

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC, and
BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT,
Petitioner,

v.

THEODORE & ASSOCIATES, LLC,
Patent Owner.

Case IPR2017-01379 (Patent 9,045,163 B2)
Case IPR2017-01380 (Patent 9,045,163 B2)

Record of Oral Hearing
Held: August 15, 2018

Before MITCHELL G. WEATHERLY, FRANCES L. IPPOLITO, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

Case IPR2017-01379 (Patent 9,045,163 B2)

Case IPR2017-01380 (Patent 9,045,163 B2)

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Wednesday, August 15, 2018, commencing at 1 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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2 JUDGE WEATHERLY: Good afternoon. Please be seated. If you'll
3 give us a moment also to get our computers awakened. Are you ready?
4 Excellent, thank you. So this is a hearing for two proceedings, IPR2017-
5 01379 and IPR2017-01380, both of which relate to U.S. Patent No.
6 9,045,163. Petitioner is BMW North America, LLC among others, I'm not
7 going to try to pronounce the German entity's name even though I took
8 German in college, and Patent Owner is Theodore & Associates, LLC.

9 I'm Judge Weatherly and I'm joined here to my left by Judge
10 O'Hanlon and we're joined remotely by Judge Ippolito out on the West
11 Coast. Because the camera through which Judge Ippolito is viewing the
12 proceedings is mounted I believe behind me if you're addressing her you
13 may want to look at the camera instead of me, it might make her feel a little
14 more welcome and comfortable, more natural for her. Also when you're
15 addressing slides during the presentation please be sure to let us know what
16 slide number you're on. I can see the slide number and I think Judge
17 O'Hanlon can see it, Judge Ippolito can't. It also makes the transcript much
18 easier for us to use after the fact.

19 Pursuant to our Hearing Order, each party is going to have 60 minutes
20 to present its argument today. Because of the similarity of the issues in the
21 case we're going to do the argument in a combined way and I see the
22 demonstrative exhibits have been prepared that way, so that's good.
23 Petitioner will open because it bears the burden of persuasion. Patent
24 Owner, you'll have a chance to respond and Petitioner you can reserve time

1 for a rebuttal that should be limited to addressing issues that are raised by
2 the Patent Owner during its presentation.

3 Before we begin I'd like to have everyone introduce themselves,
4 starting with the Petitioner including anybody that you've brought along with
5 you.

6 MR. LINDSAY: Thank you, Your Honor. Jonathan Lindsay for
7 Petitioner. I'll be arguing today.

8 JUDGE WEATHERLY: Excellent.

9 MR. LINDSAY: This is Jeff Santok.

10 JUDGE WEATHERLY: Okay. And Patent Owner.

11 MR. BEJIN: Good afternoon. Tom Bejin from Bejin Bieneman on
12 behalf of Theodore & Associates. With me is Scott Daniels from
13 Westerman Hattori. We have also Chris Theodore and his wife, Tracey
14 Theodore.

15 JUDGE WEATHERLY: Thanks very much. Does either party want
16 to address any of the Motions to Exclude or any objections that have been
17 filed to the demonstratives before we get into the substance? I'm sort of
18 hoping no to take my hand a little bit about that.

19 MR. LINDSAY: Not for Petitioner.

20 JUDGE WEATHERLY: But I don't want to stop anyone from
21 making a presentation if they want to.

22 MR. BEJIN: We have one request --

23 JUDGE WEATHERLY: Sure.

24 MR. BEJIN: -- for consideration. On Friday the new guidelines were
25 issued and we raised it with opposing counsel down in the cafeteria
26 beforehand.

1 JUDGE WEATHERLY: Okay.

2 MR. BEJIN: Relative to a request that the Patent Owner receives a
3 modest surrebuttal, so the new guidelines would allow a surreply brief. We
4 had asked for a surreply brief relative to --

5 JUDGE WEATHERLY: I recall.

6 MR. BEJIN: -- kind of an unusual supplemental declaration that was
7 submitted and I think under the guidelines that was denied properly at that
8 time but the Law 360 article that I read this morning in the guidelines
9 suggested that the Board would have authority to grant surrebuttals. So I
10 wanted --

11 JUDGE WEATHERLY: By surrebuttal do you mean to refer to a
12 surreply brief?

13 MR. BEJIN: No, I mean the last word.

14 JUDGE WEATHERLY: The last word during the hearing?

15 MR. BEJIN: Yes. So that's what was discussed in the 72 hours of
16 commentary about the --

17 JUDGE WEATHERLY: Sure.

18 MR. BEJIN: -- new guidelines that was raised, we had asked for the
19 surreply before and so as a replacement we're seeking --

20 JUDGE WEATHERLY: You'd like to have the last word today.

21 MR. BEJIN: We'd like to have the last word.

22 JUDGE WEATHERLY: And you discussed it with Petitioner's
23 counsel?

24 MR. BEJIN: Yes, sir.

25 JUDGE WEATHERLY: Okay. And what's your position, if
26 anything, on that?

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