

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDEX CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II, LLC,
Patent Owner.

Case IPR2017-00741
Patent 6,633,900 B1

Record of Oral Hearing
Oral Hearing Held: April 26, 2018

Before DAVID C. MCKONE, BARBARA A. PARVIS, and JOHN A.
HUDALLA, *Administrative Patent Judges*.

Case IPR2017-00741
Patent 6,633,900 B1

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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ON BEHALF OF THE PATENT OWNER:

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The above-entitled matter came on for hearing on Thursday, April 26, 2018, at 11:15 a.m., at the U.S. Patent and Trademark Office, Madison Building East, 600 Delany Street, Alexandria, Virginia, before Walter Murphy, Notary Public.

PROCEEDINGS

1 THE USHER: All rise.

2 JUDGE PARVIS: Please be seated. We are here for IPR2017-00741.
3 The challenged patent is U.S. patent No. 6,633,900 B1. Petitioner is FedEx
4 Corporation. Patent Owner is Intellectual Ventures II, LLC. It's the same
5 panel Judge Parvis, Judge McKone who is appearing remotely, and Judge
6 Hudalla is here next to me.

7 The parties, the same attorneys, so we don't need to redo
8 introductions. Again, the guidance for this hearing was provided in the Oral
9 Hearing Order of April 2nd, 2018. Again each side will be given 30 minutes
10 for oral argument. After this hearing we will have a one hour break for
11 lunch, and then after lunch we will conduct the remaining two hearings.
12 Again, this hearing is open to the public and a full transcript of it will
13 become part of the record. Please remember to speak into the microphone at
14 the podium so that all judges can hear you and please speak into the
15 microphone information identifying the document that is projected on the
16 screen. The remote judge has a copy of the demonstratives but can't actually
17 see the screen and anyone reading the transcript will also want to know what
18 you're referring to. So anytime counsel for the Petitioner, you may proceed.

19 MR. TUCKER: Thank you, Your Honors, and good morning. Daniel
20 Tucker on behalf of Petitioner FedEx Corp. I'd like to reserve ten minutes
21 for rebuttal.

22 The petition in this case demonstrates that claim 1 is obvious over the
23 combination of the prior art references Storch and Butler. In fact the Patent
24 Owner does not contest that Storch and Butler disclose nearly every element

1 of claim 1. Instead, the Patent Owner makes two arguments in its Patent
2 Owner response and those are what I'd like to address today.

3 First, the Patent Owner incorrectly argues that the term mobile field
4 unit requires a wireless communication capability and second, the Patent
5 Owner incorrectly argues that it would not have been obvious to combine
6 these two references, Storch and Butler. And so I'd like to start with the
7 mobile field unit argument.

8 The BRI of mobile field unit does not require wireless and Patent
9 Owner's arguments to the contrary are incorporating in from the
10 specification limitations into the claim, and so for claim construction we
11 should start with the plain language of the claim and we've reproduced claim
12 1 on slide 39. Claim 1 does not include the word wireless. It doesn't recite
13 wireless in any way, shape or form. It doesn't require a wireless network
14 and it doesn't allude at all to wireless communications. This stands in sharp
15 contrast to original claim 1 of this application which we produced on slide
16 17 that did require a wireless network and that did require that the mobile
17 field unit communicates with the wireless network. Original claim 54,
18 which is the claim that would issue as claim 1, did not include any of these
19 limitations.

20 Based on these differences as we show on slide 19, the examiner
21 issued a restriction requirement in the case dividing the claims into two
22 groups, original claim 1 which requires a wireless communication network
23 and original claim 54 which would issue as claim 1 which does not require a
24 wireless network.

1 The examiner explained, as we have reproduced in slide 20 which is
2 the prosecution history Exhibit 1005 at 197, that the difference between
3 these inventions was in fact the existence or lack of requirement of a
4 wireless communication network. The examiner stated inventions 1 and 4,
5 that is original claim 1 and issued claim 1 are related as a combination and a
6 sub-combination. The sub-combination, the one that would issue as claim 1
7 has separate utilities such as a method that lacks the following step a) a
8 wireless communication network. So the examiner recognized that this
9 distinction between the two claims and in response to this requirement, the
10 applicants elected the claims that do not require wireless.

11 They elected, as we show on slide 21 in response to that requirement
12 without traverse to prosecute the claims that do not require a wireless
13 network, and so the Patent Owner cannot argue that the mobile field unit in
14 these claims requires wireless communications when it gave that up during
15 the prosecution of this patent and instead elected the broader set of claims
16 that are not limited to wireless. As we mentioned in our reply, the Patent
17 Owner doesn't address these powerful parts of the prosecution history and
18 instead focuses their attention on the specification, and their argument is that
19 the specification consistently describes mobile field unit as including
20 wireless communications.

21 There is a problem even with that aside from the prosecution history,
22 which is that the specification is not unequivocal on this point. As we show
23 on slide 22, the specification explains that the mobile field unit may be a
24 portable computer, that's the 900 patent column 4, lines 13 through 23. The
25 mobile field unit may be the portable computer. Well there's evidence in

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