

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC. and
CHOICE HOTELS INTERNATIONAL, INC.

Petitioners

v.

FALL LINE PATENTS, LLC

Patent Owner

CASE IPR2018-00535
PATENT 9,454,748

**PATENT OWNER'S RESPONSE TO MAY 21, 2018 ORDER BY THE
COURT and DECLARATION OF JONATHAN DETRIXHE**

I. PETITIONERS DO NOT DENY THAT THE PETITION IS OVER THE WORD LIMIT NOR EXPLAIN WHY THE CERTIFICATION WAS “APPROXIMATE”

Petitioners’ Brief¹ and accompanying declaration do not dispute that: (1) Petitioners exceeded the word limit; (2) the certification is carefully worded so as to not amount to an actual certification of compliance with the word limit; and (3) a count of 13,999 was obtained by selecting only certain portions of the document.

Petitioners also fail to acknowledge the full extent of the problem.

Petitioners do not acknowledge they excluded not only certain annotations they added to the figures, but also (1) the cover page, (2) the signature block, and (3) the words in the pasted images. By excluding these portions, Petitioners undercounted by at least 786 words, not merely the 124 words that appear in the annotations.

Petitioners do not attempt to explain (or even mention) the use of “approximately” when certifying the word count of the Petition. The use of “approximately” in the certification—along with a certified number that was only one below the limit—is what called Patent Owner’s attention to this issue. It remains unclear why Petitioners certified the “approximate” word count, rather than the actual word count, as required by C.F.R. § 42.24(d) (“Any paper whose length is specified by type-volume limits must include a certification stating *the number* of words in the paper.”) (emphasis added).

¹ Petitioners’ Response to May 21, 2018 Order by the Board, Paper 8.

Notably, other petitions filed by Petitioners' counsel of record include certifications specifying an exact word count, in contrast with the "approximate" certification included in this petition. *See, e.g., General Electric Co. v. Univ. of Virginia Patent Found.*, IPR2017-00109, Paper 1 at 60 (Oct. 19, 2016) ("[T]he undersigned hereby certifies that the word count ... totals no more than 13,997"); *Uber Technologies, Inc. v. X One, Inc.*, IPR2017-01264, Paper 1 at 72 (April 11, 2017) ("I certify that this PETITION ... comprises 13,955 words.").

II. THE PROPOSED "REMEDY" IS NO PENALTY

Petitioners' proposed remedies, if adopted, would mean that failing to adhere to the Board's rules is of no significant consequence. Petitioners' proposals are, at worst, a minor inconvenience to Petitioners and would not deter future violations of the word-count or other rules because there is essentially no downside. Adopting one of the proposals would signal that failing to adhere to the rules risks only a proverbial "slap on the wrist" and only if caught.²

Petitioners argue there is no precedent for denying their Petition because of the word-count violation, but the language of 37 C.F.R. § 42.24(a)(2) is mandatory, not permissive: "Petitions to institute a trial *must* comply with the

² Patent Owner does not agree that following the Board-mandated rules is a "minor matter" that is a "waste [of] judicial resources," and Petitioners' reference as such further suggests that meaningful enforcement is necessary to compel adherence.

stated word counts” (emphasis added). This Board has made clear that “strict attention should be given to the mandated word count certification as it requires an attorney certification, and we will consider appropriate sanctions for violations of our formatting rules. *See* 37 C.F.R. §§ 42.11, 42.24(a), (d).” *Nvidia Corp. v. Polaris Innovations Ltd.*, IPR2017-01781, Paper 9 at 7 (P.T.A.B. Jan. 9, 2018).

In *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-01003, Paper 14 at 6-7 (P.T.A.B. Sept. 1, 2017), the Board noted that a party’s failure to adhere to the word-count limitations, including “[e]xcessive 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 counts, **may lead to dismissal of a party’s brief.**” (emphasis added). Indeed, the Board has expunged filings that failed to adhere to the formatting rules. *Google Inc. v. Ji-Soo Lee*, IPR2016-00022 and IPR2016-00045, Paper 25 (P.T.A.B. Nov. 23, 2016) (expunging two reply briefs because of incorrect certifications and failure to comply with the word limit); *Unified Patents, Inc. v. Rothschild Connected Devices Innovations, LLC*, IPR2016-00535, Paper 8 at 2 (P.T.A.B. June 28, 2016) (expunging patent owner’s preliminary response for failure to adhere to the word limit, among other violations). The Board should follow this precedent and dismiss the Petition for failure to follow the mandatory formatting rules.

06/04/2018
(Date)

Respectfully submitted,

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