

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AFTON CHEMICAL CORPORATION,

Petitioner,

v.

INFINEUM INTERNATIONAL LIMITED,

Patent Owner.

IPR2017-01321
Patent 8,076,274 B2

Record of Oral Hearing
Held: August 9, 2018

Before JON B. TORNQUIST, JEFFREY W. ABRAHAM, and MICHELLE
N. ANKENBRAND, *Administrative Patent Judges*.

IPR2017-01321
Patent 8,076,274 B2

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, August 9, 2018, commencing at 10 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Merinda Evans, Notary Public.

P R O C E E D I N G S

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2 JUDGE TORNQUIST: You may be seated. Okay. This is a hearing
3 for IPR2017-01321, Afton Chemical Corporation v. Infineum International
4 Limited. Who do we have from Petitioner?

5 MR. FERRARIO: Good morning, Your Honor. Matias Ferrario,
6 Kilpatrick Townsend for Petitioner, and my colleague Keith Fredlake, also
7 Kilpatrick Townsend, and Ms. Arneita Grey, also my colleague.

8 JUDGE TORNQUIST: Welcome. And Patent Owner?

9 MR. HERMAN: Good morning, Your Honors. Patrick Herman from
10 Orrick on behalf of Patent Owner, and with me are Elizabeth Gardner also
11 from Orrick and Jacob Levine from Infineum.

12 JUDGE TORNQUIST: Welcome. Okay. Pursuant to our order
13 granting oral argument in this case, each side will have an hour of argument
14 time. Petitioner bearing the burden of proof, you'll go first and you can
15 reserve time if you'd like for rebuttal, then we'll hear from Patent Owner and
16 you can also reserve time for rebuttal as to the Motion to Exclude and those
17 elements of the Motion to Amend that you bear the burden of proof, and
18 then we'll hear from Petitioner as well and any rebuttal time, and then Patent
19 Owner's rebuttal time.

20 Before we start the substance of the arguments, there are pending
21 objections to Petitioner's demonstratives. Slide 75 specifically laid out and
22 then 64, 66, 70 and 80 I believe. Petitioner, do you intend to rely on these
23 slides in this hearing today?

24 MR. FERRARIO: Yes, Your Honor.

1 JUDGE TORNQUIST: Okay. So then do you want to address then
2 briefly their objections and particularly whether exhibits, I guess it's 1051
3 and 1053 are in any of your papers before this order?

4 MR. FERRARIO: Yes, Your Honor. I'd like to start with 1051 and
5 1053, if you will. As you know, we submitted a response on the newly
6 instituted grounds, ground three in particular, after the SAS decision and in
7 that paper we -- the paper number escapes me -- but we submitted a
8 supplemental declaration by our expert, Dr. Lam, and Dr. Lam discusses
9 those exhibits specifically and you can (indiscernible) his testimony. We
10 then summarized that testimony in our response. We had limited it to 300
11 words or so, so we think it's fairly part of the proceedings.

12 JUDGE TORNQUIST: Okay. Patent Owner, do you want to address
13 their statement that they have actually relied on these?

14 MR. HERMAN: Yes, Your Honor. So those exhibits were filed in
15 connection with a two page reply brief and they were not cited in the two
16 page reply brief. They were not mentioned in the two page reply brief. The
17 reply brief did cite to an expert declaration but did not specifically cite to the
18 portions of the expert declaration citing those exhibits. It cited to other more
19 general paragraphs. So it's our view that those exhibits are not discussed in
20 any way in the briefing that's part of the record here. Yes, they were
21 attached --

22 JUDGE TORNQUIST: Counsel, let me interrupt you for a second.
23 Can you please step to the podium? Judge Ankenbrand is having trouble
24 hearing you.

1 MR. HERMAN: I apologize, Your Honor. So it's Patent Owner's
2 view that those particular exhibits were not discussed in any of the briefing
3 in any kind of meaningful way and they were essentially just attached to a
4 portion of an expert declaration that's also not being discussed in the record
5 in any kind of meaningful way. So to the extent that it's now being argued
6 that they're part of the record, it's an improper expansion of Petitioner's
7 grieving space.

8 JUDGE TORNQUIST: Okay. I think what we're going to do then is
9 we'll take this objection under advisement. If you do go to those slides I'd
10 like you to specifically address where you talk about them and if you would,
11 obviously we have the question then pending before us of whether you've
12 expanded too far. When you hit those slides please just address them if you
13 would.

14 MR. FERRARIO: Very well, Your Honor.

15 JUDGE TORNQUIST: Okay. Thank you. I don't believe there's any
16 other pending objections; is that correct?

17 MR. FERRARIO: Your Honor, I do believe maybe slide 75.

18 JUDGE TORNQUIST: Oh, slide 75. Okay. That one was more of a
19 melded one, correct? We have a table, we have some arguments and some
20 you argued were not in there. You want to address 75 then?

21 MR. FERRARIO: Yes, sure Your Honor. So, and slide 75 as you
22 pointed out.

23 JUDGE TORNQUIST: Counsel, sorry. Can you come up to the
24 microphone?

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