

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

UMBRA TECHNOLOGIES LTD.,
Patent Owner.

IPR2024-00344
Patent 11,146,632 B2

Record of Oral Hearing
Held: April 22, 2025

Before ST. JOHN COURTENAY III, MICHAEL R. ZECHER, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Tuesday, April 22, 2025, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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JUDGE COURTENAY: Well, good afternoon, everyone. My name is Judge Courtenay. With me today are two of my colleagues. On my right is Judge Zecher, and we have Judge Anderson, who's remote today. This hearing is for IPR2024-00344. The claims at issue are claims 1 through 7 of U.S. Patent Number 11,146,632. Okay.

So let's do a roll call. Who's here today? Let's start with the Petitioner, Cisco Systems.

MR. POWERS: Joseph Powers from Duane Morris on behalf of the Petitioner, Cisco Systems. And with me is my colleagues, Patrick McPherson and Patrick Muldoon.

JUDGE COURTENAY: Okay. Mr. Powers, are you going to be arguing today?

MR. POWERS: I am, Your Honor.

JUDGE COURTENAY: Okay. Okay. Patent Owner?

MR. DEVLIN: Tim Devlin of Devlin Law Firm on behalf of Patent Owner, UMBRA.

JUDGE COURTENAY: Your last name, please, can you spell it?

MR. DEVLIN: Devlin, D as in David-E-V as in Victor-L-I-N as in Nancy.

JUDGE COURTENAY: I'm sorry, one more time, please.

MR. DEVLIN: Sure.. D as in David --

JUDGE COURTENAY: Okay.

MR. DEVLIN: -- E-V as in Victor-L-I-N as in Nancy. Devlin.

JUDGE COURTENAY: Devlin. Devlin, D-E-V-L-I-N. Got it.

1 MR. DEVLIN: Thank you, Your Honor.

2 JUDGE COURTENAY: Okay.

3 MR. DEVLIN: And with me I have Patrick Delaney from our firm,
4 also.

5 JUDGE COURTENAY: Okay. I'd like to welcome all of you to
6 PTAB and the Board and the USPTO today. So we have a few things that
7 are just matters of procedure I need to go over. We have the order setting
8 oral argument. That was Paper 28. We outlined how this hearing is going to
9 be conducted today.

10 Each party, the Petitioner and the Patent Owner, you get a total of 45
11 minutes of argument time and you can reserve any portion for your -- for the
12 Petitioner for the rebuttal and for the Patent Owner, the surrebuttal time.

13 So the Petitioner has the burden of persuasion, so you're going to
14 start first. And when we get to the rebuttal portion of the hearing, your
15 arguments must be responsive to the arguments the opposing party made in
16 the immediately preceding presentation. And so try -- you know, we have a
17 rule you can't introduce any new arguments at this hearing. You know,
18 everything needs to be briefed. So don't introduce any new arguments in the
19 rebuttal stage of the hearing.

20 Okay. If -- we do have -- actually, the only person here is the Judge
21 who's remote, so I don't think he's going to get disconnected, so you don't
22 have to worry about that disconnection problem today.

23 Okay. So we have those ground rules in place. So, Petitioner, you
24 can start at any time.

25 Thank you, Your Honor.

1 JUDGE ZECHER: Can you let us know how much time you want to
2 reserve for rebuttal?

3 MR. POWERS: Yes, Your Honor. Joe Powers, on behalf of the
4 Petitioner, Cisco Systems. I'd like to reserve 15 minutes for rebuttal.

5 May I proceed, Your Honors?

6 JUDGE ZECHER: Proceed when you're ready.

7 MR. POWERS: Thank you. Your Honors, we have in the petition a
8 single ground challenging each of claims 1 through 7 of the '632 patent with
9 only claim 1 being an independent claim. It is a single reference
10 obviousness challenge based on the prior art, which has been referred to as
11 *Agarwala* in the petition. And *Agarwala* has been defined as the disclosure
12 quote, "Together the '421 patent and the incorporated '685 provisional are
13 referred to herein as '*Agarwala*'." And it's important to note, as we'll see as
14 we move through, that the '421 patent incorporates by reference in its
15 entirety the disclosure of the 4 -- excuse me, of the '685 provisional
16 application.

17 Now, with reference to demonstrative slide 3, we have an overview
18 of the disputes between the parties, at least as they stood in the Patent Owner
19 response. And the first dispute was whether *Agarwala* discloses limitation
20 1.4 of claim 1. That's the only limitation that Patent Owner disputes. And it
21 does. There's also a dispute number 2 with respect to whether data beacons
22 as used in the preamble of claim 1 is a limitation and the Board correctly
23 found in the Institution Decision that it was not. The third dispute is directed
24 to the scope of the disclosure of the *Agarwala* reference and its
25 incorporation by reference of the '685 provisional application. And finally,
26 there was a dispute, at least as teed up in the Patent Owner response, as to

1 whether *Dynamic Drinkware* analysis is required. And it is not, being that
2 the '632 patent is an AIA patent.

3 If you look at the slides, the demonstratives of the Patent Owner, I
4 think only issues 2 and 3 may be live. But I can take these in any order if
5 you have a preference. Otherwise, I'll just proceed in order.

6 JUDGE COURTENAY: Okay. Proceed.

7 MR. POWERS: With respect to demonstrative slide 4, and now slide
8 5 will give an overview of the ground 1 based on *Agarwala*. Here on slide 5
9 we have claim 1 of the '632 patent. It's directed to a network system for
10 providing data beacons. And just by way of preview, that data beacons
11 limitation is the one I refer to as the preamble dispute over whether it's a
12 limitation or not. As we will see, the rest of the claim defines a structurally
13 complete invention and doesn't refer back to the data beacon's limitation at
14 all.

15 So the first element of claim 1 and we've color-coded claim 1 in the
16 same manner we color-coded it vis-à-vis how it aligns with the disclosure of
17 the '632 patent as well as how it aligns with the disclosure of *Agarwala*.
18 Claim 1's first element is a first node in green that comprises a first read
19 queue in blue, a first write queue in red, and a first parallel file system in
20 purple. Then there's a second node that we've also color-coded in orange
21 and that comprises the same limitations: a second read queue, a second
22 write queue, and a second parallel file system.

23 From there, the claim merely defines how data moves within this
24 network system, specifically between nodes. The first node -- excuse me,
25 the first wherein clause recites "wherein the first node writes first data from
26 the first write queue to the second parallel file system." And we've shown

1 that in the petition using a blue arrow. So we have data being written from
2 the first write queue of the first node to the second parallel file system of the
3 second node. From there, in the last wherein clause, the claim recites that
4 "the second node reads the first data from the second parallel file system and
5 places the first data in the second read queue." So data is moving intranodal
6 from the second parallel file system to the read queue of the second node.

7 JUDGE COURTENAY: Okay. And I believe that's all illustrated in
8 figure 13 of the reference.

9 MR. POWERS: That is correct, Your Honor. Now --

10 JUDGE COURTENAY: I'm sorry, the patent. I'm sorry, the patent.
11 The '632 patent is figure 13. You have all that supported for the body of
12 claim 1.

13 MR. POWERS: That is correct, Your Honor. And with reference to
14 demonstrative slide 6, that is what we show here.

15 JUDGE COURTENAY: Okay.

16 MR. POWERS: The bottom portion of figure 13 closely tracks what
17 we just went through in claim 1. You've got the first node shown in green,
18 the second node in orange. Each node has a read queue in blue, a write
19 queue in red, parallel file system in purple. And you can see with the blue
20 arrow, there is a write of data from the write queue of the first node to the
21 parallel file system of the second.

22 JUDGE COURTENAY: Okay. So that depicts the data flow, as you
23 claimed, in the body of claim 1.

24 MR. POWERS: That is correct.

25 JUDGE COURTENAY: Okay.

1 MR. POWERS: And just to finish that off, you can see in the red
2 arrow that's taking the data from the parallel file system to the read queue of
3 the second node.

4 JUDGE COURTENAY: Okay, the bottom right?

5 MR. POWERS: Yes.

6 JUDGE COURTENAY: Of figure 13.

7 MR. POWERS: And with reference to demonstrative slide 7,
8 *Agarwala* has a parallel disclosure to that of the '632 patent. It just uses
9 some slightly different terminology. In *Agarwala*, this is figure 2 contained
10 in both the '685 provisional and in the '421 patent. Figure 2 is a storage
11 controller server 200. We've outlined in red *Agarwala*'s write cache, which
12 corresponds to the write queue of the '632 patent. In blue there's a read
13 cache 210, which corresponds to the read queue of the '632 patent. And then
14 there's a file system layer 214, which corresponds to the parallel file system
15 of the '632 patent.

16 Turning to demonstrative slide 8 and continuing with our color-
17 coding, we have *Agarwala* discloses that its network system has multiple
18 storage nodes. And we've identified a first storage node 302A in green and a
19 second storage node 302B in orange. *Agarwala* discloses that its storage
20 node has high-speed cache, and that includes the read cache and the write
21 cache that we looked at on the previous screen. And it, also has the
22 persistent storage in purple. And we'll see our blue arrow tracks the write of
23 data from the write cache of *Agarwala* in the first node to the persistent
24 storage in the second node. And specifically it goes through a module called
25 the asynchronous replication module, which replicates data from one node to
26 a second node.

1 Now, turning to -- and maybe a step back, we do not show in this
2 particular figure the data going from the persistent storage of the second
3 node to the read cache of the second node. But we'll talk about that in the
4 next section, which is the dispute over limitation 1.4.

5 Returning to the first dispute, demonstrative slide 9, and now 10, the
6 only limitation that Patent Owner has disputed, at least in the Patent Owner
7 response, that *Agarwala* does not disclose is limitation 1.4. And this is the
8 one that's directed to the reading of the data from the second parallel file
9 system into the read queue of the second node, so it's an intranodal transfer
10 of the first data.

11 Now, the Patent Owner does not dispute limitation 1.3. So there's no
12 dispute that data comes from the first node via the first node's write queue to
13 the second node of *Agarwala* into its parallel file system, which is the
14 persistent storage of *Agarwala*. So we have data that's already moved into
15 the persistent storage of this second node.

16 And with respect to demonstrative slide 11, that's just a recap of
17 what we went over before. Data going from the first node to the second
18 node, that checks the box with limitation 1.3.

19 Now, with respect to demonstrative slide 12, *Agarwala* demonstrates
20 that there is an intranodal transfer of data from the persistent storage into the
21 read cache. By way of example, and this is the petition page 21 in the
22 petition reply page 9, *Agarwala* discloses at 8:27 to 29, "In one embodiment,
23 an object is initially read from the SSD-412 or the HDD-410," that's the
24 persistent storage of *Agarwala*, "and added to the L1 cache 402," the L1
25 cache being the read cache of *Agarwala*.

1 With respect to demonstrative slide 13, the petition shows that
2 *Agarwala* demonstrates a particular scenario in which this reading of data
3 from the persistent storage to the read cache would occur and it occurs on a
4 cache miss. *Agarwala* explains at 10:44, 51 that, "In one embodiment, the
5 L2 cache works as follows: On L1 cache miss, the object is looked in the L2
6 cache. If there's a hit, the object is read and promoted to the MFU list in the
7 L1 cache," MFU being most frequently used. Importantly, "If there is a
8 miss, the object is read from the storFS persistent store and promoted to the
9 MRU list in the L1 cache," MRU being most recently used.

10 So we've established in element 1.3 data is written from the first
11 node to the second node into the persistent storage of *Agarwala*. From there
12 the data is to be used. It is read from the persistent storage of *Agarwala's*
13 second node into *Agarwala's* read cache. And that happens upon a cache
14 miss.

15 JUDGE COURTENAY: Okay. So aside from the preamble, the only
16 limitation is 1.4 that's in dispute here between you, the Petitioner, and the
17 Patent Owner?

18 MR. POWERS: Correct, Your Honor.

19 JUDGE COURTENAY: Okay. And I recall we went into the
20 preamble issue in the DI --

21 MR. POWERS: Yes.

22 JUDGE COURTENAY: -- I believe.

23 MR. POWERS: And I will speak now to the preamble --

24 JUDGE COURTENAY: Okay.

25 MR. POWERS: -- issue unless there's any questions on the first
26 dispute.

1 JUDGE COURTENAY: Any questions from the Panel?

2 JUDGE ZECHER: Not on the first dispute, but when you get into the
3 preamble issue, could you focus more on the prosecution history? Because
4 that appears to be what Patent Owner's relying on.

5 MR. POWERS: Again, Your Honor --

6 JUDGE ZECHER: -- to demonstrate that data beacons is -- should be
7 given patentable weight.

8 MR. POWERS: I'm on demonstrative slide 15 right now. The
9 preamble is not a limitation of this claim. This claim has all of the hallmarks
10 of a claim where a preamble should not be found to be limiting. The
11 preamble is only recited -- excuse me, the data beacons limitation is only
12 recited in the preamble. The body of the claim defines a structurally
13 complete invention on its own, with the write queues and the read queues
14 and the parallel file systems. It never refers back to the data beacons
15 limitation for any sort of antecedent basis or to impart any additional
16 structure to the claim. And the claim on its face, the preamble merely recites
17 an intended purpose of the network system and it's, quote, "for providing
18 data beacons."

19 JUDGE COURTENAY: I recall there was also an issue about
20 whether we have essential structure in the preamble. And I believe Patent
21 Owner in the records said that the data beacon was a signal and that's not
22 structure. I believe I recall that from the DI.

23 MR. POWERS: That is a good preview to my next point, Your
24 Honor. I'm on demonstrative slide 16. You're correct. In their Patent
25 Owner preliminary response, they said that the "data beacon refers to a
26 signal delivered via one-way casting or one-way multicasting." And I think

1 as the Board correctly found in the Institution Decision, the fact that the data
2 beacons is a signal merely reinforces that it doesn't impart any additional
3 structure to this claim. The structure of the claim is defined in the body of
4 the claim and it's structurally complete without the preamble.

5 And as Your Honor noted, there is a heavy reliance by Patent Owner
6 on the data beacon limitation and the prosecution. So I'll jump right to there
7 on slide 16. So, I'm sorry, slide --

8 JUDGE COURTENAY: As I recall the patent in this case, the '632
9 patent is a first action issue by the patent Examiner. Right? So there was
10 really de minimis prosecution history as I recall.

11 MR. POWERS: That is certainly true. And I'm on demonstrative
12 slide 20, so --

13 JUDGE COURTENAY: Okay. Proceed.

14 MR. POWERS: -- typically if you were to try and assert that a
15 preamble limitation was a limitation of the claim based on prosecution,
16 you'd expect to see a very robust back and forth between the Patent Owner --
17 or the patent Applicant at the time and the Patent Office, substantive
18 examination where there's a rejection, characterization of the invention,
19 perhaps an amendment of the limitation into the preamble. None of that
20 occurred here.

21 There was a first action allowance of the application and in that
22 notice allowance the Examiner stated, quote, "However, those references,"
23 those are the references the Examiner was able to find, "deal with mobile
24 networks, and do not disclose any information about read queues, write
25 queues, or parallel file systems," end quote. The Examiner expressly relied
26 on the elements that are in the body of the claim --

1 JUDGE COURTENAY: In the body of the claim.

2 MR. POWERS: -- the structurally complete aspects of the claim.

3 JUDGE COURTENAY: Gotcha. Okay.

4 MR. POWERS: So, Your Honor, on those, we believe that, you
5 know, the preamble, certainly the prosecution doesn't move the needle here
6 towards the preamble being a limitation.

7 JUDGE COURTENAY: Okay. So as I understand you, the limited
8 de minimis prosecution history, the Examiner is referring to elements in the
9 body of the claim and there's nothing about the data beacon.

10 MR. POWERS: That is correct, Your Honor.

11 JUDGE COURTENAY: in this reasons, notice of allowance.

12 MR. POWERS: The other argument that Patent Owner is making
13 here is that, and I'm on demonstrative slide, let's say, 17, they're making an
14 argument that "data beacons" is used throughout the entire specification and
15 it's argued to be an important limitation and part of the invention was.

16 Well, data beacon as a term is only used twice in the specification
17 outside of claim 1. And it's simply two cites in the specification: one in the
18 abstract, one at 7:30 to 31. The specification simply says, "Systems and
19 methods for providing data beacons are disclosed." That's the sum total of
20 the use of data beacons in the specification.

21 If we turn to slide 18, what Patent Owner does is they point to the
22 specification's description of "Slingshot" technology and "data beacon
23 pulsers powered by technology the patent calls 'Information Slingshot.'"
24 And you'll see these citations and types of citations on demonstrative slide
25 29 of their presentation.

1 And as the Board correctly found in the Institution Decision of with
2 respect to demonstrative slide 19, this isn't claim technology. Data beacon
3 pulsers aren't claim technology. Slingshot isn't claim technology. And
4 Board addressed these same arguments in the Institution Decision and found
5 correctly, quote, "None of these features are recited in any of the challenged
6 claims," end quote.

7 If Your Honors do not have any questions, I'll move on to dispute
8 number 3.

9 JUDGE COURTENAY: Proceed.

10 MR. POWERS: Now, this dispute is all about the scope of the
11 *Agarwala* reference and its incorporation by reference of the '685
12 provisional. Turning to demonstrative slide 22. The '685 provisional
13 application in its entirety is a part of the '421 patent as of the filing date of
14 the '421 -- the application that issued as the '421 patent, which is some two
15 and a half years prior to the earliest effective filing date of the '632 patent.
16 Column 1 of the 680 -- or, excuse me, of the '421 patent states, "Applicant
17 claims the benefit of priority of prior, provisional application Serial Number
18 61/739,685, filed December 19, 2012," and then the magic words, "the
19 entirety of which is incorporated by reference."

20 So we have the entire disclosure of the '685 application being
21 incorporated into the disclosure of the '421 patent as of its filing date. And
22 the fact that the provisional application was incorporated by Reference into
23 the '421 disclosure as of its filing date and the entirety of it distinguishes this
24 situation from any case that Patent Owner has relied on.

1 JUDGE COURTENAY: So you're saying that basically there's no
2 abandonment of subject matter in the provisional and there's no
3 cancellation?

4 MR. POWERS: that is 100 percent accurate, Your Honor.

5 JUDGE COURTENAY: And by that paragraph in the originally filed
6 specification of -- I'll just call it the A reference.

7 MR. POWERS: That is correct. The entirety of the provisional was
8 incorporated into the --

9 JUDGE COURTENAY: And that paragraph was not added by any
10 amendment to the specification?

11 MR. POWERS: It was not.

12 JUDGE COURTENAY: -- in the originally filed specification. Okay,
13 got it.

14 JUDGE ZECHER: Mr. Powers.

15 MR. POWERS: Yes.

16 JUDGE ZECHER: Just to be clear, what date in *Agarwala* are you
17 relying on to demonstrate it's priority? Are you just relying on its filing date
18 of December 19th, 2013, or are you trying to get back to the provisional
19 filing date?

20 MR. POWERS: We are not trying to get back to the provisional filing
21 date, Your Honor. We are relying on the filing date of *Agarwala* as it
22 existed in December of 2013 in the '421 patent, which is two and a half years
23 prior to the earliest effective filing date of the '632 patent. So this is not an
24 issue.

25 And I think Patent Owner kind of mucked up things a little bit in
26 some of the responses. It's not an issue of whether the provisional

1 application itself became prior as of any particular date. We are not really
2 on the provisional application as a prior art reference.

3 JUDGE COURTENAY: Okay. To be clear, I had to draw this out to
4 get this timeline. So your provisional, the A reference provisional rather, the
5 '685 provisional, was filed on December 19th, 2012?

6 MR. POWERS: Correct.

7 JUDGE COURTENAY: Okay. And then the A patent reference, it
8 was actually filed a year later on December 19th, 2013, a year later?

9 MR. POWERS: That's correct, Your Honor.

10 JUDGE COURTENAY: And at the time of the filing, there was no
11 request under 122(b) to publish and there was a request not to publish, right,
12 at 18 months?

13 MR. POWERS: That is correct, Your Honor

14 JUDGE COURTENAY: All right. So if there had been a request to
15 publish, that would have been, according to my timeline, June 19th, 2015, 18
16 months after filing. But there was a request not to publish?

17 MR. POWERS: That's correct.

18 JUDGE COURTENAY: So there's no patent application publication
19 here at all?

20 MR. POWERS: That's correct.

21 JUDGE COURTENAY: All right. And then the earliest date that
22 Patent Owner claims, which I believe is undisputed, is there are three
23 provisional applications, and they all have a filing date of April 26th, 2016?

24 MR. POWERS: Correct.

25 JUDGE COURTENAY: Okay. So I believe I -- you know, my
26 takeaway from the Patent Owner's argument is that because they're entitled

1 to the April 26th, 2016, filing date and the patent actually issued -- the A
2 patent issued on February 28th, 2017, that all the subject matter in the
3 provisional and because there was no patent application publication after 18
4 months, that was all essentially secret prior art. So how do you respond to
5 that? I'm not going to make Patent Owner's argument for them --

6 MR. POWERS: Sure.

7 JUDGE COURTENAY: -- but I'm just -- I'm looking at my timeline
8 here.

9 MR. POWERS: Well, I think that would be relevant, Your Honor,
10 under 102(a)(1), but we are not relying on the publication of anything as the
11 prior art itself. Our ground for *Agarwala* is 102(a)(2), which looks at what
12 was the disclosure as of the filing date of that application. It corresponds to
13 old 102(e). As of the filing date of *Agarwala*, which includes by the
14 incorporation, by reference, the disclosure of the provisional, the sum of that
15 disclosure existed in December of 2013. The fact that it remained secret for
16 some period of time is simply not relevant to 102(a)(2).

17 And if you really think about it, that's always the case under whether
18 it was 102(e) or 102(a)(2). Now, you file an application, it stays secret for
19 some period of time before it eventually publishes. The publication would
20 be the date for old 102(a) or old 102(b) or 102(a)(1) now. But just because it
21 was not public between the filing date and the publication doesn't mean
22 under 102(a)(2) and old 102(e), you don't go back to what the disclosure was
23 as of the filing date.

24 So I really do think it's a red herring, all these arguments about when
25 it published, how long it remained secret. It's just simply not relevant for
26 102(a)(2).

1 JUDGE COURTENAY: Okay. So what you're saying is all you need
2 for purposes of this A patent reference is the December 19th, 2013, filing
3 date --

4 MR. POWERS: That is correct.

5 JUDGE COURTENAY: -- and you don't need the provisional filing
6 date, the '685 provisional filing date, which was filed a year earlier,
7 December 19th, 2012? You don't need that at all?

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

9 JUDGE COURTENAY: Okay, I understand.

10 JUDGE ZECHER: Isn't the nuance really here what you've
11 incorporated by reference? So, for example, let's just say you didn't
12 incorporate a provisional application. Let's say you incorporated some other
13 patent. Would that make a difference? I guess in my mind, I don't think it
14 would.

15 MR. POWERS: No, I don't think so.

16 JUDGE ZECHER: My point is I don't think it really matters what
17 you've incorporated by reference. That counts as long as it's explicitly
18 recited what you've done here. The fact that it's provisional obviously
19 makes it kind of a unique situation, but I think it could have been anything.
20 But as I understand, incorporated by reference is effectively just a shorthand
21 to make sure that you're bringing in the content without having to reproduce
22 it again and avoid missing anything.

23 MR. POWERS: I think you are absolutely correct, Your Honor. And
24 that is what the case law tells us. That's what the guidance from the MPEP
25 tells us. We are on slide 23.

1 The MPEP says, 2163.07(b), "The information incorporated is as
2 much a part of the application is filed as if the text was repeated in the
3 application, and should be treated as part of the text of the application as
4 filed." So the entirety of what's incorporated is now a part of the '421 patent.
5 The Federal Circuit's decision on *Ultradent* is on point. There they rejected
6 an argument by plaintiff that an anticipatory reference, quote, "'said nothing'
7 about pertinent portions of an incorporated by reference -- incorporated
8 reference because 'the entire contents' were incorporated." And then in the
9 Board's decision in *Apple v. Koss*, IPR2021-00255, also on point there, there
10 is a holding that the claims were obvious. It was a combination of two
11 references, the *Brown* reference and the *Scherzer* reference. And
12 specifically the portions from *Scherzer* that were relied on were material
13 from two provisionals that had been incorporated by reference in their
14 entirety, the same situation we have here.

15 JUDGE ZECHER: So really we just need to ascertain if you've
16 explicitly incorporated by reference and then to what extent the content you
17 incorporated by reference was, and in this case it's the entire provisional
18 because you explicitly said so?

19 MR. POWERS: That is exactly right.

20 JUDGE ZECHER: Okay.

21 MR. POWERS: Now I'll turn to what does Patent Owner argue with
22 respect to this limitation? So, again, they argue or suggest that it matters
23 whether the provisional application is prior art itself. It doesn't matter. We
24 are not relying on the provisional application as prior art. We're not trying
25 to get back to the provisional application filing date. We have *Agarwala*

1 '421 patent by its filing date being prior art by two and a half years prior to
2 the earliest effective filing date of the '632 patent.

3 As we discussed earlier today, there was no canceled subject matter.
4 Here we have the entirety of the provisional application has been
5 incorporated by reference. Patent Owner suggests that there is somehow
6 more specificity was required in order to incorporate by referenced material
7 from the provisional application into the '421 patent. And that's just not the
8 case. That's the alternate case. We just looked at the MPEP guidance as
9 well as the *Apple v. Koss* case. If you incorporate it by reference in its
10 entirety, you've pulled the whole thing into your disclosure.

11 JUDGE ZECHER: And that, going back to slide 22, that's just
12 common parlance that we see. Right? "The entirety of which is
13 incorporated by reference," we see that in numerous patents all the time.

14 MR. POWERS: All the time, Your Honor.

15 JUDGE ZECHER: Yep.

16 MR. POWERS: Now, if we look at --

17 JUDGE COURTENAY: Mr. Powers, I don't mean to interrupt you,
18 but you said you wanted to reserve 15 minutes of rebuttal time.

19 MR. POWERS: Yes.

20 JUDGE COURTENAY: So we're about at 1:33.

21 MR. POWERS: Okay.

22 JUDGE COURTENAY: So you're around that time, 30 minutes into
23 your presentation.

24 MR. POWERS: Thank you, Your Honor. I'll just touch briefly on
25 some of the cases that they cite on this particular issue.

1 Here I have Patent Owner's demonstrative slides up, slide 7, and they
2 rely on the *Advanced Display* case. Well, the thrust of this case and the
3 majority of the analysis in this case was all about whether it was a legal issue
4 or it was a factual issue as to what was incorporated by reference. And the
5 Federal Circuit merely said it is an issue for the court to decide what has
6 been incorporated by reference, not a factual issue for the jury. The case
7 didn't deal with incorporation by reference of a provisional application and
8 say that when it's incorporated in its entirety, it's not with the specificity
9 that's required. That's what they're suggesting by citing this case.

10 JUDGE ZECHER: Mr. Powers, can you go to slide 13? I'm more
11 interested to hear how you distinguish this *Venkat Konda* case.

12 MR. POWERS: The *Venkat* case?

13 JUDGE ZECHER: Yeah. Is it *Venkat*? Is that how you pronounce
14 it?

15 MR. POWERS: That's the way I do. I don't know whether that's
16 correct.

17 JUDGE ZECHER: I'll go with that.

18 MR. POWERS: First, I would just note that this is a non-precedential
19 decision from the Federal Circuit. The Federal Circuit designated it in that
20 way.

21 Second, the question before the court in *Venkat* was very different
22 than what we have before us here. The issue was whether the provisional
23 application was itself a "printed publication" under 102(b). And --

24 JUDGE ZECHER: By itself?

25 MR. POWERS: By itself. So, and that's not the issue before us. This
26 is not a printed publication issue. It's a 102(a)(2) issue, not a previous

1 102(a) or 102(b). And the Court found, unremarkably, that the provisional
2 application which had been incorporated by reference into a PCT became
3 prior art because it was in the disclosure of the PCT and upon publication of
4 the PCT because it had been incorporated by reference.

5 Patent Owner also suggests that there's some standard was set forth
6 in this case about essential, relied-on teachings. "Essential" is used once in
7 the entire decision and it simply is a restatement of how the pro se Patent
8 Owner in that case presented the issue to the Federal Circuit. So I think this
9 case is far afield of the scenario that we have today.

10 JUDGE COURTENAY: Okay. But isn't this issue moot because
11 you're not relying on the provisional filing date of the A reference?

12 MR. POWERS: One hundred percent.

13 JUDGE COURTENAY: Okay.

14 JUDGE ZECHER: Nor are you relying on the provisional by itself.

15 MR. POWERS: Correct, Your Honor.

16 JUDGE ZECHER: Okay.

17 JUDGE COURTENAY: Okay. Do you want to reserve the
18 remainder of your time for rebuttal or do you want to proceed?

19 MR. POWERS: Unless you want to hear about the *Dynamic*
20 *Drinkware*. Maybe I'll take one minute of my time and I'll just deal with
21 that.

22 JUDGE COURTENAY: Okay. Proceed.

23 MR. POWERS: And I won't even get back to my slides on that.

24 JUDGE COURTENAY: Okay.

25 MR. POWERS: The '632 patent is an AIA patent, and there are
26 multiple decisions from the PTAB that have said that no *Dynamic*

1 *Drinkware* analysis is required for AIA patents. *Penumbra v. RapidPulse* is
2 directly on point. Under AIA section 102(a)(2) and 102(d), there's no need
3 to evaluate whether any claim of a referenced patent document is actually
4 entitled to priority when applying such reference. Then *Apple v. Ericsson*
5 went through a very robust analysis of the MPEP guidance, et cetera, to
6 reach the same conclusion.

7 JUDGE ZECHER: Yes, but this is really a moot point because you're
8 not relying on the provisional filing date.

9 MR. POWERS: And thank you. Because my colleagues told me I
10 needed to mention that, we are not relying on it as well. It's simply
11 irrelevant.

12 JUDGE COURTENAY: We're familiar with this case.

13 MR. POWERS: Okay. Unless you have any questions?

14 JUDGE COURTENAY: Any questions from the Panel?

15 Okay. Mr. Devlin, you're up.

16 JUDGE ZECHER: Got 14 minutes left here.

17 JUDGE COURTENAY: Okay. And Mr. Powers, you have 14
18 minutes of rebuttal time.

19 MR. POWERS: Thank you, Your Honor.

20 JUDGE COURTENAY: Mr. Devlin, again, welcome to PTAB and
21 the USPTO. We are here to, with an open mind, listen to your best
22 arguments.

23 MR. DEVLIN: One moment, Your Honor.

24 JUDGE COURTENAY: Okay.

25 MR. DEVLIN: Just making myself plugged in, if I may.

26 JUDGE COURTENAY: No problem.

1 JUDGE ZECHER: Mr. Devlin, while you're getting ready, just let us
2 know how much time you want to reserve for your surrebuttal.

3 MR. DEVLIN: I think I'll shoot for 10 minutes --

4 JUDGE ZECHER: Okay.

5 MR. DEVLIN: -- Your Honor. Thank you.

6 All right. May it please the Court -- or please the Panel. So, just at
7 the outset here, when it comes to issues 1 and 4 as set forth in the Petitioner's
8 demonstratives, we're just going to rest on the briefing there. I'm not going
9 to address *Dynamic Drinkware*. I'm not going to address the specifics of the
10 prior art application against element 1.4 as it's been labeled. So I'm going to
11 focus on the preamble limitation issue and this *Agarwala* provisional or non-
12 provisional prior art issue. In our slides, we have *Agarwala* first.

13 JUDGE ZECHER: Just to be clear, though, you still dispute that
14 *Agarwala* doesn't teach limitation 1.4. You're just resting on your briefs,
15 right?

16 MR. DEVLIN: Correct. Thank you, Your Honor. Yes.

17 JUDGE ZECHER: Just to make the record clear.

18 MR. DEVLIN: To make the record clear, we do dispute it. We are
19 resting on the briefs.

20 JUDGE ZECHER: Got it.

21 MR. DEVLIN: Thank you. Thank you, Judge. As Your Honors can
22 see, we have the preamble after *Agarwala*, if it's more convenient, since the
23 Petitioners took preamble first, then *Agarwala*, I'm happy to go that --

24 JUDGE ZECHER: However you want to proceed.

25 MR. DEVLIN: Why don't we do that, just for convenience sake? If I
26 can get us to the preamble issue. Okay. So --

1 JUDGE ZECHER: Do you mind just referencing the slide number so
2 Judge Anderson can follow along?

3 MR. DEVLIN: Of course, yeah. So I'm starting at slide 22. That's
4 just a signposting slide indicating that's the subsection we're about to go into,
5 this preamble of the claim should be limiting.

6 And now moving to slide 23. And that's just the claim language,
7 which we all agree it's undisputed, does recite the term "data beacons" in the
8 preamble. And the question is, is that an operative limitation of the claim or
9 is it not? That's the issue we're dealing with right now. I want to clean up
10 some of the things that we heard.

11 First, prosecution history is relevant. We cite the *Loctite* case. I
12 moved to slide 24 here. Cite the *Loctite* case in our briefing. Federal Circuit
13 is persuaded, as it often is, by what went on in the prosecution history to
14 help interpret the claims. That's not really a debatable point here. So I'll
15 move on from there.

16 Let's talk about *Catalina*, which is another case that was cited and, in
17 fact, cited in the Board's Institution Decision here. So *Catalina* is a case that
18 talks about this concept of the preamble not being limited necessarily if the
19 claim itself, the body of the claim, defines a structurally complete invention.
20 The *Catalina* itself recognizes that there's an exception to that. When the
21 prosecution history indicates that the preamble elements are distinguishing,
22 that's what distinguishes the claimed invention from the prior art, that
23 transforms the preamble into an operative limitation of the claim. And it
24 goes on to say, without that reliance, so now I'm on -- what I just read or
25 spoke about was sort of the red highlighted part of the quote, the Fed Circuit
26 goes right on in *Catalina*, without that reliance on the preamble to form

1 basis of patentability over the prior art, then the preamble "is not limiting
2 when the claimed body describes a structurally complete invention." But it's
3 really about the prosecution history and, of course, other indices in the
4 intrinsic record that the preamble elements are limiting. That's what we
5 have here.

6 So let's go into this statement for the reasons for allowance. So Your
7 Honor made an interesting point, referred to the prosecution history as de
8 minimis. And I would say it's short, but I would disagree that it's de minimis
9 because I think de minimis is more of a conclusion than a fact. De minimis
10 implies that it doesn't mean anything. It's not relevant. We don't have to pay
11 attention to it. That I would disagree with. I agree it's short. It's a first
12 Office Action allowance.

13 Sorry, Your Honor?

14 JUDGE COURTENAY: I said okay. But the Examiner did refer to
15 limitations that are in the body of claim 1 and the reasons for allowance or
16 the notice of allowance.

17 MR. DEVLIN: I'm going to get to that right now. In fact, I'll jump
18 ahead for a second. And if we look on -- I'm on slide 28 is where I jumped
19 to, and in the middle of this slide, three lines down there's the word
20 "however." That's the single sentence that Petitioners' are relying on and
21 that we saw on Petitioner's slide 20 in their presentation. However, those
22 references deal with mobile networks and do not disclose any information
23 about read queues, write queues, or parallel file systems. And I think read
24 queues, write queues, and parallel file systems was emphasized when
25 Petitioner quoted it on their slide 20. But that's the only sentence that's
26 quoted.

1 But let's put it in context. I'm now going to go back a couple slides
2 starting at slide 26. That quote is about references that relate to data
3 beacons. And I'm going to explain what I mean right now.

4 First, on slide 26, the Examiner has what this Panel may have had, a
5 reaction to these claims when you first looked at them. They appear at first
6 to be somewhat non-complex subject matter. That's the Examiner's
7 impression of the claims going into it, just reading them. Then the
8 Examiner, moving to slide 27, did a search for "data beacon pulser," and the
9 Examiner found no prior art related to data beacon pulser. Now data beacon
10 pulser in the patent is the thing that emits a sends the data beacons. These
11 two things are highly correlated. But we'll go on. That was slide 27.

12 JUDGE COURTENAY: That's not in the claim, though, the data
13 beacon pulser --

14 MR. DEVLIN: Correct.

15 JUDGE COURTENAY: -- is not in any of the claims.

16 MR. DEVLIN: Data beacon is, data beacon pulser is not.

17 JUDGE COURTENAY: Correct.

18 MR. DEVLIN: You query if you -- if data beacon is an operative
19 limitation, what it means where it comes from, what it does, it's intrinsically
20 aligned with the notion of data beacon pulser in the specification. I'll get to
21 the analysis of what data beacon means in a moment, Your Honor, but let
22 me just move on for a second because the Examiner also moved on.

23 As you can see on slide 27, we have a quote that's highlighted. And
24 just after that quote, a new sentence starts, "A broader search for 'data
25 beacon'." So that quote now is on slide 28. This is the full quote. So what
26 the Examiner did is I'm going to search on data beacon. And the Examiner

1 found a couple of references that use the term "data beacon," this *Crinon*
2 reference and "related references by the same inventors."

3 Then the Examiner goes and says, "However, those references,"
4 those references that use the term "data beacon," they relate to a different
5 environment, a different field, that of mobile networks and they don't
6 disclose read queues, write queues, or parallel file systems. So the Examiner
7 here is not saying the prior art in general doesn't disclose what's in the body
8 of this claim. That's not what the Examiner is saying at all in that sentence.
9 And it's a complete misread to argue that; absolute misread of that sentence.

10 What the Examiner is saying is I looked at data beacon now, which
11 I'm seeing here in the claim in the preamble. I did find some cites there, I
12 found some references that use that term, but it's used in a different context.
13 And so I'm going to issue and allow these claims because data beacon as it's
14 used here is not in the prior art. That's what the Examiner is saying in this
15 quote. It's all about data beacon.

16 JUDGE ZECHER: Mr. Devlin?

17 MR. DEVLIN: Yes.

18 JUDGE ZECHER: Can I ask a follow-up question? As you said, the
19 prosecution history was short, so I'll stick with that. We were able to read it.
20 Generally, when we see somebody come in and argue prosecution history
21 and its bearing on whether or not a feature in a preamble should be given
22 patentable weight or should be treated as limited, there's a back-and-forth
23 with the Examiner and the Applicant. And there's some statements by the
24 Applicant that allow us to kind of latch on to the fact that maybe they're
25 putting some weight into a term or some significance that's kind of clear and
26 unmistakable. Here all we have is really an Examiner's statement of

1 allowance. We don't have this back-and-forth. So how are we supposed to
2 extrapolate from a few sentences that the Examiner said here, that this "data
3 beacon" term in the preamble should be treated as limiting?

4 MR. DEVLIN: Great question. I would agree and disagree in part
5 with what Your Honor is saying. And let me tell you what I mean by that
6 specifically.

7 So it is correct that in the prosecution history there's no statement by
8 the Applicant. And I think statements by the Applicants in the Federal
9 Circuit case law would be an added component here that would really lock
10 this down. I would agree with that for sure. But we have to look at the
11 intrinsic record as a whole. We have to look at the prosecution history and
12 glean from it what a person of ordinary skill in the art would take from it.
13 And where I will disagree with you a little bit in terms of what the Applicant
14 said has to do with the specification. Let me start first to connect the dots
15 with the Examiner.

16 I'm back now on slide 27. This is the quote just before what we were
17 looking at on slide 28. It's when the Examiner is talking about the search
18 that he conducted for data beacon pulser. And he says, "a search for the
19 term 'data beacon pulser,' which is disclosed in the specification as the
20 technology upon which the invention is based." So the Examiner's reacting
21 to the specification here, where it is made absolutely clear that the invention
22 on which the whole patent is based is this data beacon pulser and data
23 beacon, we'd say, which is what the pulser does. And he says, that's not
24 found in the prior art. So why does the Examiner say that? What's the
25 Examiner talking about? Well, let's go to the specification.

1 Now I'm on slide 29. The Applicant says this in the Background of
2 the Invention, right there at the start, "The present disclosure relates
3 generally to networks, and more particularly, to the topology, configuration,
4 and operation of a data beacon pulser." That's one of the very first sentences
5 in the specification about what the invention's about.

6 And then later on at column 5, lines 22 to 32, the patentee talks, this
7 is one example, about how the invention, which is described as this slingshot
8 powering data beacon pulser, overcomes problems with earlier prior art
9 networking solutions like TCP/IP and UDP/IP. And so the Applicant did
10 say it. They didn't say it in the prosecution because the Examiner had
11 already said it. The Examiner had already referenced these statements in the
12 prosecution that describe data beacon pulser and data beacons as the basis of
13 the invention. That's what the Examiner said. Again, quote on slide 27.
14 Data beacon pulser, which is disclosed in the specification as the technology
15 upon which the invention is based.

16 So I think the Applicant did say it. The Applicant didn't reiterate it
17 in the prosecution itself, but the Applicant said it, the Examiner said it. And
18 I think when you look at this whole paragraph which begins with the words
19 "In addition," it's Exhibit 1002, that's the prosecution history at page 10.
20 And if you look at that whole paragraph, which continues on to slide 28, so
21 it's slide 27 and 28 of our presentation, that whole paragraph makes
22 abundantly clear exactly what's going on. The Examiner says, I'm going to
23 look at what's going on in the preamble here. I find some art that relates to
24 this data beacon term, but that particular art, it says it right there, "However,
25 those references" don't deal with this same technology area in general and so
26 I'm going to allow these claims. I don't think there's any other fair reading

1 of that. I'll tell you, it's not a fair reading. Plucking out that sentence that
2 begins with "However" and acting like that's what made this invention
3 applicable over -- or patentable over the entirety of the prior art. That's not
4 true. That's not a fair reading.

5 JUDGE ZECHER: Mr. Devlin, let me just ask one more follow-up
6 question. If the novelty here is the data beacon pulser, I'm sure you're
7 familiar with this term -- this statement, the name of the game is the claims.
8 Why was that not in the claim?

9 MR. DEVLIN: It is. It's in the preamble now.

10 JUDGE ZECHER: But not pulser. I mean --

11 MR. DEVLIN: Oh, thank you. Thank you, Your Honor. I'm not sure
12 of that. I didn't draft the claims. But what we do know that the words that
13 appear in the claim are "data beacons." We know, we saw the sentence that
14 the Examiner's talked about, about the search for data beacon, why that
15 element, even in light of some of the art the Examiner found, renders the
16 claims patentable.

17 And so for whatever reason, the Applicant chose just to put the
18 words "data beacons" in this particular claim, that happened. But that's
19 exactly what was examined by the Examiner. That's exactly what caused the
20 Examiner to write what he wrote in that statement's reasons of allowance
21 that we just looked at.

22 Now, just to close the loop here, there's zero evidence in the record
23 that *Agarwala* or any other reference actually discloses data beacon,
24 however it is construed. So if the term "data beacon" is construed to be a
25 limitation of the claim, I don't think there's any dispute that there's a failure

1 of proof here in the petition and the claim should be held patentable. I don't
2 think there's any dispute about that.

3 The closest thing that we see in the petition papers, Petitioner's
4 papers, is this notion of *Agarwala* disclosure being somehow parallel to the
5 disclosure of the '632 patent. But there's never any attempt to address the
6 term "data beacon" whatsoever or demonstrate its presence in *Agarwala*.

7 So unless there's any questions on the preamble section, I'll move on
8 to the provisional, non-provisional *Agarwala* issue.

9 JUDGE COURTENAY: Any further questions from members of the
10 Panel? Okay, proceed.

11 MR. DEVLIN: Thank you, Your Honor. Thank you. I'm going to
12 back up in my slides to -- there we are, so I'm starting at slide 5. That's just
13 a signposting slide and I'm going to just turn quickly to slide 6.

14 So starting at slide 6, just getting some basic facts together. I don't
15 think there's any issue here and I think we've heard it from the Petitioner that
16 the challenges are based on the combination of the *Agarwala* provisional
17 disclosure and the *Agarwala* '421 patent disclosure, those two things
18 combined. And to be clear and to be fair to Petitioner, the combination as
19 asserted by Petitioner is via an -- it's not an obviousness combination in that
20 traditional form. It's an incorporation by reference of the entirety of the
21 disclosure and figures, et cetera, of the *Agarwala* provisional into the non-
22 provisional. That's the basis, that's the piece of prior art, though, this
23 combined set of disclosures from those two individual documents that are
24 asserted in every count of this petition. And I don't think there's any issue
25 there. It's clear from the petition itself. It was reiterated in the Petitioner's
26 reply and we have those citations here on slide 6.

1 JUDGE ZECHER: And Mr. Devlin, do you agree that *Agarwala*
2 qualifies as prior art to the '632 patent based on the December 19th, 2013,
3 filing date?

4 MR. DEVLIN: Depends what you mean by *Agarwala*. So the --

5 JUDGE ZECHER: Just the non-provisional.

6 MR. DEVLIN: We do not dispute that.

7 JUDGE ZECHER: Okay.

8 MR. DEVLIN: The non-provisional is prior art as of the non-
9 provisional filing date --

10 JUDGE ZECHER: Which is December 19 --

11 MR. DEVLIN: -- in December 2013, if I recall.

12 JUDGE ZECHER: December 19, 2013.

13 MR. DEVLIN: Yeah, December, exactly.

14 JUDGE ZECHER: Okay.

15 MR. DEVLIN: Correct. There's also not a dispute here. So I agree
16 there's not a dispute about whether that non-provisional or this combined
17 disclosure can obtain the December 2012 date. That's not the dispute here
18 either. Let me get to what are the disputes.

19 So, first, and I think there are really two independent issues here, I'm
20 going to try to address them separately. And either of these issues, if the
21 Board agrees with Patent Owner, it's done, then there's no issue really of
22 patentability here. So the first of these is the quality of, the sufficiency of
23 the words that are incorporating the provisional purportedly into the non-
24 provisional. Are they sufficient? Can you just say in one line I incorporate
25 by the entirety and make that part of a single prior art reference? Can you
26 do that?

1 *Advanced Display* says no, it's not just about how. It's about -- or it's
2 not just about the Petitioner's characterization earlier. It says specifically
3 that an attempt to incorporate material by reference is insufficient if it
4 doesn't identify with particularity what specific material is incorporated and
5 where that material can be found.

6 JUDGE ZECHER: Are you kind of reading in a pretty exacting
7 standard here? I mean, we see this language all the time “incorporated in its
8 entirety by reference.” That is all over patents that we see before us.

9 MR. DEVLIN: I agree. And it's interesting how sometimes it comes
10 up and sometimes it doesn't in these arguments and which is, I think, an
11 explanation for what happened in *Ultradent* and an explanation for what
12 happened in *Apple*, two cases cited by a Petitioner. So I agree with you, we
13 see this. But let me go through a history here a little bit with Your Honors,
14 including what, of course, we cited in our papers, and explain what we mean
15 on this.

16 So *Advanced Display*, of course, doesn't come out of the blue. It
17 cites this case *In re Lund*, which we have in our papers. It also cites another
18 case *In re Seversky* (phonetic). Both *Lund* and *Seversky* are CCPA cases,
19 one from the '60s, one was from the '70s, and they both generally held that
20 you need to be specific in your incorporation by reference.

21 On slide 8, we talk about *Lund* and this is discussed in our papers.
22 *Lund*'s a little bit of a different fact pattern. *Lund* had to do with a
23 continuation in part application that attempted to simply incorporate by
24 reference in its entirety the disclosure of one of its parent applications or
25 earlier application in the line. And it said can't do that. And so *Lund* and
26 another similar case, *Seversky*, are bubbling along for a while. Sometimes

1 they're cited, sometimes they're not. Then *Ultradent* comes along.
2 *Ultradent* faced an issue of whether this, I forget the name of the patent. It
3 was Monroe -- *Monroe* patent incorporates this *Rosenthal* provisional. And
4 the case went a little sideways in the sense that there was a commercial
5 embodiment of the *Rosenthal* provisional. And there was a fight about
6 whether *Monroe* just incorporated that.

7 And long story short, the Fed Circuit said nope, it says incorporated
8 by its entirety, we're good. All of *Rosenthal's* in. Exactly what the Fed
9 Circuit said. For whatever reason, the patentee in that case never pointed the
10 Federal Circuit to *Lund*, never pointed the Fed Circuit to *Seversky*.

11 Two years later, someone does that. That's *Advanced Display*. So
12 two years later *Advanced Display* comes along and says, nope, you got to be
13 specific. And as far as I can tell, when it's come up, and it still comes up
14 now and then. There are PTAB cases this year that cite *Advanced Display*
15 for this very point that say, nope, the reference -- the reference to --
16 incorporation by reference wasn't specific. We're ignoring it.

17 JUDGE ZECHER: But aren't those cases distinguishable on the fact
18 that maybe you referenced, say, another provision or another patent in a
19 specification, but you don't explicitly use the words "incorporation by
20 reference," either in whole or in part. In other words, they may reference
21 this non-provisional or this provisional says this, but then they don't follow
22 up with I'm going to incorporate it by reference. In other words, it's just a
23 simple reference to the document in the spec. And that's where the dispute
24 comes in, whether or not it actually has been incorporated.

25 MR. DEVLIN: I'm sure there are cases like that, but there are also
26 cases like what we're talking about here in *Advanced Display* where the

1 question is about specificity and the courts generally have absolutely said, or
2 even the Board has said, you're not specific enough in terms of pointing to
3 specific subject matter.

4 JUDGE ZECHER: So what would that include here? You'd have to
5 point to specific paragraphs.

6 MR. DEVLIN: Correct. You'd point to, say, figure 3.

7 JUDGE ZECHER: It's not enough to say "in its entirety," which
8 would mean everything?

9 MR. DEVLIN: *Advanced Display* says it's not. That's right. And
10 there's --

11 JUDGE ZECHER: I'm going to quibble with you on that one, but I
12 understand what you're trying to argue.

13 MR. DEVLIN: Fair enough. Let me note that just to finish the point,
14 just like *Ultradent*, *Apple*, which is the other case that's cited by Petitioner
15 here, this issue at all -- the entire issue of the specificity of disclosure never
16 comes up whatsoever. It just -- it's assumed the reference was in its entirety,
17 was a one-line incorporation by reference. But the issue was never raised by
18 the Patentee at all about whether that was sufficient. The issue in *Apple* was
19 whether the disclosure of these provisionals actually did demonstrate what
20 was in the claim. It had nothing to do with the question of whether the
21 incorporation by reference was sufficient. So it's just the case is irrelevant
22 other than assuming what happened in *Ultradent*. And I would say, for the
23 same reasons, no one raised the issue.

24 JUDGE COURTENAY: So, Mr. Devlin, so *Advanced Display* is the
25 most on point, most recent case in your view of all the cases you've
26 submitted?

1 MR. DEVLIN: The Fed Circuit cases, for this first issue.

2 JUDGE COURTENAY: Your argument.

3 MR. DEVLIN: Yeah, there's two -- let me be very clear. There's two
4 independent issues here. One is about the sufficiency of the incorporation
5 by reference at all. So if the Panel were to agree with Patent Owner that the
6 one-liner is insufficient, then we're done. If the Panel were to disagree with
7 this, there's a totally separate issue. But on this first issue, what I'm just
8 talking about right now, yes, *Advanced Display* is the operative Federal
9 Circuit law that we're relying on.

10 JUDGE COURTENAY: Thank you. Proceed.

11 MR. DEVLIN: Thank you. Yeah, long answer to a short question,
12 but I want to be very clear what I was agreeing to. Thanks for bearing with
13 that.

14 Okay. Let's go to this other issue, which is about timing. Your
15 Honor talked about a sort of a unique issue. Some of you -- there was
16 nothing unique about the case law. At some point you were having a --

17 JUDGE ZECHER: No, I'm fascinated by this issue.

18 MR. DEVLIN: Yeah.

19 JUDGE ZECHER: I did a deep dive on it, and I was looking for
20 something directly on point. And I mean, it's got little aspects of
21 incorporation by reference, it's got aspects of other things. And so I'm
22 interested to see what you have to say.

23 MR. DEVLIN: Thank you, Your Honor. This is a unique situation
24 and there's a unique treatment of it under the law.

25 So this is a timeline, and I think it's the same timeline that Your
26 Honor had laid out. So I'm not going to belabor it, but I think it's also

1 undisputed, so I'll go through it quickly. December 2012, the *Agarwala*
2 provisional. December 2013, *Agarwala* non-provisional. It makes an
3 appropriate claim to priority, there's no doubt about that, to the provisional.
4 And it makes this one line, incorporation by reference, which for this
5 argument from now on I'm going to assume is operative. It's operative.
6 That's enough.

7 There is a request for non-publication filed. And so when otherwise
8 the non-provisional application and the provisional would have published in
9 June of 2014, that does not happen.

10 JUDGE ZECHER: Would this have been different had publication
11 happened, this whole situation?

12 MR. DEVLIN: Yes.

13 JUDGE ZECHER: You wouldn't be making this argument?

14 MR. DEVLIN: Correct.

15 JUDGE ZECHER: Okay.

16 MR. DEVLIN: Because the provisional would have been made
17 public as of June 2014, which is before the critical date of the '632 patent.

18 JUDGE ZECHER: But it's not just the provisional, it's also the
19 contents of the non-provisional. That was not public.

20 MR. DEVLIN: Correct.

21 JUDGE ZECHER: And you just told me that that was prior art.

22 MR. DEVLIN: I agree.

23 JUDGE ZECHER: So I'm trying to understand how I treat them
24 different.

25 MR. DEVLIN: I'm going to get there.

26 JUDGE ZECHER: Okay, thanks.

1 MR. DEVLIN: Yes, Your Honor?

2 JUDGE COURTENAY: Mr. Devlin, there was a request not to
3 publish of 18 months. But wouldn't 18 months after December 19th, 2013,
4 be June 19th, 2015, and not June 19th, 2014?

5 MR. DEVLIN: I believe that the publication would occur at the
6 original priority application. I could be wrong about that. I thought it would
7 be 2013. But even 2015 --

8 JUDGE COURTENAY: But the patent filed December 19th, 2013.
9 We agree with that, right?

10 MR. DEVLIN: I'm sorry?

11 JUDGE COURTENAY: A reference patent was filed -- that patent
12 application was filed --

13 MR. DEVLIN: Eighteen months from that date.

14 JUDGE COURTENAY: Yeah, 18 months from December 19th,
15 2013, would take you to June 19th, 2015.

16 MR. DEVLIN: Correct. Still earlier than the provisional date of
17 April 2015.

18 JUDGE COURTENAY: Yes, but not June 19th, 2014. So I think you
19 misspoke. But we --

20 MR. DEVLIN: Thank you.

21 JUDGE COURTENAY: I do the same.

22 MR. DEVLIN: Yes, thank you, Your Honor. I appreciate the
23 correction.

24 JUDGE COURTENAY: I just want to make that clear.

25 MR. DEVLIN: Thank you. I appreciate the correction. And then
26 with that correction, just a follow-up with Your Honor's point, we still would

1 not be here because that date is also earlier than the critical date of the '632
2 patent. But none of that happened. The request for non-publication was
3 filed and, therefore, the provisional application was not publicly available
4 until February 2017, 10 months after the critical date here.

5 Why does it matter is the question? Fair question. So this is slide 10
6 is just confirming that this -- that there's no dispute that the '632 patent is
7 entitled to the April 2016 priority date. There's no dispute about that. That's
8 slide 10.

9 And slide 11 is just confirming that, putting up the non-publication
10 request, and confirming the undisputed fact that the provisional itself was
11 not public until 2017, February 2017. So that slides 10 and 11.

12 JUDGE COURTENAY: That's the date of the issuance of the A
13 patent.

14 MR. DEVLIN: Exactly.

15 JUDGE COURTENAY: Okay. That's your position.

16 MR. DEVLIN: Well, there's no doubt about that factually. Right?

17 JUDGE COURTENAY: So your position is it was all secret prior art,
18 the provisional, and --

19 MR. DEVLIN: It was secret --

20 JUDGE COURTENAY: -- application until it issued.

21 MR. DEVLIN: And based on the very specific facts that are the exact
22 facts we have here. That matters. So that's just a timeline.

23 Again, slide 12, let's talk about the law. This is just the *Venkat* case,
24 which Your Honor asked about briefly. This was cited in our Sur-reply
25 brief. And it says a very specific set of stuff.

1 First, it talks about the exact circumstance we have here. There's a
2 provisional application and there's a non-provisional. The non-provisional
3 incorporates the provisional by reference, just like we have here. But just
4 like we have here, there's a lot of subject matter in the provisional
5 application that for whatever reason is not carried through into the non-
6 provisional. It's referred to as canceled subject matter.

7 JUDGE COURTENAY: Which is the case here.

8 MR. DEVLIN: Which is exactly the case here, which I'll go through
9 the facts after. I'll go through that in detail.

10 JUDGE ZECHER: Is the difference in *Venkat* that the non-
11 provisional was made public prior and not after, like it is here in *Agarwala*.

12 MR. DEVLIN: Exactly.

13 JUDGE ZECHER: That's what I thought. Yeah. Yeah, go ahead.

14 MR. DEVLIN: Well, that's a difference and I'll --

15 JUDGE ZECHER: It is a difference. Yeah.

16 MR. DEVLIN: We'll put an asterisk here, Your Honor, and I'll come
17 right back --

18 JUDGE ZECHER: Okay.

19 MR. DEVLIN: -- to that point in a moment because I don't think it
20 means anything under the *Venkat* law. What *Venkat* says is that when you
21 have this situation, you've got a provisional incorporated by reference into a
22 non-provisional. You have subject matter that was cancelled is the word
23 that's used. Other words that appears in the provisional, but not in the non-
24 provisional.

25 And we have another important fact. When that subject matter that's
26 in the provisional, but not the non-provisional, when that's what the patentee

1 and the Fed Circuit that adopted as essential, relied-on teachings, meaning
2 teachings that are critical to the invalidity analysis at issue in the play -- in
3 play, whether that subject matter was public as of the critical date at issue.
4 That's what *Venkat* says. Yes.

5 JUDGE COURTENAY: Okay. Is that case -- is that a precedential
6 case up there? I just see a slip opinion cite that you have on the display
7 there.

8 MR. DEVLIN: It's designated as non-precedential.

9 JUDGE COURTENAY: Okay, okay. I'm trying to read from a
10 distance here.

11 JUDGE ZECHER: So with that in mind, what weight should we give
12 this?

13 MR. DEVLIN: I think it is the law. And I will note that there is a
14 recent case, after all the briefing here in March that it doesn't cite *Venkat*, but
15 it does the very same thing: provisional, non-provisional, materials relied on
16 from the provisional. And in that case, there was a -- there was not a non-
17 publication request, so the non-provisional was published. And the PTAB
18 says, this is March of this year after all, the briefing says, I'll give the cite on
19 this in a second, Your Honor, says that then the material that was not in the
20 provisional, but not in the non-provisional, it becomes operative prior art as
21 of the publication date.

22 JUDGE ZECHER: This is the PTAB case?

23 MR. DEVLIN: Yes.

24 JUDGE ZECHER: Non-precedential or precedential?

25 MR. DEVLIN: It's a -- Your Honor, I can give you the citation. I'm
26 not sure right off.

1 JUDGE ZECHER: Yeah, no worries.

2 MR. DEVLIN: Okay. Let me just say it for the record so I have it.

3 JUDGE ZECHER: You can just give us the IPR number and Paper
4 number, though.

5 MR. DEVLIN: I have a Lexis cite, *Mastercard v. OV Loop*, 2025
6 patent app. Lexis 12-76. And the specific discussion I'm talking about
7 occurs at page -- start page 24, bottom of 24 into 25.

8 JUDGE ZECHER: Should get in the transcript.

9 JUDGE COURTENAY: Mr. Devlin --

10 MR. DEVLIN: March of this year --

11 JUDGE COURTENAY: -- I think we started about 1:37. So you're a
12 little bit over 30 minutes.

13 MR. DEVLIN: Thank you, Your Honor. Yeah, I got 30. Thank you,
14 Your Honor.

15 JUDGE COURTENAY: Okay.

16 MR. DEVLIN: I'll probably go just another couple of minutes here
17 and --

18 JUDGE COURTENAY: Okay.

19 MR. DEVLIN: -- reserve that 10 minutes or so. Thank you.

20 So let's apply *Venkat* to the facts here. Essential relied on teachings.
21 So that is true here. It's absolutely true. Again, it's the combination matters.
22 And I'm on slide 15. Let's go into specifics.

23 Slide 16 gets to what we were talking about generally a little while
24 ago. There's a ton of disclosure in the provisional that's not in the non-
25 provisional. Well, is any of it essential here to the invalidity analysis? The
26 answer is yes.

1 So moving to slide 17, we have on here a couple of pages from
2 Exhibit 2014. And Exhibit 2014 in the record is a copy of the *Agarwala*
3 provisional application that uses red strikethrough to identify all the subject
4 matter that was not carried through to the non-provisional.

5 JUDGE COURTENAY: And you argue that's cancellation, but how
6 can it really be cancellation when it's incorporated by reference?

7 MR. DEVLIN: Well, that's exactly the words that *Venkat* used to
8 refer to the information that is present, literally present, in one and yet not in
9 the other even though there was an incorporation by reference in *Venkat*.
10 That's the lingo that was used. So I'm just using that same lingo because it's
11 the same facts.

12 JUDGE COURTENAY: Proceed.

13 JUDGE ZECHER: Maybe not carried forward is probably the correct
14 way to do it, but cancel is --

15 MR. DEVLIN: Probably, and I'm happy to adopt that language.

16 JUDGE ZECHER: Yeah, that's fine.

17 MR. DEVLIN: So not carry forward, right?

18 JUDGE ZECHER: Yeah.

19 MR. DEVLIN: Yeah. And also on Exhibit 2014, so the red
20 strikethrough is information that was in the provisional, that's not in the non-
21 provisional. And then the yellow highlighting is where Petitioner is citing
22 from the non-provisional. And in some instances they're citing information
23 from the non-provisional that doesn't appear -- sorry, they're citing
24 information in the provisional that does not appear, was not carried forward
25 in the non-provisional. And that actually really, really matters here because
26 for at least one claim element of every patent, and I'll just say particularly

1 element 1.3 of claim 1, which is the only independent claim, the petition
2 only relies on the provisional. That's it. So if the provisional disclosure is
3 not itself, if that non-carried forward subject matter that's essential to the
4 analysis was not public before the critical date, then that doesn't count, that
5 subject matter. That's what *Venkat*'s saying. That's what effectively
6 *Mastercard*, in terms of timing of stuff --

7 JUDGE COURTENAY: And the critical date you're referring to is
8 your provisional application filing date of April 26, 2016, is that correct --

9 MR. DEVLIN: No.

10 JUDGE COURTENAY: -- when you say critical date?

11 MR. DEVLIN: Yes, yes. The provisional -- the undisputed critical
12 data, the '632 patent.

13 JUDGE COURTENAY: That's not disputed here between the parties,
14 that --

15 MR. DEVLIN: Exactly.

16 JUDGE COURTENAY: -- as to a critical date, the filing of those
17 three provisional applications, okay, April 26, 2016.

18 MR. DEVLIN: Agreed. Thank you, Your Honor.

19 JUDGE COURTENAY: Just to clarify for the record.

20 MR. DEVLIN: Yes, thank you. Exactly.

21 JUDGE ZECHER: But I think we understand this. Let me ask a
22 follow-up question. Putting aside whether or not the language used for
23 incorporation by reference was sufficient, let's just say it wasn't an
24 incorporation by reference of a provisional application. Let's say it's
25 something else, a patent publication or a patent, would that change the
26 situation here?

1 MR. DEVLIN: Maybe. The answer -- and I say maybe because I
2 don't know. That's not -- but *Venkat*'s very specific. It's about a provisional
3 and we're about a provisional.

4 There is something about the provisional being secret. So if the
5 document that's being incorporated by reference is not secret, I could see the
6 analysis going a different way. Clearly, in *Venkat*, the Fed Circuit is paying
7 attention to when the public actually has something available from the
8 provisional that's really important. And that's what distinguishes it from the
9 normal situation, including the classic old 102(e) normal situation where you
10 get to tack back.

11 JUDGE ZECHER: Well, and this is where I'm struggling, because if
12 we're talking about it being secret, and that's kind of the dispositive thing
13 that makes it unique here, isn't the whole disclosure and the non-provisional
14 also secret, which you've said is going to qualify as prior art? So it's
15 basically secret prior art anyways, putting aside that you have this
16 incorporation by reference of the non-provisional.

17 MR. DEVLIN: Right, yeah.

18 JUDGE ZECHER: Or the provisional, excuse me.

19 MR. DEVLIN: Sorry. No, I understand Your Honor's point. And
20 that's why I think the *Mastercard* case I just referenced is really interesting
21 because it says in a similar circumstances that the art -- the provisional
22 disclosure that's relied upon becomes prior art as of the publication of the
23 non-provisional, not the filing of the non-provisional. So the non-
24 provisional itself in that case has an effective date of its filing date. But the
25 essential components of the provisional, they are indicated as being public as
26 of the publication date. So Even though the non-provisional gets the benefit

1 of the effect of former 102(e) where you get to tack back, even though it was
2 secret for a while, the provisional in these specific circumstances where
3 someone's relying on subject matter that happens to be not carried forward
4 and you happen to be relying on it, the Fed Circuit has treated it differently,
5 and then the PTAB and *Mastercard* also has treated it differently.

6 And I'll stop there unless Your Honors have further questions.

7 JUDGE COURTENAY: In your view, given the specific
8 circumstances that we have here with the timeline, is this a case of first
9 impression?

10 MR. DEVLIN: I don't think so.

11 JUDGE COURTENAY: Cases that are analogous. But do we have a
12 case that has the specific scenario that's presented here?

13 MR. DEVLIN: I think *Venkat* was maybe --

14 JUDGE COURTENAY: That's the closest one?

15 MR. DEVLIN: -- a case of first impression. And the only, I think,
16 potential distinction is exactly what Your Honor Zecher, if I'm saying your
17 name right, Your Honor --

18 JUDGE ZECHER: Sure.

19 MR. DEVLIN: -- what Judge Zecher has said was that, well, this is a
20 102(e) case, old 102(e), I think old. And so maybe --

21 JUDGE COURTENAY: Pre-AIA.

22 MR. DEVLIN: -- maybe the -- pre-AIA, right. So, you know, maybe
23 this content, this essential relied-on teaching should also just tack back to the
24 prior art status. But that's not what *Venkat* says. It says very specifically, it's
25 when that specific material was public. And that's consistent with the
26 treatment in this *Mastercard* case that's more recent.

1 Any other questions, Your Honors?

2 JUDGE COURTENAY: Okay. Again, this is sort of repeating
3 things, but your position is that it was not public until the A patent issue on
4 February 28th, 2017, which is after your critical date of April 26, 2016?

5 MR. DEVLIN: So I'll say -- let me just answer that in two ways. It's
6 absolutely agreed upon that that material was not public. That's for sure. It's
7 undisputed. There's a secondary question which is, does it -- when is its
8 effect as prior art?

9 JUDGE COURTENAY: Right, exactly.

10 MR. DEVLIN: And that's -- and so that question, yes, we also say --
11 and not those parts of the provisional, oddly, that are -- made their way into
12 the non-provisional. Those are fine. It's only the non-carried forward
13 subject matter that was essentially relied upon for the invalidity analysis,
14 which is exactly what we have here, in particular, that subject matter of the
15 provisional relied upon for element 1.3 of claim 1 of the '632 patent. So that
16 subject matter is not available as prior art until the public -- the issue date of
17 the '421 patent, February of 2017, after the critical date of the patent at issue
18 here the '632.

19 JUDGE COURTENAY: Okay, okay. That critical date, '632 patent is
20 again April 26, 2016, and the A patent issued on February 28, 2017, after.
21 Okay.

22 MR. DEVLIN: Exactly. And that's when that essential material
23 becomes available as prior art from the provisional. Thank you.

24 JUDGE COURTENAY: I think we understand your argument. It's a
25 very interesting case. It's always also a very interesting patent with the
26 latency issues on the network, which we haven't discussed at all.

1 MR. DEVLIN: We'll rely on the paper. So as to (inaudible), I know
2 I'm eating into my extra time that I tried to reserve, but unless Your Honors
3 have questions, I'm happy to answer them.

4 JUDGE COURTENAY: Any further questions?

5 JUDGE ZECHER: Now, you have five minutes left in your Sur-
6 rebuttal.

7 MR. DEVLIN: Okay. Thank you, Your Honors.

8 JUDGE ZECHER: Mr. Powers, you have 14 minutes left in your
9 rebuttal.

10 MR. POWERS: I don't know that I'll need my slides, but I might as
11 well plug in. May I proceed, Your Honors?

12 JUDGE COURTENAY: Go ahead, proceed.

13 MR. POWERS: I believe it was Judge Zecher asked a question of
14 Counsel about, well, aren't the cases where material isn't present, those are
15 cases where there was no incorporation by reference. And I believe Counsel
16 said, well, that's not the cases we have here. In *In re Lund*, they tried to
17 incorporate by reference the material. That's just not the facts of *Lund*.

18 So in *Lund*, the statement, and I'm at star 1370 to 1371, the statement
19 that was at issue was, "The present application is a continuation in part
20 application of our application, Serial Number 763806, filed September 29,
21 1958, now abandoned," end quote. There was no attempt at all to
22 incorporate by reference anything. And that's when the Court said, "The
23 language Margerson employs is not sufficient to incorporate the description
24 of his earlier application into the patent. And the description which the
25 Patent Office relies upon appears only in the earlier application."

1 So it's not an issue of how long or how short your incorporation by
2 reference statement is. In *Lund*, there was just simply no incorporation by
3 reference. All it said was, this is a CIP. Nothing was incorporated by
4 reference.

5 I think we've talked exhaustively about *Venkat*. *Venkat* is an issue of
6 when something becomes a printed publication. That's simply not the issue
7 before us under AIA 102(a)(2). You actually won't find the word
8 "cancelled" anywhere in *Venkat*. I think the issue truly was whether
9 something was carried forward or not. So, again, we just think *Venkat* itself
10 is far afield of the issues that are before this Board.

11 Going back to the preamble issue, the appropriate way to have
12 handled -- or the appropriate route to have shown that data beacon pulser or
13 Slingshot technology is the technology upon which the claim is based would
14 have been to file a motion to amend the claims and pull that into claim 1 of
15 the '632 patent. That never happened here.

16 JUDGE ZECHER: Mr. Powers, what about Mr. Devlin's argument
17 that you're only relying on a small snippet of the prosecution history, not
18 kind of the whole context of what the Examiner is saying about data beacons
19 and data beacon pulsers?

20 MR. POWERS: Well, the entire context, Your Honor, is a paragraph.
21 There's not a whole lot there. And the Examiner does say, I looked for data
22 beacon pulsers, I found some references, but when I looked at those
23 references, I did not find read queues, write queues, parallel file systems, the
24 things that are inside of the structurally complete body of the claim itself.
25 So I think it's a gross overstatement to say that that one paragraph and the
26 build-up to the Examiner talking about the elements of the claims is

1 somehow the Examiner saying this claim is allowable because it recites data
2 beacon in the preamble. That's just not, I think, a faithful reading to how the
3 Examiner's statement of reasons for allowance proceeds.

4 JUDGE COURTENAY: Mr. Powers, it seems to me, I mean, my first
5 pass here is that maybe the Examiner, when he searched for, he or she
6 searched for, data beacons, he found references that were arguably non-
7 analogous art to the patent under IPR here. Is that a fair assessment or am I
8 off in like trying to look at the prosecution history?

9 MR. POWERS: I'm not sure that I would say he found necessarily
10 non-analogous art. What he says is he found art related to mobile networks.

11 JUDGE COURTENAY: A different area.

12 MR. POWERS: Yeah, but the claim is directed to a network system.

13 JUDGE COURTENAY: Okay.

14 MR. POWERS: They are close in my mind, I believe. And I would --
15 one other point on this preamble issue and this is --

16 JUDGE ZECHER: What standard do you think we should apply
17 when we read the prosecution history?

18 MR. POWERS: When you read the prosecution history?

19 JUDGE ZECHER: Yeah. And we try to determine whether or not the
20 data beacons feature in the preamble should be limited. Should it be clear
21 and unmistakable? What standard are you suggesting we apply there?

22 MR. POWERS: I would suggest that you're looking at the totality of
23 everything we have before us. And, you know, the name of the game is the
24 claim. We start with the claims themselves and none -- and the courts tell
25 us, well, let's look to see does it define a structurally complete invention?

1 Let's look to see if it relies on anything for antecedent basis. None of those
2 hallmarks are present.

3 Then you can also take into consideration the prosecution. And I
4 think the default here is that, particularly the way this claim is structured, is
5 that a -- the preamble is not limit . . . So I think you need to have something
6 very compelling in the prosecution in order to move that needle such that the
7 preamble is, in fact, a limitation.

8 JUDGE ZECHER: So your position is really that generally we don't
9 treat the futures in the preamble as limiting, absent some clear, unmistakable
10 discussion in the prosecution history that would demonstrate that that feature
11 should be treated as limiting, and that's not what we have here.

12 MR. POWERS: And I think that's fair.

13 JUDGE ZECHER: Okay.

14 MR. POWERS: Now, our position preamble is not limiting. There's
15 no need to construe data beacon. But even if data beacon were to be
16 considered a limitation, I think the claim tells us that the data beacon must at
17 least encompass first data, data that is written from one node to another.
18 And that's what our petition says. At petition page 29, it says, "With respect
19 to providing data beacons, the body of claim 1 does not refer to data beacons
20 and instead only recites that first data is written, e.g., 1.3 from the first write
21 queue to the second parallel file system and read, e.g., 1.4 from the second
22 parallel file system to the second read queue. As such, data that is written or
23 read across nodes is an example of a data beacon."

24 So even the claim tells us that even if data beacon somehow does
25 impart some sort of limitation, it's got to at least encompass data that's

1 written intranodal and across nodes. And that's exactly what *Agarwala*
2 demonstrates.

3 If no further questions?

4 JUDGE COURTENAY: Any further questions from the Panel?

5 MR. POWERS: Thank you.

6 JUDGE COURTENAY: Mr. Devlin, I think you have five minutes of
7 sur-rebuttal time.

8 MR. DEVLIN: Thank you, Your Honor. Let me start at the end, if I
9 may, where we just ended about what data beacon means, this issue of first
10 data. I think we heard the language. Whatever data beacon means, it has to
11 encompass or include first data. Well, whatever data beacon means, it
12 means something beyond first data. It might relate to the concept of first
13 data, it might include first data, but it means something because those words
14 are in the claim. If it's operative, it doesn't just duplicate the meaning of first
15 data. And whatever it was --

16 JUDGE COURTENAY: Well, Mr. Powers, representing the
17 Petitioner, he mentioned that the patent only has a mention in the abstract
18 and also one other place in the specification, and there's some exhibits in the
19 record for -- definitions, if you will, for data beacon. So which of those
20 exhibits is most on point?

21 MR. DEVLIN: So let me pull back up my slides, Your Honor, and it
22 may just be in our briefing. So there is a definition of data beacon in our
23 briefing. Let me just -- let me finish my point, if I may, and I'll come right
24 back to your question.

25 JUDGE COURTENAY: Proceed. I'm sorry if I interrupted you.

1 MR. DEVLIN: My point is not about the construction. My point is
2 that there's -- what we just heard was a very hand wavy attempt to say, well,
3 even if it means something, *Agarwala* discloses it. That's never
4 demonstrated in the petition. It's never addressed. It's never in the analysis.
5 There's no effort at all in the papers to show the presence of data beacon,
6 whatever it may mean, in *Agarwala*. Not at all.

7 The real fight here is about whether it's limiting or not. That's what
8 we've been fighting about. If it's limiting, it just hasn't been shown. We just
9 saw an attempt to say it's been shown. That attempt fails. It just -- it's not in
10 the papers of all.

11 Back to Your Honor's question. I don't have it at hand, Your Honor.
12 It's in the papers. We offer a definition of data beacon that basically relates
13 to a one-way multicast of data. And I forget what exhibits that's in, Your
14 Honor, but if I can just stand on that, I'll address my point.

15 JUDGE COURTENAY: Okay. There are just a few in there, so that's
16 fine.

17 MR. DEVLIN: Yeah. Thank you. Thank you. There was a question
18 about the legal standards applicable. It is absolutely not clear and
19 unmistakable. Clear and unmistakable -- a clear and unmistakable anything
20 from prosecution history has to do with the question of a disclaimer. That is
21 where you have a claim term that in its ordinary meaning would encompass
22 some subject matter, but the applicant has disclaimed that subject matter that
23 would otherwise be normally be encompassed by that term. That's clear and
24 unmistakable.

25 When we're looking to construe terms in general, we look to the
26 prosecution history and the entirety of the intrinsic record as a whole. And I

1 think we heard just before Your Honor said that, that we agreed here that it's
2 totality of circumstances, it's not clear and unmistakable disclaimer. So
3 we're not burdened by that burden, as it were, for lack of better phrasing
4 here.

5 And last, let's go back to this quote. It is absolutely clear. I wouldn't
6 know -- I wouldn't say it's necessarily analogous subject matter. Analogous
7 or non-analogous subject matter implies that I think, you know, kind of all
8 the elements are there, but it's -- you're using something in a different way.
9 And therefore, I'm going to say it's patentable. Not quite here. What's going
10 on is the Examiner found some references that had data beacon and said, oh,
11 I need to look at these now. Why did the Examiner say that? Because the
12 Examiner's treating data beacon as an operative limitation. Otherwise, the
13 however sentence doesn't matter. No one cares what those references say
14 unless data beacon matters.

15 So the Examiner's going, I found some references with data beacon.
16 I need to look at them. He looks at them and he finds other elements in the
17 claim. A claim that operatively includes data beacon. Other elements are
18 not in the references that use the term "data beacon." So those references are
19 not anticipatory.

20 Now, there's a whole other body of prior art out there.

21 JUDGE COURTENAY: But there's no anticipation issue here. It's
22 just obviousness.

23 MR. DEVLIN: Well, the question is there's a whole other body of
24 prior art out there that's not being discussed here, not in any of these slides
25 or these papers. The Examiner never said, I'm just looking at the body. I'm

1 just going to pay attention to that. I'm going to search all the prior art. And
2 you know what I don't find? Read queue, write queue, parallel file systems.

3 The Examiner didn't do that. The Examiner looked at the body and
4 the claim and said, this looks pretty simple. What's going on here? Ah-ha.
5 Data beacon pulser, data beacon, I'm going to search those. And in
6 searching those, he finds the art and that art misses other elements. And
7 that's why the claims were patentable because data beacon means something.
8 Otherwise, none of these statements mean anything.

9 JUDGE COURTENAY: So, Mr. Devlin, so you're saying if I
10 understand your argument, because the Examiner searched for data beacon,
11 the Examiner is arguably giving weight to that term by searching it, and the
12 Examiner found art in a different field. And so you're arguing that we
13 should give that -- determine the preamble data beacon weight because the
14 Examiner considered it and searched for it?

15 MR. DEVLIN: No.

16 JUDGE COURTENAY: Okay. I misunderstand your argument.

17 MR. DEVLIN: That's one of, say, one tiny step along the way. The
18 Examiner thought the claim looked simple. The Examiner looked at data
19 beacon pulser. The data looked at data beacon. The Examiner examined the
20 references that had data beacon. The Examiner looked at all this because the
21 Examiner saw in the specification that the Applicant described data beacon
22 pulser as the basis for the invention. And the Examiner said, after all of that
23 searching and deciding that the references that include the term "data
24 beacon" don't hit the other elements, I'm going to allow this claim. So it's all
25 that together. The search is one tiny step along the way.

26 JUDGE COURTENAY: Okay.

1 MR. DEVLIN: Thank you. Any other questions?

2 JUDGE ZECHER: No, none from me.

3 MR. DEVLIN: Thank you, Your Honors.

4 JUDGE COURTENAY: Okay. I guess that concludes the proceeding
5 today. A very interesting case. Maybe a case of first impression, you never
6 know. So the case is submitted. If you could stay for a few minutes, the
7 court reporter may have a few questions for you.

8 MR. POWERS: Thank you, Your Honor.

9 MR. DEVLIN: Thank you, Your Honors.

10 (Whereupon, the proceedings at 2:30 p.m. were concluded.)

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