1 BEFORE THE PATENT TRIAL AND APPEAL BOARD

2

3 VICOR CORPORATION,)
)
4 PETITIONER,)CASE NO.
)IPR2024-00704
5 vs.)IPR2024-00705
)IPR2024-00706
6 DELTA ELECTRONICS,)
)IPR2024-00715
7 PATENT OWNER.)
)
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13 TRANSCRIPT OF TELEPHONIC PROCEEDINGS

14 TAKEN TUESDAY, AUGUST 6, 2024

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21 Reported by Audra E. Cramer, CSR No. 9901
Job No. 93249

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Exhibit 1014
Vicor v. Delta Electronics
IPR2024-00705

1 TRANSCRIPT OF TELEPHONIC PROCEEDINGS

2 AT 9:33 A.M. PDT, TUESDAY, AUGUST 6, 2024, BEFORE

3 JUDGE NATHAN ENGELS, JUDGE SHEILA F. McSHANE,

4 JUDGE THU A. DANG, AND AUDRA E. CRAMER, CSR NO. 9901.

5

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1 VIA TELECONFERENCE

2 TUESDAY, AUGUST 6, 2024, 9:33 A.M. PDT

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4 JUDGE ENGELS: Good morning. This is

5 Judge Engels with the US Patent Trial and Appeal

6 Board. This is a conference call to discuss

7 IPR2024-00704, IPR2024-00705, IPR2024-00706 and

8 IPR2024-00715.

9 We requested this conference call to

10 discuss Petitioner's requests for additional

11 briefing.

12 Let's start with appearances from the

13 parties.

14 Do we have representatives for the

15 Petitioner?

16 MR. KATZ: Yes, Your Honor. This is

17 Steven Katz, K-a-t-z, with Fish & Richardson,

18 representing the Petitioner, and we've also

19 arranged to have a court reporter, Audra Cramer,

20 on the line.

21 MR. KOLODNEY: And this is also

22 Lawrence Kolodney from Fish & Richardson, also

1 representing the Petitioner.
2 JUDGE ENGELS: Thank you.
3 Do we have representatives for the
4 Patent Owner?
5 MR. KATZ: We do.
6 Miguel, are you muted?
7 (Discussion held off the record.)
8 MR. BOMBACH: Apologies. This is
9 Miguel Bombach for Delta Electronics, Patent
10 Owner. I disconnected right as I was announcing
11 myself.
12 JUDGE ENGELS: Okay. Thank you.
13 With me on the line from the Patent
14 Trial and Appeal Board is Judge McShane and
15 Judge Dang. Let's begin with Fish's request for
16 briefing in the '704 case.
17 MR. KATZ: Thank you, Your Honor. This
18 is Steven Katz for Petitioner.
19 And, you know, this issue, you know, we
20 have asked for limited briefing for issues, and
21 the first one is that the Patent Owner is using
22 implicit claim construction that is not

1 explicitly laid out, and I think we need an
2 opportunity to respond to that.
3 So that's the first basis, you know,
4 because they do have a claim construction,
5 although it's not 100 percent clear, an
6 understanding of that claim construction we
7 believe is required to fully understand the --
8 you know, what the POPR's arguments are.
9 And kind of interpreting at one-half to
10 one-third the height disposed at one-third to --
11 excuse me. Actually -- I'm sorry. That's the
12 wrong case. You want to hear about case '704.
13 So they do make a claim construction
14 arguments in the '704 case, as well, that we do
15 want an opportunity to respond to. They do
16 provide explicit claim constructions in this
17 case, but then what they actually describe in
18 their claim construction section is not clear,
19 at least to us, and we think that it requires
20 some further briefing for us to explain what it
21 is the Patent Owner is actually arguing and have
22 an opportunity to show that, in fact, the

1 petitions do provide adequate support even under
2 their arguments.
3 The second point that we want to raise
4 is they are trying to kind of eliminate the
5 whole petition on the ground that a secondary
6 reference called Hwang is not -- they're saying
7 it's cumulative. It is absolutely not
8 cumulative. We are relying on Hwang for
9 something that is clearly missing in the prior
10 art.
11 We think that the petition is pretty
12 clear on that point, but to the extent the Board
13 thinks that there might be an issue of
14 cumulativeness, we believe we need additional
15 briefing to respond to that to specifically
16 point out where the petition is relying on data
17 from Hwang that is not prior in the prior art.
18 And we do believe that their
19 representations of Hwang is inconsistent with
20 the sections of Hwang we're relying on, and, in
21 fact, it's inconsistent with the teaching of
22 Hwang. So we think that the POPR is based on a

1 misreading of Hwang, and the statements in our
2 petition, which we're relying on, I think
3 demonstrate that, but we think additional
4 briefing just to point out where that is would
5 be helpful.
6 JUDGE ENGELS: Counsel, if I can add.
7 So, as I understand it, Ground 1 is
8 based on what the Petitioner calls Patent
9 Owner's apparent constructions, and then,
10 according to your email, Ground 2 applies plain
11 and ordinary meaning?
12 MR. KATZ: Right.
13 JUDGE ENGELS: Are those claim
14 interpret interpretations different in Ground 1
15 and Ground 2.
16 MR. KATZ: Absolutely. Yes.
17 So Ground 1 is essentially based on
18 what we read their infringement contentions to
19 be, which would require -- or not require --
20 which would allow for the current limit to be
21 based on sensing the output current of the PRM,
22 of the first device, as opposed to feedback from

1 the VTM.

2 That's what they're -- how they're

3 reading the infringement intentions, and so we

4 said, well, if that's the case, then Ground 1

5 clearly shows that the prior configuration did

6 exactly that; it works the same way. Because

7 the prior art we're using are data sheets

8 describing PRM and VTM in a configuration very

9 similar to what they're accusing for the current

10 product.

11 Then Ground 2 says, you know, even

12 under what we view as the proper construction of

13 the patent, it's still obvious because you

14 could -- it would have been obvious to do

15 feedback from the VTM, and then we used the

16 white paper to demonstrate that.

17 So they are absolutely under two

18 different claim constructions, and we believe

19 that's made clear right at the start of the

20 Ground 2. We have a few paragraphs that

21 explicitly say they're under two different

22 constructions.

1 JUDGE ENGELS: So is that to say that
2 Petitioner does not believe the claim
3 construction advanced in Ground 1 is correct?
4 MR. KATZ: Ground 1 is under the Patent
5 Owner apparent construction, which they need for
6 their infringement contentions.
7 JUDGE ENGELS: Patent Owner, would you
8 like to respond to that?
9 MR. BOMBACH: Yes, I would. Thank you,
10 Your Honor.
11 With respect to the first request with
12 respect to the claim constructions, it was
13 Petitioner that presented these terms for
14 construction under what it believed to be the
15 Patent Owner's apparent construction that it
16 deciphered from its interpretations and
17 infringement contentions. Our preliminary
18 response identifies each of those terms and
19 describes the proper plain and ordinary meaning
20 that Patent Owner is actually presenting.
21 So with respect to their Request No. 1,
22 we think there's no good faith basis for -- good

1 cause for reply.

2 With respect to their Request No. 3, we

3 presented the issue as a failure in the

4 petition. The petition was constructed under

5 the -- an apparent construction, and Dr. Baker's

6 knowledge as their expert was also using that

7 apparent construction. There was no discussion

8 within the petition what the proper claim and

9 ordinary meaning was. There was also no

10 discussion in the expert declaration as to what

11 the plain and ordinary meaning was.

12 So our argument is based on the failure

13 in the petition, and the Board is well equipped

14 to decide if -- based on those [garbled],

15 whether the petition itself is defective or not

16 with respect to that, and there's no good cause

17 for reply.

18 And one point of clarification with

19 what Petitioner said -- started to discuss,

20 cumulativeness, Item 2 and Item -- and goes to

21 Item 4 of their request: We do not oppose their

22 request with respect to addressing

1 cumulativeness. We disagree with what they
2 state, but we do not oppose their requests for
3 reply for, 2, cumulativeness and, 4, objective
4 evidence of nonobviousness so long as we have
5 the opportunity to [garbled] these points.
6 JUDGE ENGELS: As I understand the
7 Patent Owner preliminary response, Patent Owner
8 also contends that the claims interpretation
9 advanced in Petitioner's Ground 1 is incorrect.
10 Am I correct about that?
11 MR. BOMBACH: Yes. Yes, Your Honor.
12 JUDGE ENGELS: Does Patent Owner
13 contend that they are incorrect for the same
14 reasons that Petitioner contends they're
15 incorrect?
16 MR. BOMBACH: I may have lost a word or
17 two, but in the -- of what was stated by Your
18 Honor, but in our preliminary -- in the past
19 specifications they had presented what they
20 believed to be the Patent Owner constructions,
21 and we rebuked that in our preliminary response,
22 saying we disagree with what the plain and

1 ordinary meaning is.
2 The constructions that you interpreted
3 are to be -- from our infringement contentions,
4 and we presented what we believe -- what the
5 plain and ordinary meaning for each of these
6 terms is.
7 JUDGE ENGELS: Let me ask another
8 question of Petitioner's counsel.
9 So Ground 1, it seems, advances a claim
10 interpretation that neither party contends is
11 correct.
12 Do I understand that correctly?
13 MR. KATZ: Your Honor, I think it's a
14 little more nuanced than that, and so let me see
15 if I can add some clarity.
16 JUDGE ENGELS: Well, let me ask another
17 question. I understand your position is based
18 on Patent Owner's infringement contentions.
19 This is what you understand their claim
20 interpretations to be. Now you represent that
21 these claim interpretations are incorrect.
22 I'm just wondering how we can move

1 forward with claim interpretations for Ground 1
2 that neither party thinks is correct.
3 MR. KATZ: I think that the problem --
4 first of all, I think we can move forward
5 because the law requires -- or the law
6 encourages that the petition provide an analysis
7 based on what we believe to be the correct
8 constructions, which we absolutely do in
9 Ground 2. And therefore, when you institute,
10 Ground 1 will come along for the ride, so to
11 speak, because Ground 2 is under the proper
12 construction.
13 The problem with answering your
14 question with a single yes-or-no answer on
15 Ground 1 is the Petitioner's analysis in its
16 POPR is inconsistent and ambiguous. So the
17 Petitioner continues to assert -- excuse me --
18 the Patent Owner continues to assert in its POPR
19 some analyses that, in fact, would suggest they
20 think our constructions in Ground 1 are correct.
21 They then have some other analyses where they
22 suggest that they are incorrect in that, in

1 fact, they're interpreting their patent more
2 narrowly.
3 The problem is, if what they're stating
4 in their POPR is taken at face value as we
5 understand it, that would clearly result in
6 noninfringement, which isn't their position.
7 They have not conceded the infringement case.
8 So there's -- it's inconsistent. At
9 some points they seem to suggest that some sort
10 of feedback from the output of the VTM is
11 required, and at other times they have vague,
12 ambiguous statements that suggest that they're
13 not requiring that. So I'm not sure that it is
14 correct to say that their POPR assume that our
15 analysis is incorrect for all purposes.
16 JUDGE ENGELS: Okay. Thank you. I
17 believe we've heard enough of the '704 case, and
18 we will take it under advisement.
19 Let's move to the request as it relates
20 to the '705 case.
21 MR. KATZ: Sure. Thank you, Your
22 Honor.

1 So this is again Steven Katz for
2 Petitioner speaking.
3 So for the '705 case, the first issue
4 that we believe we require additional briefing
5 on is we mapped the prior art onto the ordinary
6 meaning of the claim term "disposed at one-third
7 to two-thirds of the height of the device," and
8 the POPR interprets that more narrowly as
9 disposed within one-third, two-third, which is
10 not the claim language.
11 And they're not explicit about, but
12 that is the gist of the POPR. It's based on
13 reading the limitation being the entire carrier
14 must be disposed within, which we don't believe
15 is the proper construction. Nonetheless, even
16 if that were the construction, the petition
17 still demonstrates that there is disclosures in
18 the prior art that show the entire carrier
19 disposed within.
20 We didn't specifically identify it for
21 that limitation because we believe that's an
22 overly narrow construction, but if Your Honors

1 are considering that construction -- which we do
2 believe is incorrect -- then we'd like a
3 briefing to demonstrate where the prior art, in
4 fact, does show that. And, in fact, there's
5 even some figures in the petition that we can
6 point to. Not the figures the POPR focuses on,
7 but other figures.
8 So that's the first point. Would you
9 like me to continue on to the next point?
10 Hello?
11 JUDGE ENGELS: Yes, please.
12 JUDGE DANG: This is Judge Dang. Go
13 ahead.
14 MR. KATZ: Okay. The second point that
15 we think might deserve additional briefing is
16 the Patent Owner makes an argument that we
17 failed to identify the structure resulting from
18 the product by process limitation. And what
19 they're saying is that -- they seem to be saying
20 that we needed to identify the structure when we
21 discussed the process limitation itself.
22 And our response is we certainly

1 discussed the structure. It's just discussed --
2 it is the connection part, which is, I believe,
3 like, element 1C. And so it is certainly
4 discussed at length, just not under the process
5 limitation. In the process limitation we
6 discussed the process that produces the
7 structure, but we discussed the structure with
8 regard to the other limitations. So they've
9 already been discussed.
10 And Patent Owner argument appears to be
11 we had to mention it again, kind of repeat the
12 analysis under the process limitation, which we
13 do not believe the law requires, and we would
14 like some briefing just to clarify that point.
15 JUDGE DANG: So this is Judge Dang. I
16 have a question.
17 Hello? Can you hear me?
18 MR. KATZ: Yes, we can.
19 JUDGE DANG: Yes, so I have a question.
20 So I guess it goes to the good cause.
21 Are you saying you could not foresee
22 Patent Owner saying it's not disposed at

1 one-third to two-third or that the product by
2 process does not have a structure? You could
3 not have foreseen that?
4 MR. KATZ: We believe that we certainly
5 wouldn't have foreseen them interpreting
6 "disposed at" to mean "disposed entirely
7 within." Yeah, I don't believe that is a fair
8 reading of the claim, and so we certainly
9 wouldn't have foreseen that.
10 And so, again, we addressed how we
11 believed it meant -- should be interpreted, but,
12 again, the petition, we believe, does contain
13 sufficient information to institute and prevail,
14 and we would like an opportunity to kind of
15 point that out on the first one.
16 On the second point is, yes, we
17 identified the structure. We couldn't have
18 foreseen they would make the argument that the
19 structure had to be identified under the process
20 limitation. We've already discussed the
21 structure of the connection part. Now we've
22 said this limitation says it must be made in

1 this manner, and we -- you know, to show that,
2 we would refer to this Zhang reference.
3 So the structure is absolutely there.
4 We're not suggesting we couldn't have foreseen
5 the need to show structure. We absolutely do
6 show the structure. We would like the
7 opportunity to point where it is because, you
8 know, we couldn't have foreseen they'd make the
9 argument it had to have been under limitation
10 1(d). So we would like an opportunity to show
11 that, in fact, it is under the previous
12 limitations.
13 JUDGE DANG: And then I guess my
14 question --
15 MR. BOMBACH: [Speaking
16 simultaneously.]
17 JUDGE DANG: Hello?
18 MR. BOMBACH: I didn't mean to cut you
19 off.
20 JUDGE DANG: Yes, this is Judge Dang.
21 Can I have a question?
22 MR. BOMBACH: Yeah, sorry.

1 JUDGE DANG: Okay. So I have a
2 question concerning, I guess, the first issue of
3 one-third to two-thirds you both had.
4 The purpose of having further briefing
5 is that it helps us at the Board in our decision
6 whether or not to go forward, and so my question
7 is do you see it as -- that further briefing is
8 needed because we cannot determine ourselves if
9 it's within a disposed act?
10 MR. KATZ: Well, I guess I would
11 clarify it this way: Further briefing would be
12 helpful so we can point to you where in the
13 petition there is evidence of how it's disposed
14 entirely within specifically Figure 11 of the --
15 one of the prior art references, which -- I
16 don't believe we refer to that figure when
17 discussing this limitation, but it is in the
18 petition. We do refer to that figure.
19 And so the briefing would identify
20 here's where, in fact, the prior art shows this,
21 and, in fact, the petition even refers to that
22 figure to show that there's, you know, a clear

1 teaching in the art. So that's why we think
2 further briefing would be helpful and would be
3 helpful to the Board.
4 MR. BOMBACH: Maybe I can --
5 JUDGE DANG: Let me -- yeah, I'm sorry.
6 Let me finish. I'm sorry. You definitely will
7 have a chance to respond.
8 MR. BOMBACH: Okay. I apologize. Yes,
9 Your Honor.
10 JUDGE DANG: So I guess my question
11 is -- so are you asking for further -- you're
12 not asking for further briefing for claim
13 interpretation. You are asking for a briefing
14 to point out sections of the prior art that you
15 did not point out before for both the first and
16 second?
17 MR. KATZ: Yeah, I think the
18 petition -- Steven Katz, representing the
19 Petitioner.
20 I think we want to address the claim
21 construction as well, because we believe their
22 construction is incorrect and we couldn't have

1 foreseen it. So I think we'd like an
2 opportunity to say, first, why we believe that's
3 not a fair construction given the patent, and
4 No. 2 is, even if it was, the prior art has
5 sufficient disclosure to meet it.
6 JUDGE DANG: Thank you.
7 I'm sorry. Yeah, so, Patent Owner,
8 please, yeah, I want to give you the equal time.
9 I just want to make sure I have all the
10 questions out first so that you can respond.
11 MR. BOMBACH: Yeah. I apologize, Your
12 Honor. I just didn't want you-all to forget
13 about me.
14 Miguel Bombach for the Patent Owner.
15 Our big problem with [garbled], it was
16 identified by Counsel for Petitioner. It's an
17 opportunity -- they're seeking an opportunity to
18 identify sections in the prior art that should
19 have been identified in the first instance. So,
20 in effect, they're going to be identifying new
21 sections, new grounds in a way on different
22 embodiments, and if that was to be done, that

1 should be done at the petition stage. And this
2 is for both requests, 1 and 2.
3 More specifically, with Request 1 I
4 think the -- we did not apply a construction.
5 It just applies the plain and ordinary meaning
6 of the term as written, and the Board can take
7 it up and decide if either party is correct just
8 by looking at the term.
9 And with respect to No. 2, we present
10 it as a failure within the petition to identify
11 the structure. If there is a failure within the
12 petition, it's on the face of the petition
13 itself, and our reply from Petitioner only
14 serves to be a curative measure to the petition
15 to identify things that should have been done in
16 the first instance.
17 JUDGE DANG: Thank you so much.
18 Yes, so let's -- if you have any -- if
19 either party does not have any further comments,
20 I would like to go through the other cases.
21 MR. KATZ: Again this is Steven Katz
22 for Petitioner. I guess my only response is, as

1 I mentioned before, in case it was kind of lost
2 in the shuffle, we believe they could have
3 complained that it should have been in the
4 petition. We believe on both these points the
5 information actually is in the petition. It's
6 just not exactly where the POPR was looking.
7 And so we think that it would be very
8 helpful if the Board let us, certainly at a
9 minimum, point out where the petition has the
10 information, you know, for each of these points.
11 JUDGE DANG: Patent Owner, do you want
12 to respond to that before we move on?
13 MR. BOMBACH: Yes, please, Your Honor.
14 Yeah, very quickly.
15 If it is in the -- I don't know what
16 Mr. Katz is specifically referring to, but if a
17 specific element is identified in the petition
18 for the correct elements and Patent Owner
19 responded to it and it's in the petition, then
20 the Board can identify that. And if that
21 particular element, for example, under
22 limitation 1(b) -- just throwing an example out

1 there -- it is not in the petition, the Board is
2 more than equipped to identify that that is
3 absent from the petition.
4 JUDGE McSHANE: Okay. Thank you,
5 Counsel. This is Judge McShane -- that's
6 M-c-S-h-a-n-e -- and we're going to turn to the
7 issue in the '706/'715 cases.
8 And here I think perhaps it's a simpler
9 issue. Petitioner's request relates to
10 discretionary denial, and more specifically it
11 appears that the issue is that -- the question
12 is that Patent Owner has represented that two of
13 the claims in the different cases -- or the
14 claims in the two different cases are
15 substantially identical.
16 So, Petitioner, could you state the
17 basis of your request, please.
18 MR. KATZ: Thank you, Your Honor.
19 Yeah, so we have -- there is one
20 overlapping issue between the two, and then we
21 also have a priority date issue.
22 But to address the discretionary denial

1 issue that you raised, we filed two competitors
2 on two different groups of claims because the
3 second group, which we deal with in the '706
4 case, has a much -- excuse me -- in the '715
5 case, the second case. The '715 case deals with
6 a group of claims that are significantly
7 narrower than the first claim. They deserve and
8 require separate treatment.
9 And specifically the claim limitation
10 is that there's this pin that, instead of having
11 to just be on a lateral side, has to be on two
12 lateral sides, and that difference is highly
13 significant and required different art to
14 demonstrate the pin on two lateral sides.
15 And so that's the final basis why
16 they're two different petitions: because the
17 two-lateral-side requirement just really makes
18 it a very different type of claim than the
19 claims addressed in the '706 case, which only
20 require pins on one lateral side each.
21 So that's the fundamental basis.
22 JUDGE McSHANE: Okay. Thank you.

1 Good.

2 Okay. So, Mr. Bombach, what do you

3 have to say?

4 MR. BOMBACH: Yes, thank you, Your

5 Honor.

6 With respect to this issue, this is

7 something that Patent Owner -- Petitioner could

8 have and should have addressed already. In each

9 petition, the '715 and '706, it files a notice

10 ranking, and in the intro it identified the

11 trial practice guide, which prescribes the

12 succinct explanation of differences between

13 petitions, why the issues are addressed by the

14 differences are material, and why the Board

15 should exercise its discretion to institute

16 additional petitions.

17 These issues should have been raised by

18 Petitioner in this notice of ranking, and it was

19 Petitioner's reasoning for providing a second

20 petition. And now Petitioner seeks a curative

21 do-over with this notice of ranking, and we

22 think it is, in this instance, inappropriate.

1 And very briefly I wanted to address
2 the 17th priority argument.
3 JUDGE McSHANE: Hold on. Hold on.
4 MR. BOMBACH: Okay.
5 JUDGE McSHANE: Mr. Bombach, yeah, I
6 don't think that's at issue. I don't believe
7 that's part of the -- part of what we're talking
8 about here.
9 MR. BOMBACH: Okay.
10 JUDGE McSHANE: So I believe that the
11 only reason that Petitioner is asking for
12 this -- and Petitioner can clarify this, but the
13 only reason they're asking to that as to this
14 issue is your representation, that is, Patent
15 Owner's representation, of the substantially
16 identical claims in the respective different
17 cases, the two petitions. I believe that, and
18 Petitioner can, again, clarify that.
19 So, you know, if we will, Mr. Katz, if
20 you could chime in on that --
21 MR. KATZ: Sure, Your Honor.
22 JUDGE McSHANE: -- and we'll see if

1 there's a need to talk about this priority
2 issue.
3 MR. KATZ: Yes, Your Honor.
4 There actually is, because for the '706
5 case we raise a single issue, the issue of
6 substantial identicality of claims. For
7 the '715 we raise two different issues. One is
8 the priority date issue.
9 But just to wrap up the discretionary
10 denial issue, what I just argued about, the lack
11 of substantial identicality, we do address in
12 the rankings, and I do think that the rankings
13 paper does address that. But, you know, we were
14 surprised to see Petitioner's arguments in the
15 POPR, which seemed to contradict what we state
16 in the ranking paper.
17 So certainly I would encourage the
18 Board to look at the ranking paper and see if
19 they need further argument on that, but I think
20 that establishes why they're not substantially
21 identical claims.
22 So that ends the discretionary denial

1 issue.

2 Should I address the priority date

3 issue now, or do you want to -- do you have

4 questions on --

5 JUDGE McSHANE: Yeah, go ahead and talk

6 about the priority issue, please.

7 MR. KATZ: Okay. So we just point out

8 that this two -- this pin on two sides of the

9 bearing plate, that was a new claim added, we

10 believe, to attempt to read on our products.

11 And we don't believe there's a basis in the

12 priority documents for that, and so we said,

13 look, there's no basis for that.

14 Patent Owner has now pointed to very

15 oblique, you know, portions in the priority

16 documents, saying, aha, here's where this is

17 disclosed, and here's this very cryptic figure,

18 and if you look over here, you see these two

19 lines, and you look at this vertical line, you

20 know, that discloses these two pins. We

21 couldn't have predicted that argument.

22 You know, they -- we pointed to the

1 figures that made the most sense and said, look,
2 they're just not there. They've now, you know,
3 scoured their patent, they've identified this
4 figure that in our belief has really nothing to
5 do with this question, and so we believe we have
6 a right to respond to that.
7 We could not have foreseen that they
8 would have asserted that this figure discloses
9 two pins on opposite sides of a bearing plate,
10 and so we need an opportunity to explain to the
11 Board why that is absolutely not disclosed in
12 those -- in the figure they're pointing to.
13 JUDGE McSHANE: Yes. Thank you.
14 Mr. Bombach, we're back to you, and you
15 can talk about the priority date issue and this
16 issue related to the pins.
17 MR. BOMBACH: Yes. Thank you very
18 much, Your Honor.
19 With respect to the similarity or
20 dissimilarity of the claims, Counsel for
21 Petitioner says that the issue was foreseen and
22 addressed in the notice of ranking just now,

1 and, I mean, it was touched on, and this issue
2 should have been foreseen, and there's no good
3 cause to allow a reply for that.
4 With respect to the priority date issue
5 on the '715, Patent Owner does not oppose that
6 request so as long as we get surreplies equally.
7 JUDGE McSHANE: Okay. All right. Very
8 good.
9 And with that, let me just check with
10 my colleagues. Give me one second, please.
11 (Discussion held off the record.)
12 JUDGE McSHANE: Counsel, this is Judge
13 McShane. I'm back on the line. Just a few
14 tidbits about practice before PTAB.
15 No. 1 -- and, frankly, I don't recall
16 working with either counsel here, but these are
17 just reminders.
18 If you have practiced before PTAB
19 before, we do expect on any of these kinds of
20 requests that the parties meet and confer in a
21 meaningful manner, that is, that you preferably
22 talk about the issues, get each other on the

1 phone, get a resolution as to whether you agree
2 or disagree, and then write jointly to the
3 Board.
4 Additionally, our practice is -- and
5 this is reflected in the Consolidated Trial
6 Practice Guide. What we -- we don't allow
7 argument in the emails. You're supposed to just
8 identify the issue that's relevant, what you're
9 requesting, and just maybe a line or two of
10 explanation, and that's it.
11 So these are just reminders of the
12 practice, and we'd really appreciate if you
13 would conform with that. And in the future if
14 there's any issues with that, we will consider
15 you forewarned.
16 So with that, we thank you for
17 answering our questions. We appreciate it, and
18 we will take the issues under advisement.
19 With that, we're adjourned. Thank you.
20 MR. KATZ: Thank you, Your Honors.
21 MR. BOMBACH: Thank you, Your Honors.
22

(At 9:09 A.M. PDT the proceedings were adjourned.)

STATE OF CALIFORNIA)
COUNTY OF LOS ANGELES) SS.

I, AUDRA E. CRAMER, CSR No. 9901, in and for the State of California, do hereby certify:

That said proceeding was taken down by me in shorthand at the time and place therein named, and thereafter reduced to typewriting under my direction, and the same is a true, correct and complete transcript of said proceedings;

I further certify that I am not interested in the event of the action.

Witness my hand this 6th day of August, 2024.

_____

Certified Shorthand
Reporter for the
State of California