directs our attention to *Google Inc., v. Ji-Soo Lee*, IPR2016-00022, Paper 25 (PTAB Dec. 2, 2016). Counsel for Patent Owner explains that the Board expunged the reply briefs for word count violations in *Google v. Ji-Soo Lee*.

Counsel for Patent Owner further asserts that each Petition omitted spacing for exhibit and paragraph numbers resulting in savings of at least 600 words counted towards the word count limits of the Petitions, specifically, roughly 300 words for the ’239 Petition and 430 words for the ’241 Petition.

Counsel for Patent Owner asserts that the Board should not consider the Petitions due to the word count violations. Counsel for Patent Owner further contends that the Petitions that exceed the word count requirements of 37 C.F.R. § 42.24 are not complete petitions as required by 37 C.F.R. §§ 42.104, 42.106 and should be dismissed if not corrected. Counsel for Patent Owner further asserts that if Petitioner were to correct the word count violations by filing new petitions, those newly filed petitions would be accorded a new filing date and, therefore, be time-barred under 35 U.S.C. § 315(b) based on the filing date of the complaint in related district court proceedings.

Counsel for Petitioner disagrees with Patent Owner's characterization of the images with words in each Petition. Counsel for Petitioner asserts that it reproduced the images with text to as a matter of convenience for the Board in navigating the cited exhibits. Counsel for Petitioner contends that the images containing words are not intended to be arguments because the substantive arguments are laid out in the text of the Petitions. Counsel for Petitioner states that the images with words could be removed without affecting the arguments laid out in the text of the Petitions. In other words, Counsel for Petitioner contends that Petitioner merely reproduces the relevant portions of the exhibits cited in the Petitions. Counsel for Petitioner states that when the parties met and conferred, Petitioner offered to Patent Owner to correct the atypical spacing for the exhibit and paragraph numbers and would not oppose allowing Petitioner to have additional words in the preliminary responses. Counsel for Petitioner further asserts that the Trial Practice Guidelines are not specific regarding spacing.

Counsel for Petitioner further disagrees with Patent Owner's assertion that Petitioner has not filed complete Petitions. Counsel for Petitioner

indicates that it is open to taking action to correct the Petitions, as deemed necessary by the Board. Counsel for Petitioner further states that revocation of a filing date already accorded is inappropriate based on a dispute over word count, which Counsel for Petitioner argues is a clerical error.

Counsel for Patent Owner further requests that, if the Board orders Petitioner to refile the Petitions without necessitating a new filing date, the time period for filing the Preliminary Response be reset to the full three month period. Counsel for Patent Owner contends that Patent Owner is prejudiced in these circumstances because the Petitions have 30 percent more content than they are supposed to have.

We have considered the positions advanced by each of the parties. With respect to the word count limits, the Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 (“Consolidated TPG”) explains:

Parties should not abuse the process. *Excessive 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. See, e.g., Pi-Net Int’l, Inc. v. JPMorgan Chase & Co., 600 F. App’x 774 (Fed. Cir. 2015).*

Consolidated TPG 40 (emphasis added).

Based on our review of the Petitions, it appears that the Petitions circumvent the word count limits set forth in 37 C.F.R. § 42.24(1)(a) by including numerous images with excessive wording. *See e.g., ’239 Pet. 19–24.* As a result, Petitioner’s certification of word count in each Petition is inaccurate. Patent Owner, however, does not direct us to, nor are we aware of, any Board rule that precludes the use of atypical spacing for citations to exhibit and paragraph numbers such as, “EX-1001” instead of “Ex. 1001”

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and “¶¶53-54” instead of “¶¶ 53-54.” At worst, Petitioner has used atypical citations for exhibit and paragraph numbers, and did not delete spacing between words. Petitioner’s intent may have been to reduce the number of spaces in Petitions, thereby reducing the word count reported by the word processing program. We strongly discourage such space saving for citations, but acknowledge that it does not render the Petitions unreadable or incomprehensible. *See Verasonics, Inc. v. Supersonic Imagine, S.A.*, IPR2019-00799, Paper 6 at 3–4 (PTAB May 13, 2019) (Order); *cf. Pi-Net Int’l, Inc. v. JPMorgan Chase & Co.*, 600 F. App’x 774 (Fed. Cir. 2015).

Our rules provide us with the authority and discretion to take certain actions for any abuse of our rules. 37 C.F.R. §§ 42.5, 42.12(b)(8). Patent Owner does not direct us to, nor are we aware of any Board case dismissing a petition because it exceeded the word count limit. *See e.g., Comcast Cable Comms, LLC v. Rovi Guides, Inc.*, IPR2019-01413, Paper 10 (PTAB Dec. 17, 2019); *St. Jude Medical LLC v. Snyders Heart Valve LLC*, IPR2018-00105, Paper 12 at 4–5 (PTAB Apr. 3, 2018); *Innovations4Flooring NV v. Välinge Innovation AB*, IPR2017-02130, Paper 10 (PTAB Feb. 22, 2018); *Artic Cat, Inc. v. Polaris Indus. Inc.*, IPR20179-00433, Paper 15 at 3 (PTAB June 22, 2017); *Google Inc., v. Makor Issues & Rights LTD.*, IPR2016-01535, Paper 11 (PTAB Dec. 12, 2016). In view of Petitioner’s characterizations of the images with excessive wording as reproductions of portions of the exhibits to aid in navigation of the Petitions and supporting exhibits, and Petitioner’s assertion that the images with excessive words could be removed without affecting the arguments in the Petitions, we decline to dismiss the Petitions. In the circumstances before us, the Board will not consider the images with excessive wording in the Petitions. After conferring with Patent Owner, for the convenience of the Board, Petitioner is

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