

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEAD SPORT GMBH,
Petitioner,

v.

VERMONT SAFETY DEVELOPMENTS LLC,
Patent Owner.

IPR2024-01099
Patent 7,523,953 B2

Before BARRY L. GROSSMAN, MITCHELL G. WEATHERLY, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

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

On September 5, 2024, the Board held a telephone conference in this proceeding with counsel for the parties. Judges Grossman, Weatherly, and Silverman appeared for the Board. Mr. Anthony Berlenbach appeared on behalf of Petitioner. Mr. Thomas Kohler appeared on behalf of Patent Owner. There was no court reporter present, and thus no transcript of the call.

The conference was held because of an email, dated July 23, 2024, sent to the Board by Mr. Kohler. Mr. Kohler requested a conference with the Panel assigned to this case to:

[R]equest[] authorization to file a motion to strike the petition in the above-referenced proceeding based on violations of 37 C.F.R. § 42.24(a)(i) and (d) and 37 CFR § 42.6(a)(3) regarding the word count limitation/certification and incorporation by reference. In particular, the basis for the proposed motion is (1) Petitioner has certified 13,998 words, (2) Petitioner's use of abnormal spacing in citations caused an undercount of the number of words by the word processor, and (3) Petitioner's incorporation by reference of the claim terms and claim constructions renders the Petition unreadable as a standalone document and further reduces word count.

See Ex. 3001.

“The rules governing the conduct of AIA trial proceedings were designed to promote fairness and efficiency.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019)¹ (“TPG”), 35. For example,

37 C.F.R. § 42.24(a) sets word limits for petitions, motions, and replies, and § 42.6(a)(3) prohibits incorporating arguments by reference from one document into another. Thus, parties that incorporate expert testimony by reference in their petitions,

¹ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialsPracticeGuideConsolidated>.

motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board.

TPG 35–36 (citing *Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014) (informative)).

WORD COUNT

Federal courts routinely use word count limits to manage motions practice, as “[e]ffective writing is concise writing.” *Spaziano v. Singletary*, 36 F.3d 1028, 1031 n.2 (11th Cir. 1994). Federal courts have found that word count limits ease the burden on both the parties and the courts, and patent cases are no exception. *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014) (explaining that allowing a party to incorporate by reference, resulting in exceeding court’s allowable word count “would be fundamentally unfair”); TPG 39.

Petitioner has certified that the Petition contains 13,998 words, two words under the 14,000-word limit for a Petition. *See* 37 C.F.R. § 42.24(a)(1)(i). Our rules do not specify a specific format for citations of exhibits, case law, or other information to identify the cited information. Our rules, for example, do not require parties to follow Blue Book citation rules. *See Ericsson Inc. v. Electronics and Telecommunications Research Institute*, IPR2020-00239, Paper 8 (PTAB Jan. 31, 2020). As stated by the Board in this case,

Patent Owner, however, does not direct us to, nor are we aware of, any Board rule that precludes the use of atypical spacing for citations to exhibit and paragraph numbers such as, “EX-1001” instead of “Ex. 1001” and “¶¶53-54” instead of “¶¶ 53-54.” At worst, Petitioner has used atypical citations for exhibit and paragraph numbers, and did not delete spacing between words. Petitioner’s intent may have been to reduce the number of spaces

in Petitions, thereby reducing the word count reported by the word processing program. We strongly discourage such space saving for citations, but acknowledge that it does not render the Petitions unreadable or incomprehensible.

Ericsson, Paper 8 at 4–5.

Our Trial Practice Guide “provides the following practical guidance regarding compliance with the word count limits.” TPG 40. The Trial Practice Guide states:

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.

TPG 40.

In the telephone conference, Patent Owner noted specifically that Petitioner cited to submitted exhibits using the format, e.g., “Ex-1001,” which is typed as Ex[dash][exhibit number]. *See, e.g.,* Pet. 1 (citing “Ex-1003-Freudiger-1”). During the telephone conference, the parties acknowledged

that the “word count” feature of commonly used word processing systems counts this citation as one word. If the citation were typed as “Ex. 1003, Freudiger 1,” using normal punctuation and spacing, it would have counted as four words.

Counsel for Petitioner stated that the citation format used in the Petition was commonly used by his law firm. If true, two IPR petitions filed recently by Petitioner’s law firm show, at least, that the disputed citation format is not used in every instance. *See, e.g.*, IPR2024-01346 (petition filed August 30, 2024); IPR2024-00233 (petition filed January 17, 2024). These two cases follow the more typical format of citing exhibits as “Ex. 1001,” using punctuation and spaces to separate words, abbreviations, and other characters.

Here, to maintain and promote fairness and efficiency in the spirit of our rules, Patent Owner may, in its responses² to the Petition, exceed the 14,000-word count limit by 2,000 words. *See* 37 C.F.R. § 42.5(b) (stating that the Board “may waive or suspend a requirement of” our rules). We determine this is a reasonable estimate of the additional words obtained by Petitioner without imposing the burden on Patent Owner or the Board of counting the specific advantage in word count obtained by Petitioner in deleting spacing between words, or using excessive abbreviations for word phrases, in order to circumvent the rules on word count. We expect both parties to use a conventional citation format in all future submissions.

INCORPORATION BY REFERENCE

In *Cisco Systems*, the Board held the practice “of using footnotes to cite

² Patent Owner may use the additional words in both its preliminary response (if Patent Owner chooses to file one) and in its response (if we institute *inter partes* review).

large portions of another document, without sufficient explanation of those portions, amounts to incorporation by reference.” *Cisco Systems*, IPR2014-00454, Paper 12 at 7 (footnote omitted). The Board also held “[t]he practice . . . of citing to other claim charts in another document also amounts to incorporation by reference.” *Id.* at 8–9. Additionally, the Board held the “practice of citing the [Expert’s] Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference.” *Id.* at 9. The Board stated, “we will not consider arguments that are not made in the Petition, but are instead incorporated by reference to the cited paragraphs and claims charts of [an Expert’s] Declaration.” *Id.* at 10.

As discussed in the conference, in its Petition, for example, in discussing independent claim 30, Petitioner refers to claim elements 30(a), (b), (c), etc. *See, e.g.*, Pet. 14 (referring to claim element “30(b)”). The claims of the ’953 patent, however, do *not* use letters or other identifiers for portions of the claims. *See, e.g.*, Ex. 1001, 21:1–28. Thus, based on the Petition, neither we, Patent Owner, nor other readers know what Petitioner considers to be clause “30(b).” Immediately following the reference to claim element “30(b)” on page 14 of the Petition, the Petition states “Freudiger-1 discloses, or at least renders obvious, [30(b)]. Decl., ¶¶81–88.” The citation to “Decl., ¶¶81–88” refers to the cited paragraphs of Ex. 1002, the Declaration testimony of Maury Hull, Ph.D. *See* Pet. 6. Thus, we must turn to the Expert’s testimony to know what is intended by the Petition’s reference to “30(b)” and similar designations throughout the Petition.

On the incorporation by reference issue, we authorize additional briefing on Patent Owner’s allegation of improper incorporation by reference. In this context, the parties also should address whether the Petition satisfies the

requirements of 37 C.F.R. §§ 42.104(b)(4), (5). Patent Owner is authorized to submit a five (5) page brief identifying the alleged incorporations by reference and the associated violation and/or harm, and Petitioner is authorized to file a five (5) page response, as set out in the Order below.

This additional briefing does not affect the due date for Patent Owner's Preliminary Response, if Patent Owner chooses to file one.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner may file a Preliminary Response, and if we institute a trial, a Response, not to exceed 16,000 words for each document; and

FURTHER ORDERED that Patent Owner may file by no later than September 20, 2024, a brief not to exceed five (5) pages addressing the alleged improper incorporation by reference, as set forth herein; and whether the Petition complies with 37 C.F.R. §§ 42.104(b)(4), (5);

FURTHER ORDERED that Petitioner may file by no later than September 27, 2024, a response not to exceed five (5) pages to Patent Owner's brief; and

FURTHER ORDERED that this additional briefing does not change the due date of Patent Owner's Preliminary Response, if Patent Owner chooses to file one.

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