

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP
Petitioner,

v.

BRAGI GMBH,
Patent Owner.

IPR2023-01150
Patent 9,843,853 B2

Record of Oral Hearing
Held: November 20, 2024

Before LARRY J. HUME, STACEY G. WHITE, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

HAIXIA LIN, ESQ.
Wilmer Cutler Pickering Hale and Dorr, LLP
2100 Pennsylvania Avenue, NW
Washington, DC 20037
(202) 663-6029
haixia.lin@wilmerhale.com

Trishan Efram
trishan.esram@wilmerhale.com

ON BEHALF OF THE PATENT OWNER:

BRADLEY JARRETT, ESQ.
Mckool Smith, P.C
300 Crescent Court
Suite 1200
Dallas, TX 75201
(214) 978-4216
bjarrett@mckoolsmith.com

Richard Kamprath
rkamprath@mckoolsmith.com

The above-entitled matter came on for hearing on Wednesday,
November 20, 2024, commencing at 1:00 p.m., via video teleconference.

P R O C E E D I N G S

- - - - -

JUDGE HUME: Good morning. We're convened for oral arguments in IPR 2024-01150, which pertains to patentability challenges of claims in U.S. Patent 9,843,853. I'm Judge Hume, and also appearing is Judge White and Judge Wormmeester. We also have a court reporter, Ms. Watson, online to transcribe the hearing. Appearances. So, let's get started with appearances for both parties, for those who will be arguing today, including, as I understand it, a LEAP practitioner appearing for Petitioner. If anyone else is attending remotely with you today that will not be speaking, please identify them as well. For example, please state if your client is attending.

Following the hearing, please confer with the court reporter to ensure there are no questions regarding the spelling of names or terms.

We'll start with appearances for Petitioner.

MR. ESRAM: Good morning, Your Honors. I'm Trishan Efram, representing Petitioner HIMPP. With me is Haixia Lin, Lead Counsel. We are both from Wilmer Hale.

JUDGE HUME: All right. Thank you very much. Now, who is appearing for Patent Owner?

MR. JARRETT: Yes, Your Honor. Bradley Jarrett, appearing --

JUDGE HUME: Your volume is very low.

MR. JARRETT: Is this better, or?

JUDGE HUME: Slightly. Not optimum.

MR. JARRETT: Then maybe I should -- maybe I'll try to dial in to the --

1 JUDGE HUME: Or closer to the microphone, perhaps.

2 MR. JARRETT: Is this any better or?

3 JUDGE HUME: It's very faint. I don't know about the other
4 Judges.

5 JUDGE WHITE: It's faint.

6 JUDGE HUME: Very faint.

7 MR. JARRETT: If I could, I'll just quickly dial in to the
8 conference line if that would (INDISCERNIBLE). Hello.

9 JUDGE HUME: Yes, that sounds better.

10 MR. JARRETT: Okay. So, I'll just proceed through the phone
11 line. That's fine.

12 JUDGE HUME: Okay.

13 MR. JARRETT: Your Honors, Bradley Jarrett, on behalf of Patent
14 Owner Bragi from McKool Smith. I'm joined by lead counsel Richard
15 Kamprath. I also expect that principal from McKool Smith, Mr. Scott
16 Hejny, will join and our client, represented for our client, Mr. Connor
17 Kennedy from Bragi, is also expected to join as well.

18 JUDGE HUME: Okay. So, that's it for appearances. I just wanted
19 to welcome everybody and take this opportunity to address counsel and
20 clients before we begin.

21 As an inter-parties review is a contested proceeding, today's
22 hearing provides you an opportunity for counsel to orally advocate for your
23 positions on the patentability of the challenged claims as raised in the
24 petition. We understand that in every case that comes before us, the parties,
25 both Petitioner and Patent Owner, have a lot at stake. The Judges before you
26 today take our role in deciding this dispute seriously. We have reviewed the

1 briefs and evidence, and we are prepared today with questions. These
2 questions and their answers will help us decide the issues in the case. In the
3 interest of fairness and due process, we must limit our considerations to the
4 arguments and evidence already present in the record.

5 We have the briefs and evidence available to us on our computers,
6 so if we look away from the camera during a hearing, we may be consulting
7 the documents in the record or taking notes. Please know that we are paying
8 close attention to your arguments and carefully considering the case. And if
9 we interrupt you, we apologize in advance, but we do so to be able to ask
10 you questions that may be essential to our resolution of the issues or to keep
11 the hearing on track with time. And with a virtual hearing, sometimes
12 people kind of talk over each other sometimes by accident. For clarity of the
13 record, recording of any PTAB hearing is prohibited. The court reporter will
14 provide a transcript of the hearing that will become a part of the record in the
15 proceeding at a later date. To ensure that the transcript of this hearing is
16 clear, we ask you to identify yourselves before speaking, to speak directly
17 into the microphone, and to identify specific slide numbers, numbering and
18 figures, and any other pertinent identifying information when referring to
19 demonstratives.

20 Please mute yourself when not speaking. If you encounter any
21 technical difficulties, please let us know immediately. As a reminder in the
22 burdens to prepare for your oral arguments, we've familiarized ourselves
23 with the record and issues in this case. Our role as Judges on the panel is to
24 assess your arguments and evidence and weigh those in accordance with the
25 burdens established by our Rules of Procedure and precedential authority.
26 We remind the parties that Petitioner has the ultimate burden of establishing

1 unpatentability by a preponderance of the evidence.

2 The amount of argument time for each side, per the hearing order,
3 each party has 60 minutes total time. We received Patent Owner's, or excuse
4 me, Petitioner's request for Trishan Efram to participate in oral hearing
5 under the LEAP program. Because of that, Petitioner will receive an
6 additional 15 minutes of argument time during the oral hearing, bringing
7 their total argument time to 75 minutes. We remind Petitioner that the
8 LEAP practitioner must have a meaningful and substantive opportunity to
9 argue during the hearing today.

10 That said, there is no set time requirement for that argument and
11 may be longer or shorter than 15 minutes. Petitioner will open the argument
12 and may reserve rebuttal time, which may not exceed more than half of
13 Petitioner's total argument time. Patent Owner will then respond to
14 Petitioner's arguments and may reserve sur-rebuttal time also to not exceed
15 more than half of Patent Owner's total argument time. With respect to
16 objections, please remember that your argument should be limited only to
17 those arguments previously presented in your briefs. Please make it clear
18 which challenges and claims you are addressing at all times. We ask that the
19 parties hold any objections regarding the parties' arguments until it is their
20 time to speak.

21 We also note that demonstratives are not a mechanism for making
22 new arguments. Demonstratives are also not evidence and will not be relied
23 upon as evidence. Rather, demonstratives are visual aids to the parties' oral
24 presentation regarding arguments and evidence previously presented and
25 discussed in the papers.

26 The Board has considered Petitioner's objection and we reserve

1 ruling on its objection.

2 Timer. I will maintain a clock and others along with me I hope
3 will assist and endeavor to give each party time warnings as you near the
4 end of your allotted opening argument time and near the end of any reserved
5 rebuttal time. That will be helpful for the parties to also track their time,
6 which I am sure you will be doing.

7 For the Patent Owner, because he did not file a Patent Owner
8 response to the petition, but instead filed an initial MTA, a motion to amend,
9 and then a revised motion to amend without presenting arguments against
10 Petitioner's grounds, and in light of your demonstratives today, we are
11 assuming that all arguments against the Petitioner's original grounds have
12 been waived. Is that a correct understanding, Patent Owner?

13 MR. JARRETT: Your Honor, yes. We are proceeding based on
14 the revised motion to amend.

15 JUDGE HUME: Okay. Thank you. That clarifies the issues for
16 trial in our ultimate decision and may assist Petitioner in how they proceed.
17 Petitioner, do you have any -- do you wish to reserve any rebuttal time?

18 MR. ESRAM: Yes, Your Honor. Twenty minutes, please.

19 JUDGE HUME: Twenty minutes for rebuttal? All right. Very
20 good. You may begin your arguments when ready.

21 MR. ESRAM: Thank you, Your Honor. Just to be clear, I'm going
22 to mention which slide I'm on as I'm going along.

23 JUDGE HUME: Okay.

24 MR. ESRAM: May it please, the Board. Again, I'm Trishan
25 Efram representing Petitioner HIMPP, and I'm on slide 1. The original
26 claims of the '853 patent were all directed to adjusting power levels of

1 wireless earpieces in response to detecting or not detecting a magnetic field.
2 The claim techniques help manage and extend battery life of the earpieces.
3 However, Patent Owner no longer disputes managing battery life by
4 adjusting power level based on absence or presence of a magnetic field was
5 known. Patent Owner did not present any arguments as to why the original
6 claims are patentable. Patent Owner did not file a response and has waived
7 all arguments to dispute the unpatentability of the original claims.

8 On the other hand, consistent with the institution decision in this
9 proceeding, Petitioner has shown by a preponderance of the evidence that
10 the original Claims 1 through 21 of the '853 patent are unpatentable.
11 Therefore, Petitioner respectfully requests that Your Honors cancel these
12 claims.

13 Even when we consider the current disputes related to Patent
14 Owner's revised motion to amend, none of Patent Owner's argument is based
15 on any limitations related to adjusting power levels or detecting magnetic
16 fields. Instead, Patent Owner's revised motion to amend introduced a new
17 limitation, that the wireless earpieces are configured to read user biometrics.
18 This is the only limitation that Patent Owner argues is not present in the
19 prior art cited in the petition.

20 We note that Patent Owner did not add any other limitations
21 related to this user biometrics limitation. There's nothing about which types
22 of user biometrics are read, nothing about what sensors are used or otherwise
23 how this feature is implemented, and nothing about what happens with the
24 measured user biometrics. For example, nothing about how they are used,
25 stored, displayed, or communicated. The added limitation only requires
26 configuring the wireless earpieces to read user biometrics. But even with

1 respect to this user biometrics limitation, the nature of the dispute is limited.
2 Patent Owner admits this limitation was known in the art before the '853
3 patent. In fact, Patent Owner does not dispute that it was known to adjust
4 power levels of the earpieces based on temperature. And there's no dispute
5 that temperature is a type of biometrics.

6 Despite these admissions, Patent Owner attempts to argue that
7 there was no motivation to configure wireless earpieces that have a
8 mechanism for adjusting power levels to incorporate the known feature of
9 being able to read user biometrics. As I will discuss, Patent Owner's
10 arguments fail. In addition, Patent Owner's revised motion to amend fails
11 for other reasons that I will discuss.

12 And I will skip right to slide 32 and jump right into the disputes
13 related to Patent Owner's revised motion to amend. In its revised motion to
14 amend, Patent Owner proposes one substitute claim for each of the 21
15 original claims of the '853 patent.

16 Turning to slide 33, we see the first substitute Independent Claim
17 22. We've highlighted the added user biometrics limitation. Patent Owner
18 does not dispute that any non-highlighted portions, including any other
19 added limitation, was known in the prior art.

20 Turning to slide 34, we see the second substitute in Dependent
21 Claim 31.

22 JUDGE WHITE: Counselor?

23 MR. ESRAM: Yes, Your Honor.

24 JUDGE WHITE: Do we need to construe anything here? Like, do
25 we need to construe biometrics or anything like that?

26 MR. ESRAM: Your Honor, I don't think there was any dispute on

1 whether we needed to construe user biometrics. There is an issue regarding
2 the breadth of user biometrics and whether it's enabled by the spec, and I'm
3 prepared to discuss this later or now.

4 JUDGE WHITE: Please continue.

5 MR. ESRAM: So, on slide 34, again, here we're seeing the second
6 substitute Independent Claim 31. Patent Owner's only argument rests on the
7 same single highlighted limitation related to the user biometrics limitation.

8 Turning to slide 35, it's the same for the third and final substitute
9 Independent Claim 42.

10 Moving on to slide 36, as I mentioned during the opening, Patent
11 Owner's only argument in its revised motion to amend as to why its
12 proposed substitute claims are patentable is that the user biometrics
13 limitation is missing from the prior art cited in the petition. But skipping to
14 slide 45, we now turn to Patent Owner's reply to understand what exactly
15 Patent Owner disputes about this limitation, which is highlighted in the box
16 in the lower right corner.

17 Patent Owner, as shown in the top left corner, admits that
18 techniques to read biometrics that would be implemented in an earpiece
19 were known in the art and within the skill level of a POSITA to implement
20 as a priority date. In particular, Patent Owner calls out temperature as one
21 such biometric that a POSITA would know, and the techniques for reading
22 temperature using an earpiece were within a POSITA's skill level to
23 implement before the '853 patent.

24 Turning to slide 46, we see that, as shown in the lower right corner,
25 Patent Owner also admits that powering up or down an earpiece based on
26 temperature was known. In particular --

1 JUDGE HUME: I'm sorry, this is Judge Hume. This Rass
2 reference, I assume that's how it's pronounced, Ross or Rass, that's not
3 applied in any of your challenges, is that correct?

4 MR. ESRAM: That is correct.

5 JUDGE HUME: So, what is the purpose of this Rass reference in
6 your view?

7 MR. ESRAM: The purpose of the Rass reference, Your Honor,
8 was to show motivation to combine prior art reference Aumer with the
9 primary references in the petition. Rass, like the '853 patent, like the
10 primary prior art references, discloses an earpiece that's fitted with a sensor
11 that measures the temperature of a user and turn on and off the earpiece.

12 JUDGE HUME: So, this is not directly responsive to a claim
13 limitation, just to the level of skill in the art?

14 MR. ESRAM: That's correct, Your Honor.

15 JUDGE HUME: Okay, thank you.

16 MS. LIN: I just want to elaborate on what my co-counsel said.
17 The reference, there's really no dispute over whether or not wireless
18 earpieces configured to read user biometrics were known. The Patent
19 Owner doesn't dispute that. It's about whether or not you would have had
20 that feature with the rest of the claim, and Rass does go to that point, though
21 it does not form a prior art reference in the ground itself.

22 JUDGE HUME: So, to be specific, the claim doesn't address
23 temperature at all, just generic biometrics. And you're telling --

24 MS. LIN: It says user biometrics. And my understanding is
25 there's no dispute that temperature is a type of user biometric.

26 JUDGE HUME: All right. Thank you.

1 MR. ESRAM: Thank you. So, back to slide 46, I was explaining
2 that Rass then, which was five, ten years before the '853 patent discloses an
3 earpiece that has a temperature sensor. Even in the excerpts shown here on
4 the slide, talks about the earpieces being worn by the user and the
5 temperature detects the resulting increase in heat causing the earpieces to
6 turn on. Likewise, it turns off when the temperature drops. And despite
7 these admissions, Patent Owner argues that it was not obvious where
8 wireless earpiece to be configured to read user biometrics. Specifically,
9 Patent Owner argues that there was no motivation to combine prior art
10 reference on a reference about wearable biometric monitoring devices. With
11 each of the primary reference --

12 JUDGE HUME: Perhaps you could discuss Aumer reference.

13 MR. ESRAM: Yes, Your Honor. Definitely. So, moving to,
14 skipping to, or going back to slide 38. Here we are showing Aumer's cover
15 page and Figures 2A and 2B. In Figures 2A and 2B, Aumer discloses a
16 wireless monitoring earpiece 20, which includes a sensor module 24. And if
17 we move to the next slide 39, here we see that Aumer discloses that the
18 sensor module 24 is configured to contact a selected area of an ear. The
19 sensor module is configured to detect and/or measure physiological
20 information, that is user biometrics from the user. And on slide 40, we see
21 that Aumer discloses the same types of user biometrics as those disclosed in
22 the '853 patent, namely temperature, heartbeat, blood gas levels. Aumer also
23 explains that the ear is an ideal location to measure these types of user
24 biometrics.

25 JUDGE HUME: Is the sole purpose of Aumer to measure
26 biometrics, or is there some other hearing enablement type of improvement?

1 MR. ESRAM: Yeah, Aumer talks about how to improve the signal
2 for measuring -- from measuring these user biometrics.

3 JUDGE HUME: So, it's directed primarily to user biometrics, not
4 to -- it's not a hearing aid device, per se, or an earphone type device?

5 MR. ESRAM: Aumer is directed to measuring user biometrics and
6 primarily, predominantly, refers to an earpiece, which it shows explicitly in
7 Figure 2A and 2B. And there are other figures in Aumer that shows on how
8 to position the earpieces within the ear to improve the signal, the biometric
9 signal that's being measured.

10 JUDGE HUME: Thank you.

11 MR. ESRAM: And if I move to slide 41, we see that Aumer also
12 discloses the same types of sensors for its sensor module as those disclosed
13 in the '853 patent. It talks about optical sensors, thermal sensors, electrical
14 sensors. These are the types of sensors that are used to measure temperature,
15 gas levels, and heartbeat. And to Your Honor's question, also, Aumer makes
16 it clear that the ear is the ideal place to measure these types of user
17 biometrics. On the previous slides we saw it in paragraph 64. So, Aumer is
18 really focusing on an earpiece, although it's not limited to an earpiece.

19 I'm now on slide 42. Petitioner has provided expert testimony by
20 Dr. Sayfe Kiaei as to why a POSITA would have been motivated to combine
21 Aumer with each of the primary art references cited in the IPR with a
22 reasonable expectation of success.

23 On slide 43, we see that Dr. Kiaei explained that first, Aumer is
24 from the same field of endeavor. Second, a POSITA would have known
25 how to include a sensor to reduce the biometrics as taught by Aumer in an
26 earpiece, as taught by Brown, Hain, Steinbrecher, or Shaffer. Patent

1 Owner's own expert, Dr. Yong, admitted during cross-examination that a
2 POSITA would have known how to do so. In fact, as I mentioned before,
3 Patent Owner admitted that techniques to read user biometrics that would be
4 implemented in earpiece were within the scale level of a POSITA. Third,
5 around Aumer's filings, that is before the '853 patent, there were increased
6 consumer interest in monitoring personal health, and there were also
7 advances in miniaturizing sensors. And fourth, it was known to switch an
8 earpiece on and off depending on user biometrics. According to Dr. Kiaei,
9 such a feature would provide the added benefit of saving battery life of the
10 earpiece. And once again, Patent Owner admitted that adjusting the power
11 of an earpiece based on user biometrics, such as --

12 JUDGE HUME: Counselor, Judge Hume. Is that relevant to the
13 claim, any claim at issue? Turning power off based on biometrics?

14 MR. ESRAM: If the claims themselves don't explicitly recite this,
15 the Patent Owner seems to argue that the reason that the user biometrics is
16 measured is to adjust the power level of the earpiece, but that's not in the
17 claims, Your Honor. Even then, Dr. Kiaei explained why user biometrics,
18 measuring user biometrics could be beneficial to an earpiece.

19 JUDGE HUME: Thank you.

20 MR. ESRAM: So, with all these motivations, Patent Owner then
21 argues that these motivations to combine are insufficient. Patent Owner's
22 argument hinges on its assertion that Aumer is not analogous art, but Aumer
23 is analogous art, as I will discuss next.

24 So, moving to slide 48. For several decades, two separate tests
25 have defined the scope of analogous art, a field of endeavor test and a
26 reasonable pertinence test. Aumer is analogous art under either one of these

1 two tests. Starting with the first test on slide 49, based on the case law, the
2 field of endeavor may be broadly defined because it relates or relies on the
3 complete disclosure of all embodiments in the patent specification. In its
4 reply, as shown at the bottom of the slide here, Patent Owner acknowledges
5 that the '853 patent broadly relates to wireless electronics and battery
6 systems, and not exclusively to wireless earpieces that manage and extend
7 battery life.

8 Moving on to slide 50, like the '853 patent, Aumer discourses
9 wearable biometric monitoring devices, and in particular wireless earpieces.
10 Therefore, Aumer at least shares the '853 patent's general field of endeavor,
11 which we saw --

12 JUDGE HUME: And that would be monitoring devices? Is that
13 your general field that you're applying?

14 MR. ESRAM: No, Your Honor. If we look at on the left side
15 here, the field of disclosure generally relates to wireless electronics. And it
16 says not exclusively to wireless earpieces. So, the general field of endeavor
17 for us is wireless electronics, including wireless --

18 JUDGE HUME: Okay, I understand. Thank you.

19 JUDGE WHITE: But isn't wireless electronics a little broad?
20 Because as Patent Owner points out wireless electronics, that could include
21 your smartwatch. That could include a lot of things that are arguably
22 beyond what we're looking at here in the field of endeavor for the '853.
23 Don't we need to cabin that in some?

24 MR. ESRAM: Your Honor, that is a fair point, and we are not
25 looking at wireless electronics broadly. And I think you should look at the
26 motivation to combines in our position, although we do talk about

1 monitoring devices. If you keep reading the next sentences, talk about
2 wireless earpieces and all the prior art references are about wireless
3 earpieces hearing aids. And so, is Aumer predominantly looking at
4 earpieces? So, to your point, yes, the general field of endeavor is not just
5 purely wireless electronics, but it also includes wireless earpieces.

6 And the Federal Circuit noted in the Netflix case that it has firm
7 findings of analogous art where references shared a general field of
8 endeavor. And I think this is the point here that all the primary references
9 cited in this IPR and Aumer share this general field of endeavor because
10 they all relate to wireless earpieces.

11 And on slide 51, we also note that the case law says that the field
12 of endeavor of a patent is not limited to the specific point of novelty.
13 Nevertheless, the field of endeavor should at least include the alleged point
14 of novelty. As I mentioned earlier, Patent Owner identifies only one point of
15 novelty, which is the requirement that the wireless earpieces be configured
16 to read user biometrics. So, the field of endeavor should at least include
17 wireless earpieces configured to read user biometrics. And as shown here on
18 the bottom right, Aumer describes its field of invention as monitoring
19 devices and methods for measuring physiological information. And we
20 noted already before that Aumer predominantly focuses on wireless
21 earpieces. So, even under a narrow definition of a field of endeavor of the
22 '853 patent, Aumer is from the same field of endeavor.

23 Moving on to slide 52, and focusing on the second reasonable
24 pertinence test. The case law makes clear that a prior art reference is
25 reasonably pertinent only if a person of ordinary skill in the art would
26 reasonably have consulted those references and applied their teaching in

1 seeking a solution to the problem that the inventor was attempting to solve.
2 Also, if a reference disclosure has the same purpose as the claimed
3 invention, then the reference relates to the same problem.

4 Turning to slide 53, as I mentioned earlier, the only point of
5 novelty that Patent Owner identifies is the requirement that the wireless
6 earpieces are configured to read user biometrics. Well, likewise, Aumer is
7 directed to solving the problem of how to implement a wearable biometric
8 monitoring device.

9 JUDGE HUME: Counselor, Judge Hume. Is the claim, the
10 proposed claim in the RMTA, what problem is that, in your view, trying to
11 solve by adding the biometric? Is that -- are these answer to problems?

12 MR. ESRAM: It's unclear, Your Honor, because the claim simply
13 required that the wireless earpieces be configured to read user biometrics.
14 The claim doesn't require anything else that is done with a measured user
15 biometrics. It's unclear if its values of biometrics is used to do anything else
16 with earpieces. And I hope that answers your question, Your Honor.

17 JUDGE HUME: Thank you.

18 MR. ESRAM: So here, if a POSITA was faced with a problem of
19 how to configure the wireless earpiece to read user biometrics, then a
20 POSITA would have considered a reference such as Aumer that is directed
21 to improving signal quality in a wearable biometric monitoring device, such
22 as the wireless earpiece. And even if the inventors of the '853 patent were
23 involved in using user biometrics to manage wireless earpiece battery life,
24 again, that's not a feature recited in the claims. A POSITA would still have
25 reasonably considered references directed to how to configure wireless
26 earpieces to read biometrics like Aumer, to ensure that the earpieces manage

1 battery life based on accurate biometric readings. Therefore, Aumer is
2 reasonably pertinent to the problem faced by the inventors of the '853 patent.
3 The bottom line, Your Honors, is that Aumer is analogous art, and there
4 were several motivations to combine Aumer with each of the primary
5 references, thereby rendering Patent Owner's proposed substitute claims
6 obvious and unpatentable.

7 Patent Owner's revised motion to amend fails for other reasons that
8 I'd like to discuss next. So, I'm now on slide 54. Patent Owner's revised
9 motion to amend fails because they use a biometrics limitation, which is
10 included directly or indirectly in all its proposed substitute claims lacks
11 enablement.

12 Turning to slide 55, in the Amgen case, the Supreme Court made
13 clear that the specification must enable the full scope of the invention as
14 defined by its claims. But if '853 patent specification fails to enable a
15 POSITA to make and use wireless earpieces configured to read user
16 biometrics, the claims simply require that the wireless earpieces be
17 configured to read user biometrics. There are no further limitations
18 restricting user biometrics to what the '853 patent specification discloses.
19 Thus, the substitute claims cover the entire class of user biometrics.

20 JUDGE HUME: Counselor, Judge Hume. Is that true for any of
21 the dependent claims as well that they're all broad, and they encompass the
22 entire class of biometrics, or are there narrowing dependent claims?

23 MR. ESRAM: That is true, Your Honor. The dependent claims
24 don't add anything else. They don't limit the use of the user biometrics or
25 the type of the use of user biometrics. So, the class of user biometrics here
26 is pretty broad.

1 JUDGE HUME: So, there's no ability to apply the doctrine of
2 claim differentiation here in terms of the dependent claims narrowing the
3 scope?

4 MR. ESRAM: That is correct, Your Honor, because the dependent
5 claims don't add anything else.

6 So, moving on to slide 56.

7 MS. LIN: Sorry, Tishan. This is Haixia for Petitioner. And just
8 to -- since we're on this topic now, I did want to circle back to a question that
9 I believe Judge White, you raised earlier about claim construction, if there
10 were any disputes. You know, Petitioner's position is that plain and ordinary
11 meaning is sufficient. But I understand that question should probably be
12 directed to the fact that Patent Owner has effectively raised the claim
13 construction dispute in its most recent filing because it wants to exclude
14 certain user biometrics from within the scope of the substitute claims. So, in
15 that sense, there is a dispute over the scope of the claims.

16 MR. ESRAM: Thank you. So, on slide 56, I was saying that
17 during cross-examination, Patent Owner's expert, Dr. Yong, testified that a
18 POSITA would understand the term user biometrics in the context of the
19 '853 patent to mean biological, physiological, or chemical characteristics of
20 a user. And on slide 57, Petitioner's expert, Dr. Kiaei, has provided
21 un rebutted testimony that Dr. Yong's broad definition would include, for
22 example, DNA sequencing, retinal scans, vein patterns, and facial features.
23 Dr. Kiaei's testimony is consistent with Dr. Yong's testimony that a retinal
24 scan is also considered user biometrics in the context of the '853 patent.

25 JUDGE WHITE: Does that really make sense in the context of the
26 '853? I mean, a retinal scan in an earpiece, I'm struggling to understand how

1 that contextually makes sense.

2 MR. ESRAM: It does, Your Honor, because the claim doesn't
3 require anything else about how the user biometrics is measured or used. It
4 doesn't even require that the ear piece be worn in the ear to measure the user
5 biometrics. So, it is conceivable that the earpieces could be sensing or
6 measuring user biometrics when not worn in the ear. For example, the user
7 could be holding the earpieces and looking into it for a retinal scan or face
8 recognition. Patent Owner doesn't provide any reasoning of why that can't
9 be done.

10 JUDGE WHITE: Wouldn't that be to turn this into a bit of a magic
11 box, though? I don't know that we have to read biometrics that broadly in
12 order for this to all make sense. I don't see contextually why we would use
13 this earpiece for all of that, and why that would be what one of skill in the
14 art would be looking to do here.

15 MS. LIN: So, just to chime in, one view would be, okay, does the
16 user biometrics somehow have to relate to battery life or powering up or
17 down? You know, naturally, those types of user biometrics would make
18 sense. But because there is no requirements that the user biometric that's
19 read or measured is used to do anything, the claim does read more broadly.
20 And you could imagine that wireless earpieces are like our phones these
21 days. Those originally were just for making calls. And yeah, you shouldn't
22 worry about their battery life. But now they have fingerprint recognition.
23 They have facial recognition. They use user biometrics for identification
24 purposes, other purposes. Those are very multipurpose devices. And you
25 could see that with as earpieces become more common, more complicated.
26 They could be incorporating user biometrics for other purposes beyond just

1 power management, and the claim -- that would fall within the scope of the
2 claim as they are currently drafted.

3 JUDGE WHITE: Judge Hume, I think you're starting to say
4 something, and it looks like you're on mute.

5 JUDGE HUME: All right. Sorry about that. Yeah, I'm looking at
6 the '853 patent, column 3, lines 12 through 24, approximately. It talks about
7 another embodiment, the wireless earpieces may represent wireless devices
8 that may be ingested or implanted. It talks about a smart case—which we'll
9 discuss later if we need to—can be configured to work with an endoscopic
10 pill, pacemaker, tracking device, contact lenses, oral implants, bone
11 implants, artificial organs, or so forth. How does that play into your
12 argument?

13 MS. LIN: Sorry, I was on mute. I do think that is consistent with
14 what I was explaining to Judge White that these earpieces are not simply just
15 for playing music in your ear or playing something in your ear, and that they
16 could be more complicated devices or part of the more complicated system.
17 And therefore, you could imagine a wide variety of user biometrics may be
18 appropriate for wireless earpiece. Should we continue? Are there any more
19 questions? Okay, go ahead, Trishan.

20 JUDGE HUME: Oh, I just wanted to bring that to your attention.

21 MS. LIN: Yes.

22 JUDGE HUME: Because it plays both against or for both sides.

23 MR. ESRAM: Okay. So, if we continue then to slide 58, Your
24 Honors. In its reply Patent Owner does not dispute that very fact where
25 specification fails to enable how to make wireless earpieces configured to
26 read the entire class of user biometrics. Instead, Patent Owner artificially

1 limits the claims scope to arbitrarily exclude some types of a user
2 biometrics. In particular those related to DNA sequencing, facial
3 recognition, retinal scans, and so on. Patent Owner then limits its
4 arguments, including its analysis of the Wands factors to this narrowed set of
5 user biometrics. In particular, Patent Owner argues that the claims require
6 that the biometrics be both appropriate for using an earpiece worn within the
7 ear and appropriate for performing associated functions, which would
8 include powering down. But Patent Owner's arguments fails for several
9 reasons.

10 Moving to slide 59. First, the substitute claims do not limit the
11 type of user biometrics, and I think we said that either explicitly or
12 implicitly. Patent Owner's expert, Dr. Yong, broadly defined user
13 biometrics to be any biological, physiological, or chemical characteristics of
14 a user. Second, the substitute claims merely recite that a portion of a
15 wireless earpiece fits within the ear canal. In other words, a portion of the
16 earpiece can be outside of the ear canal. The earpiece could be structurally
17 configured to house a wide variety of technology for reading a wide -- a
18 broad range of user biometrics. First --

19 JUDGE HUME: Counselor, Judge Hume. Just to be clear, this
20 was Patent Owner's expert that opined on this. Is that what you said?

21 MR. ESRAM: The Patent Owner expert defined user biometrics
22 very broadly, but the reasoning of why the earpiece could be measuring a
23 wide variety of user biometrics is that it's not only worn in the ear, piece of
24 an earpiece --

25 JUDGE HUME: Right. I just want to understand who is making
26 that statement in the righthand column of your chart or your table on page

1 59.

2 MR. ESRAM: Yes. The quote is from our sur-reply, Your Honor.
3 So, we are explaining why looking at the claim language the substitute
4 claims don't limit the type of user biometrics, or how --

5 JUDGE HUME: My question is simple. That the quotation you
6 have in the first table entry is any biological, physiological, et cetera.

7 MS. LIN: That's correct.

8 JUDGE HUME: That's Patent Owner's?

9 MS. LIN: That's Patent Owner's expert's definition.

10 JUDGE HUME: That was my question. Thank you.

11 MS. LIN: That's correct.

12 MR. ESRAM: That is correct, yes. And instead, the substitute
13 claims do not require that the wireless earpieces read user biometrics while
14 worn in within the ear, and we explain that and we explain that you could do
15 many things with the wireless earpieces when they are not worn. And Patent
16 Owner's own expert testified that in the context of the '853 patent, user
17 biometrics will be understood to relate to the individual who uses or wears,
18 not only wears, but uses the wireless earpieces. Again, using could be
19 outside of the ear. And as I mentioned before, the substitute claims do not
20 recite any use of a measured user biometrics. There is no function of an
21 earpiece in the claims that depend on the measured user biometrics.

22 Moving on to slide 60. If Patent Owner's interpretation of the
23 substitute claims were to be accepted, the substitute claims would be
24 indefinite under section 112(b). It is unclear what types of user biometrics
25 fall within the claims that are appropriate for using an earpiece worn within
26 the ear. How does a POSITA determine which user biometrics are

1 appropriate for an earpiece worn within the ear versus one which is not? It
2 is unclear which types of biometrics fall within the claims that are
3 appropriate for performing associated functions which would include
4 powering down.

5 JUDGE HUME: Can you explain a little bit more about how that's
6 indefiniteness, not breadth?

7 MR. ESRAM: And now, Your Honor, you're talking about the
8 functions or whether the one or not one.

9 JUDGE HUME: Well, you say a person skilled in the art would
10 not know what's appropriate or inappropriate for a particular application.
11 Can you explain that in terms of indefiniteness?

12 MR. ESRAM: Yes, Your Honor, because for the function, for
13 example, Patent Owner points to powering down. What other functions
14 could be done using a user biometrics beyond powering down? Once again,
15 the definitions from Patent Owner's expert is very broad. You could
16 imagine all kinds of measurements being done that's related to biological,
17 physiological, chemical. And it doesn't even have to be identifying. It could
18 be any biometric that's getting measured. And I see Haixia Lin, you may
19 jump in if you need to.

20 MS. LIN: Just to build on what Trishan said, you could imagine,
21 you know, say you've got earpieces and you set them up a certain way, but
22 you share them with your partner who has different settings for them. And
23 you want the earpiece to recognize you. So, you want some kind of user
24 biometric that's used for identifying who you are. You could use a
25 fingerprint scan. It could have a camera somewhere on it and it does a facial
26 recognition and it recognizes you. That to me seems like an associated

1 function that an earpiece could have. But Patent Owner says that wouldn't
2 be an associated function. That's not the type of user biometric that's
3 contemplated by the claims. And that kind of uncertainty is why it's unclear
4 which user biometrics fall within this appropriate for associated functions
5 versus wouldn't fall within that scope.

6 JUDGE WHITE: Well, maybe the baseline question here is what
7 are you saying needs to be disclosed in order to have this all enabled? I
8 mean, what we have here that's disclosed is a system of you've got this
9 device, you've got a sensor, and you're saying that you could include any
10 variety of sensors to track biometrics. Is that sufficient disclosure? Because
11 in certain cases, the Federal Circuit has been okay with a sort of a broad
12 roadmap like that. Other times, they have not. So, I'm not going to say that
13 that's necessarily all that needs to be done. But what are you guys saying
14 needs to be done here that they didn't do?

15 MS. LIN: I think that if they really wanted to cover the entire class
16 of user biometrics, then yes, they should have disclosed more about those
17 types of biometrics, about how they could be measured, or how you create
18 sensors for them. Alternatively, when they filed their revised motion to
19 amend, they could have included limitations that narrow the scope of the
20 user biometrics that are covered. Even if they had recited how the user
21 biometrics were used for power management or saving battery life, that
22 would have narrowed the scope enough that perhaps this disclosure would
23 have been sufficiently enabling. But by opting to choose this full class of
24 user biometrics of zero restrictions whatsoever, they've now opened
25 themselves up to needing to enable a lot more than the specification actually
26 did.

1 JUDGE HUME: Well, perhaps my confusion arises to discussing
2 indefiniteness, but we keep coming back to enablement here.

3 MS. LIN: So, we raised an enablement argument, and the
4 indefiniteness has only come up in response to Patent Owner's reply,
5 because they've now, in our view, artificially narrowed the scope so that the
6 disclosure is now enabling. They've said, oh, well, don't worry about all of
7 those user biometrics that you raised that were not, you know, they don't try
8 to put an argument for why these other user biometrics are enabled. They
9 say just, they're irrelevant, ignore them. You only need to focus on user
10 biometrics that meet these requirements. They are appropriate in certain
11 ways. And, you know, if that position were to be adopted, it raises
12 indefiniteness issues because now it's unclear which user biometrics fall
13 within the scope of the claims and which don't.

14 JUDGE HUME: Okay. Thank you for that explanation.

15 MR. ESRAM: So, if we keep going, Your Honor, I think one
16 more thing we wanted to add was even Patent Owner and Patent Owner's
17 expert disagree regarding which user biometrics are covered by the
18 substitute claims, namely whether retinal scans fall within the scope. We
19 saw earlier on slide 58 that Patent Owner argued that retinal scans are
20 irrelevant. But as we saw on slide 57, Patent Owner's expert testified that
21 scanning an individual's retinal eye is a type of user biometrics in the context
22 of the '853 patent. The Patent Owner's own expert disagrees with Patent
23 Owner regarding whether retinal scans are appropriate biometric in the
24 context of the '853 patent, demonstrates that what an arbitrary and uncertain
25 claim limitation, interpretation, this is.

26 JUDGE HUME: Counselor, Judge Hume. I just wanted to let you

1 know you have about 10 minutes before you get into rebuttal time.

2 MR. ESRAM: Thank you, Your Honor. So, with that, because
3 Patent Owner's narrow claim interpretation not only has no support, but
4 would also render the claims indefinite, it should be rejected. And because
5 Patent Owner never disputes the (INAUDIBLE) of certain user biometrics
6 like, for example, retinal scanning that are not enabled by the '853
7 specification, it follows that the full scope of the substitute claims is not
8 enabled, and Patent Owner's revised motion to amend should be denied.

9 Moving on to slide 61, Your Honor, Patent Owner's revised motion
10 to amend also fails because it improperly broadens the claim scope. On
11 slide 62, we actually noted in our opposition that the limitation, the magnetic
12 field is applied by a smart case. Originally, in Claim 11 has been deleted in
13 substitute Claim 32, Patent Owner didn't add this deleted limitation
14 elsewhere in Claim 32 or in Independent Claim 31 from which Claim 32
15 depends.

16 Turning to slide 63, in its reply, Patent Owner merely states that its
17 substitute claims do not broaden the claim scope and didn't provide any
18 other explanation. Patent Owner's expert on the other hand asserts that the
19 deleted limitation is present in its base Claim 31 as we highlight here at the
20 bottom of the slide. But moving to slide 64, we can see that the deleted
21 limitation, the magnetic field is applied by a smart case, is not present in
22 Claim 31. Claim 31 recites a magnetic field that is silent about any smart
23 case. In other words, the magnetic field can be applied by something other
24 than a smart case. Because the magnetic field now is no longer limited to
25 being applied by a smart case, in either Claim 31 or 32, the scope of original
26 Claim 11 has been improperly broadened.

1 And moving to slides --

2 MS. LIN: So, why don't we reserve the rest of our time for
3 rebuttal? And I think we can end our presentation there for our opening.
4 And by the way, I've got a message that at least one person couldn't access
5 the public broadcast anymore. I don't know if that's limited to just this one
6 person or if there's been an issue.

7 JUDGE WHITE: I can send the message to our IT.

8 MR. JARRETT: Yeah, we had one of -- one of the individuals
9 from our side said the public link is no longer accessible.

10 JUDGE WHITE: Okay. Okay, so it sounds like it's a widespread
11 issue.

12 JUDGE HUME: Jamel, are you online here?

13 MR. FAVOR: Yes, I am, Judge. And I'll speak to our IT
14 personnel about it.

15 JUDGE HUME: Couldn't hear you.

16 MR. FAVOR: Yes, I am, Judge. I am online. And I'll speak to
17 our IT personnel about it. Are you still having issues hearing me?

18 JUDGE WHITE: No, I hear you.

19 MR. FAVOR: Okay. Perfect.

20 MS. LIN: Thank you.

21 JUDGE WHITE: Just to be clear, are you saying that people are
22 getting kicked off the public line or they just couldn't access it at all?

23 MR. JARRETT: Your Honor, we had one of the counsel from our
24 side, Mr. Hejny, he was on and he said the public line dropped and he can't
25 access it. So, he was able to get on, but now it dropped for him.

26 MS. LIN: That's the same experience we had on our ends and that

1 all just happened.

2 COURT REPORTER: Should I go off record now?

3 MS. LIN: It sounded like it happened pretty close to near the end
4 of our opening presentation. Yeah.

5 MR. JARRETT: A few minutes ago, Your Honor, for my
6 knowledge.

7 MS. LIN: Yeah. Oh, I think it might be working now. Let's see.

8 MR. FAVOR: Hello, hello, panel members and counsel. So, yes,
9 they said that it's fixed now.

10 MS. LIN: Okay.

11 MR. FAVOR: And that message just came through.

12 MS. LIN: Okay.

13 MR. JARRETT: Your Honor, I believe you're on mute. Sorry.

14 JUDGE HUME: Sometimes the spacebar works, sometimes it
15 doesn't. All right. So, Patent Owner, do you have -- do you wish to reserve
16 any rebuttal time?

17 MR. JARRETT: Could I reserve 20 minutes, Your Honor, please?

18 JUDGE HUME: Okay. That gives you 40 minutes for your
19 argument. Proceed when ready.

20 MR. JARRETT: May it please the Board. Your Honors, I'd like to
21 first direct to you -- good morning, Brad Jarrett, on behalf of the Patent
22 Owner, Bragi. I'd like to first direct you to slide 2 of our demonstratives.
23 This will just provide an overview of the points we intend to address with
24 our presentation.

25 So, at a high level, we'll first address the statutory and regulatory
26 requirements for substituting patent claims. We'll show that we've satisfied

1 those, namely that the substitute claims are patentable over Petitioner's prior
2 art grounds. For several reasons, particularly because Petitioners have a
3 motivation and combination problem for each of their original references in
4 combination with Aumer, it's just the product of hindsight bias, and we'll
5 show that. Also for -- we'll show that the claims, the substitute claims are
6 enabled and not indefinite as well.

7 I'd like to go to slide 8 and go quickly over some of the statutory
8 and regulatory requirements for substituting claims. If you go then to slide
9 9. So, motion to amend, as Your Honors are aware, must propose a
10 reasonable number of substitute claims that respond to a ground of
11 unpatentability involved in the trial and not enlarge the scope of the claims
12 or introduce new matter, and are not shown by a preponderance of the
13 evidence to be unpatentable. So, as for going to slide 1 and then slide 11,
14 excuse me, I have not heard any argument from Petitioner that Patent Owner
15 has not proposed a reasonable number of substitute claims for the Board's
16 preliminary guidance for our initial motion to amend. The Board recognized
17 that our one-to-one substitution ratio for challenged claims was adequate,
18 and Petitioner did not object or argue otherwise. The same is true now for
19 the revised motion to amend. There is a one-to-one ratio, one substitute
20 claim for each of the challenged claims. So, this has been satisfied and no
21 argument from the Petitioner otherwise.

22 As far as the substitute claims responding to grounds of
23 unpatentability involved in the trial, if you go to slide 13, we show here
24 where we've added the limitation regarding, as was discussed thoroughly in
25 Petitioner's presentation, the limitation regarding the biometric, the reading
26 of user biometrics, and also the, where in the portion of the earpiece fits

1 within the ear canal opening of the user. And as far as the third factor, if you
2 go to slide 14, Patent Owner substitute claims do not enlarge the scope of the
3 claims or introduce new matter.

4 Going on to slide 16. This is just an example. You see a side by
5 side here of the original claim with the substitute claim language. As far as
6 adding the biometric limitation, that does nothing but just narrow the scope
7 of the claims and specifically the limitations regarding the wireless earpieces
8 themselves. And as far as not introducing new matter, we've shown in our
9 reply brief, in our revised motion to amend as well, and through Dr. Young's
10 declaration that there is the '031, the application that became the '853 patent,
11 supports the elements of the substitute claims, namely the biometrics. If you
12 look at slide 18 this has the specific portion of the application that references
13 the biometrics and the reading of user biometrics, and it gives examples such
14 as heart rate, motion detection, sleeping, et cetera. And the other -- and now
15 if you go to slide 21, which will be the bulk of our presentation, which was
16 the bulk of the discussion of Patent -- Petitioner's presentation as well.

17 JUDGE HUME: Counselor, it's Judge Hume. Do you care to
18 address --

19 MR. JARRETT: Yes, Your Honor.

20 JUDGE HUME: -- the specific statements regarding, I think it was
21 Claim 32 being enlarged, that's the smart case being deleted?

22 MR. JARRETT: Your Honor, as far as the enlargement of that
23 claim, we rest on the reply, what we addressed in our reply brief. We don't
24 believe that it enlarges the claim. It's just an element that does not add
25 anything new to the claim specifically or enlarges it. That's just our -- that is
26 our position.

1 JUDGE HUME: Okay. We'll rely on the briefs then. Thank you.

2 MR. JARRETT: Yes, Your Honor. So, with slide 21, this will be
3 the bulk of our presentation as it was with your discussion with Petitioner.
4 The substitute claims here are patentable over Petitioner's obviousness
5 grounds.

6 And going to slide 23, this is just an overview, a summary of the
7 obviousness grounds that Petitioner has raised. From the original grounds in
8 the petition, the notable addition is obviously the Aumer reference, which
9 Petitioner is pointing to as disclosing the biometric, the reading of user
10 biometrics. Then in combination with all of the previous grounds Petitioner
11 inserted in their initial petition.

12 Going to slide 24, this is Ground 1, the combination of Brown and
13 Aumer. And for reference, a lot of the, as you're aware, Your Honors, with
14 Petitioner's opposition brief, much of the factors for the motivation to
15 combine were repeated through the different grounds. So, in reference to
16 Ground 1 for several of the motivation to combine factors, those will apply
17 for the other grounds. They're not reference specific. I just wanted to make
18 the Board aware of this before jumping into the Brown discussion of Brown
19 and Aumer.

20 And so, an overview just of Brown itself. This is an invention
21 relating to, if you look at slide 25, we've noted from the application, the
22 Brown application itself. This is an invention relating to miniature hearing
23 aids, and specifically it's looking to solve the issue of implementing a
24 reliable switch that's suitable for switching on it, small dimensions for
25 switching on and off a hearing aid device, a miniature hearing aid device.
26 And then looking at that at Aumer. Aumer is directed to wearable monitor,

1 monitoring devices for user biometrics, measuring user biometrics, and
2 specifically as in slide 26, as the title of the patent itself would indicate, it is
3 directed towards methods and apparatuses for improving the signal quality
4 in wearable biometric monitoring devices.

5 And so, going on to slide 27, these are Petitioner's factors that
6 they've analyzed -- that it's analyzed in relation to the motivation to
7 combine. Their motivation and combined argument for in this case for
8 Ground 1, Brown and Aumer, rest on these five factors and these are the
9 same five factors that they've applied to all seven of the grounds where
10 they've combined their initial prior art references and prior art grounds with
11 the newly found Aumer reference. So, the motivation to combine breaks
12 down to these five factors. Petitioner alleges that they -- that the Aumer
13 reference and the original references are in the same field of endeavor. They
14 would have resulted in predictable results for a POSITA to combine them.
15 There is increased in consumer interest in personal health that Petitioner
16 points to is alleged reason to combine these references. The POSITA's
17 knowledge, which I believe was discussed during Petitioner's presentation
18 regarding what a POSITA would or would not have known regarding the
19 implementation of biometric sensors in an earpiece, and it is not our position
20 and we've never conceded that the implementation of biometric sensors
21 within an earpiece was commonly known, commonly practiced to those of
22 skill in the art, or known to those of skill in the art. Our reply brief does not
23 state that. Our expert did not concede that. And we'll explain that in a little
24 more detail when you address factor four, then also the fifth factor
25 reasonable expectation of success in combining. So, these are the factors
26 Petitioner is pointing to.

1 And we can start with the first factor if you go to slide 28. Aumer
2 is not analogous art. It's not analogous to the '853 patent, which is a proper
3 comparison that's to be made for analogous art when considering a prior
4 reference. And it's also not analogous or in the same field of endeavor as the
5 Aumer reference. So, either way Petitioner has not shown that Aumer is
6 analogous for either analysis regarding the '853 patent or the -- in
7 combination with the -- Aumer with in combination with the references.

8 And here on slide 29, this is the legal standard regarding the
9 determination of analogous prior art or analogous art for a prior art
10 reference. The art must be in the same field of endeavor, and if not, must be
11 directed to a reasonably pertinent, rather reasonably pertinent to a particular
12 problem with which the inventor was involved. And we believe that -- it's
13 our position that Petitioner has not shown that either of these are met for
14 Aumer.

15 And also just for reference on slide 30, the comparison should be
16 made to the reference and the challenged patent. So, Aumer to the '853
17 patent Petitioner didn't make that comparison in its initial opposition. It
18 compared the Aumer reference to the prior art ground references, which
19 again, as I just mentioned a moment ago, either way, it won't work for
20 Petitioner in the motivation to combine.

21 JUDGE WHITE: So counselor, what should we make of the fact
22 that Aumer does specifically reference in ear or on the ear, it's ear adjacent,
23 whatever it is, mobile devices. So, it's not just wireless devices period, but
24 it's specifically got some wireless ear devices. Why shouldn't that be enough
25 to link Aumer?

26 MR. JARRETT: Yes, Your Honor. And to address that on part, I

1 can refer you to the next slide, slide 31. Still we would -- our position is that
2 even if it's just addressing wireless ear pieces, it's still too broad. Because in
3 this case, looking at the field of endeavor of the '853 patent, the '853 patent
4 is directed to adjusting power levels within a wireless earpiece and
5 preserving battery life. Even with the biometric limitation that's been added,
6 still the overall direction of the patent and the claims are still directed
7 towards preservation of battery life, and the Aumer reference is not in any
8 way directed to that. It's limited cabin to biometric readings. So, it's
9 incompatible essentially with the prior art grounds, the references that
10 Petitioner has asserted in its initial -- in its petition, which are all directed
11 again to battery life, changing power levels, and also charging of the case for
12 the earpieces, which are also part of the claim elements of the '853. So,
13 essentially, Aumer doesn't fit. It doesn't fit either with the '853 patent in that
14 sense, or all of the prior art grounds and references that the Petitioner has
15 asserted. It's essentially just one reference that's in isolation related to
16 improving biometric signals. That's just been essentially cobbled together, if
17 you will, with the other references that are related to power battery life,
18 battery life presentation, and charging. That is our position, Your Honor, if
19 that does answer your question.

20 JUDGE WHITE: It doesn't necessarily get me all the way there,
21 because if we look at the test, it is, it's an or. So, it's same field of endeavor
22 or really pertinent to the problem. So, if Aumer is dealing with wireless
23 earpieces, why is it that the same field of endeavor as the '853 patent?

24 MR. JARRETT: Just our position, Your Honor, is referring back
25 to slide 31, just that that's still that that's defining it too broadly. Whether it's
26 the field of endeavor, it's defined too broadly, or whether it's the reasonably

1 pertinent problem, because the problem Aumer is trying to solve is not
2 related to the problem that the '853 patent is trying to solve, which is related
3 again to battery preservation and empowering.

4 JUDGE HUME: What about slide 29? The art is from the same
5 field of endeavor, regardless of the problem addressed. Wireless earpieces
6 being the field of endeavor. What's -- I'm not catching your distinction
7 there?

8 MR. JARRETT: Just the distinction again, Your Honor, is just the
9 fact that wireless earpieces is a very broad field of endeavor that could
10 include countless things. Our position is just it's still too broad of the field
11 of endeavor, and we cited a few of the cases in our reply brief that related to
12 the field of endeavor and also the reasonably pertinent problem and it being
13 defined finding it too broadly. It's just our position that it's still too broad,
14 even wireless earpieces is still too broad in this sense.

15 JUDGE HUME: Well, perhaps you could address the problem
16 solved, the second prong of the test. Then what is the Aumer problem
17 solved is what in your view?

18 MR. JARRETT: Improving biometric signals, improving the
19 signal quality of a biometric signal for a wearable device.

20 JUDGE HUME: And what is the problem solved in the '853
21 patent claim as with the substitute claims?

22 MR. JARRETT: Well, the substitute claim is still addressed --

23 JUDGE HUME: What problem is that addition of user biometric
24 measurement. What problem does that solve in your view?

25 MR. JARRETT: Well, the overall context of the claim is still
26 related to the altering of the power modes. Claim 1 still has the power mode

1 limitations. The biometric -- the reading of the biometric signals is still just
2 in that context. Although, as Petitioner had said, and we don't dispute, there
3 is no specific claim element in the independent claim that requires, or the
4 dependent claims that require, the use of biometrics to adjust the power
5 levels themselves. It's still -- the claims are still in that context. And
6 overall, looking at the claims, it's still directed, in our view, Patent Owner's
7 view that it's still directed to the problem related to altering power modes,
8 preserving battery life.

9 JUDGE WHITE: Well, let me take you back to the language of
10 the '853 patent. When I look at the abstract of the '853, the first sentence of
11 the abstract is a system and method for managing wireless earpieces, period.
12 And then when I look at the claims -- the original claims of the '853, it says,
13 the preamble says, what is claimed as a method for managing wireless
14 earpieces. And then it talks about what that's comprising. Wouldn't those
15 things tend to indicate, to one skilled in the art, that the field of endeavor
16 here is managing wireless earpieces and it's not what you're trying to make it
17 out to be, which is this thing about battery life and such. It's just wireless
18 earpieces. Why is that not what the field of endeavor is in light of the words
19 of the patent?

20 MR. JARRETT: I still think, Your Honor, it's Patent Owner's
21 position that in the full context, even of the abstract where it still discusses
22 additional aspects of the management of wireless earpieces, that it's not just
23 at the highest level of the management of wireless earpieces, that things like
24 I said, the battery life preservation and adjusting power modes to preserve
25 battery life are a part of that field of endeavor. It's just that at that level,
26 managing wireless earpieces is too broad.

1 JUDGE WHITE: Okay.

2 MR. JARRETT: And yes, Your Honors, going to slide 33, this is
3 just a side-by-side comparison of the Aumer reference and the '853 patent,
4 which we've discussed some now in detail, and it's just, again, our position
5 that it's not analogous, not in the same field of endeavor, and not directed to
6 the pertinent problem that the inventor is trying to address with the '853 in
7 its claims. And also, for slide 34 --

8 JUDGE HUME: I'm sorry. I'm still not clear, and I know you
9 made a whack at it, but I'm still not clear as to what the problem solved by
10 the addition of the user biometric is in the claim, the revised motion to
11 amend. If we were to take you at your word that they're not the same field
12 of endeavor, then we need to address the second prong of the test. And it's
13 unclear to me what problem is being solved by the addition of the user
14 biometric measurement.

15 MR. JARRETT: Although the claim limitation itself does not
16 expressly state that it's related, that the use of biometrics, the reading of
17 biometrics is directly related or used in the adjustment of the power mode,
18 reading the claim in light of the specification, we -- Patent Owner's position
19 is it's still -- that is still the relevant problem is the battery life preservation
20 and the biometric reading fits within that, although not expressly claimed as
21 such, but reading the claims in light of the specification, that's our position
22 that the biometrics, the reading of biometrics is in that context of the claims.

23 JUDGE WHITE: So, are you trying to say that that's implicitly
24 part of the claim?

25 MR. JARRETT: Your Honor, when read in light of the
26 specification, that is our position that it would be in the context of the power

1 mode adjustments. As one of the examples, I could -- believe it was on one
2 of the slides, I think it was 18 that addresses the parts of the application that
3 are also in the specification, discussing the adjustment of the power mode
4 and one of the examples from one of the embodiments in that context, Your
5 Honor.

6 JUDGE WHITE: I think that there's clear that there are examples
7 and such in the spec that have to do with power. I think the thing that we are
8 wrestling with is the claim language itself, which has you taking this reading
9 and I think this infuses a lot more than just as part of the conversation, but it
10 infuses a lot of what we need to do with this claim, is that we take this
11 reading and then we don't do anything with it. We are sort of struggling
12 with what that means in the scope of things that we have this reading that we
13 take and that we don't use for anything in particular. And I think that that
14 colors how we're going to look at everything. So, I want you to explain to
15 me what is the import in the express claim language of this reading and what
16 does that mean. What are we really doing here? We take this reading and
17 then what? Nothing? I think that's where a lot of our struggle comes from.

18 MR. JARRETT: Yes, Your Honor, in the express claim language,
19 we would agree there's not an express limitation or element of the claim in
20 which the biometric is being used. But again, it's our understanding of just
21 reading in light of the specification that it is related to earpieces which are
22 involved with the alteration of the power mode. It's in that context, but you
23 are correct, Your Honor, there's no express limitation in the independent
24 claim. The one we examined, I believe it was substitute claim 22, the first
25 independent claim that says in the express limitation that it's used
26 specifically for the purpose of adjusting the power mode, for example.

1 JUDGE HUME: So, are you asking us to do claim construction
2 here where we're importing limitations from the spec into the claim? Is that
3 what you're asking?

4 MR. JARRETT: Just, Your Honor, my understanding would be
5 just reading the claim in its full context and giving the terms their plain and
6 ordinary meaning in light of the specification. That will be our
7 understanding of how the limitation would be understood and read.

8 JUDGE WHITE: I think maybe that will help us. What claim
9 terms, is there a slide that's got your claim language?

10 MR. JARRETT: Yes, Your Honor. I believe it is slide, give me
11 one moment. Slide 7, Your Honor. That is the independent claim.

12 JUDGE WHITE: The revised language?

13 MR. JARRETT: Yes, Your Honor. And that adds --

14 JUDGE WHITE: All right. So, looking at slide 7, looking at this
15 Claim 22, you're saying that sort of in the ether when you read the spec,
16 that's part of your understanding, it has to do with some power. What
17 terminology, where is the hook in the spec, I mean in the claim language,
18 whether it be in the new or the old, that would bring this all together for me?
19 What am I reading here that's like, yes, that's why the biometric is here? Is
20 there something that needs to be construed somewhere that would get you
21 there?

22 MR. JARRETT: Yes, Your Honor. The configure to read user
23 biometrics and then going back to slide 18 in reference to this specification
24 in that context, where there's the reference to the reading of the user
25 biometrics, and then one of the embodiments gives the example of how it's
26 used. That would be what I can point you to in the specification that would

1 shed some light on the meaning of that -- the reading the user biometrics in
2 the claim itself.

3 JUDGE WHITE: So, we're supposed to say that one of ordinary
4 skill in the art would read this configured to read language as meaning --
5 dealing with power alteration? I'm getting kind of lost here.

6 MR. JARRETT: In the context of the specification, yes, Your
7 Honor, that's what our understanding -- the plain and ordinary meaning of
8 the claim term in its context of the claim and in the context of the
9 specification.

10 JUDGE HUME: Well, how does the Rass reference, and I know
11 it's not applied in a challenge, but if we were to do that, Rass seems to
12 control power based on user biometrics.

13 MR. JARRETT: Your Honor, if I could go to slide -- take you to
14 slide 42. This is -- or even going back one to even slide 40, sorry. And this
15 is where Petitioner made the argument that it was known in the art that
16 biometrics could be used to switch on or off a wireless earpiece. And then
17 going again to the next slide 41, where there's this specific portion of Rass
18 there that's been cited by Petitioner in their opposition brief, where it
19 discusses temperature sensor. And then going to slide 42, to add
20 clarification, there's no disclosure in Rass of biometrics. The temperature
21 sensor is not specific to body heat, it just says heat, heating up. Our expert,
22 Dr. Yong, points that out in his declaration, I believe it's paragraphs 68 and
23 69 of Exhibit 2007. Also with our reply brief, we address this in pages 5 and
24 6, where we're discussing Rass. And essentially, I think it's telling, Your
25 Honor, that Rass doesn't control for the simple fact that Petitioner hasn't
26 included in any of its grounds.

1 JUDGE HUME: I'm looking at the abstract, I understand your
2 point about it's not in a challenge, but I'm looking at the abstract of Rass,
3 talks about it's fitted with a temperature sensor to detect the body heat of the
4 hearing aid wearer, and therefore that the hearing aid is inserted in the
5 auditory canal, and the hearing aid is then switched on and off again based
6 on the temperature signal. Body heat when it's in the ear canal sounds pretty
7 close.

8 MR. JARRETT: As far as the in the abstract, but in in practicality,
9 Your Honor, reading a description of the invention there's nothing limiting
10 in this sense that there's no description of how Rass would limit the
11 detection of heat to biometrics, and I think that's the reason, I'm just
12 surmising that's the reason why Petitioner has not included it in any of its
13 grounds because if it were in fact disclosing biometrics to adjust power
14 modes, it's frankly it'd be more on point than Aumer is. So, essentially Rass
15 doesn't work because of the lack of biometrics. So, essentially Petitioner is
16 now trying to use it as a bridge between Aumer and the other grounds to
17 form some kind of motivation to combine.

18 JUDGE HUME: Is your point that Rass doesn't use the word
19 biometric when describing the temperature in the ear canal?

20 MR. JARRETT: Well, not just that, Your Honor. I think the
21 larger point is in the description of the invention when it just discusses the
22 temperature sensor to heat. It's not specific that just the biometric -- the
23 biometric or the body heat of the user is the only thing that could be heated.

24 JUDGE HUME: I'm looking at column 2 -- oh, go ahead. Sorry.

25 JUDGE WHITE: Does Rass need to do that for what Petitioner is
26 attempting to use Rass for? Does Rass need to be only about biometrics or

1 is it enough that it encompasses biometrics? Because I think you will have a
2 rough time saying that it wouldn't encompass biometrics and isn't that
3 enough for what Petitioner is using it for, which is just one of ordinary skill
4 in the art would have known that this was out there in the ether. They're not
5 using this in their ground. It's just sort of one of ordinary skill in the art
6 knows these things. Don't we get enough from Rass to be able to say that?

7 MR. JARRETT: Potentially at a minimum, Your Honor. But I
8 would also say just because the fact that Rass and the potential use of body
9 heat, for example, could adjust the power mode of an earpiece doesn't get
10 Petitioner to a motivation to combine. Just the fact that it's a known element
11 independent of the other grounds that contain potentially known elements, it
12 still doesn't bridge the gap for the motivation to combine in our opinion.

13 JUDGE HUME: Yeah, I'm reading from column 2, line 64, 63 of
14 the Rass reference. Figure 1 shows a schematic diagram of an in-ear hearing
15 aid. It has a temperature sensor TS when worn, the hearing aid 1 or its shell
16 heats up. The temperature sensor registers this heat once a certain
17 temperature threshold is exceeded, the device is switched on. If the
18 temperature drops back to below as lower temperature threshold, the hearing
19 aid 1 switches off again. I know it's pretty specific to being in ear and
20 measuring the temperature of the ear is reflected by the temperature of the
21 shell of the hearing device. Maybe we've beat up Rass too much here a little
22 bit. But go back to, is it -- are you asking us to do claim construction to
23 import limitations into the claim that aren't there? Because your argument
24 seemed to hinge on power control aspects, which are not claimed.

25 MR. JARRETT: As far as the novelty aspect or the purpose, I
26 guess, taking it back to the purpose of, for the problem that the '853 is

1 directed to with then the addition of the biometric reading limitation, it still
2 would be our position that it would be in the context of the overall claim of
3 regarding power control, not express in the limitation itself but still in that
4 context of the claim. And that's not necessarily, in my view, not necessarily
5 a matter of necessarily the claim construction, but more of an issue of
6 looking at the field of endeavor and the pertinent problem analysis and more
7 from the context of the motivation to combine rather than specifically
8 importing a limitation from the specification, if that makes sense, Your
9 Honor.

10 JUDGE HUME: I understand your argument.

11 MR. JARRETT: Yes, Your Honor. And so, for the remaining
12 factors that we did not address for the motivation to combine that Petitioner
13 has raised, the yielding of predictable results, slide 38 there, the lack of a
14 motivation to combine, which is, in our opinion, there is none to combine
15 Aumer and Brown. If there's no motivation to combine the two references,
16 then it's our position that it would not be, the combination would yield
17 predictable results. I believe that, sorry, I believe that was slide 36. My
18 apologies.

19 JUDGE HUME: Right. Counselor, you have about 10 minutes
20 before you're into your rebuttal time.

21 MR. JARRETT: Okay. Yes, Your Honor. And for the remainder
22 of the Grounds 2 through 7, we have addressed the differences between the
23 Aumer and the references themselves in relation to the field of endeavor,
24 that's been addressed in our reply and also in conjunction with Dr. Young's
25 declaration on those points. But the arguments regarding the remainder of
26 the factors for Petitioner's motivation to combine are common from what

1 we've addressed in Brown versus Aumer.

2 I'd like to then go to the enablement. Petitioner's enablement
3 arguments and address those. Starting with slide 57 and then going to slide
4 58. So, as far as enablement, Your Honors, the legal standard is the
5 specification of the patent must teach a POSITA how to make and use the
6 full scope of the claimed invention without undue experimentation. And so,
7 when the patent specification is a broad disclosure, it's not required to
8 disclose every single embodiment. Generally, the Federal Circuit's held that
9 a genus that's representative, or a few examples that are representative of the
10 genus are sufficient. And in looking at how to determine whether there is
11 undue experimentation, going to the Wands factors, which Petitioner did not
12 address in its initial presentation, which I think is illuminating and helpful
13 for some of the discussion about the scope of what biometrics are relevant
14 for determining whether the claims are enabled. And the Wands factors, the
15 eight different factors, address these head-on, essentially.

16 So, if you go to slide 60, the first four factors, we have the breadth
17 of the claims, the nature of the claims, the presence or absence of working
18 examples, and the state of the prior art. So, the nature of the claims, again,
19 going back to the fact that there's the reading of biometrics in the context of
20 an earpiece and the power control and power adjustment and battery life.
21 And Petitioner in the initial presentation was suggesting that we have taken
22 the claims and arbitrarily narrowed what biometrics is or what it entails.

23 But looking at the nature of the claims which Wands directs us to
24 do, the Federal Circuit has directed us in Wands, the breadth of the claims,
25 the nature of the claims are relevant to determining whether they're enabled.
26 And looking at a wireless earpiece, as Your Honors alluded to or discussed

1 with Petitioner, there is some question whether it would make sense for a
2 retina-activated or retina-controlled earpiece to exist or for a POSITA to
3 understand that that would be something that they would be expected or
4 should expect to have to use as far as user biometrics. It just doesn't make
5 sense in the nature of the claims for a wireless earpiece to have an earpiece
6 activated by a retina scan, a facial recognition. I've come across many
7 earpieces, used many earpieces, looked at many earpieces. I've never seen
8 one that does a retina scan, a facial recognition scan, either based on the size
9 of an earpiece, a wireless earpiece, or other complications or the utility of
10 that technology. It just doesn't make sense. And that was our position in the
11 reply.

12 JUDGE WHITE: All right. Counsel.

13 MR. JARRETT: Yes, Your Honor.

14 JUDGE WHITE: Let me jump into this one with you because you
15 want us to go back to the spec to get this power idea. But if I go back to the
16 spec as far as biometrics, I've got -- there was a portion of column 3 that my
17 colleague pointed out where you're talking about artificial organs, contact
18 lenses, bone implants. I mean, you're talking about this device touching on
19 all sorts of things. So, if you've got something that's -- if we've got to go
20 back to the spec for the power management, don't we have to go back to the
21 spec and see all this bit in here about endoscopic pills, pacemakers, tracking
22 devices, contact lenses, oral implants, bone implants, artificial organs. If
23 we're talking about all of this in the context of a biometric, then don't we
24 have to enable you to be able to do a wide variety of different things other
25 than just temperature? Don't we have to have a whole lot more detail if
26 we've got to be dipping back to the spec to find this out?

1 MR. JARRETT: The examples, Your Honor, the examples we've
2 cited in the specification relating to its heartbeat, temperature. Sorry, Your
3 Honor, if you wouldn't mind what -- I'm looking at column 3 to address your
4 question.

5 JUDGE WHITE: Column 3, starting at line about 11, the wireless
6 device may represent something that can be ingested or implanted, and then
7 the smart case may be configured to work with an endoscopic pill, a
8 pacemaker, tracking device, contact lenses, oral implants, bone implants,
9 artificial organs, or so forth. The smart case may act as a logging tool for
10 receiving information data, or measurements made by the wireless device.
11 For example, the smart case may be attached to a belt or worn by a user to
12 download data from a wireless device in real time. So, we're getting
13 readings looking at this particular paragraph that could be all over the place,
14 and it's doing more than just a simple temperature sensor. Have we enabled
15 all of this if that's what we've got to get to?

16 MR. JARRETT: Your Honor, for this specific embodiment, I
17 believe it's the references to those different biometric, I guess you could say,
18 biometric techniques. Those are relating to the smart case itself, which we
19 have not claimed any biometrics specifically related to the smart case. So, I
20 would agree if we had claimed biometrics related to the smart case itself or
21 working with the smart case, that that could open the door potentially to
22 some of these other options here. But specifically, since we are limiting
23 them to the earpiece, I think based on what we've looked at in this
24 specification, what we've cited relating to the temperature readings, the
25 heartbeat sensing, that makes more sense in the context of an earpiece. And
26 those are things that a POSITA and Dr. Young has opined that a POSITA

1 would understand how to do. So, I think the distinction here would be the
2 smart case. For example, it could be a larger item that could open up
3 opportunities for some of these, and also just the ability to communicate
4 between the smart case and, for example, an endoscopic pill, a pacemaker, a
5 contact lens, an oral implant. I think it just opens the door for more
6 biometric options.

7 JUDGE WHITE: I think that's insight to the issue is that the door
8 is open for a wide variety of biometrics. And my understanding of the spec
9 is that the way the smart case works is it's getting the readings of these
10 biometrics from the wireless device, and then it may be doing whatever it's
11 doing. But the readings are all coming from the wireless device, not from
12 the smart case itself.

13 JUDGE HUME: Counselor, you're at 40 minutes. But I would
14 point out that same column says, in another embodiment, the wireless
15 earpieces may represent a wireless devices and may be implanted, et cetera.
16 So, we can think about that. And then, as Judge White just indicated, the
17 data is coming from the earpiece or the representative earpiece, which may
18 represent wireless devices that may be ingested. So, the smart case isn't --
19 it's just logging. It says it's a logging tool for receiving information. But
20 we'll preserve your 10 minutes of -- or your 20 minutes of rebuttal time for
21 that.

22 MR. JARRETT: Thank you, Your Honor.

23 JUDGE HUME: Yeah, I believe you have about 26 -- Petitioner,
24 you have 26 minutes left. And my colleagues can confirm that.

25 JUDGE WHITE: Yes.

26 JUDGE HUME: You can proceed.

1 MR. ESRAM: Thank you, Your Honors. Patent Owner's counsel
2 just made a comment about Patent Owner never conceded that wireless
3 earpieces configured through to read the user biometrics were commonly
4 known or practiced. I would like to turn your attention to Petitioner's slide
5 44. That includes two excerpts from Patent Owner's reply. In the very first
6 one on top, Patent Owner concedes actually that techniques to read user
7 biometrics that would be implemented in an earpiece such as heartbeat and
8 temperature were known in the art and within the skill level of a POSITA.
9 So, clearly Patent Owner concedes that and it is in the prior art and we see it
10 in Rass, and that's the second piece down in the slide 44 when Patent Owner
11 actually is describing Rass and doesn't dispute that Rass discloses an ability
12 to power up and down a hearing aid based on temperature, and I think Your
13 Honors and counsel for Patent Owner discussed this at length.

14 Talking about Rass, we did object to slide 42 from Patent Owner,
15 the two red bullet points are new arguments that Patent Owner never made
16 anywhere in any briefing for this IPR. So, we wanted to make that clear.
17 But even then, Your Honor, I think it is clear that Rass clearly describes
18 using temperature, and there is no dispute that the temperature is of a user.
19 And that's a user biometric and it talks about (INDISCERNIBLE) long
20 enough.

21 JUDGE HUME: Counselor, Judge Hume here. Just so we have a
22 clear record, you're relying upon Rass as providing indication of what is
23 known to a person of skill in the art? Is that the purpose of Rass, in your
24 view, and not directed to any specific claim limitation? I think we've been
25 over this before, but just wanted to make sure we had a clear record.

26 MR. ESRAM: That is correct, Your Honor.

1 JUDGE HUME: All right, thank you.

2 MS. LIN: Yes, that's correct. It's not to -- it's for what a person of
3 ordinary skill in the art would know. It provides a motivation to take the
4 teachings from Aumer and to combine them with the teachings of the
5 primary prior art references from the petition. That's correct.

6 MR. ESRAM: Also, Your Honor, we wanted to direct you to
7 Exhibit 1027, which is the transcript, the cross-examination deposition of
8 Dr. Young, where Dr. Young at page 17, line 14 through 6, page 17, line 14
9 through page 18, line 6 talks about how a POSITA would have known how
10 to configure an earpiece to read the temperature of a user, for example, by
11 having a temperature sensor built as part of that device to monitor body
12 temperature or skin temperature, which is exactly what Rass discloses.

13 JUDGE HUME: Can you repeat that citation again?

14 MR. ESRAM: Yes, Your Honor. And the citation is Exhibit 1027,
15 starting at page 17, line 14 through page 18, line 6. And, Your Honor,
16 unless you're still looking at that site, the other point we wanted to make was
17 that Patent Owner's field of endeavor arguments are inconsistent with their
18 substitute claims. And I think Your Honors can see that and how they are
19 arguing non-obviousness also is very inconsistent with their arguments. On
20 one side, they are not disputing that the original claims are known in the art
21 and the original claims were directed to the power management. But now
22 they are focusing the substitute claims on the feature that has to do with user
23 biometrics. And then their field of endeavor arguments are not -- are still
24 looking back at the power management. So, all that is creating a lot of
25 inconsistency in their arguments. And I think the case law for the field of
26 endeavor doesn't look at how the patent itself describes the field of

1 invention, but looking at all the embodiments and the claimed invention.
2 And I think Your Honor kept looking at the substitute claim, which was the
3 right thing to do. And the fact that now Patent Owner is focusing on this
4 very specific point of novelty, which is the reading of a user biometrics, is
5 the right thing to do.

6 JUDGE WHITE: Could I get into something that we brought up
7 but I don't feel was completely answered and that's on the enablement
8 question. I think that there is a discussion going on as far as what needed to
9 have been disclosed and all I feel like I'm hearing from your side is more.
10 More needed to be said, well how much more? What is it that they did that
11 was inadequate in itself because they did mention more than just
12 temperature? They've got heart rate monitors. Yes, you brought up a couple
13 esoteric ones that, you know, it doesn't have a DNA -- was it a DNA,
14 something about DNA, I don't remember.

15 MR. ESRAM: DNA sequencing.

16 JUDGE WHITE: DNA sequencing, and maybe that one isn't
17 specifically mentioned but there is allowed to be a certain amount of
18 experimentation to include something. Why is it that what they've done here
19 isn't enough? What did they need to do here, other than just saying more?
20 Because you can always come up with something that they didn't include,
21 because even if they'd include DNA sequencing, you can say, well, they
22 didn't include a retina scanner. I mean, there's always some other individual
23 thing you can name. They would never be able to name every single
24 possible permutation, and that's not what's required. What's required is that
25 they've done enough. And what is the line here between what they've done
26 and what would be enough? Why is what they've done here not enough?

1 MS. LIN: So, I'll take this one. So, if you think about what
2 they've decided to claim, and it's any, I think, what did their experts say?
3 Physiological, chemical, or biological characteristic of a user. And their
4 enablement for that rests on two of those, heartbeat, and temperature. And I
5 understand your question. I think if they had talked more about the wide
6 variety of user biometrics, where you could have put those sensors, what
7 sensors could have been included? If they wanted to cover the full gamut,
8 they could have said the biometrics that you hold here, biometrics that you
9 use if you're a smart case. If you're going to be using your smart case with
10 various implants or whatever, they could have talked about what sensors are
11 you using? What biometrics are you measuring? There's just -- I understand
12 that it's hard to talk about what they could have. And it's hard to put myself
13 in the position of an inventor who was going after the entire full class of user
14 biometrics. But the reality is there's any physical, physiological, chemical,
15 or biological characteristic, and then there's the two that they disclosed with
16 nothing more. If they wanted to limit these user biometrics in some kind of
17 way to be related to power management, it should be in the claims.

18 And if you don't have any more questions about that, I did want to
19 just elaborate on what my co-counsel was saying about the inconsistencies.
20 Their field of endeavor argument and their reasonably pertinent argument
21 really rests on painting the '853 patent as being about power management for
22 these wireless earpieces. But in the broader context, their entire non-
23 obviousness argument rests on a limitation that has nothing to do with power
24 management. There is no requirement that these user biometrics have
25 anything to do with power management or battery life or adjusting the
26 power. They can't on the one hand say, well, I'm not going to argue any of

1 these power management features. I'm just going to argue on reading user
2 biometrics, but then say, but you can only look at art about power
3 management. There's an inconsistency there that they shouldn't be allowed
4 to argue.

5 JUDGE HUME: Thank you. You have about 15 minutes left on
6 your rebuttal, Petitioner.

7 MR. ESRAM: Your Honors, I think we don't have anything else
8 that we wanted to rebut at this point. Thank you.

9 JUDGE HUME: Counsel for Patent Owner, you have a 20-minute
10 rebuttal. Please proceed when ready.

11 MR. JARRETT: Yes, Your Honor. I'd like to first address a point
12 that Petitioner raised about their slide 44 and what Patent Owner has
13 admitted or has not admitted or has conceded or has not conceded. Looking
14 at this slide and reading it, techniques to read, for example, the predictability
15 or unpredictability of the art in reference to the Wands factors, techniques to
16 read biometrics that would be implemented in an earpiece, such as heartbeat
17 or temperature, were known in the art and within the skill level of a POSITA
18 to implement as of the priority date. We're not disputing that a POSITA
19 physically could have the knowledge to implement a sensor of, or some kind
20 of wire sensor inside of an earpiece. It goes more to the motivation to
21 combine, is what our argument has been. And the idea that it was very well
22 known, which is what Petitioner has asserted, we dispute that. They've
23 pointed to one reference, Rass, which is not even included in one of their
24 prior art grounds. So, that is our response to slide 44.

25 JUDGE HUME: Well, what do you mean then in techniques to
26 read biometrics that would be implemented in an earpiece such as heartbeat

1 or temperature were known in the art and within the skill level? What did
2 you mean by that? I assume they're quoting something you submitted.

3 MR. JARRETT: Yeah.

4 JUDGE HUME: You said it's in reference to the Wands factors,
5 but is that the only context we should consider that statement?

6 MR. JARRETT: It was in recognition of the fact that someone had
7 the knowledge to be able to do this. It's just a matter of not having the
8 motivation to combine it with the grounds and the references that Petitioner
9 has set forth. We never said that, again, slide 44 says what it says. We
10 didn't say that it was so well known. We were just conceding that they
11 pointed to one example, and even that example doesn't specifically limit or
12 specifically cabin temperature sensing to biometrics or tie it to biometrics,
13 which is -- my understanding why Petitioner would not have included Rass
14 as one of its prior art references and grounds, because Petitioner understands
15 there's a problem, it needs to bridge the gap between Aumer and its other
16 references, and those -- to bridge that gap, it has to try to fit Rass into that
17 gap without expressed disclosure of biometrics, which Rass doesn't
18 expressly limit its power control to biometrics. And we didn't concede that
19 the biometrics or the heartbeat or temperature were specifically related to
20 power control. We said it was just known in the art that a POSITA would
21 know how to implement a sensor into a small electronic device, whether it's
22 an earpiece, whether it's a smartphone, something that --

23 JUDGE HUME: Isn't that all the claim requires that it be
24 implemented?

25 MR. JARRETT: It requires, yes, to the ability to read a biometric,
26 but again, whether a POSITA would have been motivated to do it is a

1 different question than whether it was just known or not. And Petitioner has
2 not bridged the gap to show that there was a motivation to combine Aumer
3 with the grounds that it has asserted in its petition. There's a gap between
4 just a biometric sensor standing alone versus power control, remote
5 charging. There's a gap between those two, and the attempt to just plug Rass
6 in that gap without any reason why a Petitioner would look to a third
7 reference that's not included, a third patent's not included in any of its
8 grounds to try to bridge the gap between its cited reference in Aumer and its
9 other grounds just doesn't make sense. It's trying to bridge a gap without
10 any justification, really. There's no reason to now plug Aumer in. At some
11 point, most inventions are based on building blocks of known things in the
12 art. That's why the Federal Circuit's instructed that motivation to combine
13 has to be more than just two things that are known. There has to be a reason
14 to combine them, and there's nothing in Aumer, nothing in the prior art, none
15 of Petitioner's examples, such as customers' desire to have health sensors in
16 small electronic devices that would motivate a POSITA to bridge the gap
17 and combine Aumer with the other grounds, the initial grounds in
18 Petitioner's petition. And Rass doesn't bridge that gap either. It fails. That's
19 our position.

20 And getting back to exactly what we were discussing here, that's
21 essentially what we were getting at. We weren't saying that there's a
22 motivation to combine. We were saying that a POSITA could physically put
23 a small electronic sensor into a small, whether it was a smartphone, an
24 earpiece, a small electronic device, but that still doesn't mean that there's a
25 motivation to combine. Petitioner, frankly, has not shown that. Other than
26 saying something was known, it's pointing to a known element, known

1 element, but no reason to combine the two. No reason to take the Aumer
2 reference, which is specifically related to biometric signals, and combine it
3 with the ground, such as Brown, and hearing aids that deal with power
4 control and a switch. The only reason to combine them is taking the '853
5 and working backwards. That's the only reason to combine the two. It's
6 hindsight. So, that's our position on the motivation to combine.

7 And just to address, I've --

8 JUDGE HUME: Counselor, on that point, do you make the
9 hindsight argument in any of your briefs?

10 MR. JARRETT: If we didn't state the word hindsight explicitly,
11 the implication would be that there would be no motivation to combine
12 based on what Petitioner has presented. So, either there's no motivation to
13 combine on the front end, and the only thing that they've looked to is
14 working backwards from the claims.

15 But briefly, Your Honors, I just wanted to address one last point
16 that Judge White had raised.

17 JUDGE WORMMEESTER: Counsel, I just have one question,
18 sorry. If Rass specifically says that it uses the temperature to turn the
19 hearing aid on or off, or automatically switches on and off, how is that
20 hindsight? Because Rass is telling you why you would use it. You know,
21 Petitioner is not coming up with it, Rass is telling a POSITA about it.

22 MR. JARRETT: But Rass is, Your Honor, Rass is not one of the
23 grounds that Petitioner has raised. The ground is Aumer. And going from
24 Rass to Aumer is actually going backwards in a way. It doesn't make sense
25 to look at Rass and then go to Aumer to then combine Aumer with the
26 original grounds.

1 JUDGE WORMMEESTER: Well, I don't think Petitioner is using
2 Rass, like you said, as part of the ground. Petitioner is using Rass to show
3 what a POSITA would have known. So, if they already know that you can
4 use biometrics or temperature sensing to turn things on and off, isn't that the
5 motivation? Well, we've got a temperature sensing biometric signal here,
6 and then we've got a hearing aid here. Why wouldn't they use that knowing,
7 already knowing through Rass, Rass being the evidence that they know, why
8 wouldn't they?

9 MR. JARRETT: Yes, Your Honor. Looking at Rass, Rass is,
10 again, not expressly limited in any way to biometrics. The heating, while
11 there's the figure disclosure shows an in-ear earpiece, it doesn't expressly
12 limit the temperature sensing to biometrics specifically.

13 JUDGE WORMMEESTER: Does it encompass it? Does it
14 encompass it? I thought Judge Hume said there was somewhere in the
15 patent that says --

16 JUDGE HUME: Measuring ear canals.

17 JUDGE WORMMEESTER: -- actually measuring the body
18 temperature. So, in your view it has to only be used for that purpose? It
19 can't -- it has to be limited to biometrics in Rass? Is that your position?

20 MR. JARRETT: I think that would make sense, and that's
21 probably the reason why Petitioner did not use Rass as one of its references,
22 because I think it's telling. I think if Petitioner believed that it disclosed
23 biometric temperature control, that it would have been one of the prior art
24 grounds that they would have asserted.

25 JUDGE WORMMEESTER: Well, we don't know why. I mean
26 but there's no tie, and I don't know that they needed to use it because the

1 claim language doesn't require it.

2 MR. JARRETT: Again, I just would disagree with Petitioner's
3 contention that it's expressly disclosing or limiting to the use of a biometric
4 sensor for an inner ear piece. And again, there has to be a jump between --
5 we're combining Aumer and combining the grounds, and I just don't think
6 Rass fills that gap based on what the teachings of Aumer are, and then what
7 the teachings of the grounds are specifically because the grounds also
8 include more than just -- the grounds they've raised include more relating to
9 the charging, relating to the case, not specifically.

10 JUDGE WORMMEESTER: Okay, thank you.

11 JUDGE HUME: So, you've indicated the motivation is deficient to
12 combine Aumer with these other references. And so, for purposes of this
13 question, let's assume that Aumer passes at least one of the analogous art
14 tests. Just -- I'm not saying that we've come to that conclusion, but let's
15 assume it does. One of their arguments, Petitioner's argument is increased
16 consumer interest in personal health and advances in miniaturizing sensors
17 and talking about a variety of personal health monitoring devices. This is
18 coming from Petitioner's opposition to Patent Owner's revised motion to
19 amend, pages 7 and 8. It talks about consumer interest in miniaturizing
20 devices and biometric tracking, and then that Aumer explicitly discloses if
21 the ear is an ideal location for wearable health and environmental monitors.
22 And so, their motivation in this case to implement (INDISCERNIBLE) in
23 this case, Brown's hearing aid to include one or more sensors, a processor,
24 and a communication component is taught by Aumer to read and provide
25 user biometrics to consumers, allowing them to monitor their personal
26 health. You haven't specifically addressed that particular aspect of their

1 motivational argument. Would you care to do so now?

2 MR. JARRETT: Yes. And with respect to using Brown as the
3 example, Brown, again, is limited, very limited in scope of what it's trying to
4 do, what the problem is trying to solve relating to hearing aids. The hearing
5 aid specifically for and directed towards --

6 JUDGE HUME: Well, let's -- so, it sounds like you're going back
7 to an analogous art argument. Maybe. I apologize if I misheard what you're
8 trying to say. Why wouldn't a person with skill in the art be motivated to
9 incorporate these miniaturized sensors into an earpiece given the current
10 commercial -- I'm not saying commercial success, that's probably a bad
11 choice of words -- interest to consumer interest in personal health monitoring
12 devices. Why is that not a viable motivation?

13 MR. JARRETT: Even considering if Brown were, for the
14 purposes of this example, analogous art, it still relates -- we still have to look
15 at what Brown is addressing the problems it's solving. Hearing aid,
16 empowering a hearing aid, it seems like a stretch to go from there just to
17 implement a consumer's desire for monitoring health. They just don't seem
18 compatible or seem related. Perhaps I'm going back to the analogous
19 argument, if I am, I apologize, but that's just my understanding, thinking
20 through, still, even if the art is analogous, we still have to look at what the
21 claims are directed to and what the patent is directed to. I still think there's a
22 gap between there with looking at an on-off switch, which is what Brown is
23 really specifically targeting to improve that. It's very specific in its
24 description of what is trying to be solved with the invention. I still think we
25 have to look at that, and that's part of the analysis. And I think looking
26 between that and biometrics, there's still a gap there. So, I apologize if I'm

1 going back to the analogous art argument, that's just my understanding.
2 Even if it is analogous, we still have to consider those. Those are still
3 considerations.

4 JUDGE HUME: If you do go back to the analogous art, you're
5 still stuck with the field to endeavor. You said that it only has to satisfy one,
6 right?

7 MR. JARRETT: And again, our position would be the field of
8 endeavor is not so broad as to encompass any wireless ear device.

9 JUDGE HUME: Well, I guess this is kind of new to me that
10 Brown is not analogous to your claimed invention.

11 MR. JARRETT: Oh, I was in reference to -- I was in reference to
12 Aumer with referring back and comparing Aumer and Brown. My
13 apologies, Your Honor.

14 JUDGE HUME: You have about five minutes left.

15 MR. JARRETT: Yes, Your Honors. I just wanted to make one
16 last point. It was in relation to the enablement discussion that Judge White, I
17 believe, had posed a question, or had pointed to the specification right before
18 my time expired. I just wanted to briefly go back and address a few points
19 that may be helpful.

20 Looking at column 3, I know starting with line 11 there with the
21 other embodiment, I know we were discussing in relation to the smart case.
22 And our position was just that this example here goes beyond just what's
23 disclosed as far as being the biometrics that would be collected or read by
24 the earpiece itself, just the fact that there's the endoscopic pill and
25 pacemaker tracking device, contact lenses, those would be our understanding
26 is those would be items that would be communicating with the case, and

1 exclusive of the earpiece. That was just a distinction I wanted to raise from
2 our position. But pending Your Honors, if you have any other questions, I
3 cede the rest of my time.

4 JUDGE HUME: Thank you. Okay. Thank you all for appearing
5 today and for answering our questions. Do either of the other Judges on the
6 panel have any further questions?

7 JUDGE WHITE: Nothing from the panel.

8 JUDGE HUME: Okay. I'd like to thank our LEAP practitioner for
9 appearing today to participate in the oral hearing. PTAB benefits from your
10 participation. So, we're very appreciative to you for your willingness to take
11 part, and to your law firm and client for allowing you this opportunity. We
12 hope you gain valuable experience from your participation today.

13 We'll take this case under advisement and issue our decision in due
14 course. We'll now go off the record.

15 COURT REPORTER: All right. We're going off record. The
16 time is 12:11 p.m. Eastern Standard.

17 (Whereupon the above-entitled matter went off the record at 12:11
18 p.m.)

PETITIONER:

Haixia Lin
Brian Lambson
Trishan Efram
WILMER CUTLER PICKERING HALE AND DORR LLP
haixia.lin@wilmerhale.com
brian.lambson@wilmerhale.com
trishan.esram@wilmerhale.com

PATENT OWNER:

Richard Kamprath
Casey Shomaker
Scott Hejny
Bradley Jarrett
MCKOOL SMITH, P.C
rkamprath@mckoolsmith.com
cshomaker@mckoolsmith.com
shejny@mckoolsmith.com
bjarrett@McKoolSmith.com