

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP,
Petitioner,

v.

BENHOV GMBH, LLC,
Patent Owner.

Case IPR2017-00930
Patent 8,170,884

Record of Oral Hearing
Held: April 30, 2018

Before BARBARA A. PARVIS, DANIEL N. FISHMAN, and CHARLES J.
BOUDREAU, *Administrative Patent Judges*.

Case IPR2017-00930
Patent 8,170,884

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Monday, April 30, 2018, commencing at 1:00 p.m. at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

PROCEEDINGS

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1:00 p.m.

JUDGE PARVIS: Good afternoon, everyone. Please be seated.

This is an oral argument in IPR 2017-00930. The challenged patent is US Patent No. 8,170,884 B2. Petitioner is K/S HIMPP. Patent Owner is Benhov GmbH, LLC.

I'm Administrative Patent Judge Parvis. Judges Fishman and Boudreau are appearing remotely from the Denver and San Jose offices respectively.

At this time, we'd like counsel to introduce yourselves, your partners and your guests, starting with Petitioner. Please use the microphone.

MR. STEINBERG: Good afternoon.

Donald Steinberg on behalf of the Petitioner from Wilmer-Hale. With me sitting at counsel table is Chris O'Brien, also from Wilmer-Hale. Thank you.

JUDGE PARVIS: Thank you.

MR. PETRI: Good afternoon, your honors.

My name is Henry Petri with the Polsinelli firm on behalf of the Patent Owner. With me here today is Margaux Savee, also with our firm.

JUDGE BOUDREAU: Excuse me.

Could I just ask counsel to stand closer to the microphone? We can't hear online.

MR. PETRI: I'm sorry.

1 Henry Petri on behalf of the Patent Owner. With me here today is
2 Margaux Savee also of our firm. And sitting in the back row is Russ Rigby,
3 in-house counsel, on behalf of the Patent Owner.

4 JUDGE PARVIS: Thank you.

5 JUDGE BOUDREAU: Thank you.

6 We still seem to be having a problem with the microphone there.
7 The sound is fading in and out.

8 (Discussion off the record.)

9 THE STAFF: Can you hear now?

10 JUDGE BOUDREAU: Yeah, that's much better. Thank you.

11 JUDGE PARVIS: For the record, we had a call with the parties
12 Wednesday, April 25th, 2018, to discuss the Supreme Court's decision in
13 SAS Institute, Incorporated versus Iancu.

14 The parties were to meet and confer prior to the hearing today. We
15 will give the parties a chance to comment briefly now, starting with Patent
16 Owner.

17 MR. PETRI: Thank you, Your Honor.

18 Yes, we did confer with Petitioner's counsel. One of the suggestions
19 that was made on the call by the Petitioner was withdrawing the claims that
20 were instituted.

21 We disagree with that proposal and we believe that those claims
22 ought to be -- remain part of the case. And so -- so the trial instituted on
23 those claims as well.

1 Our position would be, in terms of briefing, that if this were
2 following the normal course, we would file the Patent Owner response in
3 response to the Institution Decision. But since we agreed with the
4 conclusion of the Institution Decision regarding these non-instituted claims,
5 we wouldn't be filing a brief. And so, our position would be there would be
6 nothing for the Petitioner to respond to.

7 However, if the Board is considering permitting the Petitioner to file
8 some paper in response to institution of the previously non-instituted claims,
9 then we would request the opportunity to file a reply in response to whatever
10 Petitioner files.

11 JUDGE PARVIS: Thank you.
12 Petitioner.

13 MR. STEINBERG: Thank you.

14 That's -- it's consistent with what we discussed. We would have
15 proposed something just slightly different in that it would seem to us
16 following, as Patent Owner suggested, the normal course of a proceeding. If
17 they want to file a brief, we would suggest they should do that in the essence
18 of a Patent Owner response.

19 Initially, we then would like to file a reply brief potentially including
20 a declaration from our expert, we'll be responding to arguments, in effect,
21 raised in their response, but raised in the preliminary response and as
22 identified in the original institution decision denying some of the claims.

23 It's hard for me to address the request for a sur-reply until we see
24 what they want to request. I would just note that in the ordinary course of

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