

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.,
Petitioner,

v.

CAPSA SOLUTIONS LLC,
Patent Owner.

IPR2023-01274 (Patent 7,594,668 B2)
IPR2023-01275 (Patent 8,215,650 B2)

Record of Oral Hearing
Held: December 6, 2024

Before BART A. GERSTENBLITH, MATTHEW S. MEYERS, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

IPR2023-01274 (Patent 7,594,668 B2)

IPR2023-01275 (Patent 8,215,650 B2)

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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ON BEHALF OF THE PATENT OWNER:

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The above-entitled matter came on for hearing on Friday, December 6, 2024, commencing at 10:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

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

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3 JUDGE PESLAK: Welcome to the Patent Trial and Appeal Board.
4 We're now on the record. This is the consolidated oral hearing for IPR2023-
5 01274 and IPR2023-01275. Howard Industries, Inc. versus CAPSA
6 Solutions, LLC. I'm Judge Peslak. I'm joined by Judge Gerstenblith and
7 Judge Meyers. As stated in our hearing order, this is an oral video hearing.
8 We'll start with appearances. Counsel for Petitioner, please state your name
9 and firm affiliation for the record.

10 MR. JORDAN: Good morning, Your Honor. I'm Daniel Jordan,
11 counsel for Petitioner, Howard Industries, Inc. I'm joined today by my
12 colleagues, Michael Young and John Mulcahy.

13 JUDGE PESLAK: I know we have a LEAP. We approved the LEAP
14 request for you. Mr. Jordan, are you going to present the entire argument?

15 MR. JORDAN: Yes, Your Honor.

16 JUDGE PESLAK: Okay, thank you. Have there been any changes in
17 Petitioners real parties in interest since the last time you filed mandatory
18 notices?

19 MR. JORDAN: No, Your Honor.

20 JUDGE PESLAK: Okay, thank you. Patent Owner, would you
21 please state your name and firm affiliation for the record.

22 MR. STANLEY: Hello. Jeffrey Stanley. And with me is my partner,
23 James Kwak. And we represent CAPSA Solutions, LLC. And today, Mr.
24 Kwak will be giving our presentation.

25 JUDGE PESLAK: Has there been any changes in Patent Owner's
26 real parties in interest since the last time you filed mandatory notices?

1 MR. STANLEY: No, Your Honor.

2 JUDGE PESLAK: Okay, thank you. Before we get into the hearing,
3 I'm going to go over a few ground rules. The court reporter is transcribing
4 the hearing today, so please try to speak clearly so we have an accurate
5 transcript. The transcript constitutes the official record of these proceedings.
6 Recording of any PTAB hearings is strictly prohibited. To ensure that the
7 transcript is clear we ask that you identify yourself before speaking and
8 please mute yourself when you're not speaking. We want to be sure that you
9 have an opportunity to present your arguments today. So if you encounter
10 any technical difficulties during the hearing, please let us know immediately.
11 For example, if for some reason you lose the connection, please contact our
12 IT support staff who set up the call. Likewise, if one of the judges gets
13 disconnected, we may have to pause and then reset things.

14 We have the entire record, including the parties' demonstrative
15 exhibits. When referring to a demonstrative paper or other exhibit, please do
16 so clearly and explicitly by slide or page number. Please also pause a
17 moment after identifying it to provide us time to find it. Generally, you
18 should not be raising objections when the other side is speaking. You can
19 save whatever objections or commentary you have for your rebuttal time.
20 I'll be keeping track of the time for the hearing. We don't have an electronic
21 timer for our video hearings, but I'll try to give each side a warning when
22 you're getting close to the end of your time. But you should also keep track
23 of the time.

24 There's a public line open today, and members of the public may be
25 listening in. I note that neither party informed us if it will be discussing any
26 confidential information today, so the public line remains open during the

1 entire hearing. We have a LEAP practitioner participating today on behalf
2 of Petitioner. Under the Board's LEAP policy, the Petitioner will receive an
3 additional 15 minutes of argument time in addition to what is stated in the
4 oral hearing order. Petitioner will receive 75 minutes today and Patent
5 Owner will receive 60 minutes of argument time. Those times are the total
6 for both cases involved in this consolidated hearing. We also plan to take a
7 short break after both sides present their opening arguments before rebuttals.
8 Petitioner, do you have any questions about the procedure today?

9 MR. JORDAN: No, Your Honor.

10 JUDGE PESLAK: Does Patent Owner have any questions?

11 MR. STANLEY: No, Your Honor.

12 MR. KWAK: No, Your Honor. Thank you.

13 JUDGE PESLAK: Thank you. Petitioner, how much of your 75
14 minutes do you wish to reserve rebuttal?

15 MR. JORDAN: I'd like to reserve 30 minutes for rebuttal, please.

16 JUDGE PESLAK: Okay, so you'll have 45 minutes for your opening
17 time. The time is 10:05. You can start when you're ready.

18 MR. JORDAN: Thank you. Your Honor, again, this is Daniel Jordan
19 for Petitioner Howard Industries Inc. I'm going to begin by sharing a
20 presentation with you of our demonstratives. Please give me a moment to
21 get that up. Are the slides visible on your screens, Your Honor?

22 JUDGE PESLAK: Yes, they are.

23 MR. JORDAN: Thank you. Please turn to slide 2. To begin with,
24 Petitioner's main points. Today the Petitioner has challenged three
25 independent claims and a series of dependent claims across two patents. In
26 these proceedings, the Patent Owner only disputes a single element across

1 all of these claims in the proceedings. And that's compartments disposed in
2 the portion of the work platform that projects from the height adjustment
3 mechanism in the forward direction. All of Patent Owner's arguments rely
4 on an unduly narrowing claim construction for this term. Nevertheless, the
5 petitions demonstrate that all challenge claims would have been obvious
6 even under Patent Owners unduly narrow constructions. Turn to slide 3.

7 What's not advanced in arguments in the proceeding today are the
8 alleged points of novelty found by the examiner during prosecution of the
9 '668 and '650 patents for the '668 Patent. That's the location of the actuator
10 where the actuator is disposed above the compartments and on the portion of
11 the work platform that projects in the forward direction. Moving to slide 4.
12 The '668 Patent was allowed on a first action allowance when the applicant
13 represented that the claims in the application were previously allowable
14 subject matter from prosecution of the parent application. That parent 030
15 application indicated here that it is the actuator location that the examiner
16 considered the point of novelty. There's claim 24 on the right of the screen
17 with the then pending claim matches claim 3 of the '668 Patent.

18 Notably, during prosecution of that parent application, the examiner
19 refused to allow a very similar claim 43 where the actuator was merely
20 recited to be on the work platform and not in the forward projecting portion.
21 Turning to slide 5 for the '650 Patent. The prosecution history of that patent
22 shows that the examiner considered the work surface disposed above the top
23 of the compartment wherein the work surface is movable relative to a
24 remainder of the work platform from an extended position to a non extended
25 position. The examiner relied on these claim amendments for a movable
26 work surface in allowing the claim. Now the Patent Owner advances no

1 arguments for either of these elements in the proceeding here today.

2 Turning to slide six.

3 JUDGE PESLAK: Mr. Jordan, just so we're all sort of on the same
4 page here. It's my understanding that the work surface is. I see on this slide
5 it looks like element 350 that you labeled in orange. And that sort of comes
6 out of the side of the work platform. That's what the spec describes as the
7 work surface. Is that correct?

8 MR. JORDAN: Yes, Your Honor. That is the work surface in the
9 specification.

10 JUDGE PESLAK: Okay, thank you.

11 JUDGE GERSTENBLITH: And that, just to be clear, that was slide 6
12 of your demonstratives?

13 MR. JORDAN: Slide 6 of the demonstratives on screen now shows
14 Figure 1 colored in blue, red, orange and green. And orange shows the
15 element that's supposed to be the work surface in the specification of the
16 patent. So the limitation at dispute today is similar across all of the
17 independent claims of the two challenge patents. Claims 3 and 4 for the
18 '668 Patent include a limitation for a compartment disposed in the portion of
19 the work platform that projects from the height adjustment mechanism in the
20 forward direction. Claim 1 from the 650 Patent similarly recites a
21 compartment disposed in the portion of the work platform projecting in the
22 forward direction. This is the only element with arguments in this
23 proceeding to resolve today. Moving to slide 7.

24 There are two claim construction arguments to discuss. The first is
25 whether compartments need be disclosed under the plain and ordinary
26 meaning of the term, they need not be enclosed. But the petition

1 demonstrates the challenged claims are obvious under either party's
2 construction. The second issue for construction is whether the
3 compartments need to be disposed entirely within the forward projecting
4 portion of the work platform. Under the plain and ordinary meaning, this is
5 not the case. Nor has CAPSA demonstrated disavowal of claim scope to
6 produce to restrict the term to such a construction, even though there are.
7 Nevertheless, the petition still demonstrates the challenged claims are
8 obvious under either Patent Owners or Petitioners construction.

9 Moving to slide 8, the construction of the term compartment. The
10 intrinsic record is clear. The claims do not say compartments must be
11 enclosed. The only thing the claims require that compartments do are for
12 containing items. There's no evidence in the specification for lexicography
13 or disavowal. The example --

14 JUDGE GERSTENBLITH: Mr. Jordan, let me just ask you a quick
15 question. In Patent Owner's response in 1274, page 20, they say that after
16 the petitions were filed, Petitioner agreed to adopt a construction of
17 compartment that says an enclosed space for containing an item. Is that
18 correct?

19 MR. JORDAN: In the District Court proceeding, the Howard
20 Industries chose to no longer contest the Patent Owners construction for that
21 term. That is correct.

22 JUDGE GERSTENBLITH: Okay, so why are you advocating for a
23 different construction now?

24 MR. JORDAN: We're advocating for a different construction now
25 because the issues in this case are different than those in the District Court
26 case. This case provides for us reaching to discuss what the plain and

1 ordinary meaning of compartment is. Whereas the District Court case, that's
2 not an issue for the -- that's not an issue that we need to resolve there to
3 settle that dispute.

4 JUDGE GERSTENBLITH: So now I'm even more confused based
5 on your answer. So, you're telling me that in the District Court you disputed
6 the construction. Then agreed by not disputing. So you agreed, you
7 acquiesced in this construction that's on page 20. And now you're saying,
8 oh, we need to construe it in a different way here because there's different
9 issues involved. But that's not how claim construction works. Right? The
10 term either has a meaning or it doesn't have a meaning. There may be
11 nuances to that meaning. I don't even know exactly what meaning you guys
12 are actually proposing for plain and ordinary meaning. But I don't
13 understand. What case law are you going to cite to me from the Fed Circuit
14 that tells me a Petitioner can argue a different construction in District Court
15 than here when we're applying the exact same claim construction rules and
16 case law?

17 MR. JORDAN: Your Honor, we can provide Federal Circuit citations
18 for you after the hearing. In our papers we cited a Board decision, one
19 explaining, you know, claim construction is a legal determination, not an
20 issue of fact that can be conceded. That comes from *The Cook Group v.*
21 *Cook Medical LLC* case IPR2017-00135. Similarly *Apple Inc. v. Virnetix*
22 *Inc.* IPR 2015-00810, Paper 44, where the Board recognized they're not
23 bound by party stipulations.

24 JUDGE GERSTENBLITH: Let me ask you another question.
25 Petitioner's view is that the references teach an enclosed space for
26 containing an item, right?

1 MR. JORDAN: The Petitioner's view is both the primary reference
2 teaches enclosed spaces for containing items in the form of drawers and also
3 partitions or areas that are marked or partitioned off as the institution
4 decision recognized. That would be what the Petitioner's advocating is the
5 plain and ordinary meaning today.

6 JUDGE GERSTENBLITH: Okay, so let me just take one at a time.
7 If Petitioner is arguing, and I believe I saw it in the petition, but I guess
8 Patent Owner will tell us if I got that wrong. But I believe I saw in the
9 petition, at least for the first ground based on Clark, that there's an
10 alternative disclosure that talks about a drawer. And if everybody agrees,
11 but let's just back up. If we construe compartment as an enclosed space for
12 containing an item and everybody agrees that a drawer is one of those
13 things, then I don't understand why Petitioner is arguing here for a different
14 construction.

15 Now you may have the right to argue something different, but you
16 know, you're going into two different judicial bodies arguing two different
17 constructions with no good basis for doing it. So I would encourage you
18 guys, as you consider your arguments, whether you really want to maintain
19 that position, it's up to you to maintain it. But it looks really bad to argue
20 two different constructions in two different tribunals whether you have a
21 right to or not. Especially when you're making an argument that the
22 reference teaches this enclosed space for containing an item either way. So
23 consider that as you. I'm not saying that you have the ability to change this
24 right now, but you can decide whatever you would like to do as you move
25 forward.

1 MR. YOUNG: Your Honor, if I can offer some clarifying comments.

2 Can you hear me okay? If I'm using this microphone?

3 JUDGE GERSTENBLITH: We can hear you, but we don't see you

4 on video. But that's okay. I don't think you have to be on video.

5 JUDGE PESLAK: Who's speaking?

6 MR. YOUNG: Sorry, Michael Young, lead counsel.

7 JUDGE GERSTENBLITH: Okay.

8 MR. YOUNG: I am on camera on a different screen.

9 JUDGE GERSTENBLITH: Okay, no problem.

10 MR. JORDAN: Just offer a little context. We were in claim
11 construction briefing when we filed a petition at the time, we had not agreed
12 to stipulate to the construction that the Patent Owner had proposed. That
13 came after and during pre-institution briefing where that's covered. I
14 recently continued to advance both constructions because the Board seemed
15 to appreciate that the plain and ordinary meaning was as we had put it in the
16 first place. But we had put in both constructions just to be sure that during
17 claim construction, if we chose one path versus the other, that the petition
18 covered either construction. I just wanted to offer that clarifying comment.
19 I can answer your questions, too, if you have any.

20 JUDGE GERSTENBLITH: Sure. So I think what you're saying is,
21 Petitioner is saying, look, you're fine with. You would be fine with the
22 construction that Patent Owner says everybody agreed to in the District
23 Court, and you would also be fine with construction that was potentially
24 more in keeping with what was done in the DI.

25 MR. YOUNG: That's correct, Your Honor.

1 JUDGE GERSTENBLITH: Okay. And in the DI, if I'm not
2 mistaken, I think the primary issue was based on whether something was
3 fully enclosed as compared to just whether it was enclosed at all. But the
4 parties argued. The parties, I believe, have argument throughout the papers
5 based on a meaning of enclosed being included in that construction. Do you
6 agree that the parties have argued. Had ability to argue the construction
7 meaning to include enclosed?

8 MR. YOUNG: Yes. Your Honor, both constructions were fully
9 briefed. We wanted to do a belt and suspenders because we were in the
10 middle of claim construction in the District Court where we have other
11 concerns such as infringement considerations and overall case strategy. And
12 this is why the Federal Circuit allows even different District Courts on the
13 same claims and same terms that have slightly different meanings. But we.
14 Yes, we did belt and suspenders. We briefed both. The petition covers both.
15 And parties had equal opportunity to address both constructions. And as we
16 said, we think the patents are obvious under either construction. So we leave
17 to the Board on their interpretation of the claim.

18 JUDGE GERSTENBLITH: Okay. Thank you so much, Mr. Jordan.
19 And sorry to – I mean, Mr. Young, and sorry to have you jump in there.
20 Thank you, Mr. Jordan. I appreciate that. I'll let you go back to your -- to
21 where you were going.

22 MR. JORDAN: Thank you. Your Honor, would the Board like to
23 hear additional arguments have been fully briefed on the compartment at this
24 time, or would you prefer we move on?

25 JUDGE GERSTENBLITH: Yeah, I think you can continue with
26 where you were planning to go.

1 MR. JORDAN: Thank you. Your Honor, turning to Slide 9. CAPSA
2 relies on a redefinition argument in the SkinMedica case, which seems in a
3 positive to any of the issues in the specification here to more narrowly
4 defined compartments. The SkinMedica case involved comparisons of
5 culturing cells in three dimensions and whether that included culturing cells
6 on beads. In doing so, it compared those cells to beads to three dimensional
7 cells. It disparaged alternative methods of culturing cells on beads. It
8 disclaimed these during prosecution, and it used words of redefinition. That
9 is, none of those issues are present in the specification or the prosecution
10 history we have here. Turning to slide 10, what we do have is a brief
11 description of the figures which, notes, Figure 7 is an image without
12 compartments. And what that section of the specification really is saying is
13 that drawers can be modified to different sizes and placed in the cavities of
14 the work platform in various configurations. There's no comparison of
15 drawers to alternative styles of compartments. There's no disparagement of
16 alternative compartments in view of drawers, no prosecution statements
17 discussing compartments at all, and no words of redefinition. So, we don't
18 think lexicography is appropriate here.

19 Moving on to slide 11. The other issue for construction is how to
20 define compartments disposed in the portion of the work platform that
21 projects from the height adjustment mechanism in the forward direction.
22 Patent Owner seeks an unduly narrow interpretation of that term to require
23 compartments to be disposed only within or entirely within a select portion
24 that they identify here in Figure 12. On the left, marked in orange, is Patent
25 Owner's figure coloring in orange. The only area that they say is the
26 forward projecting portion. To support their arguments, they rely on this

1 figure on the right, which they claimed it would be impossible to install
2 compartments in a different configuration because it would conflict with the
3 height adjustment mechanism shown in yellow.

4 JUDGE PESLAK: Mr. Jordan? Judge Peslak here. Go back to that
5 slide 11.

6 MR. JORDAN: Yes, Your Honor.

7 JUDGE PESLAK: Just so the record is clear. What's shown on the
8 right there is not part of the patent specification. That's correct, right?

9 MR. JORDAN: Yes. Your Honor, these. These figures are modified
10 and annotated by the Patent Owner and placed in their papers. The figure on
11 the left is colored. The figure on the right is redrawn.

12 JUDGE PESLAK: And is there any disclosure in the specification
13 about dimensions of compartments? That or any description that shows any
14 kind of dimensions or relations between the size of the compartments and
15 the work platform or anything where we could determine where things are
16 placed definitively?

17 MR. JORDAN: Not in the specification, Your Honor. There are
18 certainly no dimensions. And as I'm sure that the Board recognizes this,
19 figure 12 is simply a cross section through the middle of the work platform.
20 What is shown in the provisional application. This exhibit 1040. I shifted to
21 slide 15 of the presentation. And on the right you'll see a figure from a
22 provisional application, i.e. that the specification claims priority to. And it
23 shows an inside rear view where the drawers are compared to a hole or a
24 cavity for the height adjustment mechanism. Now, as Mr. Kemnitzer
25 testified during his examination, he said it may be possible to have drawers
26 be shaped in a way that surround that column, and they also could be

1 configured to go around that column. And this image from the provisional
2 shows that there's space available on the side of that height adjustment
3 mechanism for drawers to do just that.

4 I'm turning back to slide 12. The other point to make is on Patent
5 Owner's construction on the right on slide 12. They've annotated the Clark
6 reference, which is used in the obvious misconduct in this proceeding, to
7 define a rectangle. That is the only place that Patent Owner says
8 compartments may be disposed to satisfy the limitation. In doing so, they're
9 excluding the area above it, which includes the horizontal tray 12. This
10 construction would contradict the claim language. Your Honor, I moved to
11 slide 13. And as you can see, the claims are on the right side of the screen
12 here. And they simply note that only a portion of the work platform is in the
13 forward direction. It implies other portions of the work platform are
14 certainly in other directions, such as a rearward direction.

15 And the use of the word forward is not meant to be limiting. Instead,
16 it contrasts with later use in the same claim term for the rearward direction.
17 The forward direction contrasts with a user facing the rearward direction to
18 show that the direction that compartments must face. The specification
19 confirms this understanding. Here on the left on the demonstrative, a quote
20 from the '668 and '650 Patent simply says the plurality of compartments
21 face the user and move up and down with the work platform. The other
22 important component is later on in the independent claims. There is the
23 actuator limitation, which explains that the actuator is disposed above the
24 compartment and on the portion of the work platform projecting in the
25 forward direction. Moving to slide 14.

1 JUDGE PESLAK: Mr. Jordan. Can you move back to slide 13 for a
2 second, please. So, if we accept the construction of compartment as being
3 enclosed, that was agreed to in the District Court, how does Clark meet that?

4 MR. JORDAN: Clark meets that with its disclosure of a drawer
5 located under the horizontal tray.

6 JUDGE PESLAK: Okay, so then you would not be relying on that
7 keyboard, that compartment for the keyboard in that case.

8 MR. JORDAN: We would not rely on the compartment for the
9 keyboard. There's a keyboard tray.

10 JUDGE PESLAK: That's what I meant. I'm sorry.

11 MR. JORDAN: We would rely on that for the work surface that is
12 included with in addition to the drawer.

13 JUDGE PESLAK: Okay, I just wanted to make that clear. Go ahead.

14 MR. JORDAN: Thank you. Moving to slide 14. This demonstrates
15 just why the narrowing construction that CAPSA advances contradicts the
16 claims. On the left you can see an annotated figure by the Patent Owner
17 showing the actuator location on the handle of Clark's work platform. On
18 Figure 12, that handle is shown above and outside of the area in orange and
19 above the yellow colored height adjustment mechanism. Again, the
20 limitation is where the actuator is disposed above the compartment and on
21 the portion of the work platform projecting in the forward direction. And so
22 it must include that handle area as well. Demonstrating CAPSA's
23 construction is too limiting.

24 Moving to Slide 15, we briefly discussed this already. As Mr.
25 Kemnitzer recognized, it's certainly not impossible for drawers to be shaped
26 around the height adjustment mechanism. Slide 16 shows a CAPSA product

1 today that does just that. As shown in red. On the right is the slim cart with
2 a notch for drawers that go around the height adjustment mechanism. On
3 the left is transcripts from Mr. Rydingsward's testimony. He's CAPSA's fact
4 witness where he explained that a drawer certainly works for its intended
5 purpose to hold items and it's not impossible for a drawer to extend around
6 the side of the height adjustment mechanism.

7 JUDGE PESLAK: Mr. Jordan, exhibit 1043 is not prior art. Is that
8 correct?

9 MR. JORDAN: That is correct, Your Honor. It's not prior art.
10 Moving to slide 17, CAPSA repeatedly advances arguments that we should
11 limit the construction of this compartment term to the embodiments in the
12 specification. As *Phillips* and other cases make clear that this is an incorrect
13 way to perform claim construction. We cannot limit the claims to the
14 disclosed embodiments. Moving to slide 18, CAPSA relies on prosecution
15 history of the '650 Patent to retroactively apply to the '668 Patent. Well,
16 that may be appropriate in certain circumstances. The *Georgia Pacific* case
17 explains that for a later made argument to apply retroactively to a patent that
18 was already issued, it has to involve a statement that would have to be one in
19 which the examiner relied upon in allowing the claim from the patent at
20 issue. And as you've seen in the briefing, the statements used in the '650
21 Patent are directed to a movable work surface. There is no movable work
22 surface limitation in the 668 patent. Those arguments cannot reach back for
23 that claim element. I'm going to move to slide 20.

24 It's simply a quote from the *Avid Tech* case which explains for the
25 '650 Patent for prosecution disclaimer to attach it has to be a situation where
26 the alleged disavowal is ambiguous or unambiguous or not amenable to

1 multiple reasonable interpretations. When prosecution disclaimer or
2 statements are ambiguous or amenable to multiple reasonable
3 interpretations, there is no disclaimer. And that's certainly the case here.
4 Moving to slide 22 on the left, there's the claim amendments from the
5 prosecution of the '650 Patent, which we've already seen show that the
6 amendments made in prosecution were directed to the movable work
7 surface. On the right are the arguments that the applicant made to secure an
8 allowance where the applicant quotes the amended claim language to
9 explain that cart does not teach or suggest a cart wherein the work services
10 dispose above atop one compartment, wherein the work service is movable
11 relative to a remainder of the work platform from an extended position to an
12 un-extended position.

13 As for the other arguments raised in prosecution, those are directed to
14 the prior art reference Ellefson. Taking a look at slide 23, the examiner
15 raised Ellefson for its pivotal work surface. The movable work surface
16 element. On the left is a clip from the office action issued by the examiner
17 where he says Ellefson teaches it is well known in a cart structure to provide
18 at least one work surface. Items 48, 50 and 52, work surfaces travel in
19 arcuate directions. On the right is a picture of Ellefson showing those
20 movable work surfaces. What this demonstrates is that the applicant's
21 arguments and prosecution do not have unambiguous statements directed to
22 claimed compartments. They are certainly subject to an interpretation that
23 they are about a movable work surface and not about the location of the
24 claimed compartment. And so prosecution disclaimer cannot attach for that
25 claim element. Slide 24.

1 These are simply additional quotes from the prosecution history of the
2 ‘650 Patent. And in each case the applicant relied and specifically referred
3 back to a height adjustable work platform with a movable work service
4 located above a compartment. All the arguments wrap up into that. And so,
5 there's no way that we can apply these statements back to restrict the
6 interpretation of compartments disposed in the forward projecting portion of
7 the work platform. They are not unambiguously directed to that claim
8 element. And they're at least subject to an interpretation that they are about
9 the removable work service.

10 JUDGE PESLAK: Mr. Jordan, there were also arguments about Clark
11 being top heavy and having a higher center of gravity. And you don't see. I
12 know what you're focusing on here is the movable surfaces. But can you
13 address what Petitioner's view is on whether those statements create some
14 type of prosecution disclaimer, at least with respect to the ‘650 Patent,
15 because they were made in that case?

16 MR. JORDAN: Yes, Your Honor. And we do intend to cover the top
17 heavy arguments about Clark in detail about whether Clark can install a
18 drawer. But as far as prosecution goes, the Avid Tech makes clear that the
19 disclaimer can only apply when the statements are unambiguous or not
20 subject to multiple interpretations. And because here, even though the
21 applicant made statements about Clark and suggested they're top heavy,
22 they're made in context with the reference Ellefson raised to the movable
23 work surface. And so, if anything, they're directed to the work surface
24 element and not to play the compartment element. That is the appropriate
25 way to apply those statements. And in fact, it's why the petition contains
26 entire grounds devoted to an alternative movable work surface.

1 JUDGE PESLAK: Okay, I understand.

2 MR. JORDAN: Your Honors, at this point, I'll pause and just see if
3 there are any more questions about claim construction. And if not, I'll move
4 to the petition ground.

5 JUDGE GERSTENBLITH: Mr. Jordan, I just want to be 100 percent
6 clear. Petitioner does not object to the construction that it agreed to in
7 District Court, right?

8 MR. JORDAN: That's correct, Your Honor.

9 JUDGE GERSTENBLITH: Okay. Thank you.

10 MR. JORDAN: So, the petition sets, each petition sets forth grounds
11 based on two primary references. Clark and Reeder disclosing movable
12 parts in combination with those grounds. Or a separate set of grounds based
13 on Gillis, which applies to an alternative claim construction for the move or
14 the work surface and whether it moves in an arcuate direction. The Gillis
15 grounds have not been briefed past the petition. We understand there are no
16 live arguments on the Gillis ground today. So, as for Clark, Clark discloses
17 compartments in two ways. One is the cavity below the work surface. And
18 above the pullout keyboard tray shown in red among slide 26. You can see
19 that cavity shown on the right. That's Figure 4B of Clark annotated in the
20 petition and moving to slide 27. This compartment is certainly disposed in
21 the forward projecting portion of Clark's work platform, shown in blue.
22 Annotated Figure 2B. Mr. Kemnitzer's declaration explains that that
23 compartment is disposed in the forward direction because it extends to the
24 forward side of the height adjustment mechanism. Moving to slide 28.
25 CAPSA argues that Clark's keyboard tray is top mounted, placed over top of
26 the height adjustment mechanism. In the proceedings today. But this is a

1 different story. Earlier in the proceeding there in Dr. Ben-Tzvi's
2 declaration, pre-institution, he's just the opposite. That the height
3 adjustment mechanism of Clark extends through a middle portion of the
4 compartment, dividing it in half. On the right, Dr. Ben-Tzvi annotated this
5 middle portion, showing where that height adjustment mechanism extended
6 through the cavity. This demonstrates that Clark is not in fact top mounted.

7 Slide 29, when asked about this figure, Dr. Ben-Tzvi, during his
8 examination changed his story. When asked if the shaft extends through the
9 bottom of the tray into the tray, he said there isn't enough detail, technical
10 detail, to conclusively determine whether it's going through any hole at the
11 bottom of 12 slide 30. Again, Dr. Ben-Tzvi when asked how have you
12 conclusively determined Clark's tray is top mounted? He responds, because
13 of the absence of such an explanation in this patent, it didn't say anything is
14 going through anything so it's fully on top. Again, this directly contradicts
15 the declaration submitted pre-institution and the figures which show that the
16 height adjustment mechanism does extend through the cavity.

17 Slide 31 shows Clark's additional disclosure of the compartment and
18 that's a drawer located underneath the horizontal tray 12. It's not native to
19 Clark's figure, but it's explained in the specification here. Column 10 from
20 Clark explained that the docking station could be supported in a substantially
21 horizontal position, for example by a drawer or pull out tray located above
22 or under the horizontal tray. Mr. Ben-Tzvi in his declaration located that
23 drawer at the location shown in Clark's Figure 2B, annotated here on the
24 slide drawn in red. Moving to slide 32, Mr. Kemnitzer provided support
25 during his examination explaining any designer of ordinary skill would
26 understand to locate a drawer in this forward position so it could be

1 accessible by the user of the platform. His declaration pre-institution offers
2 more support. Moving to slide 33, Mr. Kemnitzer explained implementing
3 multiple drawers in medical carts was routine. A POSITA would have been
4 motivated to do so to improve the ability to organize unlike items in separate
5 storage compartments.

6 He also commented that security of health information, medical
7 history, test results, prescriptions as well as the medications themselves was
8 a common concern in the medical card industry and his opinion is supported
9 by evidence. Boone and McDonald are references in addition to Reeder and
10 Eldon. On the right is an image of Reeder showing a medical cart with
11 drawers that are located above atop work surface. Now CAPSA complains
12 that this isn't height adjustable, but on the one hand it's talked about
13 collectively with the height adjustable figures in reader. Figures 30 through
14 34 are discussed collectively but two it's shown at a standing position which
15 is the top height that the Clark cart would go to and that the playing that the
16 assertive patent the challenged patent describes the top height of the height
17 adjustable cart and so in a standing position. It was well known in the art to
18 have drawers located right below a work surface to the front side of a
19 support located to the rear. Reeder supports Mr. Kemnitzer's testimony on
20 that point.

21 And moving to slide 34, Ellman similarly shows a surgical cart with a
22 work platform at the top and drawers located right below it. So evidence
23 supporting Mr. Kemnitzer's opinions that it would have been obvious to
24 implement drawers in this location on Clark. As for CAPSA's criticism that
25 Clark cannot be cannot include a drawer because it's top heavy. This is
26 simply not the case. Looking at slide 35 on the left, you can see a figure

1 10B from the '668 and '650 Patent. And it shows how the work platform,
2 the frame, attaches to the height adjustment mechanism coming up through,
3 and the drawers would then hang below the frame. It's similar to Clark on
4 the right, which also shows portions of the height adjustment mechanism
5 here, the rod 72 going up and the drawers would hang below that location.
6 There's no difference between how Clark is mounted compared to the '668
7 and '650 Patents. Moving to slide 36.

8 In making their top heavy criticisms, CAPSA ignores Clark's base
9 and match distribution, which are factors that are used in a stability analysis.
10 Dr. Ben-Tzvi explained this in his declaration, explaining that stability is
11 influenced by factors such as the base area of the object and the mass
12 distribution, as well as the position of the center of gravity. Mr. Kemnitzer
13 in his examination explains a similar concept that if an object is tilted, it will
14 tip over with a vertical line from its center of gravity falls outside the base.
15 And so, the location of the center of gravity compared to the base and how
16 the mass is distributed is important and something that a procedure would
17 consider in a stability analysis. In making their criticisms on Clark, the
18 Patent Owner I'm on slide 37. They say in Dr. Ben-Tzvi's declaration that
19 adding heavy compartments to the workstation of Clark with its higher
20 center of gravity would render the cart more unstable and more prone to
21 being knocked over. But when asked at his examination whether adding a
22 drawer under the keyboard tray of Clark would render Clark unstable, Dr.
23 Ben-Tzvi explained he never said anything like that. Instead, he was simply
24 trying to explain the common wisdom in the time frame of 2003 and 2004.

25 Moving to slide 38, Dr. Ben-Tzvi, when asked how did he calculate
26 the tipping angle for Clark, he explained he did not have access to the

1 product and he didn't. And more to the point, Dr. Ben-Tzvi never examined
2 the literature specified in Clark, describing the chassis used in the Clark
3 reference here on slide 39 there's a quote from Clark which explains the
4 chassis is a model MPC 2001 manufactured by JACO, Inc. On the right is
5 the specification sheet for the MPC2001, and what it shows is that that very
6 chassis could support heavy elements like a cathode ray tube monitor sitting
7 on top of the work platform and that the chassis itself weighs 70 lbs.

8 On slide 40. When asked whether he had evaluated the MPC2001,
9 Dr. Ben-Tzvi admitted he never did. He never evaluated that he didn't have
10 access to products. He did have access to literature and did not consider
11 this. Moving to slide 41, Petitioner submitted a status problem
12 demonstrating that CAPSA's argument that a lower center of gravity alone is
13 wrong. A lower center of gravity alone does not improve stability. Other
14 considerations like the distribution of that center of gravity compared to a
15 tipping point and where it's located in the overall body also matter. And so,
16 here what this figure shows on the left is a Figure 1, a hypothetical part
17 demonstrated to have box shaped like compartments in front of a column in
18 the back that is positioned 8 inches from a tipping point and 18 inches above
19 the ground on the right. Figure 2 shows an alternative configuration with a
20 centered drawer embodiment with a center of gravity higher 24 inches above
21 the ground.

22 Moving to slide 42. Dr. Ben-Tzvi reviewed the math in calculating a
23 tipping force to push and rotate the cart about point A, and he agreed that the
24 cart in Figure 2 has a higher center of gravity than the cart in Figure 1, and
25 the force required to tip the cart in Figure 2 is more than the force required
26 to tip the cart in Figure 1. This demonstrates that Patent Owner's argument

1 about a lower center of gravity alone is not correct, nor is there any reason
2 why a facilitator would be unable to consider stability concerns when
3 implementing the drawers as described by Clark. Moving on to slide 43.
4 Discussing the Reeder grounds, Reeder discloses compartments in three
5 ways. One is a wire tray shown in Reeder's Figure 31 on slide 44, storage
6 containers 718 shown in Reeder's figures 45 and 46, and on slide 45,
7 drawers located 346 and 394 on figures 30 and 32 of Reeder.

8 Moving to slide 46. The petition explains that a POSITA would have
9 modified Reeder's tray and container embodiments with Reeder's drawer
10 embodiments. Kemnitzer explained that the POSITA would have been
11 motivated to do that to provide secure storage on the height adjustable carts.
12 And again, he opined that implementing drawers in medical carts was well
13 known and routine. And he cited these alternative embodiments with
14 drawers in Reeder as well as Ellman for support. CAPSA also criticized
15 Reeder as saying it is top heavy. But during his examination, when asked.
16 During Mr. Kemnitzer's examination, he excused that and he, Mr.
17 Kemnitzer explained that Reeder has a large footprint. All the items above it
18 are suspended and fall within the footprint. And he explained it's not
19 unstable. That's slide 47 moving to slide 48. During Dr. Ben-Tzvi's
20 examination, he admitted --

21 JUDGE PESLAK: Mr. Jordan, you have about three minutes left in
22 your opening time. If you go over, we'll just take it out of your rebuttal. But
23 we just wanted to let you know.

24 MR. JORDAN: Thank you, Your Honor. When asked whether the
25 cart in Reeder had a higher center of gravity than the cart in the '668 Patent,
26 Dr. Ben-Tzvi said he did not know. He needed more specifications to be

1 able to determine that. Slide 49. When asked if he calculated the tipping
2 angle per liter, Dr. Ben-Tzvi explained he wouldn't know what is the tipping
3 angle and what it would make it unstable. Finally, slide 50 CAPSA submits
4 a declaration on secondary considerations. But this declaration faces a
5 critical shortcoming. For one, there's no sales evidence included with the
6 declaration to demonstrate commercial success of any of CAPSA's carts.
7 Two, CAPSA's fact witness Mr. Rydingsward admitted that the claim's
8 success is driven by unclaimed features. One he attributes it to a lower
9 center of gravity and better weight distribution. But this is not a claimed
10 feature of the '668 or the '650 Patents.

11 Moreover, Mr. Rydingsward admits he's not an engineer or a
12 POSITA, and he admits to not knowing what the claims require. Because of
13 this, he's unable to provide a nexus between the claim's features and the
14 commercial success. Moreover, CAPSA sells model carts without drawers
15 using the same frame with no modifications to get the tipping UL
16 certification that they claim to drive their commercial success. And there's
17 no sales data separating out sales between parts with drawers and parts
18 without. Finally, Mr. Rydingsward admitted that sales are driven by
19 unclaimed features such as aesthetics, touchscreen and fleet management
20 software.

21 As for copying and long felt unmet need, Mr. Rydingsward submitted
22 no evidence substantiating this claim. And he admitted he didn't enter the
23 industry until after the patents had been filed. Moreover, CAPSA's
24 technical expert, Dr. Ben-Tzvi, could not name a single manufacturer of
25 medical parts at the filing date. So for these reasons CAPSA's secondary

1 considerations fall short. This time I like to just ask if the Board has any
2 questions for me. If not, I'll reserve the remainder of my time for rebuttal.

3 JUDGE PESLAK: We have no further questions. Looks like it
4 finished right on time. So Petitioner will have 30 minutes for rebuttal. And
5 now, Patent Owner, we'll hear your opening arguments. How much time do
6 you wish to reserve for rebuttal?

7

8 JUDGE PESLAK: We'll take a five-minute recess. It's 10:50. We'll
9 be back at 10:55.

10 (Recess)

11 JUDGE PESLAK: I don't see Mr. Jordan back. Is he? Oh, there he
12 is. Okay. Looks like everyone is back. Patent Owner, how much time do
13 you wish to reserve for rebuttal?

14 MR. KWAK: We would like to reserve 20 minutes for rebuttal, Your
15 Honor.

16 JUDGE PESLAK: Okay, so you'll have 40 minutes. You can start
17 when you're ready. But I'd like to ask you one question. During Petitioner's
18 argument, Judge Gerstenblith had colloquy about the construction of
19 compartment as being enclosed. We just want to confirm that Patent Owner
20 has had a full opportunity to brief that issue prior to the hearings?

21 MR. KWAK: Yes, Your Honor, we believe that we did.

22 JUDGE PESLAK: Okay, okay. So you can begin with your
23 argument. Thank you.

24 MR. KWAK: Thank you, Your Honors, and good morning. I'd like
25 to share the presentation, so bear with me.

1 JUDGE GERSTENBLITH: Could you introduce yourself, sir?

2 Obviously you're not DeAnna Barnett.

3 MR. KWAK: Yes, Your Honor. Do you see the presentation of --

4 JUDGE GERSTENBLITH: This is Judge Gerstenblith. Let me just
5 say. This is Mr. Kwak, right? Is that how you pronounce your last name?

6 MR. KWAK: Yes, Your Honor. I'm just. Yeah, my name is James
7 Kwak. I'm sorry, Your Honor. I'm trying to get the exhibit corrected. But
8 my name is James Kwak. And yes, I will be arguing. DeAnna Barnett is
9 our paralegal, and she -- I'm working on her computer, and that's why her
10 name is up there.

11 COURT REPORTER: Thank you, Your Honor.

12 JUDGE GERSTENBLITH: Thank you.

13 MR. KWAK: Okay, Your Honors. Do you see the presentation? The
14 where the case caption for the IPRs. Can you see that on your screen?

15 JUDGE PESLAK: Yes.

16 MR. KWAK: Okay. Thank you. So, just a quick overview of the
17 '668 and '650 Patents in the case. They're continuations, so they do have the
18 exact same description. And see in Figure 1, the embodiment showing the
19 perspective view where the compartments are in front of the support column
20 or the height adjustment mechanism. And Figure 12 shows the side view of
21 that. And you can see that in the only embodiment described, the
22 compartments are forward projecting from the height adjustment mechanism
23 there on the right.

24 JUDGE PESLAK: Mr. Kwak, I just have a question about this. You
25 have that block in the middle that says work surface of work platform.

26 Seems to point to the top of the work platform. That's not the claimed work

1 surface. Correct. Am I correct about that? Isn't the work surface those trays
2 that come out the side?

3 MR. KWAK: Yes, there could be. That could be the work surface.
4 But the arrow is really just kind of pointing it generally. But yeah, the work
5 surface that was pointed to earlier coming out the slide, was it the work
6 surface that is movable? Yes.

7 JUDGE PESLAK: Okay, go ahead.

8 MR. KWAK: So, I just want to spend a little bit of time going over
9 the evidence that we have in the record that stability issues with these mobile
10 parts and tipping over in certain environments was a real life problem. This
11 was straight from the declaration of Mr. Craig Rydingsward. He's a head of
12 sales at CAPSA who was actually at Rubbermaid when some at some
13 portion, not at the time that these patent applications were filed but he was
14 there during the time period that Rubbermaid did own these patents. And he
15 testified that having the compartments in the forward portion and not on top
16 of these carts is very beneficial and it creates a lower center of gravity,
17 increases stability. And hospitals also look for these types of features
18 because they have UL certifications that they like their carts to meet,
19 stability certifications, so that they know that the carts that they're buying
20 have met these certifications and are stable and have met these standards.
21 And again he testified that moving the compartments down front of the
22 height adjustment mechanism helps lower the center of gravity and increases
23 as a major reason why these cast of carts sell so well.

24 JUDGE PESLAK: Mr. Kwak, let me ask you a question about Mr.
25 Rydingsward. I didn't see anything in his declaration about his educational
26 background, whether he's an engineer. I don't see anything in his

1 declaration supporting the statements that he's made. Is there any evidence
2 that would allow us to give any weight to this testimony about --

3 MR. KWAK: I believe in a declaration we provided evidence that,
4 you know, he has been head of sales and he's in marketing and so he has to
5 get a knowledge of these products and why they operate, and he does deal
6 with and work closely with the design and engineering team. But yes, he is
7 not an engineer himself.

8 JUDGE PESLAK: Okay.

9 MR. KWAK: Some other evidence about in the record we have this
10 Miller patent which was filed after the patents in the case and as it says
11 directly from this Miller patent that there's problems with medical carts
12 picking over when maneuvered over uneven or slanted surfaces. Hospitals
13 have ramps for handicapped people and always these carts are going over
14 these surfaces and you have to make sure that they're stable enough so that
15 when they're going over these ramps and planted surfaces in different
16 directions that they're not going to tip over. And this patent says that a lower
17 center of gravity can enhance the stability of the cart and reduce the
18 likelihood of the cart tipping over.

19 And again, our experts testify that stability is just not, you know, how
20 lifting the cart off the ground, it's how resistant that object is to tipping over.
21 And as he testified in great detail in his declaration and the briefing by
22 lowering the center of gravity, a lever arm through which gravity can exert
23 torque on the object is effectively decreased, making it more stable and
24 resistant to tipping over.

25 JUDGE GERSTENBLITH: Counsel, can I -- I don't want to take you
26 too far off, but can I ask you about the secondary considerations for a bit?

1 MR. KWAK: Sure, yes.

2 JUDGE GERSTENBLITH: If I'm taking you way out of sequence,
3 I'm happy to wait. But you tell me, should I wait?

4 MR. KWAK: No, go ahead, Your Honor.

5 JUDGE GERSTENBLITH: Okay, so I see Patent Owner is arguing
6 first commercial success and praise. And for support, you're citing the
7 Rydingsward declaration, and that's the only, I dare say, evidence in support
8 of that. Is that right?

9 MR. KWAK: I'm sorry, Your Honor. Which factors.

10 JUDGE GERSTENBLITH: So I'm starting with commercial success
11 and praise, which is page 61 of the brief in the 1274 case of Patent Owner.

12 MR. KWAK: Yes, commercial success. I believe some of the things
13 that he was relying on in the declaration was also the fact that he knows that
14 the sales increased based on that feature. And, yeah, we didn't put the sales
15 number, but he did have. He does have personal knowledge of the sales
16 increases. And, you know, with his exposure to customers, he knows why
17 those sales increase. And that was part of the testimony in this declaration.

18 JUDGE GERSTENBLITH: Okay, so just to be clear, I just want to
19 make sure. So the support for this paragraph on commercial success and
20 praise is the only evidence that Patent Owner has put in is Rydingsward's
21 declaration.

22 MR. KWAK: I'm not positive about that, Your Honor. If I can just
23 wait until my section of the secondary considerations presentation, I might
24 be that. But I don't have that memorized. I'm sorry.

1 JUDGE GERSTENBLITH: Okay, so why don't I wait. And when
2 you get. You're going to speak to that. Do you plan to speak to that in your
3 opening discussion?

4 MR. KWAK: Yes, I do.

5 JUDGE GERSTENBLITH: Okay, so when we get to that, I'll come
6 back to all these.

7 MR. KWAK: Thank you.

8 JUDGE GERSTENBLITH: Sure.

9 MR. KWAK: And so this patent is -- this patent to Kemnitzer is not a
10 patent that our expert obtained. Kemnitzer is Petitioner's expert, and he
11 obtained a patent. And he filed for this patent years before the patent issue,
12 where he tried to solve the exact same problem. Instability of mobile carts.
13 And if you look at Mr. Kemnitzer, the description here, it says in quotes that
14 this enhanced the area of support at the bottom of the base portion, expanded
15 to the support numbers 330 and 360. This enhanced support offsets the
16 instability created by the upward movement of the center of mass of the
17 entire unit when the portable computer is deployed. So in other words this
18 laptop computer on top, mounted on top as it rises up. What Petitioners
19 expert is saying in his patent is that that causes instability creating caused by
20 the upward movement of the center of gravity. And he invented this
21 kickstand invention to offset that instability.

22 And so, I bring this up because Petitioners own experts try to solve the
23 same problem as patents. And then in their reply I believe they mentioned at
24 some point that they believed that CAPSA was inventing this problem of
25 tipping over an instability and that it wasn't a real problem. And the facts
26 and evidence certainly contradict that. This is one of the claims claim one of

1 the '650 Patent. I just put that in there so we can refer to it later if we have
2 to but don't have to spend much time on that. So in summary the '650 and
3 the '668 have the same claims despises claim limitations of their
4 compartment locations. Nobody in the industry prior to these patents
5 thought of disposing the compartments in that very specific location in front
6 of the height adjustment mechanism in order to lower the center of gravity,
7 increase the stability of the car. Mr. Kemnitzer, Petitioner's expert got a
8 patent on his solution. Rubbermaid, the applicant at the time got a patent on
9 their solution which is the lower compartments, make it lower to the ground
10 so that it's more stable.

11 JUDGE GERSTENBLITH: So counsel, are you saying that the
12 claims here require the compartments to be lower in some way? Am I
13 understanding that right?

14 MR. KWAK: Yes, because when they're relative to being on top of
15 the height adjustment mechanism. So the claims recite that the
16 compartments are disposed in front of the height adjustment mechanism.
17 And we're obviously claiming that doesn't mean on top and therefore that
18 means that the performance because they're disposed in front and not on top,
19 they are lower to the ground when compared to the Clark and that --

20 JUDGE GERSTENBLITH: I understand that you're comparing it to
21 Clark, but what I'm asking you is what in the claim requires a lower
22 compartment?

23 MR. KWAK: Because. And I think that. And we'll get to that as we,
24 as we go into the disclaimers of the file history. If you can bear with me just
25 Judge, I'll get to that.

26 JUDGE GERSTENBLITH: Sure.

1 MR. KWAK: Thank you. The claim construction in summary, the
2 primary reference that Clark that the Petitioner is presenting was the exact
3 reference that was overcome during the Prosecution of the '650. Petitioner
4 gives no weight. The arguments of instability and the top heaviness of Clark
5 and the disclaimers of Clark in their briefing. There are the most important -
6 -

7 JUDGE PESLAK: Counsel? This is Judge Peslak. Now, you agree
8 that Clark was not cited in an office action during the prosecution of the
9 '668 Patent, correct?

10 MR. KWAK: Yes, I do agree with that, Your Honor.

11 JUDGE PESLAK: Okay, so Petitioner has cited pretty clear Federal
12 Circuit case law that prosecution disclaimer in a child application does not
13 apply to the parent. Do you have any case law that says that we can apply
14 the disclaimers. Even if we were to determine they were a disclaimer that
15 that would apply to the '668 Patent?

16 MR. KWAK: Yes, Your Honor, when I did cite that, I cited to a case
17 and in the briefing and I don't have that memorized, but basically they did
18 say that we're. It's the same description which is the case here. The claim
19 term is the same, which is here. We have the same examiner that things that
20 references that were disclosed and other related applications in that scenario
21 were deemed considered in both continuation and the parent. So in that
22 same situation, if you have the same claims limitations, same description,
23 and here we have the same examiner construing the same term, why
24 wouldn't you apply it consistently throughout? Why wouldn't you? Why
25 would you define the same exact term, the same description, same examiner
26 differently? And we cited to that case in our brief.

1 JUDGE PESLAK: Okay, so when you come back on rebuttal, why
2 don't you tell us exactly the cite of that case?

3 MR. KWAK: Okay, thank you, Your Honor. And not only did they,
4 they didn't address these instability arguments. Petitioners' expert admitted
5 in his deposition that in the petition he failed to consider those statements
6 about instability around Clark. And yet in the reply that they filed, he failed
7 to submit a declaration. So we still don't know how that expert and how a
8 person of ordinary skill in his view, would interpret those limitations. The
9 only evidence that we have of how a person of ordinary skill would interpret
10 these disclaimers of instability around Clark is what our expert provided.

11 So, the construction the first issue is disposed in and we're arguing
12 that it must be entirely or contained in and Petitioners arguing that that's not
13 the correct definition that it could be outside of the forward projecting
14 portion. First, the specification's only embodiments are that the
15 compartments are entirely in front of the height adjustment mechanism.
16 Another factor that we looked at is if the compartments were extended to go
17 behind the height adjustment mechanism as shown here in this figure where
18 the X is. There's no way that a user facing the rearward direction, standing
19 in front, could access those items at the rear of the height adjustment
20 mechanism. And as the claims recite that you have to have that feature. The
21 claims say that somebody standing in front must be able to access items in
22 the drawer. And if the item --

23 JUDGE PESLAK: Counsel?

24 MR. KWAK: Yes.

25 JUDGE PESLAK: This is Judge Peslak. What you show on slide 12
26 is a hypothetical, correct? That's not intrinsic evidence.

1 MR. KWAK: Well, the Figure 12 is intrinsic evidence. What I drew
2 the X box. That's extrinsic evidence. But I'm trying to illustrate --

3 JUDGE PESLAK: So even if you move the height adjustment
4 mechanism towards the center, as you did in another figure in your Patent
5 Owner response, what in the claim requires the drawers to extend past the
6 height adjustment mechanism?

7 MR. KWAK: Well, the claims recite the limitation that a user facing
8 the front of that part must be able to access the item.

9 JUDGE PESLAK: So, if the drawers are only half this distance and
10 move the height adjustment mechanism to the middle of the cart, why can't
11 they access the items?

12 MR. KWAK: What we're trying to say is I think we're -- I don't know
13 if we're saying the same thing because what we're trying to say is Petitioner
14 is trying to argue that the drawers can extend to the rear as a height
15 adjustment mechanism. That's their definition. It doesn't. What their
16 definition is if it closes then is that it doesn't have to be entirely in the front.
17 The compartment can go in the back. And what we're saying is if that's the
18 case, this claim wouldn't work.

19 JUDGE PESLAK: No, we're talking about claim construction here.
20 And I'm asking you, you're basing this on the drawer going behind the height
21 adjustment mechanism. And why is that required by the claim? If you
22 move the height adjustment, the claim says the compartments are disposed
23 in the portion of the work platform extending in the forward direction from
24 the height adjustment mechanism.

25 MR. KWAK: I'm sorry.

1 JUDGE PESLAK: Why do the drawers in that scenario have to
2 extend behind the height adjustment? For claim construction purposes?

3 MR. KWAK: Yeah, we're saying the drawers cannot extend to the
4 rear. We're saying that the drawers have to be disposed entirely in the front
5 of the system mechanism.

6 JUDGE PESLAK: Okay, so if we accept that and we look, how does
7 that help you for the Clark grounds? Because the illustrations that we saw
8 during Petitioner's argument showed that the drawer was disposed in front
9 was entirely disposed in front of a height adjustment mechanism. So does
10 this really matter for our decision based on the drawer embodiment of
11 Clark?

12 MR. KWAK: Clark never shows a compartment or drawer disposed
13 in that front. Completely in the front. They drew that. The Petitioner drew
14 that red drawer in there. And that's our point. They just drew that in there.
15 Clark doesn't teach it in that it goes entirely in the front. So it's a huge point
16 that we're arguing this for.

17 JUDGE PESLAK: This is an obviousness ground no anticipation.
18 So, Clark specifically says you could have a drawer under the compartment
19 and is it your position that it is beyond the level of the ordinarily skilled
20 artisan to put the drawer in the place where Petitioner is arguing it would
21 go?

22 MR. KWAK: Yes, we're definitely saying that. Your Honor, we have
23 case not a sport. The only thing that the Clark patent says is one sentence
24 that says the compartment, the alleged drawer could be above or under the
25 tray. It doesn't say to put it in that specific location. And that there's case
26 law in many cases that say if you have a very broad genus description that

1 does not make every specific species under that genus taught by that art.
2 Many cases say that you have to have factual findings to make that finding,
3 which they don't have. Petitioner assumed by that one vague statement the
4 drawer is above or under the tray, that that meant it could be at that location.
5 That is not the law. The law is they have to make factual findings. They
6 can't make that assumption. And they didn't do that, Your Honor. And
7 we're going to get to that point later.

8 If I may go back to here. We're trying to define the word disposed in.
9 Does it mean entirely in, or can it mean partially in? And I recited the case
10 in the briefing where they said within. They defined the term within. And
11 they said normally the plain and ordinary meaning of within can mean
12 partially end, but not in this case, because to do so would make the claim
13 impossible. And that's exactly what's happening here. If the Petitioner's
14 argument. We take the Petitioner's argument that the compartment being
15 disposed in doesn't have to be entirely in that it can go to the rear of the
16 height adjustment mechanism. It would. The claim would be impossible.
17 Wouldn't work. You couldn't access things behind the height adjustment
18 mechanism. So disposed in then has to mean in front.

19 JUDGE GERSTENBLITH: Counsel, let me just ask you about this
20 thing, because I didn't appreciate that Patent Owner was saying that it was an
21 impossibility to construe it this way. So the height adjustment mechanism,
22 if we're taking it as what's in the patent right, we're focused on the patent
23 itself. And we look at. I don't know if you want to pull up a figure for us to
24 look at, but hypothetically. Not hypothetically, we look at. I don't know
25 what's the best one. Figure 12. Everybody keeps pointing to. What is the
26 reason why a drawer -- so the height adjustment mechanism is basically a

1 narrow. It's narrower than the width of what is being supported on top,
2 correct?

3 MR. KWAK: Yes.

4 JUDGE GERSTENBLITH: Okay, so why would it be an
5 impossibility that a drawer couldn't extend from the sides of that height
6 adjustment mechanism forward? In other words, why couldn't I have a
7 drawer underneath that goes from the back of the height adjustment
8 mechanism right under that top surface piece that then extends along the side
9 of the height adjustment mechanism in the forward direction? Why is that
10 impossible to have a drawer like that?

11 MR. KWAK: We have to look. Well, if you look at this, you look at
12 the presentation. If you've looked at. I'm trying to get the presentation up
13 here, and for some reason it's not. I can't get out of this here. Is that right?
14 Okay. Do you see the presentation, the claim construction? Okay. Yeah.
15 So, if you look at this, this is the, you know, first of all, the -- this is the only
16 embodiment described. And if you look at the section here, it says the
17 drawers have slides and grooves. So you have to have these drawers go in
18 and out. If the drawers were to extend back to the rear, essentially the
19 drawer would have a hole through the bottom of the drawer. You couldn't
20 pull. You couldn't pull it out. It would be like this. Your Honor, if you can
21 see my -- if this pen was the height adjustment mechanism and this was the
22 drawer with the height adjustment mechanism going through the middle, you
23 couldn't even slide it out, and you couldn't even access. You couldn't even
24 open the drawer to get anything in the front or the back.

25 JUDGE GERSTENBLITH: So, let me just take that. I know you're
26 holding up your paper with a pen in it, but let me just ask you, why does the

1 drawer have to be the entire width of that? Why can't it just be the one side
2 of where your pen was in that example, the pen being the height adjustment
3 mechanism? If it's on one side of it, I don't understand why. And it looks
4 like that if you look at your Figure 1 of the '668 Patent. Right. The drawers
5 are not the entire width of that top structure. They're about half. A little bit
6 less than half the width. And I don't see why anything in this patent
7 excludes or, let's just say if we, if we were to construe that disposed in
8 means disposed in, but it doesn't exclude also being in another part, meaning
9 a rearward part or at least equivalent part. In other words, you're saying it
10 has to be completely forward of. I'm saying, why can't it also include being.
11 What would be the word if I'm not forward of, you know, parallel to the
12 height adjustment mechanism? So I'm not even. Let's not even say it has to
13 be rearward of it. Let's just say parallel to the height adjustment mechanism.
14 Okay. To the side of it. Why is that an impossibility?

15 MR. KWAK: It is not an impossibility, but what my point is, that's
16 extrinsic evidence, Your Honor. That's not what's described here. You
17 would have to bring in that extrinsic evidence to the hypothetical to meet
18 that claim term. But if you look at the intrinsic evidence, this is the only
19 embodiment described, and you can see what the inventor was trying to do.
20 He was trying to say that it's in the front. And the question that was posed
21 before, does this matter? If we lose this definition we still have the other
22 definition of what does forward mean. So, you know, this is not the end all,
23 be all to our arguments, but we still feel strongly that the compartment has to
24 be in the front based on just what the patent describes and what the inventor
25 is trying to do and come up with all these hypothetical possibilities of, you
26 know, what can the drawer look like?

1 I've never seen a drawer look like that. I don't think it's proper. If you
2 look at the intrinsic evidence, and that should. If that makes clear what the
3 definition should be, then you don't have to resort to this extrinsic evidence.
4 If you look at the claim, the case that we cited, it had very similar fact
5 patterns to this. And they didn't go and make other hypotheticals of what
6 could be. They looked at what the intrinsic evidence describes in order to
7 define that claim term.

8 JUDGE GERSTENBLITH: So, is there any figure that shows a view
9 that lets us know to what extent the compartments or drawers extend, how
10 far they extend? Let's say we can see the forward part, right? How far they
11 extend in the other direction? Because when I look at, say, Figure 11 and I
12 look at Figure 10B, which doesn't really show that area, the top of the cart,
13 in other words, the top structure does have a portion that includes being
14 parallel to the -- I'm going to get the term wrong. But the height adjustment
15 mechanism, in other words, there's part that's parallel to that. There's
16 structure there. I don't know what is specifically in there? Because 12 is a
17 cross section. Right. So it's not showing. It's only showing part of the
18 figure. It's not showing the 3D dimension of that. But 13, 14, 11. There is
19 certainly area inside that top structure that doesn't have an image of showing
20 what is actually in there. I don't. I don't want to presume that it's wasted
21 space, in other words, that there would be material there that wouldn't be
22 used. But I don't see how this is necessarily excluded by what's shown,
23 because that area is not actually shown unless I'm missing it. And that's why
24 I'm asking you, am I missing any kind of figure or description of what is
25 parallel to the height adjustment mechanism? And I want to just be clear
26 that you understand the part that I'm talking about.

1 MR. KWAK: Which figure are you referring to? Your Honor?

2 JUDGE GERSTENBLITH: So we can start with Figure 11. Okay.

3 And if you look at where 325 is pointing to.

4 MR. KWAK: Yes.

5 JUDGE GERSTENBLITH: Okay. To the left and the right, there is a
6 fat area is parallel to the height adjustment mechanism which goes, you
7 know, into that top structure. There's area inside there to the left and the
8 right that's parallel to that height adjustment mechanism. Same with Figure
9 10B shows that top sort of giving like the contour of the top. And you can
10 see the height adjustment mechanism comes up and there's area to the left.
11 There's area to the right. Right. Same with the other figures. It shows
12 anything that shows that connection. And we can't see it in Figure 1. Right.
13 Because it's behind it. But anything that shows that connection shows that
14 there is. There is area there. There's space there. And I'm wondering
15 where. Where are we getting the fact that in the patent does not
16 contemplate that there could be a drawer there? Where is that coming from?

17 MR. KWAK: Very, very clearly. The next figure next to it, which is
18 the cross-section view. If you cut a cross section right up the middle, you
19 can see that the drawers are completely in front of the height adjustment
20 mechanism column. So that's, you know, that cross section 12 shows that
21 the drawers are completely in front of that.

22 JUDGE GERSTENBLITH: Cross section 12 doesn't show what's
23 behind the height adjustment mechanism. Right. It's showing, let's say,
24 right at that height adjustment mechanism. Yes. I think we all agree you
25 couldn't have a drawer magically go through that. Right. You didn't
26 demonstrate this exactly with your pen. But you can't have a drawer in the

1 exact same spot that you have the height adjustment mechanism. But we
2 can't see behind this view. Nothing suggesting what's behind this. There's
3 also nothing suggesting what's in front of this. You understand what I'm
4 asking?

5 MR. KWAK: I'm sorry, I'm completely lost here. I'm not sure where
6 you're. Which area you're trying to the front of --

7 JUDGE GERSTENBLITH: I'm saying the height adjustment
8 mechanism is vertically extending. Okay. And it's showing in this picture
9 that there are drawers that go to the left.

10 MR. KWAK: Yes.

11 JUDGE GERSTENBLITH: Okay. This is a cross section. And we
12 know that the height adjustment mechanism is not the width of the drawers.
13 You agree with that?

14 MR. KWAK: Yes, I agree with that.

15 JUDGE GERSTENBLITH: So, we cannot see in this view. If I'm
16 looking at the height adjustment mechanism and I'm wondering what is
17 behind this in the picture? What is. I'm going into the page of the picture.
18 We cannot see what's on the other side of the height adjustment mechanism
19 because this is just showing a cross section through the middle.

20 MR. KWAK: That's correct.

21 JUDGE GERSTENBLITH: So, what I'm asking you is, why is it an
22 impossibility that there is not a drawer on the other side of what we are
23 seeing the other side of the height adjustment mechanism?

24 MR. KWAK: There could be a drawer on the other side of that, Your
25 Honor.

1 JUDGE GERSTENBLITH: I agree with you. There could be. And if
2 there could be a drawer on the other side of that, that drawer is parallel to the
3 height adjustment mechanism from a forward and rearward perspective,
4 correct?

5 MR. KWAK: Exactly. But there is no drawer in this particular
6 patent. I thought you meant hypothetically, could there be a drawer? But if
7 you look at the other figures, there is no drawer on the other side of that.
8 There is no.

9 JUDGE GERSTENBLITH: So which figure concludes. I mean, we
10 were trying to use a figure to conclusively construe a term. I understand if
11 that's the position, but what I'm trying to say is you said it was an
12 impossibility to have a drawer there. And I think we just agreed that it's not
13 impossible. You're just saying that the patent doesn't specifically have a
14 figure showing it.

15 MR. KWAK: Yeah, the intrinsic evidence doesn't have this. Intrinsic
16 evidence doesn't have a drawer there. Yes.

17 JUDGE GERSTENBLITH: Okay. But it's not impossible.

18 MR. KWAK: Hypothetically, it's not impossible, no.

19 JUDGE GERSTENBLITH: Okay, I apologize. I took a lot of your
20 time. If we end up, you know, we can give time back because I took a lot
21 right there to go through all that. But I appreciate you going through that
22 with me. Thank you.

23 MR. KWAK: Thank you, Your Honor. Thank you. Appreciate it.
24 So if we can just move forward to the definition of forward and why forward
25 means in front as being on top. So one of the things that we did argue is that
26 forward is forward. We identified some dictionary definitions, and we

1 argue that the plain and ordinary meaning, forward was in front. And
2 Petitioner did not respond to that particular argument. We want to go into
3 what we believe is a very important part, the disclaimer of Clark. And we
4 talked about how in the examiner interview in the '650 Patent, the examiner
5 and the applicant, which was Rubbermaid at the time, had an interview.
6 And this was after obviously Clark was cited by the examiner, Ellefson,
7 some other references like Murphy. And what they agreed upon was this
8 examiner interview here. They said, okay, the examiner is going to amend
9 the claim to add this movable work surface above the top of at least one
10 compartment. And we're going to do that to all the independent claims.
11 And then look what the examiner says at the bottom highlighted. There was
12 some further discussion directed to the structural compatibility as Ellefson
13 referenced with the examiner suggesting that in combination with the
14 amendment that was discussed above, an argument directed to the structural
15 issues associated with the combination of Clark and Ellefson would likely be
16 persuasive in overcoming the rejections as currently step four.

17 So, what's clear is that not only were they talking about the
18 amendments of adding the movable surface, the examiner was saying, okay,
19 that might not carry the day. We might. We need you to make another
20 argument about why it's not feasible to make this combination of Clark and
21 then maybe we can find that persuasive. And so the next very next action,
22 the amendment, the applicant filed a response to 312, 328 2012 Amendment
23 Response and of course made the exact amendment to the independent
24 claims of adding the movable surface of those requirements. And then he
25 made these arguments. Furthermore, one of ordinary skill would not
26 incorporate the teachings of Rice, Murphy and Ellefson into the workstation

1 of Clark, who has to arrive at a height adjustable work platform with a
2 movable work surface located above a compartment.

3 For example, if one of ordinary skill had tried to incorporate the
4 pivotal trays of Ellefson into the workstation of Clark, a resulting
5 workstation will be top heavy if the trays are deployed. The result is that the
6 deployed trades would make the workstation of Clark unstable so that it
7 would be easily knocked over. What is the example? What is the applicant
8 arguing here? The applicant is basically saying, don't --

9 JUDGE PESLAK: Mr. Kwak, I don't see in either one of these slides
10 any discussion of the word forward. And that's what you seem to be
11 arguing, that this is related to the word forward.

12 MR. KWAK: Yes.

13 JUDGE PESLAK: I don't see that. And you're at your time the first
14 40 minutes, but you can go on. I'll give you some extra time because of the
15 policy. But I don't understand what this has to do with construing the word
16 forward.

17 MR. KWAK: Yes. And if you allow me to continue, I think we'll get
18 to that explanation. So what the applicant was saying here is he's doing
19 exactly what he agreed to with examiner. I'm going to give you a reason
20 why you can't just add in features from Ellefson into Clark to reach the
21 proposed modifications. Because really, you know, what they were saying
22 is if you're just adding a movable surface above a compartment, okay, I can
23 go find these movable surfaces and throw it above the compartment in Clark.
24 And isn't that obvious? And so the examiner wanted more. The examiner
25 said, give me reasons why we can't combine other features of Ellefson and
26 Murphy into the workstation of Clark to reach what you're proposing. And

1 he said, because you can't do that. Clark is intended to be top heavy. It's
2 intended to be higher above the ground. And we'll get to that higher above
3 the ground quote in the next section. But what he's saying is you can't put
4 any other features into the workstation of Clark because it wouldn't support
5 it, it would become unstable, and it would be easier to topple over.

6 And so, he went further in the next paragraph, he says similarly.
7 Similarly, one of ordinary skill in the art will not have any reason to
8 incorporate any features, not just the work surface, any feature of Murphy
9 into the workspace in Clark because Murphy is designed to be low to the
10 ground. And modifying the workstation of Clark with its higher center of
11 gravity, based on the teachings of Murphy, would likely make the resulting
12 workstation top heavy such that it would be easily knocked over. So, what
13 is applicant doing here? Don't add any other feature from these other
14 references into the workstation of Clark. It's not going to work. It's going to
15 be make it unstable and tip over.

16 And so, the examiner and the applicant and the examiner allowed the
17 case right after this. And so, the examiner and the applicant were basically
18 anticipating the arguments that the Petitioner is making on this IPR and
19 disclaim them. They said, don't add any more features into Clark because
20 it's not going to work. Ours is different and yet they're making the exact
21 same argument. They're using Clark. They're saying let's throw up this
22 compartment, this alleged drawer in this vague one sentence, let's throw it up
23 in the workstation of Clark and it's going to meet your claim.

24 JUDGE PESLAK: Counsel, let me tell you what the crux of my
25 thought is on this prosecution disclaimer. First of all, I think you're mixing
26 and matching two things. One, does Clark meet the claim limitation as

1 opposed to claim construction? And I know you made an argument about
2 Clark during prosecution, but you have to disclaim something that's in the
3 claim. The disclaimer has to be clear and unmistakable. There's nothing
4 about center of gravity, top heavy tipping. There's not a word about that in
5 your patent, let alone in the claim. So you can't have a disclaimer that says
6 you can never add anything to Clark, which is what you're arguing, I think.
7 So, can you tell us how this actually relates to language that's in the claim
8 that would create a disclaimer apart from whether or not Clark meets the
9 claim limitations?

10 MR. KWAK: So, if you look at this excerpt where he says one of
11 ordinary skill will not incorporate any feature of Murphy into the
12 workstation of Clark, he goes on to say why Murphy is designed to be low to
13 the ground. Clark is designed with a higher center of gravity. In other
14 words, it's designed to be higher from the ground. The only reason that and
15 if you look at Murphy, you know, it's got a cabinet that's got it's lower to the
16 ground. It's not mounted on top of the height adjustment mechanism. If you
17 look at the claims, the claim limitations at issue and despite it that we're
18 talking about, it says that the compartments are disposed in the forward
19 portion of the height adjustment mechanism. If you dispose it in the front
20 forward portion of the height adjustment mechanism and not on top, it is
21 lower to the ground. That is why it's tied to that. That's exactly what the
22 applicant was saying. We're like Murphy, we're lower to the ground because
23 our cabinet is lower to the ground. It's not on top of the height adjustment
24 mechanism. That's how it's tied to those terms.

25 There's no case law that says that you have to have explicit language
26 that says, oh, and by the way, I'm making these disclaimers of Clark, and it's

1 tied to this claim. It's obvious that that is what is being done. What's clear is
2 that there is a disclaimer of Clark. And what's clear is that they've
3 disclaimed adding any features into Clark. That is absolutely clear. If that
4 disclaimer is clear, they cannot rely on that, especially without an
5 explanation of why those disclaimers 12 years ago saying Clark is different.
6 Adding features to Clark is different. It's not our invention. They at least
7 have to explain what those disclaimers mean then. And instead their expert
8 admitted that they didn't. He didn't address those issues in his petition. And
9 then in the reply, they didn't even submit a declaration from him. So, we
10 had no idea how he or somebody of ordinary skill on the Petitioner's side
11 would construe these disclaimers. We have nothing. All they said was, it's
12 irrelevant. It's just a movable work surface. But obviously it's not. It's other
13 all features. And they didn't have any evidence construing how a person of
14 oriental skill would construe those. Would construe those disclaimers. But I
15 just go back to this --

16 JUDGE PESLAK: Counsel, I just want to make sure you understood
17 my question. We have to have a disclaimer of what's in the claim. You're
18 talking about this word forward. And now you're trying to. Now we have to
19 focus on the claim, not what Clark teaches. How does this disclaimer
20 affect the claim language if there is a disclaimer?

21 JUDGE GERSTENBLITH: Can I? I apologize, and I don't want to
22 hijack Judge Peslak's question, but, counsel, let me just ask you just to be so
23 I can be 100 percent clear, what we're talking about here in Patent Owner's.
24 Is this issue only for the 1275 case, or is this issue also for the 1274 case?

25 MR. KWAK: It's for both, because there's the exact same claim
26 language, the same exact same limitations in both patents.

1 JUDGE GERSTENBLITH: Okay, so if I look at. I have the 1274 file
2 open, so I'm going to ask you about this one first. This is about the
3 construction of forward, which is what this slide 17 says. Correct? And on
4 page 31, I guess it's 30 to 31 of Patent Owner's response, Patent Owner is
5 saying that the term. See, the term forward means in front. That is the
6 construction that Patent Owner wants. Is that correct?

7 MR. KWAK: And not on top.

8 JUDGE GERSTENBLITH: And not on top. But that's not listed
9 here. Right? You're just saying compartments are contained in the portion
10 of the work platform projecting in front of height adjustment mechanism. It
11 means in front.

12 MR. KWAK: And I'm sorry --

13 JUDGE GERSTENBLITH: No, no, please, go ahead.

14 MR. KWAK: No, what I'm saying is, and we did say that in the, in
15 one of our briefing, is that forward means in front, which can't mean on top,
16 because then that would bring it in exactly what Clark is. So that's what we
17 argue with what forward means.

18 JUDGE GERSTENBLITH: Okay, and you're saying that Clark has
19 on top because why?

20 MR. KWAK: Based on the disclaimers and based on the description
21 that's on top, Clark is described as being on top of the height adjustment
22 mechanism. So it's intended to be higher off the ground.

23 JUDGE GERSTENBLITH: Is there a figure that you're pointing to in
24 Clark? Like, where are you getting this from in Clark that it's on top of?

25 MR. KWAK: Yes, we can bring up Clark. It's just -- let me see.

26 Well, we do have it in the presentation here. I'll get it. So Clark, if you go.

1 This is a figure of Clark. Actually, if we can find. This is an annotated
2 figure of Clark. In this figure, that red drawer is something the attorney
3 drew in. And the blue coloring isn't there. But see, this is the Clark cart.
4 And you can see this is a height adjustment mechanism, and it's mounted on
5 top. And there's no drawers disclosed here. This is the forward direction.
6 That's where the drawers are in the patented invention, and theirs is on top.

7 JUDGE GERSTENBLITH: So let me just make sure I understand
8 this completely. So if we were to say that Clark at least suggests that a
9 drawer could be mounted where this red box is, which this is slide 22. If
10 Clark suggests that a drawer could be there, do you agree that that's in front
11 of the height adjustment mechanism and satisfies the claim language, even
12 under whatever construction you're reading that term to mean. Is that
13 correct?

14 MR. KWAK: Yes. If there was a disclosure in Clark that the drawer
15 was at that location of the red box, that would meet the claim limitation.
16 That would be in front. But Clark doesn't. They drew. The Petitioner just
17 drew that red word box in there.

18 JUDGE GERSTENBLITH: Okay. And that would also be the case
19 in. Let's see. I think in your sur-reply, you have multiple possible locations
20 of where Clark could. Somebody could understand a drawer to be located.
21 And in each of them, that drawer at least has part of it in front of the height
22 adjustment mechanism. Not on top of.

23 MR. KWAK: No, I don't believe that to be the case. There was one
24 embodiment where if you put the drawer on top of the height adjustment
25 mechanism, but under that blue portion, it would still be on top. And I do --

1 JUDGE GERSTENBLITH: So, what part in Clark do you consider
2 the -- so if you go back to. Let's take this figure. Actually, you don't have a
3 figure of. Let's see. I think there was a better Figure 12. Not Figure 12, a
4 figure of Clark. If I -- yeah, okay. Right. So I know there was some dispute
5 with the expert testimony, but this is not the best one either. But want to try
6 to. Was trying to find the best. I think it's Figure 4a and 4b. Well, 4b with
7 Clark. That shows that there's some part of the height adjustment
8 mechanism that's extending up to, I guess, the top of 12. So let's. We can
9 take the one you're showing, 2B on your slide 26. There's some part of that
10 that's extending up to the top part of 12, right?

11 MR. KWAK: Yes.

12 JUDGE GERSTENBLITH: Okay.

13 MR. KWAK: So.

14 JUDGE GERSTENBLITH: Right. So that part, when you say
15 mounted on top of the height adjustment mechanism is the entire vertical
16 structure that's going from the base all the way up to where it's somehow
17 mounting into the top of that structure 12.

18 MR. KWAK: Yeah. This is the height adjustment mechanism here.

19 JUDGE GERSTENBLITH: Okay. So while it's -- I guess my
20 question is the notion of on top of. When the height adjustment mechanism
21 comes into that structure, it's on the top, but it's also within.

22 MR. KWAK: Exactly. But what the claim limitation said is that the
23 drawers are projecting from the height adjustment mechanism. And that
24 means this portion here, that the portion that goes up the middle is just a
25 button to press the gas spring. Nothing projects from that. So that can't
26 meet the portion of the height adjustment. What I'm saying is that nothing

1 projects from that portion that goes up the middle. What the drawers is
2 projecting from this portion in yellow. Not the portion that -- the little
3 button, which is basically. If you take the cover of the height adjustment
4 mechanism off, you have the inside shaft 72. That's the portion that goes up
5 here. And that this actuator comes down and presses down on that to raise
6 up the height adjustment mechanism. But nothing projects from that. And
7 so, this argument of theirs is, you know, basically smokescreen. I mean, it's.
8 Nothing projects from that portion. And that's what the claim requires.

9 JUDGE GERSTENBLITH: Okay, I think I understand what you're
10 saying. But you do agree that the height adjustment mechanism of Clark
11 goes all the way up to that top part of 12.

12 MR. KWAK: The button part, the inner shaft 72. That's inside the
13 cover of portion 22. Part of it goes into the --

14 JUDGE GERSTENBLITH: Yeah, correct. And that part is also
15 considered the height adjustment mechanism. In other words, it's part of the
16 height adjustment mechanism.

17 MR. KWAK: Yeah. I didn't look at that issue, Your Honor, that
18 closely. Yeah, I've got a -- I know that it's the actuator, that shaft that
19 connects to the gas spring that makes it go up. I'm not sure I have to look at
20 that question, Your Honor, but it certainly doesn't. Nothing projects off that.
21 The compartments don't project off that. So I don't think that's.

22 JUDGE GERSTENBLITH: I know that we took a lot of your time
23 and I don't want to extend it beyond too much, but I do want to ask you
24 about the objective indicia questions before we go over to Petitioner for their
25 rebuttal or, you know, if we don't, then you won't be able to talk about it in
26 your sur-reply unless they raise it. So when I say sur-reply I mean your sur-

1 rebuttal. So I just want to ask you a few things and then I'm going to stop.
2 And then I believe you're, you're pretty much I don't know if you're out of
3 time or about to be out of time, so I would suggest you save the rest of the
4 time for after. But I'm going to come to this. So, I had asked about
5 commercial success and praise, which in the 1274 case starts at page 61 of
6 the Patent Owner response and the only evidence that Patent Owner is citing
7 is the Rydingsward declaration for that in support of that argument. Is that?
8 And I believe you said that that's correct, but I just want to make sure.

9 MR. KWAK: Sure, I believe that's correct.

10 JUDGE GERSTENBLITH: Okay. And I believe you also said that
11 you did not submit any sales information or data numbers, monetary
12 numbers or unit numbers or any other information like that. Is that correct?

13 MR. KWAK: Yes, that's correct.

14 JUDGE GERSTENBLITH: Okay. And you also don't have any
15 evidence specifically on praise beyond Mr. Rydingsward's declaration that
16 customers had appreciated and respected the cart, the medical carts, that, I
17 understand that right? Okay.

18 MR. KWAK: Yes, that's correct.

19 JUDGE GERSTENBLITH: And then I'm going to go to copying. So,
20 the next thing that Patent Owner argues is that after the applications were
21 filed, others copied patented features and started to sell them. This is citing
22 to paragraph 18 of Mr. Rydingsward's declaration. Patent Owner doesn't
23 submit any claim charts or other evidence at all showing what any of the
24 other industry quote unquote, major players, any of their carts, comparing
25 them to any of the claims in either of the patents, is that right?

1 MR. KWAK: Yes, that's right. And if I can I explain why we didn't
2 do that? We didn't think we needed to do that.

3 JUDGE GERSTENBLITH: Sure.

4 MR. KWAK: We didn't think we needed to do that because we tied it
5 to the very specific limitation that's at issue here today in the claims, which
6 is the feature that's claimed of having the compartments disposed in front of
7 the height adjustment mechanism. And we focused on that particular feature
8 of the claim, and we provided evidence that before patents at issue, none of
9 the competitors had that particular placement of the doors in front of the
10 height adjustment mechanism. But after the patents came out they did copy
11 that. So we did just concentrate on that particular feature.

12 JUDGE GERSTENBLITH: Okay, but even with that feature, you
13 don't have any picture, document, or other support or anything showing what
14 those products look like, correct?

15 MR. KWAK: Well, we don't. We have a picture obviously of the
16 Petitioner's carts. I don't know if we put those in the record, but the
17 Petitioner's carts and our carts, I don't know. I'd have to go back and look at
18 --

19 JUDGE GERSTENBLITH: Yeah, I would say if it's not in the -- it's
20 certainly not discussed in this section and it's certainly not cited to in the
21 declaration. So I don't know if it's in the record somewhere else, but it's not
22 in the record for this point. The next section by Patent Owner is called long
23 felt need and failure of others. And again, actually in this section, there's no
24 citation to anything not Mr. Rydingsward's declaration or any other
25 evidence. So what? Exactly? Maybe there isn't. But am I missing
26 something? Does Patent Owner have any evidence at all that's actually cited

1 that others had tried to make a cart that has some aspect of this claim or
2 claims that and failed or that there was a long felt need for something that
3 matches this claim?

4 MR. KWAK: Yeah. Other than Craig Rydingsward's declaration, we
5 did cite to the patent of Petitioner's own expert Kemnitzer, who has filed the
6 patent application for a couple few years at least before the patent issue,
7 where he was trying to solve that exact issue and he didn't come up with a
8 solution of putting the compartments in the front of the path adjustment,
9 nothing, used the kickstands instead. And that was our evidence to that.

10 JUDGE GERSTENBLITH: Okay. Okay. All right. I don't have any
11 other questions. Thank you.

12 MR. KWAK: If I could just conclude, Your Honors, real quick. You
13 know, we talked about the disclaimers in depth and the judge asked, you
14 know, how is that tied to the claims? It's tied to the claims through the
15 limitations that we've been talking about, which is the placement of the
16 compartments in front, the front projecting portion of the height adjustment
17 mechanism and not the top. And because you're placing it in the front, it's
18 lower to the ground when compared to putting it on top of the height
19 adjustment mechanism as shown in Clark. And because that placement of
20 the drawers in front similar to the lowering of the cabinets and Murphy and
21 things like that, they're arguing the same thing, that this, these disclaimers
22 are different, these disclaimers of Clark, meaning that it's top mounted, it's
23 designed to be higher to the ground, is different from the claimed invention,
24 which is designed to be lower to the ground like Murphy, because the
25 compartments are in front and not on top of the height adjustment
26 mechanism. And that's how it is tied to the claims, these disclaimers.

1 And the last thing I want to say is we've all looked at these, you know,
2 Petitioners counsel, we looked at the intrinsic evidence over and over. And I
3 keep asking myself the question, how can Petitioners arguments prevail
4 here? They're using the exact same Clark reference, virtually the same
5 arguments that were overcome in this claim. And they didn't answer that
6 question. It's their duty to answer why. How can you make the same exact
7 arguments that were overcome and then not even explain it? They just
8 waved it off saying it's irrelevant. How can that be the winning argument
9 here? They have not presented the factual findings necessary to make the
10 prima facie case, especially with the disclaimers. How can they argue the
11 same exact argument?

12 So, in other words, Clark is the exact reference in the examinations.
13 They disclaimed adding the pivotal tray of Ellefson above the workstation.
14 And now they're trying to say this big pull out drawer of Clark and sentence
15 can be put above the compartment, which now I don't even know if they can
16 argue that because the keyboard tray, they've said that they're okay with the
17 compartment being not being enclosed or the compartment being closed.
18 That keyboard tray of Clark is not enclosed, it's open keyboard tray. So that
19 can't be the compartment. So they can't just add a tray above that like they
20 argued and meet the claim limitations. They have to throw a compartment
21 in the workstation now underneath the keyboard tray to meet these claim
22 limitations. And to do that, they would have to do exactly what was
23 disclaimed. Adding a feature of the prior art into that workstation. And that
24 was disclaimed.

1 JUDGE GERSTENBLITH: And so, counsel, I don't mean to extend
2 the time, but I believe your argument is that the applicant disclaimed any
3 modification of a reference. That's what it sounds like you're saying.

4 MR. KWAK: What I'm saying --

5 JUDGE GERSTENBLITH: They disclaimed that a reference can be
6 modified. And I've never heard anybody make that argument before.

7 MR. KWAK: I'm sorry, Your Honor, I did not, I did not mean to say
8 that. What I'm saying is they disclaimed adding the Clark reference, and
9 they disclaimed adding any features from the prior art, like the drawers and
10 the work surfaces like that, into the top workstation of Clark. That's clear.
11 They disclaim Clark and adding features from the prior art into that top
12 workstation. That's what they --

13 JUDGE GERSTENBLITH: And there is no ability by an applicant to
14 disclaim something like that. Because basically what you're trying to tell us
15 is the applicant tried to say, hey guys, this reference can never make my
16 claims obvious because you can't add anything to it. And that makes
17 absolutely no sense. I apologize.

18 MR. KWAK: What I'm trying to argue is that they disclaim, and they
19 distinguish that. They said our invention is different because -- Clark is
20 different, because you cannot add these features in there because it would
21 add me to an unstable device that would be easier to tip over. So we're not
22 saying we can never modify it, but at least make an argument that's different
23 than what was disclaimed.

24 JUDGE GERSTENBLITH: So, I have no problem if you want to say
25 that they argued one of skill in the art would not have modified Clark
26 because it would make it unstable. Fine, they can argue that. But as Judge

1 Peslak was saying, that is not a disclaimer of something in the claim. We
2 don't have to agree on this point. That is not a disclaimer. It is an argument
3 against obviousness based on a combination where an applicant is saying
4 one would not have been motivated to do this for this reason. But that is not
5 a disclaimer of something in the claim because there is no limitation in the
6 claim that this applies to. It is an argument about whether something would
7 have been obvious to do. Now, again, we can agree to disagree. You're out
8 of time. So we're going to stop here and we'll come back with additional
9 time. And Judge Peslak, I'm going to turn it over to you for what we do
10 now.

11 JUDGE PESLAK: Okay, thank you. Thank you, Mr. Kwak. We did
12 use all your time, but we asked a lot of questions, which is very helpful to us
13 to get the information we need. We will give you 10 minutes for rebuttal.
14 Petitioner actually has 30 minutes. We're hoping they don't use the entire
15 30 minutes, but we'll give you 10 minutes. And right now it's 12:03. We're
16 going to take a five minute break and come back at 12:08.

17 (Recess)

18 JUDGE PESLAK: We're back, we're back on the record. It's
19 Petitioner's turn. You have --

20 JUDGE GERSTENBLITH: Judge Peslak, before we turn over to
21 Petitioner, I just wanted to apologize to Mr. Kwak. Mr. Kwak, I got a little
22 bit excited in that last exchange back and forth. I understand you're
23 advocating for your client. I appreciate that. So I just wanted you to know
24 that I apologize for getting a little excited there. Go ahead, Judge Peslak.
25 Sorry about that.

26 JUDGE PESLAK: Mr. Jordan, you have 30 minutes. You can begin.

1 MR. JORDAN: Thank you, Your Honor. Daniel Jordan for
2 Petitioner. The first item, I just wanted to get back with you on a case cite
3 that you asked me for on the opening understanding, it may no longer be
4 needed. But as for claim construction between PTAB and the District Court,
5 a case to a case on point *Skyhawk Texts LLC. v. DECA International Corp.*,
6 828 F3D 1373. That's Federal Circuit 2016. The second point I'd just like to
7 make is counsel for Patent Owner about the height adjustment mapping in
8 the petition and what it includes, I would just like to point to the petition
9 does include shaft 72 in addition to vertical beam 22 and the gas spring
10 height adjustment mechanism 74. And that's on page 28 of the petition for
11 the '668 Patent. And on page 25 and 26 of the petition for the '650 Patent.

12 The last thing I'd just like to conclude with is to address Mr. Kwak's
13 argument about the Petitioner including Clark as a ground in this
14 proceeding. I'd like to point out that both petitions included the 325D
15 section in those petitions explaining just why that's proper in this situation.
16 And the board has reviewed those. With that, I have no further points to
17 make. I have plenty of time to address any questions from the Board.

18 JUDGE PESLAK: Judge Gerstenblith, any questions?

19 JUDGE GERSTENBLITH: No. No questions.

20 JUDGE PESLAK: Okay. Judge Meyers?

21 JUDGE MEYERS: No questions. Thank you, Mr. Jordan. Nice job.

22 MR. JORDAN: Thank you very much.

23 JUDGE PESLAK: Mr. Kwak, you have 10 minutes to respond to
24 anything Petitioner said.

25 MR. KWAK: Yes, sir. I just, am I allowed to talk about the case that
26 you asked for in terms of why the final histories of –

1 JUDGE PESLAK: Oh, yes.

2 MR. KWAK: Okay. So in the response that we filed in footnote 5,
3 we did cite to the *Amber.IO* in case in footnote 5 as support for that. So I
4 just want to conclude with saying, addressing the point about that you can't
5 just exclude modifying Clark forever. And that's not what we're trying to
6 say. And maybe I didn't artfully present my oral arguments here today, but
7 what I'm saying is you can't. You shouldn't be able to argue the same
8 modifications of Clark that were already overcome and disclaimed. I'm not
9 saying you can never modify Clark, but just don't make the same
10 modifications that were disclaiming and overcome. And if you do, at least
11 explain why those disclaimers before apply differently today than they were
12 back then, which they didn't do. They didn't provide any expert analysis of
13 how somebody of ordinary skill would look at those disclaimers regarding
14 instability and things like that. If you look at the disclaimers around
15 Ellefson, they said, and the examiner made him put these arguments in about
16 the incompatibility of Ellefson and Murphy, he said you can. Ours is
17 different than adding in these other features of the moveable tray or any
18 other features of Murphy into the workspace in Clark. You can't just do that
19 because these things would add to the weight of the top workstation of Clark
20 and it would cause it to be unstable.

21 Unlike Clark, these Murphy and the present invention is designed to
22 be lower to the ground. Why is it lower to the ground? Because the
23 compartments are in front, not on top of the height adjustment mechanism.
24 It is tied to the claims. So again, I've asked myself over and over, how can
25 Petitioner make the same? Bring the same Clark reference that was
26 disclaimed, making essentially the same arguments of adding features from

1 the other references into the workstation, and that was disclaimed and
2 overcome? How can they make the same arguments and expect to win this
3 IPR, especially when they haven't explained it, given an alternative
4 explanation through somebody of ordinary skill in the art of how they would
5 construe that, and because they haven't met that burden, their IPRs must fail.
6 Thank you.

7 JUDGE PESLAK: Okay, thank you, Mr. Kwak. The hearing is over.
8 The case is submitted. We'll issue our decision in due course. I want to
9 thank both counsel today for an excellent and informative presentation. Mr.
10 Jordan, I know you're a LEAP practitioner, so we look forward to having
11 you appear before us again in the future. And the parties just stay on for a
12 moment in case the court reporter needs spellings or any clarifications. So
13 with that, thank you. Have a good day. Have a good weekend.

14 MR. KWAK: Thank you, Your Honors.

15 MR. JORDAN: Thank you, Your Honors.

16 JUDGE GERSTENBLITH: Thank you. Happy holidays to
17 everybody.

18 (Whereupon, the proceedings at 12:14 p.m. were concluded.)

IPR2023-01274 (Patent 7,594,668 B2)

IPR2023-01275 (Patent 8,215,650 B2)

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