

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

RAYTHEON COMPANY,
Patent Owner.

Case IPR2015-01201
Patent 5,591,678

Before JENNIFER MEYER CHAGNON and JEFFREY W. ABRAHAM,
Administrative Patent Judges.

CHAGNON, *Administrative Patent Judge.*

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

On June 14, 2016, a conference call was held involving counsel for the respective parties and Judges Chagnon and Abraham. The purpose of the call was to discuss Petitioner's request for an increase in the word count for its Reply. Additional related issues also were discussed, as summarized below.

Word Count Limit for Reply

During the call, Petitioner's counsel noted that a significant portion of Patent Owner's Response is dedicated to arguments regarding prior invention, which is not a subject Petitioner would have been able to address in its Petition. Petitioner's counsel argued, thus, due to the volume of exhibits and declarations presented by Patent Owner with respect to its prior invention case, Petitioner needs more than the 5,600 words set forth in 37 C.F.R. § 42.24(c)(1) for its Reply, requesting 9,000 words instead.

Patent Owner's counsel indicated that, while Patent Owner would be amenable to a reasonable accommodation, Patent Owner did not agree with an increase to 9,000 words. Patent Owner's counsel argued that the material presented in the Response is not out of the ordinary, and that such a large increase in the word count was not necessary. Based on the facts and circumstances of this proceeding, we authorized an increase of the word count for Petitioner's Reply to a total of 7,000 words.

Other Guidance to the Parties

We also discussed additional points of clarification raised by Petitioner, in view of our ruling regarding the word count for the Reply. First, Petitioner requested clarification regarding whether it was necessary to discuss in its Reply arguments made only in declarations submitted with Patent Owner's Response. During the call, we indicated that this was not a

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question that we could answer in the abstract. While we will not comment on specific portions of Patent Owner's response evidence at this time, we remind the parties of 37 C.F.R. § 42.6(a)(3) which states that "[a]rguments must not be incorporated by reference from one document into another document." *See also Petroleum Geo-Services v. WesternGeco LLC*, Case IPR2014-00688, slip op. at 42 (PTAB Dec. 15, 2015) (Paper 101) (limiting review to "evidence actually discussed in Patent Owner's Response," noting "[w]e will not play archeologist with the record to discover evidentiary support for bare attorney argument made in such a response," and also declining to consider "information presented in an Exhibit, but not discussed sufficiently in Patent Owner's Response").

Petitioner's counsel also requested guidance on how it could, if needed, note in the record arguments that it would have made in its Reply but for the word count limitation. For example, Petitioner's counsel suggested it could file an additional paper, similar to a proffer in a district court proceeding, which would note any such arguments for the record. Petitioner's counsel also suggested it could use footnotes in the Reply to note such arguments. We advised the parties we would take this under consideration and provide guidance in our order summarizing the call.

We have taken Petitioner's request under consideration, and do not authorize any additional filings at this time. This does not limit the filing of papers provided for in the rules or already authorized in any other order in this proceeding. We note, however, Petitioner is not prevented from making any particular arguments in its Reply, but merely is limited to the amount of words in which it must present its arguments. Petitioner may use the

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7,000 words provided for its Reply to present its arguments in any manner it sees fit.

It is:

ORDERED that the word count for Petitioner's Reply is set to 7,000 words; and

FURTHER ORDERED that no additional filings are authorized at this time. This does not limit the filing of papers provided for in the rules or already authorized in any other order in this proceeding.

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