

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner,

v.

SURGETECH LLC,
Patent Owner.

IPR2023-00735
Patent 11,334,598 B2

Before JAMES A. TARTAL, MICHAEL L. WOODS, and
RYAN H. FLAX, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION AND ORDER
Granting Petitioner's Motion to Exceed Page Limit and
Entering Terms of Joint Proposed Stipulation
37 C.F.R. §§ 42.5(a) and 42.24(a)(2)

I. INTRODUCTION

Uber Technologies, Inc. (“Petitioner”)¹ filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting an *inter partes* review of claims 1–20 (“the Challenged Claims”) of U.S. Patent No. 11,334,598 B2 (Ex. 1001, “the ’598 patent”). Paper 2 (“Pet.”). Petitioner acknowledges that the Petition contains 15,014 words, exceeding by 1,014 words the number of words authorized for a petition under 37 C.F.R. §42.24(a)(1)(i). Along with the Petition, Petitioner filed a Motion to Waive Word Count Pursuant to 37 C.F.R. § 42.24(a)(2). Paper 5 (“Motion” or “Mot.”). Petitioner also filed, at the same time, a shortened version of its Petition comprising only 13,690 words and challenging only claims 1–5, 8–13, and 16–18 of the ’598 patent. Paper 3.

Simultaneously, Petitioner further filed a separate petition under a second proceeding challenging only claims 6, 7, 14, 15, 19, and 20 of the ’598 patent, that is, the claims not challenged in the shortened version of its Petition under this proceeding. *Uber Technologies, Inc. v. Surgetech LLC*, IPR2023-00736, Paper 2. The grounds of unpatentability Petitioner asserts against claims 6, 7, 14, 15, 19, and 20 are the same in both the Petition and in the petition filed in IPR2023-00736. *Compare* Pet. 13–14, *with* IPR2023-00736, Paper 2 at 13–14. Additionally, Petitioner filed an Explanation of Parallel Petitions, stating that the petition filed in IPR2023-00736 “need only be considered in the event the Board denies Petitioner’s Motion to Waive Word Count in IPR2023-00735.” Paper 4, 1. According to Petitioner, waiving the default word limit for the Petition is in the interests of justice

¹ Petitioner states that it “also identifies, as a potential [real party in interest], Uber Freight Holding Corp.” Pet. 11.

and necessitated by the length of the Challenged Claims, alternative claim construction issues, and “a substantive discussion of discretionary denial under 35 U.S.C. §314” in the Petition. Mot. 1–6. Surgetech LLC (“Patent Owner”)² has not yet filed a preliminary response in either proceeding and we have made no determination on institution at this time. At our request, the Parties met and conferred in regard to the Motion and the petition filed in IPR2023-00736 and, subsequently, filed with our prior authorization a Joint Proposed Stipulation (the “Stipulation” or “Stip.”). Paper 9.

II. DISCUSSION

We appreciate the substantial efforts of the Parties to reach agreement on the Stipulation to efficiently address briefing and consideration of the issues raised in this proceeding and in IPR2023-00736 in an efficient manner. We find that the terms of the Stipulation are reasonable, warranted, and in the interests of justice. *See* Stip. 2–3. In short, under the Stipulation, Patent Owner agrees not to oppose the Motion, with the provision of a proportional increase in the word limitations for further briefing, and, if the Motion is granted, the Parties agree to file a joint motion to dismiss the petition in IPR2023-00736. *Id.* We grant the Motion and adopt the word limitations as set forth below. Simultaneous with this Decision and Order, in IPR2023-00736, we authorize a joint motion to dismiss the petition and terminate that proceeding.

III. ORDER

Upon consideration of the record before us, it is:

ORDERED that Petitioner’s unopposed Motion to Waive Word Count Pursuant to 37 C.F.R. § 42.24(a)(2) (Paper 5) is granted;

² Patent Owner identifies no additional real parties in interest. Paper 7, 2.

FURTHER ORDERED that Petitioner's shortened version of the Petition (Paper 3) is expunged;

FURTHER ORDERED that Patent Owner may file a preliminary response to the Petition pursuant to 37 C.F.R. § 42.107 not to exceed 15,014 words;

FURTHER ORDERED that if *inter partes* review is instituted, Patent Owner may file a response to the Petition pursuant to 37 C.F.R. § 42.120 not to exceed 15,014 words;

FURTHER ORDERED that if Patent Owner files a response to the Petition pursuant to 37 C.F.R. § 42.120 that exceeds 14,000 words, then Petitioner may file a reply not to exceed 6,003 words, and Patent Owner may file a sur-reply not to exceed 6,003 words; and,

FURTHER ORDERED that if Patent Owner files a response to the Petition pursuant to 37 C.F.R. § 42.120 that does not exceed 14,000 words, then Petitioner may file a reply not to exceed 5,600 words and Patent Owner may file a sur-reply not to exceed 5,600 words.

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