

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON.COM, INC., AMAZON DIGITAL :  
 SERVICES, INC., AMAZON :  
 FULFILLMENT SERVICES, INC., :  
 HULU, LLC, NETFLIX, INC., and :  
 GOOGLE, LLC, :  
 Petitioners, :

v. : CASE IPR2017-00948

UNILOC LUXEMBOURG S.A., : CASE IPR2017-01665

Respondent. :

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Telephonic conference  
 Silver Spring, Maryland  
 Thursday, December 21, 2017 - 10:32 a.m.

Reported by:  
 Cassandra E. Ellis, RPR  
 Job no: 20378

1                   Hearing before Judge David C. McKone, Judge  
2           Barbara A. Parvis, and Judge Michelle N. Wormmeester,  
3           held telephonically, pursuant to agreement, before  
4           Cassandra E. Ellis, Certified Court Reporter -  
5           Washington, Certified Shorthand Reporter - Hawai'i,  
6           Registered Professional Reporter, Certified Livenote  
7           Reporter, Realtime Systems Administrator, and Notary  
8           Public of The State of Maryland.

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A P P E A R A N C E S

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C O N T E N T S

PAGE

PROCEEDINGS

5

E X H I B I T S

(None.)

1 P R O C E E D I N G S

2 JUDGE MCKONE: We are on the  
3 line for the IPR2017-948 and  
4 IPR2017-1665 matters. I have  
5 Judges Parvis and Wormmeester with  
6 me on the call, it sounds like  
7 there is a court reporter on the  
8 call, is there -- I understand  
9 there's several petitioners in the  
10 Amazon case, I'm going to refer to  
11 them collectively as Amazon, for  
12 convenience.

13 Is there anyone on the line  
14 for petitioner Amazon? Okay, I'll  
15 take that as a no. Is there  
16 anyone on the line for petitioner  
17 Google?

18 MR. RENNER: Yes, Your  
19 Honor, this is Karl Renner, from  
20 Fish and Richardson, and I'm  
21 joined by Adam Shartzter.

22 JUDGE MCKONE: Okay. Who

1 will be doing the speaking today  
2 for Google?

3 MR. RENNER: Thank you, Your  
4 Honor, we'll probably both  
5 contribute, but Mr. Shartzler will  
6 be take the lead on that.

7 JUDGE MCKONE: Okay. Is  
8 there anyone on the line for  
9 patent owner Uniloc?

10 MR. MANGRUM: Yes, Your  
11 Honor, good morning. This is  
12 Brett Mangrum, lead counsel for  
13 Uniloc, and I'll be doing the  
14 speaking today.

15 JUDGE MCKONE: Okay. Is  
16 there anyone else on the line for  
17 patent owner?

18 MR. HUANG: Yes, Your Honor,  
19 this is Jeffrey Huang, for patent  
20 owner Uniloc.

21 JUDGE MCKONE: Okay. I will  
22 assume that Mr. Mangrum will be

1           doing the speaking, unless you  
2           introduce yourself otherwise,  
3           Mr. Huang.

4                     If there is anyone else on  
5           the line and wishes to speak  
6           please first identify yourself and  
7           the party you represent.

8                     Now, which party has  
9           arranged for the court reporter?

10                    MR. RENNER: Your Honor,  
11           it's Google has arranged for the  
12           court reporter.

13                    JUDGE MCKONE: Okay.  
14           Please, when you get a transcript,  
15           file it as an exhibit in the case.

16                    MR. RENNER: Yes, Your  
17           Honor. Thank you.

18                    JUDGE MCKONE: Okay. So the  
19           reason why we are having this call  
20           is Amazon filed a petition  
21           challenging the challenge patent  
22           in the 948 case, and after we --

1 after we received a preliminary  
2 response in that case Google filed  
3 another petition challenging the  
4 same patent in the 1665 case, on  
5 grounds it significantly  
6 overlapped with the -- the ground  
7 in the 948 case.

8 Patent owner, in its  
9 preliminary response in the 1665  
10 case, has raised 35 USC Section  
11 325D as a defense, and is asking  
12 us to -- to deny the petition in  
13 1665 for -- for section 325D.

14 Now, as we stated in our --  
15 our order of last week, we do see  
16 merit in the 325D defense, but we  
17 also have to weigh that against  
18 the -- if we were to deny it then  
19 Google would not have an  
20 opportunity to -- to challenge  
21 this patent on art that we've  
22 already said has a likelihood of



1 success.

2 So our thought was a joinder  
3 would be a possible compromise  
4 position between denying Google's  
5 petition outright and -- on one  
6 hand, and on the other hand  
7 subjecting the patent owner to  
8 serial attacks with similar art.

9 So we asked the parties to  
10 meet and confer and determine  
11 whether they could agree to  
12 joinder and, if so, what the terms  
13 of that joinder might look like.

14 So our understanding is that  
15 the parties have not been able to  
16 reach agreement or at least not --  
17 not entirely. For the purposes of  
18 this call is for us to understand  
19 what the parties' disagreement is  
20 and determine whether we ought to  
21 join the case, cases, or what the  
22 terms would be, or whether we

1           should just simply consider the  
2           1665 petition and make a ruling on  
3           that.

4                     So we'll start with --  
5           with -- with Google. So I assume,  
6           during my talking here, no one  
7           from Amazon has -- has joined, is  
8           that correct? Okay.

9                     So we'll start with  
10          petitioner, Google, because we  
11          need to start with someone.

12                    So as a result of the meet  
13          and confer does any party object  
14          to joinder in principal or is the  
15          dispute rather around, I guess,  
16          the terms of -- of a possible  
17          joinder?

18                    MR. SHARTZER: Your Honor,  
19          this is Adam Shartzter, for Google,  
20          and I can certainly address that.

21                    JUDGE MCKONE: Go ahead.

22                    MR. SHARTZER: I believe the

1 parties do not have a  
2 disagreement, in principal, with  
3 respect to joinder. As you  
4 suggested, there is, however,  
5 disagreement with respect to what  
6 that joinder looks like and the  
7 terms of it.

8 It is Google's position that  
9 it has brought forth substantially  
10 and meaningfully different  
11 arguments with respect to in one  
12 ground overlapping art and with  
13 respect to Google's second ground  
14 some art did overlap but also a  
15 meaningfully different reference,  
16 the Colloso (phonetic) reference,  
17 and Google would like to have the  
18 benefit of carrying its arguments  
19 forward in a proceeding on the  
20 argument that it made with respect  
21 to the references in its petition.

22 Google made arguments, for

1 instance, with respect to source  
2 code that is in the Domello  
3 (phonetic) reference, and there is  
4 an expert declaration attached to  
5 Google's petition in support  
6 explaining what a person of  
7 ordinary skill would understand  
8 from that source code.

9 Those --

10 JUDGE MCKONE: I think, in  
11 our order, I made it clear that  
12 we're not here to reargue the 325D  
13 issues.

14 MR. SHARTZER: Okay.

15 JUDGE MCKONE: So my  
16 understanding of your position is  
17 Google wants to press the  
18 arguments that it made in its --  
19 in its petition that are -- that  
20 it contends are substantially  
21 different from those pressed in  
22 the Amazon petition, is that -- is

1           that, I guess, your position in a  
2           nutshell.

3                   MR. RENNER:  Yes, Your  
4           Honor -- this is Mr. Renner --  
5           yes, Your Honor, that's correct.  
6           And I think the only reason to go  
7           down the path that we were just  
8           talking about is to help Your  
9           Honors, if it weren't apparent, to  
10          note exactly that, that these are,  
11          we think, materially different  
12          presentations of the grounds.  And  
13          that speaks to whether or not  
14          there's a reason to concern  
15          ourselves with trying to put them  
16          on a different schedule, same  
17          schedule, and frankly, have the  
18          arguments come along with, but  
19          we'll let that rest as -- as  
20          you're noting, and maybe just talk  
21          about the schedule that we  
22          proposed that's -- that's of

1 interest to you.

2 MR. MANGRUM: I would like  
3 to present the patent owner's  
4 position.

5 JUDGE MCKONE: I'm sorry,  
6 who's speaking?

7 MR. RENNER: This is Brett  
8 Mangrum for Uniloc, patent owner.

9 JUDGE MCKONE: Okay. Well,  
10 I will -- I will -- I will let --  
11 I will let you speak after --  
12 after Google's had a chance to put  
13 forth its position.

14 MR. MANGRUM: But Your Honor  
15 asked whether or not we agreed, in  
16 principal, to that joinder, and I  
17 wanted to answer that question,  
18 but we can -- but we can wait  
19 until Google has presented its --

20 JUDGE MCKONE: Please.

21 MR. RENNER: And to that  
22 point, Your Honor, Mr. Renner

1           again, our intentions in answering  
2           that was only to suggest that both  
3           parties came to one another with  
4           an expression of -- of what  
5           joinder might look like.

6                     And so our -- our take from  
7           that is that each party is willing  
8           or at least amenable to  
9           considering joinder, it was really  
10          the "what does it look like" is  
11          where we really had a hard time to  
12          coming to terms with one another.

13                     So if we conveyed otherwise  
14          that's all our intention was  
15          there.

16                     JUDGE MCKONE:   Okay.

17                     MR. RENNER:    But as to the  
18          schedule we proposed, and how  
19          joinder would look, if you're  
20          amenable to, we're happy to take  
21          you through that.

22                     JUDGE MCKONE:   Yes.

1                   MR. SHARTZER: This is Adam  
2                   Shartzter, for Google. The  
3                   schedule that we had proposed to  
4                   Uniloc was one essentially where  
5                   there would be a slight delay in  
6                   the current proceeding between  
7                   Uniloc and Amazon. We would then  
8                   give Uniloc an opportunity to  
9                   respond to the differences in the  
10                  arguments made by Google. And  
11                  then what would happen is,  
12                  essentially, the schedule would  
13                  pick back up with what we propose  
14                  is the time about a five-week  
15                  delay in the current deadlines.

16                 And when I say picked back  
17                 up, once Uniloc files a response  
18                 to Google's petition then Amazon  
19                 and Google would simultaneously  
20                 file a reply brief, about five  
21                 weeks later, that would allow  
22                 Amazon and Google to coordinate on



1 a joint deposition, on a single  
2 day, so we're not taxing the  
3 Uniloc's declarants any more than  
4 would otherwise occur in a single  
5 joined proceeding.

6 And then, from there,  
7 essentially a five-week delay  
8 would roll through the rest of the  
9 deadlines in the schedule, moving  
10 the hearing from early May to  
11 early June.

12 And then, from there, the  
13 board either would have  
14 approximately nine weeks to draft  
15 a final written decision or in the  
16 joinder situation, as we've seen  
17 common, the board could take  
18 advantage of the -- the -- the  
19 additional time it could grant  
20 itself to issue a final written  
21 decision in a joinder situation.  
22 So that would --

1                   JUDGE MCKONE: You are  
2                   anticipating extending our  
3                   schedule beyond the final written  
4                   decision deadline in 948?

5                   MR. SHARTZER: It was a  
6                   possibility. There was --  
7                   essentially we move the hearing  
8                   about a month, which would  
9                   certainly compress the amount of  
10                  time that the board had to issue a  
11                  final written decision, and to the  
12                  extent the board needed more time  
13                  than nine weeks that would  
14                  certainly be an option of the  
15                  board to -- to extend the schedule  
16                  if, you know, at the board's  
17                  discretion.

18                  JUDGE MCKONE: Now, was --  
19                  was Amazon or the Amazon  
20                  petitioners part of the meet and  
21                  confer process?

22                  MR. SHARTZER: Yes, Your

1 Honor, they were.

2 JUDGE MCKONE: Did they,  
3 since they're apparently not on  
4 the line today, were they -- did  
5 they agree or disagree with  
6 extending the final written  
7 decision deadline in the 948 case?

8 MR. SHARTZER: Your Honor,  
9 they were neutral. They were not  
10 going to take a position. But  
11 they appeared to be fine with a  
12 schedule that included additional  
13 time just for the board to issue a  
14 single final written decision that  
15 could handle both cases moving  
16 forward.

17 JUDGE MCKONE: Okay. So to  
18 summarize your -- Google's  
19 position, if there was a joinder  
20 you would -- you would prefer  
21 joinder that allowed you to  
22 present -- press your additional

1 arguments presented in the 1665  
2 case that were not presented in  
3 the 948 case, and you would  
4 propose approximately a five-week  
5 delay in the deadlines in order to  
6 allow for those issues to get  
7 vetted, and that might result in  
8 an extension of the final written  
9 decision deadline in 948; is that  
10 accurate?

11 MR. SHARTZER: Yes, Your  
12 Honor, that's accurate. There --  
13 again, there is case law support  
14 for that in the Enzymotec  
15 proceeding, it's IPR2014-00556,  
16 paper 19, in that particular  
17 decision a board determined to  
18 join a second filed petition and  
19 allowed additional arguments to be  
20 brought into that proceeding,  
21 detecting that there was neither  
22 language in section 311 or 315C

1           that required the board to limit  
2           the second petitioner to just the  
3           issues of the first petition.

4                    JUDGE MCKONE:  Okay.  
5           Anything else, then, Google,  
6           before I turn to the patent owner?

7                    MR. RENNER:  One last, this  
8           is Mr. Renner again, just one last  
9           note, I think you maybe picked up  
10          on this, I want to make sure it's  
11          clear, in joinder situations we've  
12          seen articulated is that the  
13          one-year bar is not applicable.

14                   So that if the nine weeks  
15          weren't sufficient we don't  
16          believe that the proposal that  
17          we're making requires the board to  
18          go into its six-month period that  
19          is also allowable, it's not --  
20          it's not really an invasion of  
21          that period, it's just simply the  
22          joinder cases are outside of the

1 typical schedule that's imposed on  
2 the board is -- is the -- and yet  
3 if nine weeks were sufficient then  
4 maybe the one year could still be  
5 observed, in any event.

6 JUDGE MCKONE: Okay.

7 MR. RENNER: Thank you, Your  
8 Honor.

9 JUDGE MCKONE: Would you  
10 envision a change in the hearing  
11 date, then, in the 948 case?

12 MR. RENNER: We do, as  
13 Mr. Shartzler has pointed out, we  
14 think the five weeks that we're  
15 talking about, that allows for  
16 patent owner to respond to the  
17 issues that are newly raised here,  
18 and then get our schedule  
19 consistent with -- with each of  
20 the proceedings thereafter.

21 We think rather than  
22 compressing later parts of the

1           schedule that five weeks would, if  
2           it could carry through, it would  
3           just shift the oral argument by  
4           the same five weeks.

5                     If there were opportunities  
6           to compress later on we would be  
7           open to considering them, of  
8           course, but we thought the  
9           simplest would be to carry that  
10          through.

11                    MR. SHARTZER:  And to be  
12          clear -- this is Adam Shartzter for  
13          Google, again -- the schedule that  
14          we proposed to Uniloc would move  
15          the hearing from May 8th, to June  
16          6th, 2018, of course, that's  
17          obviously subject to the board's  
18          availability, which we didn't have  
19          the benefit of when we posed the  
20          schedule, but we are proposing  
21          what is a somewhat limited amount  
22          of delay in order to sync the

1 schedules.

2 JUDGE MCKONE: All right.  
3 Patent owner, what is -- you've  
4 been waiting patiently, here, what  
5 is your position?

6 MR. RENNER: Yes, good  
7 morning, Your Honor. Again, thank  
8 you for the opportunity to be  
9 heard today.

10 I wanted to just clarify one  
11 point from one of the original  
12 questions, and that is, Uniloc  
13 does not necessarily concede  
14 joinder is appropriate, here.  
15 However, in the interest of  
16 compromise we were prepared and  
17 did discuss the possibility of  
18 joinder under certain terms, and  
19 offered a terms of joinder to the  
20 opposing counsel during the meet  
21 and confer.

22 However, we just point out



1           that in this instance the -- as  
2           the board noted in its order the  
3           deadline is passed for joinder.  
4           So we're not necessarily conceding  
5           joinder is correct.  However --

6                     JUDGE MCKONE:  Well, the  
7           deadline is for petitioner to  
8           request joinder.

9                     MR. RENNER:  Exactly.  But  
10          in view of the board's  
11          instructions I think we met and  
12          conferred and provided a proposal.  
13          I would like to discuss the terms  
14          of that proposal.

15                    So petitioner's offered a  
16          case today, they did not offer a  
17          case during the meet and confer,  
18          so this is the first time that  
19          they brought up any case law that  
20          allegedly supports their position.

21                    However, for our meet and  
22          confer we did cite to them, and

1 collectively, the group, pulled up  
2 a case and read from it during the  
3 meet and confer that supports  
4 patent owner's position.

5 So our position is this: To  
6 the extent joinder is allowed  
7 petitioner should take a limited  
8 understudy role. The understudy  
9 role is a term I'm sure the board  
10 is familiar with, it's been  
11 applied in other cases.

12 Now, there's actually a case  
13 with surprisingly similar facts,  
14 it is, and this is the case that  
15 we brought up as the group during  
16 the call, it's case IPR2016-00089,  
17 it's Innopharma Licensing versus  
18 Senju Pharmaceutical, and in that  
19 case here's just some facts, there  
20 was a follow-on petition that  
21 essentially had the same ground as  
22 the original petition, but then

1           they added additional grounds, and  
2           the board had not yet reviewed on  
3           those additional grounds. So the  
4           same question came up, should we  
5           join those proceedings and what  
6           should be the parameters of  
7           joinder.

8                     And in that case, in the  
9           answer to facilitating joinder,  
10          what was decided is that the  
11          follow-on petitioners would take  
12          an understudy role and that the  
13          joinder they would be joined to  
14          the original petition under the  
15          same grounds instituted in the  
16          original -- petition -- petition,  
17          and the new grounds would --  
18          would -- would not be considered  
19          by the board.

20                    And there was reasons for  
21          that, I mean, there's some policy  
22          concerns, and the board's already

1           noted that in its order, here in  
2           this instance, and in the prior  
3           instance, the petitioners have --  
4           Google has taken -- has the  
5           benefit of patent owner's response  
6           to the original petition. And  
7           since we've retooled and revamped  
8           their petition based on our  
9           response, so it's kind of like a  
10          second follow-on that's an  
11          extension of that briefing,  
12          almost.

13                   And then we -- one of the  
14          problems we have with the proposal  
15          of opposing counsel is that it's  
16          really not a request for joinder,  
17          it's almost, in a sense, a reverse  
18          joinder, where the follow-on  
19          petition controls the schedule and  
20          the follow-on petitioners  
21          articulate and argue based on  
22          grounds that have not even been

1           instituted by the board.

2                     And I want to -- we had a  
3           call earlier in this matter, with  
4           the board, when we discussed how  
5           to proceed in -- in the instance  
6           of a contingent notice to amend,  
7           which the board likely recalls.  
8           And there it was decided that we  
9           were instructed that we would  
10          proceed. So I'm talking about the  
11          original case, we would proceed in  
12          the original case according to the  
13          original scheduling order.

14                    So pursuant to those  
15          instructions patent owner filed  
16          its contingent motion to amend,  
17          and its formal response in the  
18          original trial, so I'm talking  
19          about the 948 on timeliness. We  
20          timely filed pursuant to that  
21          deadline.

22                    Under this proposed revised

1           schedule the response, to that  
2           motion to amend, the opposition  
3           would effectively be given an  
4           additional five weeks. So not  
5           only is it a reverse joinder  
6           scenario it's also a scenario  
7           where patent owner met their  
8           deadline and then -- and when we  
9           tried to just buy the fact that  
10          there will be additional five  
11          weeks for the -- in the original  
12          case for the petitioners to then  
13          respond.

14                   And so the -- the delaying  
15          the schedule, and having a reverse  
16          joinder where the follow-on  
17          petitioners essentially control,  
18          not take an understudy role but  
19          take the lead role, and introduce  
20          new arguments that haven't even  
21          been instituted, we think, is just  
22          inconsistent with the case we

1           cited and highly prejudicial to  
2           the patent owner.

3                   JUDGE MCKONE: Okay. Now,  
4           as between us instituting on the  
5           new -- the 1665 petition, and  
6           setting the separate schedule for  
7           that case, and joinder of 1665 to  
8           the 948 case, with the new issues,  
9           and setting a combined schedule  
10          there, which would be, I guess,  
11          patent owner's preference, and to  
12          make clear, we haven't made any  
13          decisions on the merits of the  
14          1665 petition yet.

15                   MR. MANGRUM: Understood,  
16          and I appreciate the question  
17          allowing us to respond to that, we  
18          would prefer to keep, to the  
19          extent the trial's even instituted  
20          on the new grounds, to keep them  
21          separate. We believe they're  
22          separate issues. And it's in

1 interest to my client to proceed  
2 in the original case as  
3 expeditiously as possible.

4 JUDGE MCKONE: So you would  
5 prefer, if we decide we ought to  
6 go forward on the 1665 case, you  
7 would prefer that to just proceed  
8 on its own separate schedule?

9 MR. MANGRUM: That is  
10 correct.

11 JUDGE MCKONE: Okay.  
12 Does -- does Google have anything  
13 else? Actually, before Google,  
14 patent owner, do you have anything  
15 else to say on the issue?

16 MR. MANGRUM: No, Your  
17 Honor.

18 JUDGE MCKONE: Okay. Google  
19 do you have any response?

20 MR. RENNER: Your Honor,  
21 just to Uniloc's final point,  
22 there, to your question regarding



1 proceeding under a separate  
2 schedule or a joined schedule, you  
3 know, certainly we -- we  
4 approached the issue of joinder  
5 with Uniloc because the board  
6 requested us to do that.

7 If it's Uniloc's preference  
8 to proceed separately, you know,  
9 certainly, you know, it sounds  
10 like that is their preference, and  
11 there is precedent for that, the  
12 3Shape case, which actually came  
13 after the Innopharma case, so the  
14 3Shape is IPR2016-00481, in legal  
15 paper number 12, 3Shape was a --  
16 was a third petitioner in line,  
17 that shared a 102 ground with all  
18 three petitions that had been  
19 filed.

20 There the patent owner had  
21 argued that 325D should apply, but  
22 the board rejected that argument,

1           and -- and it moved forward on  
2           the -- the difference -- the --  
3           the overlapping grounds and the  
4           different grounds, essentially  
5           allowing the parties to proceed  
6           separately and not detecting any  
7           type of 325D issues.

8                     And so I just wanted to  
9           supplement the record, at least  
10          with that case, and say that  
11          certainly if the board's inclined  
12          to institute and move forward  
13          separately on Google's petition  
14          that is something that Google is  
15          amenable to, and for which there  
16          is support.

17                    MR. MANGRUM:  And, Your  
18          Honor, this is Brett Mangrum, for  
19          patent owner, I just wanted to  
20          clarify an earlier answer, if I  
21          understood the question.  So there  
22          is essentially there's multiple

1 options, here.

2 The patent owner's  
3 preference is actually joinder,  
4 for the reasons articulated  
5 earlier, but joinder under the  
6 limited understudy role. We  
7 believe that serves everyone's  
8 interests. And -- and -- and  
9 applying the same understudy role  
10 conditions set forth in the  
11 2016-89 case, that's our  
12 preference.

13 But if -- if the question  
14 is, essentially, what I'm told is  
15 a reverse joinder that Google's  
16 proposing or -- or proceed  
17 independently in the different  
18 matter, that the reverse joinder  
19 we feel is just highly  
20 prejudicial.

21 So if that's the question  
22 then we believe the proceedings

1           should be kept -- and in the event  
2           that the board decides to  
3           institute, if that's the question  
4           we believe it should be  
5           independent or separate.

6           JUDGE MCKONE: To summarize,  
7           it's patent owner's position that  
8           if we should consider -- if we go  
9           forward with Google's new issues  
10          you prefer that it go forward in a  
11          separate case on a separate  
12          schedule?

13          MR. MANGRUM: That's  
14          correct.

15          JUDGE MCKONE: Okay.

16          MR. MANGRUM: And in the  
17          event the board is inclined to  
18          consider a joinder under the same  
19          parameters as the Innopharma,  
20          where there is joinder, but  
21          there's no new issues, there would  
22          be essentially joinder on the

1 original petitions, the 948  
2 petition, that would actually be  
3 our preference. We believe it  
4 serves all interests.

5 MR. RENNER: Your Honor,  
6 counsel for Google, if you have --  
7 if we may say another word?

8 JUDGE MCKONE: Okay.

9 MR. RENNER: Sir, this is  
10 Mr. Renner again, and two  
11 comments, one is that of all of  
12 the options prior to, that is the  
13 option that we actually least  
14 prefer, a ride-along joinder. In  
15 the case that's been cited, the  
16 Innopharma case, we think is  
17 distinct. We think that the  
18 understudy role that was described  
19 in that case is wholly  
20 inappropriate here.

21 In that case the record  
22 reflects that even the petitioner

1           that was second filing classified  
2           the grounds they were presenting  
3           as essentially the same as those  
4           grounds that had earlier been  
5           provided. In our case, as you  
6           heard Mr. Shartzler began our talk  
7           today, we think that the  
8           presentation and the application  
9           of the art is quite different in  
10          our petition as it relates to the  
11          first filed petition.

12                 So we think the Innopharma  
13          case is very specific on that  
14          point and submits material  
15          distinction.

16                 And then as to the other two  
17          grounds or two approaches we just  
18          want to see this done as  
19          efficiently and effectively as  
20          possible.

21                 So we're amenable to Your  
22          Honor's whatever discretion would

1           have, but we're amenable to either  
2           approach that is a separately  
3           conducted proceeding, where the  
4           material differences can be  
5           vetted, we think most efficiently,  
6           again, in this forum, since the  
7           board is taking this up as opposed  
8           to a later different forum.

9                     But alternatively, if we  
10           could have a schedule that is  
11           consolidated in the way that we've  
12           described we think that's a fair  
13           way to efficiently move forward  
14           here, as well.

15                    JUDGE MCKONE:   Okay.

16                    MR. MANGRUM:   Your Honor,  
17           this is Brett Mangrum.

18                    JUDGE MCKONE:   Hold on, I'll  
19           give you another chance in a  
20           moment.

21                    So for Google, as between  
22           joinder and an understudy role

1 with no new issues, and outright  
2 denial of Google's petition,  
3 Google, do you have a preference  
4 as between those two?

5 MR. RENNER: Sorry, I -- I  
6 think I was expecting the question  
7 to be a little different. Can you  
8 repeat it just to make sure I'm  
9 getting it right?

10 JUDGE MCKONE: As between  
11 joinder with the 984 case, under  
12 the terms of the 948 case, as an  
13 understudy, in the understudy  
14 role, as between that and outright  
15 denial of Google's petition under  
16 325D, does Google have a  
17 preference?

18 MR. SHARTZER: Well, Your  
19 Honor, it's -- it is not something  
20 that we have discussed with Google  
21 and our client, there is precedent  
22 in the 3Shape case for moving



1 forward on substantial grounds in  
2 a separate proceeding.

3 JUDGE MCKONE: We understand  
4 that, and that's one of the things  
5 we will be considering, but one of  
6 our other options is to deny the  
7 1616 -- 1665 petition under  
8 section 325D.

9 If we reach the conclusion  
10 that that -- that that ought to  
11 be -- that that's the correct  
12 result, would you oppose joinder  
13 to the 948 in an understudy role  
14 in order to protect Google in the  
15 event that Amazon settles?

16 MR. RENNER: Your Honor,  
17 we're not in a position to be able  
18 to accept a joinder under those  
19 particular terms. And we do have,  
20 you know -- our second ground in  
21 our petition is certainly  
22 different from anything that has

1           been instituted in the current  
2           proceeding, and with Amazon, and  
3           at minimum we would think that  
4           that grounds ought to be heard  
5           certainly as a matter of, you  
6           know, fairness and certainly for  
7           completeness of the record.

8                   MR. SHARTZER:  And Your  
9           Honor, you seem to be in command  
10          of this, I'll say it just to make  
11          sure it's on the table, we do  
12          think, as a matter of policy,  
13          these proceedings being ones that  
14          are affected to relieve district  
15          courts that otherwise could be  
16          held more efficiently here, we  
17          have some concerns over -- over  
18          that kind of approach, however,  
19          because it seems like that might  
20          create the most inefficiency.

21                   JUDGE MCKONE:  Okay.  Sounds  
22          like a moment ago patent owner

1 wanted to say one more thing.

2 MR. MANGRUM: Yes, Your  
3 Honor, and thank you for the  
4 opportunity.

5 I wanted to correct the  
6 record of something, in attempting  
7 to distinguish Innopharma  
8 Licensing versus Senju  
9 Pharmaceutical case IPR2016-0089,  
10 paper number 13, the counsel for  
11 petitioner seems to suggest that  
12 there were no additional grounds  
13 authorized or -- or considered in  
14 the follow-on petition, and that's  
15 just not correct.

16 I'm reading from paper  
17 number 13, the board said, and I  
18 quote, Innopharma's petition  
19 includes additional grounds not  
20 authorized in the inter partes  
21 review instituted in the loop in  
22 IPR.

1           So -- and I -- I apologize,  
2           I'm done with the page, because I  
3           had screen scraped this, but  
4           that's from paper 13, it's very  
5           clear in that matter that there  
6           were new grounds. And so the  
7           point of distinction is really  
8           illusory.

9           And the second point I want  
10          to make is in good faith Uniloc  
11          did its research before the meet  
12          and confer, and provided this case  
13          to opposing counsel during the  
14          meet and confer, and then gave  
15          opposing counsel the opportunity  
16          to pull it up during the meet and  
17          confer and read it and consider  
18          it.

19          Here, opposing counsel's  
20          lied behind the law, and for the  
21          first time during the call  
22          introduced cases without providing

1 any notice to patent owner that it  
2 was going to even present these  
3 cases or arguments with respect to  
4 this case. And it's kind of a  
5 prejudicial strategy to, you know,  
6 for the first time, during a call,  
7 introducing case law.

8 To the extent the board's  
9 going to even consider that Uniloc  
10 would appreciate the opportunity  
11 to maybe even have a briefing or  
12 discussion of that further. It's  
13 just -- it -- we -- we --

14 MR. RENNER: Your Honor,  
15 we're not asking for any  
16 additional briefing here.

17 MR. MANGRUM: Okay. I just  
18 want to at least make the record  
19 clear of the circumstances of how  
20 Uniloc is prepared to discuss case  
21 law in our meet and confer and we  
22 had no cases cited to us during

1 the meet and confer by opposing  
2 counsel.

3 MR. RENNER: Your Honor, on  
4 that note, if I may, I'd just like  
5 to make sure you're apprised of  
6 what the petitioner said about its  
7 grounds.

8 JUDGE MCKONE: I -- I don't  
9 need to go over the back and forth  
10 of your meet and confer. I think  
11 the parties have put forth what  
12 their -- what their positions are  
13 on this point.

14 MR. RENNER: Thank you.  
15 And -- and I just cite to page  
16 three, paper one in the same case,  
17 in lead up to Your Honor's review.  
18 I'm happy to comment on it but I  
19 will leave it at that.

20 JUDGE MCKONE: Okay. So  
21 we're not going to give a decision  
22 today. At this point we're going

1 to fully consider the 1665  
2 petition and consider whether or  
3 not the 325D argument raised by  
4 patent owner has merit.

5 And we'll also consider the  
6 party's argument today for and  
7 against joinder if -- if we reach  
8 the point where we think we need  
9 to consider that. And it's been  
10 helpful today to hear what your  
11 positions are.

12 And Google, do you have any  
13 other -- anything else to say on  
14 these issues?

15 MR. RENNER: No, thank you,  
16 Your Honor. I appreciate the  
17 time.

18 JUDGE MCKONE: Okay. Patent  
19 owner, do you have anything else  
20 to say on these issues?

21 MR. MANGRUM: No, Your  
22 Honor. Again, thank you for the

1 opportunity to be here.

2 JUDGE MCKONE: Okay. We'll  
3 issue decisions on these issues in  
4 due course, as soon as we can,  
5 and -- and with that, this call is  
6 adjourned. Thank you very much.

7 (Whereupon, the hearing was  
8 adjourned at 11:07 a.m.)

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1 CERTIFICATE OF SHORTHAND REPORTER - NOTARY PUBLIC

2 I, Cassandra E. Ellis, Registered Professional  
3 Reporter and Notary Public, the officer before whom  
4 the foregoing proceedings were taken, do hereby  
5 certify that the foregoing transcript is a true and  
6 correct record of the proceedings; that said  
7 proceedings were taken by me stenographically and  
8 thereafter reduced to typewriting under my  
9 supervision; and that I am neither counsel for,  
10 related to, nor employed by any of the parties to this  
11 case and have no interest, financial or otherwise, in  
12 its outcome.

13 IN WITNESS WHEREOF, I have hereunto set my hand  
14 and affixed my signature this 22nd day of December  
15 2017.

16 My commission expires:  
17 December 14, 2022

18

19

\_\_\_\_\_

20 CASSANDRA E. ELLIS, CSR-HI, CCR-WA, CLR, RPR

21 REALTIME SYSTEMS ADMINISTRATOR

22 NOTARY PUBLIC IN AND FOR THE DISTRICT OF COLUMBIA

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