

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner

v.

SURGETECH LLC,
Patent Owner

Case IPR2023-00735
Patent 11,334,598

**MOTION TO WAIVE WORD COUNT
PURSUANT TO 37 C.F.R. § 42.24(a)(2)**

Pursuant to 37 C.F.R. §42.24(a)(2), in the interests of justice Petitioner requests a waiver of the word count requirement of §42.24(a)(1)(i) for the appended Petition for *inter partes* review (“Proposed Petition”) of claims 1–20 of U.S. Patent No. 11,334,598 (the “’598”). Concurrent with the filing of this Motion and Proposed Petition, Petitioner has filed an abbreviated version of the Petition for *inter partes* review addressing claims 1–5, 8-13, and 16-18 of ’598, which complies with the 14,000-word limit of 37 C.F.R. §42.24(a)(1)(i). Petitioner has also filed a second backup petition (IPR2023-00736), along with filing fees, addressing claims 6-7, 14-15, 19-20 in the event this motion is denied.

Surgetech has asserted *every claim* of the ’598 patent (claims 1-24) against Petitioner in litigation. Petitioner has not challenged claims 21-24 before the Board to streamline its PTAB challenges, and because Petitioner is demonstrating in district court that those claims include indefinite means-plus-function limitations. Petitioner has made every effort to present its arguments addressing the ’598 patent’s remaining 20 claims, along with a discussion of discretionary denial issues in keeping with the Board’s guidance, in one petition that complies with §42.24(a)(1)(i)’s word count requirement but is still sufficiently detailed to meet Petitioner’s burden. Because this has not been possible given the number and length of the 20 litigated claims being challenged, Petitioner respectfully requests that the Board grant this motion to waive the word count requirement of

§42.24(a)(1)(i).

The 20 claims challenged in the overlength Petition here are lengthy: the independent claims each contain as many as seven (claims 1 and 9) to nine (claim 17) limitations, and claims 1-20 together stretch across almost 3 columns of the patent. *See* EX1001, 41:18-44:5. Notwithstanding Petitioner’s efforts, it has proven impractical to fit a sufficiently-explained six-way obviousness combination—with the appropriate explanation and level of necessary detail, including motivations to combine, for 20 claims of this length—into a single Petition under 14,000 words. In order to present its arguments as efficiently as possible, Petitioner has limited all of its asserted grounds to a single base reference, Jacob, and has endeavored not to repeat theories or explanations when claim limitations overlap. However, while some claims of ’598 have overlapping limitations, other claims do not.

Indeed, Petitioner relies only on a single base reference (Jacob), and combines that reference with secondary reference Phillips for each ground. While Petitioner recognizes there are a large number of Grounds identified with this single base, this is a result of Petitioner’s effort to be clear that fewer than all of the four additional secondary references (Evangelist, Franklin, Kono and Tamura) may be necessary, depending on PO’s arguments. Evangelist is relied on in the event PO argues, or the Board determines, that Jacob does not disclose an initial “allocation” despite its teaching to “reallocate inventory to [a] better-selling channel” (EX1004,

¶[0180]) (*see, e.g.*, -00735 Short Pet.34, 40; -00736 Pet.34, 40); Franklin is relied on for “real time” (*see, e.g.*, -00735 Short Pet.41, 44-47; -00736 Pet.41, 44-47) in the event Jacob’s disclosures that “***confirmation information is sent to... the Property***” (EX1004, ¶[0086]) and of “real time” (EX1004, ¶[0005]) are deemed insufficient (-00735 Short Pet.44; -00736 Pet.44); and Kono and Tamura are relied on for a set of additional limitations in the event Jacob’s disclosures are deemed insufficient—with Kono and Tamura as alternatives presenting distinct systems (from slightly different perspectives) as to some of these (*see, e.g.*, -00735 Short Pet.47-49, 56-57; -00736 Pet.§VI, 47-48, 56-57), Tamura without Kono as an alternative for certain other limitations and as a requirement for certain dependent claims (*see e.g.*, -00735 Short Pet.§VI, 64 & 69-72 (cl.9[f]), 84-87 (cl.11 with Tamura as a required part of the combination), 87-90 (cl.13 with Tamura as a required part of the combination); -00736 Pet.§VI, 64-65 & 69-72 (cl.9[f])), and Kono (without Tamura) as an alternative for certain other limitations (*see e.g.*, -00735 Short Pet.§VI, 80-84 (cl.10)).

In addition, Petitioner has identified several claim construction disputes, and has provided obviousness analysis under both the correct constructions, and other alternative constructions, in the event Patent Owner argues them. §VI.A, Long Pet.44-47, 68-72, 77-80; *see also* EX1022, 2; EX1021, 2.

Further, in accordance with its understanding of the Board's prior guidance, rather than requesting a sur-reply after the POPR to first address such issues in detail, Petitioner has included in the Petition a substantive discussion of discretionary denial under 35 U.S.C. §314, which consumed about 587 words. Under the circumstances, 14,000 words is insufficient to address all 20 claims of the '598 patent while also properly addressing discretionary denial.

Thus, Petitioner respectfully requests an additional 1014 words in order to address claims 6-7, 14-15, 19-20 (the "additional claims") of '598 while still appropriately addressing discretionary denial issues. Petitioner's minimal request will (1) preserve the resources of all those involved, including the Board's, and (2) prevent substantial future injustice to Petitioner.

The Board's and Parties' Resources: Permitting Petitioner to challenge claims 1-20 here would allow the Board to efficiently resolve related patentability issues for all 20 of the non-means-plus-function claims of '598 in a single proceeding, promoting both efficiency and the public interest in having these questions substantively addressed. Although Petitioner has filed a separate backup Petition to cover the claims that could not be fit into a single petition if this motion is not granted (along with the associated filing fees), the overlap between the two IPRs is substantial, with only about 2000 words of the second Petition not included in the first (and vice versa).

Further, providing additional words here would avoid the need to consider the second petition on the remaining claims. A vast majority of Petitioner's 14,000 words in the second petition, over about 12,000 words, are devoted to the same information. The new information in the second petition is entirely encompassed by the overlength petition in this proceeding. Thus, requiring a separate second petition, rather than a single petition with this slight increase in words, would be unnecessarily and wastefully duplicative.

In addition, because the Proposed Petition would be only 427 words over the 14,000 word limit if the discretionary denial arguments were omitted, any additional effort associated with the inclusion of additional words would be minimal, and in large part limited to the pre-institution period, because such discretionary denial arguments will become moot at the time of institution.

Lastly, whether or not Petitioner prevails in this proceeding, the effort and resources expended by the Board in considering the additional claims in this single proceeding may save the Board from having to administer and review the entirety of a second Petition only for the sake of less than about 2000 words of new content.¹

¹ Petitioner submits the Board may deny institution of the second petition (IPR2023-000736) as moot (*e.g.*, under §314) in the event this motion is granted.

Interests of Justice: In the related district court litigation, Patent Owner has not made any attempt to narrow the claims that it has asserted against Petitioner, instead asserting every claim of all three related patents in litigation. The inability of Petitioner to challenge the asserted claims in the PTAB would pose a risk of substantial injustice to Petitioner if this Motion is denied (unless, instead, the second Petition is instituted)—depriving Petitioner of the “quick and cost-effective alternative[] to litigation” intended by Congress (*e.g.*, H.R. Rep. No. 112-98, pt.1, 40 (2011), 2011 U.S.C.C.A.N. 67, 69), and requiring Petitioner to litigate (and in various respects repeat) in district court the invalidity arguments it is already presenting here for the asserted claims.

Conclusion: For the reasons above justice requires, and Petitioner respectfully requests, that the word count requirement of 37 C.F.R. § 42.24(a)(1)(i) be waived, and that Petitioner be permitted to file the Proposed Petition. If Petitioner’s request is granted, Petitioner would not oppose a corresponding percent increase in the word limit for Patent Owner’s Preliminary Response.

Respectfully submitted:

/s/ Megan Raymond
Megan F. Raymond

3/28/2023

CERTIFICATE OF SERVICE

It is certified that a copy of the following document has been served in its entirety on the patent owner as provided in 37 CFR §42.205:

MOTION TO WAIVE WORD COUNT
PURSUANT TO 37 C.F.R. § 42.24(a)(2)

The copy has been served on March 28, 2023 by causing the aforementioned document to be mailed by Priority Mail Express to the following attorneys of record for patent owner listed below:

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Dated: March 28, 2023

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