

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LECTROSONICS, INC.,
Petitioner,

v.

ZAXCOM, INC.,
Patent Owner.

Case IPR2018-00972
Patent 9,336,307 B2

Record of Oral Hearing
Held: August 5, 2019

Before SCOTT R. BOALICK, *Chief Administrative Patent Judge*,
KALYAN K. DESHPANDE, and LYNNE E. PETTIGREW,
Administrative Patent Judges.

Case IPR2018-00972
Patent 9,336,307 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

C. BRANDON RASH, ESQUIRE
CORY C. BELL, ESQUIRE
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

ON BEHALF OF THE PATENT OWNER:

DR. GREGORY J. GONSALVES, ESQUIRE
Gonsalves Law
2216 Beacon Lane
Falls Church, Virginia 22043-1713

RITA C. CHIPPERSON, ESQUIRE
Chipperson Law Group, P.C.
163 Madison Avenue, Suite 220-40
Morristown, New Jersey 07960

The above-entitled matter came on for hearing on Monday, August 5, 2019, commencing at 2:01 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

PROCEEDINGS

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JUDGE DESHPANDE: Thank you. Please be seated. Okay, we are here for IPR2018-00972. Could we have our appearances first. Who do we have for Petitioner?

MR. RASH: Brandon Rash from Finnegan, Henderson, on behalf of the Petitioner, and also with me is Cory Bell, also from Finnegan.

JUDGE DESHPANDE: Okay, thank you.

DR. GONSALVES: My name is Gregory Gonsalves representing the Patent Owner, Zaxcom, and with me is Rita Chipperson.

JUDGE DESHPANDE: Great. Before we get started, there was a little bit of housekeeping I wanted to take care of. We received in an email by request from Patent Owner to file the application 12/772,471. That's Exhibit 2111, and which it is my understanding is that it was unopposed. We didn't get a chance to respond to the emails. We're going to go ahead and authorize just uploading that application as Exhibit 2111.

DR. GONSALVES: Thank you, Your Honor.

JUDGE DESHPANDE: And then our order for today's hearing spelled out the order we are going to go in. We have an hour for each side. Petitioner bears the ultimate burden. Petitioner will present arguments first. You may save up to 20 minutes for your rebuttal time.

Patent Owner you will proceed to present your argument, you may save some time for sur-rebuttal. If there aren't any questions, Petitioner, you may argue first. Just in case there's any confusion, let me introduce my panel. To my right is Chief Judge Boalick, to my left is Judge Pettigrew.

MR. RASH: Can I reserve 20 minutes, please Your Honor.

JUDGE DESHPANDE: Yes.

1 MR. RASH: Thank you. May it please the Board. I do have spiral
2 bound copies of the demonstratives, if that would be helpful for any of Your
3 Honors.

4 JUDGE DESHPANDE: Sure. Thank you.

5 MR. RASH: And also, Your Honor, I believe there was one other
6 housekeeping matter with respect to Exhibit 2105, that's the Dear
7 Declaration.

8 The Patent Owner had sent an email to the Board asking that that
9 exhibit be expunged because the witness was not available for cross
10 examination. Petitioner also filed a motion to expunge that document. I just
11 wanted to bring that to your attention.

12 JUDGE DESHPANDE: Yeah, we'll take that under advisement, but
13 we'll deal with that in our final decision.

14 MR. RASH: Great. Thank you, Your Honor. The Petition has 8
15 Grounds, Grounds 1, 3, and 5 are the Strub Grounds. Grounds 2, 4, and 6
16 add the Wood Reference, those are the Strub-Wood Grounds. And then
17 Ground 7 and 8 are the Lee Grounds.

18 I'd like to start with Grounds 1 through 6, the Strub and the Strub-
19 Wood Grounds. Slide 2 shows the two independent claims of the 307
20 Patent. On the left is Claim 1, on the right is Claim 12.

21 There are two elements of the claims that the Patent Owner has
22 directed its arguments to with respect to whether the prior art discloses them.
23 The first is the wearable element in each of the claims. And the second is
24 the combined-with element in each of the claims. And I'd like to start with
25 the combined-with element.

26 If we could turn to Slide 3. Slide 3 shows Claim 1 on the left, and
27 Figure 3 from Strub on the right. Where I'd like to start is the claim

1 language itself, as well as the Petition’s position because I think there's been
2 quite a bit of briefing that strays from what the claims actually say, and what
3 the Petition’s position actually puts forward.

4 Claim 1 is an apparatus claim. It recites an apparatus or system
5 comprising at least one local audio device. And that local audio device
6 includes four components: a local audio device receiver, an audio input
7 port, a memory, and a control unit that is electrically coupled to those first
8 three components. Except for the wearable element, the Patent Owner does
9 not dispute that Strub discloses a local audio device with these four
10 components.

11 There are also elements surrounding those components that go to the
12 intended purpose or use of the apparatus, whether or not those elements are
13 limiting, the Patent Owner also does not dispute that those elements are
14 present in Strub.

15 What we’re left with is the last element, the wherein clause and this
16 wherein element says that, “said local audio data may be retrieved after said
17 locally recording and combined with said remotely recorded audio data.”

18 Really, there is no dispute that Strub has local audio data, and that
19 local audio data may be retrieved from the device and combined with said
20 remotely recorded audio data. And that is all that Claim 1 requires.

21 Now, instead of addressing this language in the claim, the Patent
22 Owner started in the preliminary response arguing that the combined-with
23 limitation requires replacing. And, if Your Honors recall in the Institution
24 Decision, Your Honors rejected that argument and said that combined-with
25 is not limited to replacing, and in the POR, the Patent Owner has dropped
26 that argument. That is now an issue for a Motion to Amend.

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