

RECORD OF ORAL HEARING

U.S. PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN GLOBAL CORPORATION,
Petitioner,

v.

IKEDA FOOD RESEARCH, LTD.,
and PHC CORPORATION,
Patent Owner.

PGR 2019-00032
Patent 9,976,125 B2

Oral Hearing Held: June 18, 2020

Before DAVID COTTA, ROBERT A. POLLOCK and ERICA A.
FRANKLIN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

AARON S. ECKENTHAL, ESQUIRE
Lerner David Littenberg Krumholz & Mentlik
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PGR 2019-00032
Patent 9,976,125 B2

ON BEHALF OF THE PATENT OWNER:

KENNETH P. GEORGE, ESQUIRE
Amster Rothstein and Ebenstein
90 Park Avenue, 21st Floor
New York, NY 10016

The above-entitled matter came on for hearing on Thursday, June 18, 2020, commencing at 1:00 p.m. EDT, by video/by telephone.

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PROCEEDINGS

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JUDGE COTTA: So, do we have everyone on the line who's supposed to be on the line?

MR. GEORGE: This is Kenneth George representing the patent owners. I'm on the line.

MR. ECKENTHAL: Hi, this is Aaron Eckenthal representing petitioner.

JUDGE COTTA: Okay, thank you. Okay, let's get started then. Good afternoon, this the final hearing in PGR2019-00032, regarding Substitute Claim 11 of U.S. Patent Number 9,976,125. The petitioner is Lifescan Global Corporation. The patent owners are Ikeda Food Research Company, Limited and PHC Corporation. The hearing is open to the public and a full transcript of the hearing will be made of record. I'm Judge Cotta and with me are Judges Pollock and Franklin.

Counsel for the petitioner, would you please identify yourself for the record?

MR. ECKENTHAL: Yes, good afternoon, Your Honors. My name is Aaron Eckenthal from the law firm of Lerner David representing Lifescan Global Corporation.

JUDGE COTTA: Thank you. And counsel for the patent owner, could you kindly identify yourself for the record as well?

MR. GEORGE: Yes, Kenneth George with Amster Rothstein and Ebenstein, counsel for the patent owners.

1 JUDGE COTTA: Okay. So, as set forth in our hearing order of May
2 12, 2020, each side has 45 minutes to present its case. My colleagues and I
3 will do our best to keep track of time, but we suggest that the parties do the
4 same.

5 Counsel for the petitioner, would you like to reserve any time for
6 rebuttal?

7 MR. ECKENTHAL: Yes, I would, Your Honor. I'd like to reserve 15
8 minutes for rebuttal.

9 JUDGE COTTA: Okay. And counsel for patent owner, you may
10 have the last word today if you'd like it. Would you like to reserve any
11 time?

12 MR. GEORGE: Yes, 10 minutes, thank you.

13 JUDGE COTTA: Okay. Before we begin, there are a few things I'd
14 like to cover. First, on behalf of the board, I'd like to thank everyone for
15 their flexibility in participating in this all video hearing. Given that this is a
16 departure from our typical practice, I'd like to emphasize that our primary
17 concern is your right to be heard. So, if at any point during the proceeding
18 you encounter technical difficulties or other difficulties that you feel
19 undermine your ability to represent your client adequately, please let us
20 know.

21 Second, if you're not speaking, please mute your microphone so we
22 have a clearer connection. Third, and please try to identify yourself each
23 time you speak. We will do the same for the benefit of the record. Fourth,
24 we have access to the entire record, including demonstratives. So, when you
25 refer to each demonstrative, paper, or exhibit, please do so by slide or page
26 number and allow us a few seconds to find it. Finally, if you come to a good

1 faith belief that the pace of this proceeding prevents you from adequately
2 explaining your position, please speak up and we'll consider extending the
3 allotted time.

4 Petitioner will go first as it bears the burden of showing
5 unpatentability of the challenged claims. So, petitioner, you can begin
6 whenever you are ready.

7 MR. ECKENTHAL: Thank you, Your Honor. Good afternoon. As
8 we heard before, my name is Aaron Eckenthal and I am from the law firm of
9 Lerner David representing the petitioner in this case, Lifescan Global
10 Corporation. And as Your Honor just stated, it seems that you have access
11 to the demonstratives so, I'm going to refer to those throughout today's
12 presentation.

13 I'd like to start with slide number 2. Just to touch on the 125 patent
14 briefly here in the fact that it relates to an FAD-conjugated glucose
15 dehydrogenase, which is a specific enzyme that's used in a biosensor and its
16 ability is to detect glucose. And through patent owner's amendments here, I
17 think the overall issue is really quite narrow. And Your Honors seem to
18 have really zeroed-in on this precise dispute between the parties at this point
19 as having to do with the particular FAD-conjugated GDH enzyme. Which in
20 this case at issue is *Aspergillus oryzae* NBRC 30104.

21 And I will address the points that the board sought to be addressed
22 earlier this week in their email. But I just want to give some context to
23 patent owner's amendments. And the amendments made to Substitute Claim
24 11, which is really original Claim 8 that's been rewritten into independent
25 form, focuses on two particular aspects in addition that have been amended
26 from the original claim.

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