

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMware, Inc.
Petitioner,

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE,
Patent Owner.

Case IPR2014-00901
Patent 6,978,346 B2

Before BRIAN J. McNAMARA, MIRIAM L. QUINN, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

ORDER TO CORRECT NON-COMPLIANT PETITION
Conduct of the Proceedings
37 C.F.R. § 42.5

On June 4, 2014, Petitioner filed its initial Petition. Paper 2, “Petition.” The Board issued a Corrected Notice of Filing Date Accorded to Petition on June 27, 2014 notifying petitioner that the Petition included a defect, i.e., improper usage of claim charts. Paper 5, “Notice.” In particular, the Notice stated the following:

Improper usages of 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.*

Paper 4, 2. The Corrected Petition filed on July 7, 2014 (Paper 6) has not corrected sufficiently the improper usage of claim charts. As one of many instances of improper usage, we direct Petitioner to the following example where, in the claim chart provided at page 19 of the Corrected Petition, the following is stated:

In addition, Hathorn Fig. 5 discloses shadowing data across multiple disks to create a remote dual copy, *which is a RAID architecture commonly known as RAID 1.* (Ex. 1005 at 8:64-9:51; 12:54-60; Ex. 1003, ¶ 143.)

Paper 6, 19 (emphasis added). In the above example, we find that the portion emphasized is a conclusion reached by a declarant and constitutes argument. As stated in the Notice, the use of claim charts is limited to an element-by-element showing, such as by providing citations to a prior art reference or quotations from a prior art reference. Explanations, characterizations, conclusions, or inferences drawn from the references are improper in a claim chart. The example provided above, where the source of the characterization of the prior art is a declarant’s opinion, is at odds with the Notice. If there is *any* need to explain how a reference

discloses or teaches a limitation, that explanation must be elsewhere in the petition—not in a claim chart.

Therefore, the Corrected Petition is held to be in non-compliance with the Notice and Petitioner will be allowed one *final* opportunity to correct the deficiencies in the petition. Failure to correct the petition will result in an order to show cause why the Board should not dismiss the petition and deny institution of a trial.

Order

It is

ORDERED that the Corrected Petition is non-compliant with the Notice;
FURTHER ORDERED that Petitioner shall arrange for a joint conference with the Board to discuss the deficiencies in the Corrected Petition; and

FURTHER ORDERED that Petitioner must correct the defect(s) within **FIVE BUSINESS DAYS** from this Order.

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