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To: [Trials](#)
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Subject: IPR Nos. IPR2023-00220, IPR2023-00221, IPR2023-00254, and IPR2023-00255 - Request for Immediate Denial of Institution
Date: Thursday, April 20, 2023 11:27:33 AM
Attachments: [image001.png](#)
[RE IPR Nos. IPR2023-00220 IPR2023-00221 IPR2023-00254 and IPR2023-00255.msg](#)

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Dear Trials,

We recently discovered that all of the Petitions in the above-referenced proceedings exceed the allowed word counts—by thousands of words in some cases—thereby prejudicing Patent Owner. We have conferred via email with Petitioner, who disagrees that the Petitions exceed the word count and asserts that we have waived our ability to raise the issue in any event. We request that the Petitions be denied immediately. As no bar date is pending, doing so would not prejudice the petitioner, who could simply refile Petitions that comply with the Board’s rules if Petitioner so wishes.

IPR Petitions are limited to 14,000 words and Petitioners must certify compliance with the word count. “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.” 37 C.F.R. § 42.24 (emphasis added). The Consolidated Trial Practice Guide (“TPG”) states, “[e]xcessive words in figures, drawings, or images . . . in order to circumvent the rules on word count, may lead to a party’s brief not being considered. TPG, 40 (citing *See, e.g., Pi-Net Int’l, Inc. v. JPMorgan Chase & Co.*, 600 F. App’x 774 (Fed. Cir. 2015)). The TPG also notes that “except in cases of obvious abuse, the Board will generally accept a party’s certification of compliance with word count limits” and also urges the parties to raise the issue promptly once discovered. *Id.*

In preparing Preliminary Responses for the above-referenced proceedings, we relied upon the Certificate of Word Counts provided by Petitioner’s counsel. However, in preparing the Preliminary Response for the -00255, we discovered by converting the PDF document to Word and then utilizing the word count feature that the Petition exceeded the Word count by at least 2,000 words. This is in addition to the numerous and excessive annotations used in the figures, which we have noted in each of the Preliminary Responses. We then determined that all of the Petitions in each of the above-referenced proceedings, contrary to Petitioner’s certificates, exceed the word count (e.g., -00221 > 17,000; -00254 > 16,000). Having discovered the issue, we immediately informed Petitioners’ counsel. *See* Attached Email Thread.

Petitioner responded that (1) the petitions comply with the word count limitations, and (2) Petitioner believes Patent Owner has waived the argument by failing to discover Petitioner’s violation earlier. In support of its position regarding compliance with the word count limit, Petitioner relies on 37 C.F.R. § 42.24, which states that claim listings are not included in the word count limit. Petitioner asserts that

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while Petitioner has reproduced claim language throughout the Petition, the claim language is formatted in a particular manner, each time it is formatted as a table cell, and thus does not count regardless of where or how many times it is included. Email, April 13th. An example is shown below:

3. Element 1[b]

1[b]	a cover panel forming a forward portion of the housing, wherein the cover panel is located forward of, and at least some distance from, the electronic image assembly and is configured to permit viewing of images displayed at the electronic image assembly through said cover panel;
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Karppanen discloses this claim element because Karppanen's display casing

IPR2023-00221, Petition at 30. Under Petitioner's interpretation, the highlighted text above is excluded from the Word Count because of its formatting, i.e., the box around the claim language, despite the fact that this claim language appears in the argument sections of the Petition. This is incorrect as Rule 42.24 excludes only an appendix including a claim listing. Petitioner also apparently asserts that our reliance on their Certificate of Word Count was misplaced, and we should have identified the issue earlier. *See* Attached Email, April 19th ("in any event, MRI failed to raise any objection promptly. To the contrary, MRI delayed four months before raising any issue.").

The limitation on word count is clear and Petitioner's violation is grossly excessive. Patent Owner thus requests that the Board immediately deny institution. Doing so would not prejudice Petitioner as no bar date has passed, and Petitioner can simply prepare petitions that comply with the Board's rules and file them. And doing so immediately further lessens any possibility of prejudice to the Petitioner. In contrast, Patent Owner is prejudiced because the Petitioner included thousands of additional words of argument in each of the Petitions, which otherwise would have been unavailable to it.

Should the Board wish to convene a telephone conference, the parties will meet and confer to determine mutually-acceptable dates and times.

Sincerely,
John Alemanni
Lead Counsel for Patent Owner

John Alemanni

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