

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELTA ELECTRONICS, INC.,
Petitioner,

v.

VICOR CORPORATION,
Patent Owner.

IPR2024-00187
Patent 9,166,481 B1

Before GEORGIANNA W. BRADEN, KARA L. SZPONDOWSKI, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

On February 5, 2024, Patent Owner Vicor Corporation (“Patent Owner”) contacted the Board, stating that the parties disputed whether the Petition (Paper 1, “Pet.”) violated the word count of 37 C.F.R.

§ 42.24(a)(1)(i). Ex. 3001. Patent Owner further stated that the parties had conferred per the guidance in the Consolidated Trial Practice Guide,¹ and reached the following agreement:

Patent Owner requests, and Petitioner does not oppose, that the Board raise the word count allotted to the Patent Owner Preliminary Response under 37 CFR 42.24(b)(1) to 21,000 words. If the requested word count is granted, Patent Owner will not make arguments, in the Preliminary Response or otherwise, that Patent Owner was prejudiced by the word count in the Petition or that the Board should enforce the word count limit for any other reason.

Id.

We appreciate that the parties conferred and came to an agreement on this disputed issue prior to approaching the Board. *See* CTPG 40. Petitions requesting *inter partes* review are allotted 14,000 words. *See* 37 C.F.R. § 42.24(a)(1)(i). The CTPG provides practical guidance regarding compliance with the word count limits. CTPG 40. For example, “when certifying word count, a party need not go beyond the routine word count supplied by their word processing program.” *Id.* However, “[p]arties should not abuse the process. Excessive words in figures, drawings, or images, deleting spacing between words, or using excessive acronyms or

¹ Consolidated Trial Practice Guide, 39–40 (November 2019) (“CTPG”), available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=Tri alPracticeGuideConsolidated>.

abbreviations for word phrases, in order to circumvent the rules on word count, may lead to a party's brief not being considered.” *Id.*

We have reviewed the Petition filed by Petitioner Delta Electronics, Inc. (“Petitioner”). In our view, Petitioner has excessively used images of text from the asserted references in support of their arguments, resulting in excess of thousands of words past the word count limit.² *See, e.g.*, Pet. 30, 32, 35, 37, 38, 41, 43, 44, 53, 54, 56, 61, 65, 71, 73, 76–79, 81–83, 86, 90, 97–99, 101–104, 108–110, 114, 119, 120. This approach is in direct conflict with the guidance provided in the CTPG. Petitioner is cautioned that using such an approach in future briefs may result in those briefs not being considered. *See* CTPG 40 (citing *Pi-Net Int’l, Inc. v. JPMorgan Chase & Co.*, 600 F. App’x 774 (Fed. Cir. 2015)).

However, given that the parties agree on the appropriate resolution, and further given the timing of the request,³ we will allow Patent Owner an additional 7,000 words in the Preliminary Response, for a total of 21,000 words. *See* 37 C.F.R. § 42.24(b)(1) (allowing 14,000 words for a preliminary response); CTPG 40 (“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.”).

ORDER

For the foregoing reasons, it is

² Petitioner’s certification of compliance states that the Petition totals 13,914 words, and that counsel relied upon the word count feature provided by Microsoft Word, which we understand to mean that the text included in these text images was *not* counted in the provided word count. *See* Pet. 133.

³ Patent Owner’s Preliminary Response is due on February 21, 2024.

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ORDERED that the word count allotted for Patent Owner's Preliminary Response is increased from 14,000 to 21,000. *See* 37 C.F.R. § 42.24(b)(1).

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For PETITIONER:

Russell E. Levine, P.C.
Joshua P. Glucoft
Jiaxiao Zhang
KIRKLAND & ELLIS LLP
russell.levine@kirkland.com
josh.glucoft@kirkland.com
jiaxiao.zhang@kirkland.com

For PATENT OWNER:

Matthew A. Smith
Andrew S. Baluch
Amy Greywitt
Elizabeth Laughton
SMITH BALUCH LLP
smith@smithbaluch.com
baluch@smithbaluch.com
greywitt@smithbaluch.com
laughton@smithbaluch.com