

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC.,
Petitioner

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner

Case IPR2014-00631
Case IPR2014-00632
Patent 7,817,914 B2¹

Before RICHARD E. RICE, JAMES B. ARPIN, and PETER P. CHEN,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge*.

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

¹ This order addresses issues that are identical in each case. We, therefore, exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2014-00631

Case IPR2014-00632

Patent 7,817,914 B2

INTRODUCTION

Patent Owner requested a conference to discuss Petitioner's compliance in these related cases with the Board's rules on formatting of petitions. *See Paper 1.*² In response, a conference call was held on May 29, 2014. Counsel for the respective parties and Judges Rice, Arpin, and Chen participated. Patent Owner arranged for a court reporter and agreed to provide a copy of the transcript of the conference to Petitioner for its prompt review and then to file a copy of the transcript as an exhibit with the Board, by June 5, 2014. This order addresses the issues discussed during the conference.

DISCUSSION

During the conference, Patent Owner raised two issues in connection with perceived deficiencies of the petitions. First, Patent Owner asserted that the claim charts contained in the petitions included excessive and improper arguments, contrary to the Board's rules and to guidance proved in FAQ (Frequently Asked Question) D12 on the Board's website, <http://www.uspto.gov/ip/boards/bpai/prps.jsp#heading-5>. Second, Patent Owner asserted that Petitioner improperly numbered the exhibits referenced in each petition, contrary to the guidance proved in FAQ (Frequently Asked Question) D9, also on the Board's website.

At the outset, we observe that more than five weeks have passed since the filing of the petitions on April 15, 2014. *See Paper 3, 1.* It is not apparent why Patent Owner did not raise its concerns as to the content of the

² Paper numbers referenced in this order are from IPR2014-00631. Corresponding papers were filed in IPR2014-00632.

Case IPR2014-00631

Case IPR2014-00632

Patent 7,817,914 B2

petitions or the numbering of the exhibits sooner.³ Nevertheless, we now consider the issues raised by Patent Owner.

1. Alleged Arguments in Claim Charts

According to Patent Owner, the petitions run afoul of Board rules governing document formatting by including argument within a claim chart. *See* 37 C.F.R. § 42.6(a)(2)(iii). In support for its position, Patent Owner directed us to Paper 3 of IPR2014-00587, which states that: “Claim charts may not include *arguments*, claim construction, statement of the law, or detailed explanations as to why a claim limitation is taught or rendered obvious by the prior art” (emphasis added). As examples of such alleged impermissible argument, Patent Owner pointed to examples in the petition in IPR2014-00631 at pages 14 and 18. Paper 1, 14, 18.

We have reviewed the claims charts, including the portions of the charts found at pages 14 and 18 of the cited petition. We do not discern, however, that the claim charts include content that is prohibited. Although quotations from a prior art reference are permitted, and, in many cases, may be preferable, Board rules do not mandate such quotations to the exclusion of other indications of how the prior art teaches the limitations of a claim. To that end, there is no prohibition on the use of a concise summary of the disclosure of a reference as an alternative to quotation from the reference in an element-by-element showing. That Petitioner’s claim charts include such a concise summary of the disclosure of the involved references, beyond a

³ In the Notice of Filing Date in each of these proceedings, the Board advised the parties that the petitions had been accorded a filing date of April 15, 2014. *See* Paper 3, 1. No deficiencies in the petitions were noted at that time.

Case IPR2014-00631

Case IPR2014-00632

Patent 7,817,914 B2

strict quotation, does not, in our view, present excessive and improper argument in the claim charts. We also do not discern that, in this case, the brief introductory or expository statements that precede expression of the disclosure of a reference and an accompanying citation in connection with a claim element rise to the level of “argument” that *must* be excluded from a claim chart.

During the conference call, Patent Owner indicated that the relief it seeks is our order requiring that Petitioner file corrected petitions, removing the allegedly excessive and improper argument from the claim charts, and inserting the arguments in the text of the petitions, and that the corrected petitions not exceed the 60 page limit for petitions. *See* 37 C.F.R. § 42.24(a)(i).⁴ Because we do not conclude that the petitions contain excessive and improper argument, that requested relief is *denied*.

2. Improper Numbering of Exhibits

Patent Owner further asserts that Petitioner has numbered improperly the exhibits filed in each of the above-captioned proceedings. We have reviewed the exhibits filed in each proceeding and agree with the Patent Owner that the exhibits are not numbered properly.

Initially, we note that each proceeding challenges the same patent, Patent No. US 7,817,914 B2. As noted above, the Board has provided guidance for the proper numbering of exhibits in such situations in FAQ D9, as follows:

⁴ Patent Owner did not request that we adjust the deadline for Patent Owner to file any preliminary responses in these proceedings or that we dismiss the petitions.

Case IPR2014-00631

Case IPR2014-00632

Patent 7,817,914 B2

D9. If I am filing two petitions challenging the same patent, should I use the same exhibit numbers in both cases?

No. In the situation where a petitioner files multiple petitions challenging the same patent, the petitioner should number its exhibits uniquely for both cases, such as 1001-1099 for case #1 and 1101-1199 for case #2. *See § 42.63(c).* Similarly, the patent owner in such situation should number its exhibits uniquely for both cases, such as 2001-2099 for case #1 and 2101-2199 for case #2. Therefore, if the Board decides to consolidate the cases, the exhibits would continue to be uniquely numbered in the consolidated proceeding.

In each proceeding, Petitioner improperly has numbered its exhibits beginning with exhibit number 1001.

During the conference, Patent Owner indicated that the relief it seeks is our order requiring that Petitioner properly number the exhibits in each proceeding. Because we conclude that Petitioner has numbered the exhibits in IPR2014-00632 improperly, that requested relief is *granted*. Therefore, we order Petitioner to renumber and refile the exhibits in IPR2014-00632 and to request that the Board expunge the exhibits currently filed by Petitioner in that proceeding.

ORDER

It is

ORDERED that Petitioner shall renumber and refile the exhibits in IPR2014-00632 and request that the Board expunge the exhibits currently filed by Petitioner in that proceeding, by no later than 5:00 PM Eastern Time on Thursday, June 5, 2014; and

Case IPR2014-00631

Case IPR2014-00632

Patent 7,817,914 B2

FURTHER ORDERED that the due date for filing any Patent Owner Preliminary Response in either proceeding remains unchanged by this order. The due date for any such response remains July 18, 2014.

PETITIONER:

Justin J. Oliver

Daniel S. Glueck

FITZPATRICK, CELLA, HARPER & SCINTO

Canon914IPR@fchs.com

PATENT OWNER:

Herbert D. Hart III

David Z. Petty

MCANDREWS, HELD & MALLOY, LTD.

hhart@mcandrews-ip.com

dpetty@mcandrews-ip.com