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PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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How Many Words Do You Have to Challenge Each Patent Claim in IPR?

By Charles W. Shifley

January 4, 2017 — As almost everyone involved in patent practice knows, *inter partes* reviews (IPRs) are the new way to challenge patents. An IPR petition at the Patent Trial and Appeal Board, if the Board takes the matter up for trial, has a 71 percent statistical chance of killing the challenged patent. But when you start to write one of these petitions, how many words do you have per claim for your challenge? The answer is: not too many. Conceivably, you have as few or fewer than two paragraphs made up of eight sentences available per limitation of the challenged claims. To do what you need to do, you need to sharpen your use of words.

First, of course, by law or rule, there is no single answer to the number of words per claim. Petitions may in total have 14,000 words, excepting portions like the table of contents, table of authorities, mandatory notices, exhibit lists, and certificates of service and word counts. More length is possible, by motion. Assume you don't qualify. You might assume that with a typical patent of 20 claims, 14,000 words gives you 14,000 divided by 20, which equals 700 words per claim. Assuming 10 word sentences, that's 70 sentences. Assuming five-sentence paragraphs, that's 14 paragraphs, per claim. That's generous.

But step back. First, type a cover page for your petition — 75 words. Second, write an introduction — 25 words. Third, write of your compliance with the requirements for a petition, i.e., your payment of fees, your certification the patent is available for review, and that you are not barred or estopped — 100 words. Fourth, write a top-level identification of your challenge, listing the grounds, the associated statutory sections, and the prior art — 100 words. Fifth, write your positions on claim construction, and assume you write little — 200 words. Sixth, write a summary of your argument — 350 words. Seventh, write a section explaining the challenged patent and its prosecution history — 1,200 words. Eighth, write an overview of the prior art, assuming several references — 1,000 words. Ninth, write a stand-alone section on motivation to combine, assuming

yours is an obviousness challenge — 400 words. Finally, write a short conclusion — 50 words. The total of these writings is 3,500 words.

The remainder of your 14,000 words after you write 3,500 words as above is 10,500 words. Divided by 20 claims in our example, this is 525 words per claim. This is also, with 10-word sentences, 52 or 53 sentences, and with five-sentence paragraphs, 10 or 11 paragraphs. This is still not too bad.

But go further. Assume it takes 50 words just to list the limitations of each claim in headings and otherwise. Assume also that you include citations to the prior art for each sentence you state about the prior art, i.e., you will state the exhibit number for each item of art, and column and line references. Assume these citations take 50 words per claim. With 20 claims, you have consumed another 2,000 words for these basics. Redoing the math, you have not 70 sentences and 14 paragraphs per claim, not 52 or 53 sentences and 10 or 11 paragraphs per claim. You have 42 or 43 sentences, and eight or nine paragraphs per claim.

This is still a reasonable amount per claim, perhaps. But assume you must write about three independent claims, each with five limitations, and about the 17 dependent claims, each with two limitations on average. That means you have to write about 49 limitations in total.

Adjusting the computation, you have about 174 words per limitation, i.e., 17 or 18 sentences in three or four paragraphs per limitation. You should write about 85 to 90 sentences and 17 or 18 paragraphs for each of the independent claims, and about 34 or 36 sentences and about seven paragraphs per dependent claim.

But life is cruel. Assume not 20 claims, but 25 or 30, or more. Assume another independent claim with each increase. Work the average per limitation. Here in a table is the cruel math:

Number of claims	25	30	40
Available sentences for independent claims	66-67 13 per limitation	56-67 11 per limitation	42 8 per limitation
Available paragraphs for independent claims	13 3 per limitation	11 2 per	8 Under 2 per
Available sentences for dependent claims	26-27	22-23	17
Available paragraphs for dependent claims	5	5	3

The pinch is on now. For a patent with, for example, 30 claims, you have two paragraphs with a total of 11 sentences available per limitation of all independent and dependent claims. For a patent with 40 claims, you have under two paragraphs and eight sentences for each limitation. The math can also get much worse, as it is certainly possible to pose hypothetical independent claims of more than five limitations and dependent claims of more than two limitations.

Did you notice that this assumes to this point one ground of challenge per claim? Assume you have three grounds for all the claims. The cruel math is now killer math. Divide all the above by three.

For the patent with 30 claims, you now have the same-as-above two paragraphs with 11 sentences available per claim limitation spread across three grounds, meaning less than one paragraph and less than four sentences per claim limitation per ground.

For a patent that is more complex and deserves more explanation in all parts of a petition, or one with complex claiming, like multiple dependent claims, or worse, has both complex technology and claims, how do you fit in all that you need and state all positions for all limitations of all claims in the available length? Here are some answers by way of tips:

1. Be spare. Be uncompromisingly spare.
2. Group claims. If the challenged patent has dependent claims that repeat for independent claims, group the dependent claims. For example, if claims 2-10 are repeated as claims 12-20 except for new dependency on claim 11, not claim 1, group the dependent claims in pairs, 2 & 12, 3 & 13, etc. in your treatment of them.
3. Consider a claim listing, an appendix.
 - a. If you use a claim listing and file it as an exhibit, see IPR2017-00122 for an example, you can abbreviate headings by referring to claim limitations by reference numbers, such as “1a, 1b,” etc.
 - b. The words of the claim listing do not count toward the word count of 14,000. See 37 C.F.R. 42.24(a)(1)(“word count ... not ... claim listing.”)
 - c. Of course, be careful that you don’t make your petition hard to follow and thereby unpersuasive.
4. Trim citations to the evidence to their essence.
 - a. Don’t cite, for example, in the form “See Exhibit 1, Mellons U.S. Patent No. 1,234,567 at column 1, lines 1 through 12.” That’s 15 words toward the word count every time you use something like this.
 - b. Cite, for example, in the form “Ex. 1001 1:13.” That’s three words, saving 12 words per citation. (Or note that “Ex-1001-1:13” is one.)
5. “POSA” or “POSITA” are one-word substitutes for the eight-word “person of ordinary skill in the relevant art.”
6. Do the same kinds of trimming with as many parts of your work as possible.
 - a. You don’t need to repeat, for example, “ground engaging tool” or “peripheral component interconnect specification” all the time.
 - b. You can say “tool” or “GET,” or “specification” or “PCIS” after you use the longer terms.
 - c. Why must you have prepositional phrases like “the end of the point on the member”? Say “the member’s point end.”
7. In *extremis*, split your petition.
 - a. Split it into two or more petitions. See, e.g., IPR2016-01840, -01841 (Apple petitions).

- b. If you split it so you challenge half the claims in one petition, and half in the other, you are not filing the second petition on grounds that are cumulative of those of your first petition, you are filing independent challenges to different sets of claims.

In sum, be careful when you start writing IPR petitions to stay within word limits. Use several available techniques to get within limits.

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The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office's Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer frequent summaries of the board's significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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Addendum: How Many Words Do You Have to Challenge Each Patent Claim in IPR?

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February 6, 2018 — Since writing this highlight and in part expressing that citations like exhibit references might be reduced to the smallest word count possible, I have written *inter partes* review (IPR) filings where I was a severe case of shortening references, such as “E1101” instead of something like “Harish ‘243 Patent, Ex. 1101.” The much-shortened reference “E1101” makes the reference one word for the word count. I haven’t had any Patent Trial and Appeal Board (PTAB) complaint about this. But I note an issue with what has been branded “creative punctuation.” For example, in *Axon v. Digital Ally*, IPR2017-00375, Paper 9 at 2 n. 2 (June 6, 2017), a PTAB panel stated the following complaint and warning, against “deleting spacing” and “excessive acronyms or abbreviations”:

² We caution Petitioner that in future briefing strict attention should be given to the mandated word count certification. *See* 37 C.F.R. §§ 42.24(a), (d). Petitioner’s certification states that the Petition “has a total of 13,912 words.” Pet. 75. Petitioner, however, fails to use normal spacing in the Petition for numerous citations in order to reduce the word count. For example, Petitioner did not place spaces in many of its citations such as in “(Ex.1008, ¶22).” Pet. 3; *see also* The Blue Book, Twentieth Ed., Rule 3.3; *Pi-Net Int’l, Inc. v. JPMorgan Chase & Co.*, 600 F. App’x 774, 775 (Fed. Cir. 2015) (determining deletion of required spacing circumvents rule on word count). The Board expects the use of ordinary spacing in phrases and citations in submitted documents. *See Google Inc. v. Makor Issues & Rights Ltd.*, Case No. IPR2016-01535, slip op. at 7 (PTAB, Dec. 1, 2016) (Paper 8) (“Excessive wording in figures, drawings or images, deleting spacing between words, or using excessive acronyms or abbreviations for word phrases, in order to bypass the rules on word count, are not reasonable.”). Parties and their counsel ought to give strict attention to the related rule especially as it requires an attorney certification and we will consider appropriate sanctions for violation. *See* 37 C.F.R. § 42.11.

My current recommendation is to shorten citations, and use reasonable acronyms and abbreviations, such as “POSITA” and “Ex. 1101,” but not so much as to even become accused of “creative punctuation.”

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