

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MARVELL SEMICONDUCTOR, INC.,  
Petitioner

v.

INTELLECTUAL VENTURES I LLC,  
Patent Owner

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Case IPR2014-00547  
Case IPR2014-00548  
Case IPR2014-00552  
Case IPR2014-00553<sup>1</sup>

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Before THOMAS L. GIANNETTI, JAMES A. TARTAL, and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

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<sup>1</sup> This paper addresses issues that are identical in the listed cases. The parties are not authorized to use this heading style for any subsequent papers.

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Patent Owner requested a conference to discuss Petitioner's compliance with our rules on formatting in connection with its Corrected Petitions. Paper 6.<sup>2</sup> In response, a conference call was held on May 21, 2014. Counsel for the respective parties and Judges Giannetti, Tartal, and Boucher participated. Patent Owner arranged for a reporter and will file a copy of the transcript. This Order addresses the issues discussed at the conference.

1. Improper Argument in Claim Charts

In the Board's Notice of Filing Date in each of these proceedings, Patent Owner was advised of improper argument in the claim charts in its Petitions: "Claim charts should be presented in a readable manner and be free from attorney or declarant Argument." Paper 3, 2. Patent Owner was given five days to correct the defect, and submitted a Corrected Petition in each proceeding. Paper 6. Patent Owner asserts that the claim charts in the Corrected Petitions still contain improper argument and asks to have the Petitions dismissed.

We have reviewed those claim charts and agree with Petitioner that they contain excessive, improper argument. Guidance on this is provided by FAQ (Frequently Asked Question) D12 on the Board's website, <http://www.uspto.gov/ip/boards/bpai/prps.jsp#heading-5>:

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<sup>2</sup> Paper numbers referenced in this Order are from IPR2014-00547. Corresponding papers were filed in each of the four proceedings.

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D12. Can claim charts include claim constructions, arguments, and explanations as to how the claims are unpatentable?  
(revised – February 11, 2014)

No. Extensive usage of claim charts in a petition is discouraged.

The rules require that a petition identify how the challenged claims are to be construed and how the claims are unpatentable under the statutory grounds raised. This information is to be provided pursuant to the page limit requirements, which require double spacing. Additionally, the rules require that the petition specify where each element of a challenged claim is to be found in the prior art. The element by element showing may be provided in a claim chart, which is permitted to be written with single spacing. *See § 42.6(a)(2)(iii). Placing one's argument and claim construction in a claim chart to circumvent the double spacing requirement is not permitted, and any such argument or claim construction may not be considered by the Board.*

(Emphasis added.)

Petitioner's counsel stated that they had contacted the Board for guidance before preparing the Corrected Petitions and discussed the matter of the claim charts with a Board paralegal. Petitioner's counsel is reminded that ex parte contact with Board employees about a specific proceeding is prohibited. *See 37 C.F.R. § 42.5(d)*. The exception for "ministerial communications" (e.g., to arrange a conference call) does not apply here, as the inquiry by counsel related to the substantive presentation of Petitioner's case. *See Rules of Practice for Trials Before the Patent Trial and Appeals Board, 77 Fed. Reg. 48612, 48616-17 (August 14, 2012)*. Petitioner's counsel will refrain from further ex parte contacts of this nature.

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For guidance on the correct use of claim charts, Petitioner is directed to the FAQ cited above and to Paper 3 in IPR2014-00587, referred to by Patent Owner's counsel during the call, which provides:

Arguments in Claim Charts: Claim charts should only be used to provide an element-by-element showing as to how the prior art teaches the limitations of a claim (e.g., citations to a prior art reference, quotations from a prior art reference). Claim charts may not include arguments, claim construction, statements of the law, or detailed explanations as to why a claim limitation is taught or rendered obvious by the prior art. A mere citation to an expert declaration (e.g., "See Ex. 1015 ¶ 29") in a claim chart is permissible, but anything more than a mere citation is improper.

## 2. Improper Line Spacing and Fonts

Patent Owner contends additionally that the block quotes in Petitioner's Corrected Petitions are not in compliance with our rules on fonts and spacing. *See* Rule 42.6 (37 C.F.R. § 42.6). Patent Owner does not dispute the fact that the block quotes use a smaller than 14-point font and are not properly spaced, and offered to revise its Corrected Petitions accordingly.

It is, therefore,

ORDERED that Petitioner will have five business days from entry of this Order to submit substitute corrected petitions that are fully compliant with our rules; and

FURTHER ORDERED that Patent Owner's preliminary response under 37 C.F.R. § 42.207 shall be due three months after the entry date of a

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notice from the Board that Petitioner's substitute corrected petitions authorized by this Order are fully compliant with the Board's rules.

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