

From: [Dutta, Sanjeet K](#)
To: [Trials](#)
Cc: [Morlock, Michael](#); [Sanders, Carl](#); [Dabbiere, Courtney](#); [Saul, Andrew](#); [Adkins, Robin](#); [Kline, Douglas J](#); [Reddy, Srikanth K](#); [Woo, Darryl M](#); [Larochelle, Christie](#); [Birbach, Naomi](#); [Alemanni, John](#)
Subject: IPR Nos. IPR2023-00220, IPR2023-00221, IPR2023-00254, and IPR2023-00255 - Proposal For Corrected Petitions
Date: Wednesday, April 26, 2023 11:59:37 AM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)
[image007.png](#)

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Dear Board:

In response to the Board's Order of April 21, 2023 (Paper 8), Petitioner proposes to file Corrected Petitions that delete the language that was not counted in Petitioner's original word count certifications based on its good faith understanding of the applicable rules. Because Petitioner will be deleting quoted claim listings throughout the Petitions, Petitioner proposes that it be allowed to add an appendix of claim listings to the Corrected Petitions pursuant to 37 C.F.R. 42.24(a)(1). Each Corrected Petition will include a Certification that it satisfies the word count requirement while counting every word within the tables and charts in the body of the Petitions. In addition to filing the Corrected Petitions, Petitioners also propose that it file red-lined versions of the original petitions showing the deletions and the additional appendices.

The Corrected Petitions will not include any additional argument or substantive revision. Therefore, there is no need for Patent Owner to file supplemental Preliminary Responses. As requested by the Board, Petitioners do not propose allowing Patent Owner additional words in future filings.

Petitioners propose filing the Corrected and red-lined Petitions within three (3) business days of the Board's decision on this proposal.

Regards,

Sanjeet K. Dutta
Partner



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From: Dutta, Sanjeet K

Sent: Friday, April 21, 2023 9:47 AM

To: Trials <Trials@USPTO.GOV>

Cc: Morlock, Michael <MMorlock@kilpatricktownsend.com>; Sanders, Carl <csanders@kilpatricktownsend.com>; Dabbiere, Courtney <CDabbiere@kilpatricktownsend.com>; Saul, Andrew <ASaul@kilpatricktownsend.com>; Adkins, Robin <RAdkins@kilpatricktownsend.com>; Kline, Douglas J <DKline@goodwinlaw.com>; Reddy, Srikanth K <SReddy@goodwinlaw.com>; Woo, Darryl M <DWoo@goodwinlaw.com>; Larochelle, Christie <CLarochelle@goodwinlaw.com>; Birbach, Naomi <NBirbach@goodwinlaw.com>; 'Alemanni, John' <jalemanni@kilpatricktownsend.com>

Subject: RE: IPR Nos. IPR2023-00220, IPR2023-00221, IPR2023-00254, and IPR2023-00255 - Request for Immediate Denial of Institution

Dear Board,

Patent Owner's email request that the Board deny institution of the above-referenced Petitions is both unwarranted and procedurally improper.

First, Patent Owner should have raised any arguments regarding the Petitions' compliance with the word limit in the Patent Owner Preliminary Responses to these Petitions. Having failed to do so, the appropriate mechanism should have been to request a telephone conference with the Board in order to request permission for either a supplemental response or to file a motion. Patent Owner instead sent the Board an email arguing for "immediate denial of institution." This is procedurally improper and effectively denies Petitioner an opportunity to be heard on the substance of Patent Owner's request.

Second, even though substantive argument is best reserved for the appropriate procedural mechanism, out of an abundance of caution, Petitioner notes that Patent Owner wrongfully argues that Petitioner should be penalized for including helpful tables of claim language into the Petition. It was and is Petitioner's good faith belief that quoting the lengthy claim language in this fashion did not affect the word count under 37 C.F.R. § 42.24 because this is nothing more than a "claim listing," which is excluded from the word count. As such, Petitioner stands by its certification of the word count. Petitioner is not aware of an interpretation of the rule that has previously determined Petitioners should be penalized for quoting the claim language in the body of the Petition as Petitioner has here. Highlighting this point, Patent Owner has not articulated any legitimate prejudice it has suffered from Petitioner's inclusion of the claim language in tabular format within the body of the Petitions. Nor could it -- as Patent Owner recognizes that Petitioner did not exceed the word count for its argument. In other words, removing the tables of claim listings throughout the petition, which are duplicates of the table of claim listings at the beginning of the Petitions, would not in any way alter the substantive content of the Petitions. Patent Owner has had a fair

opportunity to respond to Petitioner's arguments as Patent Owner used far under the 14,000 word limit for each of its Preliminary Responses to address the substantive arguments of the Petitions. (See, e.g., POPR in IPR2023-00254, certifying 4,525 words).

Further, Petitioner has not included excessive annotations of figures, contrary to Patent Owner's assertion. All annotations merely provide labels for the structures in the figures and, in large part, correspond word-for-word with the descriptions provided within the prior art references; none of the annotations include any argument. The Board has previously determined that such annotations need not be counted toward the word limit. See *Tesla, Inc. v. Unicorn Energy GMBH*, IPR2022-00110, Paper 19, 11 (Feb. 17, 2022) ("[T]he annotations consist primarily of highlighting or other coloration and very short (a few words) labels. We find nothing improper or excessive in the use of figures and annotations in the Revised Petition. To the contrary, we determine that the figures and annotations are likely to properly aid us in our consideration of the Revised Petition.").

On the other hand, Petitioner would be significantly prejudiced by withdrawing these petitions given the June 26, 2023, ITC hearing in *In re Certain Outdoor and Semi-Outdoor Electronic Displays Products Containing Same, and Components Thereof*, Investigation No. 337-TA-1331, where Patent Owner asserted these patents against Petitioners. Institution Decisions on four of the Petitions are expected by June 20, 2023.

Petitioner respectfully requests that Patent Owner's request be denied. To the extent the Board considers Patent Owner's e-mail as a request to file a motion, Petitioner further requests that it be denied for the reasons above. Alternatively, Petitioner requests a telephone conference with the Board to discuss a procedurally appropriate process for resolving this dispute.

Kind regards,

Sanjeet K. Dutta

Partner



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From: Alemanni, John <jalemanni@kilpatricktownsend.com>

Sent: Thursday, April 20, 2023 8:27 AM

To: Trials <Trials@USPTO.GOV>

Cc: Morlock, Michael <MMorlock@kilpatricktownsend.com>; Sanders, Carl <csanders@kilpatricktownsend.com>; Dabbiere, Courtney <CDabbiere@kilpatricktownsend.com>;

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Subject: IPR Nos. IPR2023-00220, IPR2023-00221, IPR2023-00254, and IPR2023-00255 - Request for Immediate Denial of Institution

EXTERNAL

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 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



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