

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL CORPORATION,
KINGSTON TECHNOLOGY COMPANY, INC.,
TOSHIBA CORPORATION,
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC., and
APRICORN,
Petitioners,

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2018-00082
Patent 6,088,802

Record of Oral Hearing
Held: January 24, 2019

Before LYNNE E. PETTIGREW, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

Case IPR2018-00082
Patent 6,088,802

APPEARANCES:

ON BEHALF OF PETITIONER WESTERN DIGITAL CORPORATION:

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The above-entitled matter came on for hearing on Thursday, January 24, 2019, commencing at 3:30 p.m. Eastern Standard Time by teleconference.

P R O C E E D I N G S

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3:32 p.m.

JUDGE FISHMAN: This is a telephonic oral argument hearing for IPR 2018-00082.

We have all the parties on the line. I wanted to remind both parties, as we indicated in our original hearing order, we are limited to the record. And any arguments that are being presented in this oral argument should be supported in the record.

We have asked you to be prepared to identify where there is such support. I'll temper that a bit only by saying if we find arguments that were not identified as supportable in the record, if we can locate support, that's fine. If not, we will be noting such an argument being disregarded in any final written decision.

So, with that, the parties have a half hour each. Each party may reserve some time for rebuttal. Petitioner will proceed first, carrying the burden of persuasion and may reserve some time.

Petitioner, do you want to reserve any of your time for any rebuttal?

MR. BUROKER: Yes, your Honors, I'll reserve ten minutes for rebuttal.

JUDGE FISHMAN: Okay. Patent Owner, when we start with you after Petitioner's argument, we'll determine if you want to reserve any time for rebuttal. Let me just get a timer set up here.

Okay, Mr. Buroker, you may proceed.

1 MR. BUROKER: Thank you, Your Honors. Today, as I previewed
2 in various telephone conferences set in advance of this hearing, I will only
3 be addressing grounds 1 and 3 with regard to the Harari, Anderson, and
4 Dumas combination in ground 3, and the Harari-Anderson combination in
5 ground 1. And those relate to Claims 1, 2, 11, and 12 only, not the other
6 claims.

7 And as we previewed, Your Honor, we wanted to formally make the
8 record clear on our point about what we think the record should have
9 included in those proceedings.

10 As we said in Paper No. 24, which is our motion for reply, pages 1
11 and 2, we believe the *SAS Institute* case holds that the Board has an
12 obligation to allow the parties to address all grounds presented in the petition
13 and issue a decision as to all of those grounds.

14 And, therefore, we believe that Western Digital should have been
15 permitted an opportunity to supplement the record and make argument post-
16 institution as to the deficiencies that the Board identified in its institution
17 decision. In particular, the arguments related to the means for mediation,
18 means for mediating claim limitation.

19 We believe that the denial of both the supplemental information
20 request and this denial of a motion for a reply were in error, because they
21 then froze the record with the petition, leaving the petition as the sole
22 evidence in the record. And, therefore, that Western Digital was not
23 presented an opportunity to make its case during the trial phase.

1 And we believe that the current framework of the rules should have
2 been set aside to permit us to do so, so that we could cure what the PTAB
3 Panel found to be deficiencies in the record.

4 Your Honor, first, when we moved for supplemental information in
5 Paper No. 17, the supplemental information states, the Board's decision in
6 Paper No. 22 at page 10 said that we wouldn't -- that there was no de facto
7 determination, because there could be further development of the record.

8 But of course, there was no further development of the record
9 permitted. And so that couldn't have been a proper reason for denying the
10 supplemental information. The petition effectively was frozen in time as to
11 the supplemental information request.

12 So then the petitioner moved for a reply in Paper No. 24, and in
13 Paper No. 32, the denial of that motion, some of the rationale we take issue
14 with, Your Honors. First of all, the Panel said that we could have moved for
15 reconsideration of the institution decision.

16 But as the Panel knows, the reconsideration is limited to determining
17 whether something has been overlooked or misapprehended. And that's not
18 the argument the Petitioner is trying to make. What we are trying to make is
19 a supplemental record to cure deficiencies in the petition.

20 So taking the Board's initial institution decision at its face that there
21 wasn't a deficiency of evidence as to the proof on the means for mediation,
22 means for mediating limitation, that cannot be cured within the four corners
23 of the petition.

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