

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

QUANTUM IMAGING LLC,
Patent Owner.

IPR2023-00954
Patent 8,458,028 B2

Before SCOTT A. DANIELS, KEVIN W. CHERRY, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

Denying Authorization for Patent Owner's Motion to Strike
Denying Patent Owner's Request for Additional Words in its Sur-reply

On June 17, 2024, Patent Owner, Quantum Imaging LLC requested a call with the Board to seek (1) authorization for a motion to strike exhibits and associated argument and testimony in Petitioner’s Reply and (2) additional words for its Sur-reply because of alleged word count violations by Petitioner Sony Interactive Entertainment LLC in its Reply. Ex. 3004. On June 20, 2024, Judges Cherry and Daniels conducted a telephonic conference with counsel for the parties regarding these requests. *See* Exhibit 2014 (Transcript of Conference Call).¹

With respect to the Motion to Strike, Patent Owner seeks to strike portions of the Reply and Exhibit 1026, which contains excerpts from the textbook “Software Architecture: Foundations, Theory, and Practice,” which lists Patent Owner’s declarant, Dr. Nenad Medvidovic as one of its authors. *See* Ex. 2014, 7–8. Patent Owner argues that the evidence and the related arguments in the Reply are improper and untimely. *Id.* at 6–11. Patent Owner does not persuade us that a motion to strike is warranted in this instance. As the Consolidated Trial Practice Guide explains, “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.” PTAB Consolidated Trial Practice Guide at 80 (Nov. 2019) (“CTPG”).² Indeed, the CTPG continues that “[a] motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety, whereas further briefing may be more appropriate when the party wishes to address the proper weight the Board should give to the arguments or evidence.” *Id.*

¹ Exhibit 2014 contains two sets of numbers, one for the transcript, and one added by Patent Owner in the lower-righthand corner. We cite to the numbers in the lower-righthand corner.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Patent Owner's arguments that Exhibit 1026 is from after the priority date of the challenged patent goes to the weight we should give the evidence, not whether we should strike it. Nor do Patent Owner's arguments that the exhibit is untimely and Petitioner has changed its theories persuade us that a Motion to Strike is warranted. As the CTPG further explains, "[i]n most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply." *Id.* Dr. Medvidvic mentioned his textbook at his deposition, so Patent Owner was aware of its potential relevance to this proceeding. *See* Ex. 2014, 13. Moreover, Patent Owner will be free to explain in its sur-reply how Petitioner's argument is new and untimely and why we should disregard it. Thus, we disagree that a Motion to Strike is warranted and deny Patent Owner's request for authorization to file a Motion to Strike.

As for the word count issue, Patent Owner argues that Petitioner failed to count words found in the various figures from the prior art and prosecution history reproduced in the Reply. *See* Ex. 2014, 21–29. Patent Owner requests 380 additional words. *Id.* at 21. We agree with Petitioner that the CTPG addresses this issue. In particular, the CTPG explains:

The Office provides the following practical guidance regarding compliance with the word count limits. With a word count limit, parties may include concise arguments in claim charts if they choose. Moreover, when certifying word count, a party need not go beyond the routine word count supplied by their word processing program. 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). Except in cases of obvious abuse, the Board will generally accept a party's certification of compliance with word count limits. If a party feels that it would suffer undue prejudice from an opposing party's alleged word count limit violation or abuse, that party should raise the issue with the Board promptly after discovering the issue. The Board expects the parties to take reasonable steps to remedy any such issues before approaching the Board. If an opposing party raises a word count limit violation or abuse, the Board will consider such a violation or abuse on a case-by-case basis.

CTPG 38.

We agree with Petitioner that this is not an obvious case of abuse. *See* Ex. 2014, 22–24. The images included in the Reply are mostly just figures from the challenged patent, the prior art patents, and the prosecution history. Most of the words contained within those figures are not relevant to this case, or are merely labels for the boxes in the figures. This is not an effort to evade the word count limit by using images to fool the word processor. Moreover, Petitioner informed us that they would not object to Patent Owner reproducing figures from the prior art references or prosecution history, without textual annotations, and excluding those words from any word count. *See id.* at 37–38. We find that, even if Petitioner did violate the word count, this accommodation is a sufficient remedy for Patent Owner. Accordingly, we deny Patent Owner's request for 380 additional words in its sur-reply.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Patent Owner's request for authorization to file a motion to strike is *denied*; and

FURTHER ORDERED that Patent Owner's request for additional words for its sur-reply is also *denied*.

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