

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner

IPR2024-00867
Patent 10,176,848 B2, C1

Record of Oral Hearing
Held: August 14, 2025

Before NEIL T. POWELL, TERRENCE W. MCMILLIN, and KEVIN C.
TROCK, *Administrative Patent Judges*.

IPR2024-00867
Patent 10,176,848 B2, C1

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IPR2024-00867
Patent 10,176,848 B2, C1

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P R O C E E D I N G S

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JUDGE POWELL: We will now start our oral argument for IPR2024-00867, that involves U.S. Patent number 10,176,848 B2, C1. I am Judge Powell, and I am joined by Judges McMillin and Trock. We'll have appearances for the parties again, starting with the Petitioner.

MR. JAY: Good afternoon, Your Honor. Michael Jay of DLA Piper on behalf of Samsung, Petitioners. Along with me is James Heintz of DLA Piper and Matt Bathon of Samsung.

JUDGE POWELL: Okay. While you're at the podium, to keep things moving along here, you don't anticipate discussing any confidential information in this hearing?

MR. JAY: I do not, Your Honor.

JUDGE POWELL: Okay. Let's then get Patent Owner's appearances.

MR. PLUTA: Good afternoon, Your Honor. Robert Pluta from Mayer Brown on behalf of Maxell, Ltd. With me is Saqib Siddiqui and Seth Bruneel.

JUDGE POWELL: And you don't have any confidential information?

MR. PLUTA: We do not, Your Honor.

JUDGE POWELL: Okay. So, we'll follow the same order that you all are used to normally, and I'll omit the long description of that. We had that in the hearing before. Each party in these proceeding has 45 minutes of total argument time. And I guess I'll just ask, if anybody has any

1 questions, you're welcome to go to the podium and ask them, but otherwise,
2 I'm going to give the floor to Petitioner, and we'll begin when you are ready.

3 MR. JAY: Thank you, Your Honors. If I could reserve, I guess,
4 15 minutes for rebuttal time.

5 JUDGE POWELL: Okay, we can do that. We 're ready when you
6 are.

7 MR. JAY: Okay. Thank you, Your Honors. So, I have an agenda
8 here for what I want to talk about today, and there's a number of things in
9 the agenda, but I'm primarily going to focus on three things: first, whether
10 the prior art is analogous to the '848 Patent; second, claim construction of
11 the 'mode' term, and then, the third thing I'm going to focus on is whether
12 Haitani discloses the reproducing mode limitations.

13 So, the '848 Patent is about registering a VIP, using facial
14 recognition and selectively reproducing image information based on using
15 the registered person's face information. So, the figures here from the '848
16 Patent, show how registration takes place in the '848 Patent. The '848 Patent
17 discloses two ways of registering a person: one, is what we see on the left,
18 which is photograph now, where you register a person from a newly-taken
19 photograph, and on the right, we see the second way, it says, select from list,
20 where you register a specific person, or a VIP, using images already stored
21 on the device.

22 Now, moving to Slide 4, and here, I'm going to focus on the other
23 aspect of the '848 Patent, which is selectively reproducing image
24 information based on using the registered person's face information. And
25 this particular aspect of the '848 Patent is important to the disputes between
26 the parties here.

1 So, in the '848 Patent, selective reproduction begins with
2 assignment of chapter importance levels. When a video is created, it's
3 broken up into chapters, and each chapter is given an importance level based
4 on how frequently the registered VIP appears in it. So, 5 is the least
5 important, 1 is the most important. In the patent embodiment, a video is
6 split up into nine chapters and they're given various important levels from 1
7 to 5.

8 So, moving to Slide 5, the embodiment in the '848 Patent
9 specification discusses three reproducing modes: a standard reproducing
10 mode, an express reproducing mode, and a superexpress reproducing mode.
11 One important point I want to mention here is, that this is the only
12 embodiment in the '848 Patent covering the reproducing modes.

13 Now, moving on to Slide 6, the reproducing modes are ways of
14 selecting all, or a subset of the chapters. So, standard reproducing mode
15 reproduces all the chapters, regardless of the importance level. The express
16 mode reproduces only the chapters within an importance level of 3 or less.
17 And then, the superexpress reproducing mode, reproduces only chapters
18 with an importance level of 1.

19 So, moving on to Slide 7, all reproducing modes, in the
20 embodiment, always reproduce at least chapters with an importance level of
21 1one. After that, the extent to which certain chapters are filtered out,
22 depends on the importance level threshold of the mode that the user has
23 selected from the device menu, and this is what the patent calls the chapter-
24 select reproducing function.

25 So, moving on to Slide 8, the chapter-select reproducing function
26 is shown here in Figure 10 on the left side of the slide. And what's

1 important here in Figure 10, is what's highlighted as block SP22. That's
2 where the chapter importance levels are compared against the threshold
3 value of the selected mode. As the specification states, the threshold value is
4 5 in the standard reproducing mode, 3 in express, and 1 in superexpress.

5 So, moving on to Slide 9, going back again to Figure 9, we see in
6 the upper right, you can see that if you apply a filtering threshold of 1, 3, or
7 5 to the logic block SP22 in the chapter-select reproducing function, you
8 would reproduce either all of the chapters, as we see with the standard mode,
9 or different subsets of the chapters, as you can see with the express and the
10 superexpress mode.

11 JUDGE TROCK: Counsel, this is Judge Trock. Can you hear me?

12 MR. JAY: I can, Your Honor.

13 JUDGE TROCK: You used the word, "filter."

14 MR. JAY: Yes.

15 JUDGE TROCK: Is that word used in the patent?

16 MR. JAY: No, that word is not used in the patent, Your Honor.

17 JUDGE TROCK: So, can you explain to me why you're using it
18 here?

19 MR. JAY: Sure. So, the patent talks about thresholds, and the
20 effect of the thresholds is to filter out chapters that have been given
21 importance levels that do not fit with the threshold. So, when you apply the
22 threshold for the express mode, for instance, it filters out anything with a
23 importance level of 4 or 5. Likewise, if you apply the superexpress mode,
24 there's a threshold of 1, which has the effect in the step SP22 of filtering out
25 anything with a importance level of 2, 3, 4, or 5.

26 JUDGE TROCK: So, is that use of 'filtering out,' just attorney

1 argument, or do you have some kind of evidentiary testimony to this effect,
2 and whether or not a person of ordinary skill in the art would understand that
3 this is filtering in reading the '848 Patent?

4 MR. JAY: Yes, our expert, Dr. Bederson, in his declaration, does
5 talk about how the effect of how applying these thresholds filters out, certain
6 chapters with importance level that are above the threshold level.

7 JUDGE TROCK: Can you give me that citation?

8 MR. JAY: Sure.

9 JUDGE TROCK: You can give it to me later if you don't have it
10 on-hand.

11 MR. JAY: Yeah, I don't have it on me right now, Your Honor.
12 What I'll do is, I'll give it to you in my rebuttal, if that's okay, Your Honor.

13 JUDGE TROCK: That's perfectly fine, as long as I can get a
14 citation to it.

15 MR. JAY: Certainly. Thank you very much. So, moving on to
16 Slide 10, Your Honor, the concepts of the reproducing modes, or the
17 embodiment that I just talked about in Figures 9 and 10, are reflected in the
18 claims of the '848 Patent. You can see a reference to selective reproduction
19 in Limitation 8[i], in which Claims 11 and 12 depend, and more importantly,
20 in Claims 11 and 12, you see the multiple reproducing modes recited there in
21 those claims. The challenged Claims 16, 17, 19, and 20 have similar
22 limitations with only a couple small exceptions.

23 So, I want to just briefly talk about the grounds of unpatentability
24 that we see here on Slide 11.

25 Moving to Slide 12, we have the grounds listed. So, Nozaki is the
26 primary reference and discloses all, or almost all of the independent claim

1 elements. It's combined with Haitani to render obvious the reproducing
2 modes of the dependent claims, as well as the touchscreen limitation of
3 Claim 84. I think it's Limitation 84[d].

4 Now, Claim 84, generally speaking, includes all of the limitations
5 in the other challenge claims with a few additional claims added, such as
6 video segmentation and thumbnail markers, and Graham and Kim both
7 disclose all of those additional limitations.

8 It's important to point out that the Patent Owner, Maxell, does not
9 dispute that Kim and Graham do in fact disclose these additional elements of
10 Claim 84. They only dispute that it would have been obvious to combine
11 either Graham or Kim with the Nozaki/Haitani combination.

12 Now, moving on to Slide 13, Maxell's Patent Owner response
13 disputed whether Nozaki, Haitani, Graham, and Kim are analogous art to the
14 '848 Patent. The Patent Owner's response, however, argued that these
15 references were not analogous because they were directed to solving
16 different problems from the '848 Patent. In our reply, at pages 6 to 7, we
17 explained why that's wrong as a matter of law in this case, where the prior
18 art comes from the same field of endeavor as the patent. That's the Wires
19 case that talked about how prior art is analogous if the art is from the same
20 field of endeavor, regardless of the problem addressed.

21 Now, Petitioner's expert, Dr. Bederson, submitted a declaration
22 with a reply that reiterated the evidence supporting a conclusion that the
23 references are all in the same field of endeavor as the '848 Patent. They all
24 have to do with recording and reproducing apparatuses. So, beyond that,
25 even if the problem addressed does matter, we see here in paragraph 20 of
26 Dr. Bederson's reply declaration, that he also explains why the references are

1 directed to solving similar problems as the '848 Patent.

2 Now, Patent Owner's surreply concedes that the field of endeavor
3 for the '848 Patent is image recording and reproduction, and we agreed
4 completely. Patent Owner though, in the surreply, then never says anything
5 about why the asserted prior art is not also in that same field of endeavor.

6 All that the Patent Owner says, is that in a couple of instances, we, the
7 Petitioner, refer to Nozaki and Haitani as disclosing digital cameras. That's
8 the surreply at 9, and they are digital cameras. And digital cameras are
9 reproduction and reproducing apparatuses. They involve image recording
10 and reproduction. The Patent Owner fails to address any of Petitioner's
11 actual evidence of the field of endeavor that Dr. Bederson and Petitioner
12 cited and that we can see in paragraphs 19 and 20 here.

13 Now, I want to move on to claim construction of 'mode'. Almost
14 all of the Patent Owner's arguments in these proceedings revolve around a
15 construction of the term 'mode' that appears in all of the challenged claims.

16 Now, just as an initial matter, there's no basis, under the law,
17 governing claim construction to construe this term. There's no contention by
18 Patent Owner that there's been any lexicography in the '848 Patent with
19 respect to the term 'mode' and there's no contention by the Patent Owner that
20 there's been any disclaimer of claim scope that would warrant a construction
21 of mode.

22 So, I think as initial matter, I don't think that any mode, or that any
23 construction of mode is proper. In any event, even just going with their base
24 construction, the operational state that a system has been switched to, that
25 language proposed by the Patent Owner is not itself problematic. The prior
26 art all still invalidates the claims if mode is construed as an operational state.

1 But the Patent Owner goes further and offers an additional requirement
2 within the body of its submissions, further requiring that an operational state
3 cannot be defined by a selected filter. It's this additional constraint from the
4 Patent Owners that we, the Petitioners, dispute.

5 Now, before I get into this further, there's an important
6 clarification I want to make. Patent Owner's positions, in its papers, and I
7 can see that it's likely to come also -- you can see that in their
8 demonstratives, that they make the argument that we, the Petitioners, are
9 equating filter and mode. That's not an argument that we're making. We
10 never state that a filter is a mode. We don't do that when we're discussing
11 claim construction, and we don't do that when we're talking about Nozaki
12 and Haitani. What we say is that the use of filters can create different
13 reproducing modes as recited in the claims. We see that in the '848 Patent,
14 in the embodiment that I went through earlier and that I'm going to go
15 through again. We also see that in Nozaki and Haitani.

16 So, with that in mind, I want to move to the claim construction
17 dispute. So, I move to Slide 15. And so, getting beyond the fact that there's
18 no basis to construe the term 'mode' at all, let alone in this manner, the
19 Patent Owner's construction is wrong for the simple reason that it would
20 exclude this embodiment. As I mentioned before, this embodiment is the
21 only disclosure in the '848 Patent specification about multiple reproducing
22 modes. The embodiments' modes are filters for the reasons I discussed
23 earlier. Depending on the selected mode, whether it's standard, express, or
24 superexpress, the chapter-select reproducing function applies a different
25 threshold in its one algorithm to filter out chapters with an importance level
26 that are above that threshold. The threshold are criteria to filter out data.

1 And if we look at Slide 16, we see that the Patent Owner's expert,
2 Dr. Balakrishnan, confirmed as much. One type of filter would, in fact, be a
3 threshold. That's exactly what we saw on the previous slide. So, when
4 Maxell says, a filter cannot create a mode, that's just wrong in the context of
5 the patent.

6 And we see that even more -- and moving on to Slide 17, we see
7 that problem even more clearly in Maxell's application of its proposed
8 construction. On the right, in the upper right, you have Patent Owner's
9 expert, Dr. Balakrishnan, explaining why the prior art, in his view, doesn't
10 have multiple modes. He says that just because it was running a single
11 algorithm, and switching out the filtering criteria, it's not using different
12 modes. But then when we look at the chapter-select reproducing function
13 from the '848 Patent on the left of this slide, we can see that it is a single
14 algorithm that applies to all three reproducing modes. And the only change
15 that occurs, depending on the user-selected mode, is that it switches out the
16 filtering criteria -- the threshold, in that highlighted block SP22. So, Maxell,
17 their construction cannot be right. Their position on mode defies the basic
18 principles of patent law by excluding, from the claim scope, the patent's only
19 disclosed embodiment reproducing mode.

20 JUDGE TROCK: Counsel, this is Judge Trock. So, is it your
21 position then that the use of these different filters leads to the use of these
22 different modes?

23 MR. JAY: Yes, correct, Your Honor. That it is the -- the claims
24 are silent as to how the reproducing modes are created. It doesn't matter, as
25 long as you have the reproducing modes, right. So, what I'm talking about
26 here, with respect to the '848 Patent, and we see it again later on with respect

1 to Haitani, is that employing these filters or thresholds, what it does is, that
2 is what creates the different reproducing modes.

3 JUDGE TROCK: All right. So, it's not that the filters are modes,
4 it's that they're more like a trigger, or a switch that turns on these different
5 modes -- what you called superexpress, express, or standard; is that correct?

6 MR. JAY: Yes, Your Honor.

7 JUDGE TROCK: All right, thank you.

8 MR. JAY: All right. So, now I want to go to Slide 18, and this is
9 the extrinsic evidence that Maxell points to. And I wanted to just discuss
10 why this extrinsic evidence doesn't help their claim construction position.

11 So, first of all, we have the PC Magazine definition in the first row
12 from earlier this year. It doesn't shed any light on the meaning of the word
13 'mode' at the time of the '848 Patent. Then, we look at the McGraw-Hill
14 definition on the second row, and that defines mode a little differently and in
15 much broader terms. And just as importantly, even though it gives a
16 separate definition of filter, it does not say anything about whether modes
17 can be distinguishable based on the filters they employ.

18 And as we talked about, that's really the key issue here. We're not
19 equating words mode and filter. Instead, we're saying that the use of filters
20 creates the different modes as that term is used in the '848 Patent. That's
21 exactly what I showed that the '848 Patent covers on the previous slide.

22 So, if to the extent that this extrinsic evidence shows anything, it
23 shows that Petitioner's view of mode is correct, not that of Patent Owner's.

24 So, with that in mind, I'm going to move on to Nozaki and Haitani.
25 So, looking at Slide 20, we see that Maxell concedes that Nozaki does
26 disclose almost all independent claim limitations. So, for Claim 8, we see

1 that the one limitation that Maxell disputes is Limitation 8[i].

2 And so, I'm going to move to Slide 21. So, Maxell says that there's
3 no selective reproduction, according to Limitation 8[i], in Nozaki, and that
4 position is not correct. It's undisputed that Nozaki discloses registering a
5 person. Here, on Slide 21, we see Figure 4 from Nozaki, showing some of
6 the people -- four different people who have been registered on the device.

7 So, there are pictures stored on the device of each one of these
8 people, and you can selectively narrow the reproduced image to only those
9 of a single registered person by choosing from the list as shown on Figure 4,
10 so we see this selection frame, kind of towards the bottom of the image.
11 And here, basically, what Nozaki is saying is, that you picked the third entry,
12 that would be Yama Hiko. So, when you select that, that brings you to what
13 you see on Slide 22, which is the detailed information screen, which is
14 Figure 5 in Nozaki.

15 So, the lower portion of Figure 5 has a scrollable list. You can see,
16 there's a little scrollbar kind of to the right of the blue section in Slide 22,
17 that allows the user to look through the image information, and that's face
18 registration image, associated with every single picture taken of that person.
19 So, in Figure 5, the index image shown is a cropped photo, but Nozaki
20 actually also says that you can use the entire photo of the person rather than
21 this cropped photo, and that's in paragraph 191 of Exhibit 1006 in Nozaki.

22 So, here we have Nozaki disclosing the ability to sort through
23 thumbnails of only the registered person that the user selected on Figure 4
24 that we saw on the previous slide. That alone, meets the limitation,
25 according to Maxell's own expert, Dr. Balakrishnan, who confirmed in his
26 deposition, that showing thumbnails on the screen is reproducing image

1 information. And we have that in our reply that's at page 11, footnote 4, it's
2 page 19, lines 16 through 21 of Dr. Balakrishnan's deposition, Exhibit 1018.
3 Now, Maxell never addresses this.

4 Now, moving on to Slide 23, in addition to Nozaki alone, it would
5 have been obvious to modify Nozaki in view of Haitani. So again, Nozaki
6 Figure 5 shows that there can be a lot of stored images of a registered
7 person, and that filtering the photos captured on the device, based only on
8 the person's face information, may not be sufficient enough. For example, if
9 there are a lot of photos of a registered person, the scrollbar in Nozaki, in the
10 blue part on the left image, could be a difficult way to navigate them.

11 So, Haitani offers a solution of further narrowing the selectively
12 reproduced images by employing modes that use filters. So, what we see
13 here is Figure 5 -- on the right side of Slide 23, we see Figure 5 from
14 Haitani, which shows the menu for selecting what filter you want to use in a
15 mode that operates to limit the reproduced photos by place. There's also
16 another mode we can see here for time. And so, there would be another
17 mode that could be used to apply both filters simultaneously. All have
18 different operational outcomes just like with the example in the '848 Patent.
19 A POSITA could implement these modes in the screen on Figure 5, in
20 Nozaki, to further narrow the selectively reproduced image information.

21 Now, I'm going to move to Slide 24. Now, another option that we
22 raised in our petition would be to use the regeneration mode in Nozaki. So,
23 Nozaki discloses that the face registration image data is stored on the
24 memory and can be reproduced and displayed on the screen, essentially like
25 a gallery application that we're all accustomed to seeing on our phones now.

26 Now, Haitani's filter modes would work on the regeneration mode

1 in Nozaki as well. The Patent Owner's papers just kind of quickly gloss over
2 this regeneration mode, offering nothing more than a conclusory statement
3 that this regeneration mode could not be combined with Haitani, but the
4 Patent Owner never actually explains why that combination is not feasible.
5 So, for all intents and purposes, this is unrebutted.

6 Now, I'm going to move on to the dependent claims.

7 JUDGE TROCK: Counsel, before you move on --

8 MR. JAY: Yes.

9 JUDGE TROCK: -- this is Judge Trock again. Going back to your
10 Slides 23 and 24, you're now bringing in your combination with Haitani, and
11 you're using the words filter and mode with respect to Haitani.

12 MR. JAY: Mm-hmm.

13 JUDGE TROCK: So, looking at Figure 5 from Haitani here, can
14 you please explain to me more clearly what the filters are that are being
15 applied here and what the modes are?

16 MR. JAY: Sure. So, what Haitani allows for is you just select
17 -- what you would do is, you would, say, for instance, touch on any place,
18 and it would give you a drop-down menu where you could select one of
19 various filters, the same with any time.

20 JUDGE TROCK: Counsel? So --

21 MR. JAY: Yeah.

22 JUDGE TROCK: -- the category of place, this is a filter?

23 MR. JAY: Correct.

24 JUDGE TROCK: Okay. And the category of time, in this drop-
25 down, would also be a filter?

26 MR. JAY: Correct.

1 JUDGE TROCK: Okay.

2 MR. JAY: Okay. And so, from that --

3 JUDGE TROCK: What about the mode?

4 MR. JAY: Pardon me, Your Honor?

5 JUDGE TROCK: What about the modes? You use the term
6 'mode' --

7 MR. JAY: Right.

8 JUDGE TROCK: -- also when describing the combination with
9 Haitani.

10 MR. JAY: Right. So, once you -- say, click on any time, for
11 instance, it gives you the drop-down menu, and you can pick, say, something
12 that happened in the last week. So, you select that, and then it filters out and
13 gives you a reproducing mode where you are seeing only the images that fall
14 within those parameters that you've set. Similar to what we see in the
15 embodiment in the '848 Patent where you select the express mode, for
16 instance, and what it does is, it filters out everything that is below, or I guess
17 above, the certain threshold of 3, and it gives you, as a reproducing mode,
18 only the chapters that have an importance level of 1, 2, or 3. So here, you hit
19 any time, you select the particular filter or criteria, and then it reproduces
20 only the images that fit within that specific criteria.

21 JUDGE TROCK: Okay. So, with respect to Figure 5 of Haitani,
22 the word 'filter' that you're using is applied here for the dropdowns, place
23 and time, where you're selecting a particular place or a particular time, that
24 filters all of the images you see in the display below you so that once you
25 pick the particular filter, the result of what it now displays to you are just the
26 ones that fit that filter?

1 MR. JAY: That is exactly correct.

2 JUDGE TROCK: And that display to you, that's what you're
3 referring to as a reproducing mode; is that correct?

4 MR. JAY: That is absolutely correct.

5 JUDGE TROCK: Right.

6 MR. JAY: And just one quick point of clarification is, you can
7 certainly filter out by place, you can filter out by time, and you can also filter
8 out by both, so that would give you another way of doing it as well.

9 JUDGE TROCK: All right, thank you.

10 MR. JAY: All right. So, I'm going to move on to Slide 26. So,
11 we showed in our petition the reproducing modes that I just went through,
12 and this is the obviousness combination that we're presenting for Claims 11
13 and 12. Haitani discloses filtering by face recognition, time, location,
14 events, et cetera, and a POSITA would know that these modes can be
15 incorporated into Nozaki to perform selective reproducing operations of
16 varying scope that return larger or smaller sets of the same imaging data.

17 JUDGE TROCK: Okay. Let me stop you right there again,
18 Counsel.

19 MR. JAY: Yep.

20 JUDGE TROCK: So, I believe you said Haitani discloses filtering
21 by face recognition?

22 MR. JAY: Yes. Correct, Your Honor.

23 JUDGE TROCK: Okay. But that's not -- is the face recognition
24 filter shown here in Figure 5?

25 MR. JAY: No, it is not, Your Honor.

26 JUDGE TROCK: Okay.

1 MR. JAY: It's not. And that's just, I think, to show why you
2 would work to combine -- how it would work to combine Nozaki and
3 Haitani, but that is one aspect of Haitani. But really, the filters that we're
4 focusing on are the things like the place and the time.

5 JUDGE TROCK: All right.

6 MR. JAY: So, Maxell's sole dispute with this argument is that
7 they are not modes because the filters are not modes. That argument fails
8 for all the reasons we explained with respect to Maxell's claim construction
9 position. And even beyond that, even if one were to consider Maxell's
10 position, according to its claim language, these filters actually do create
11 operational states that the device has been switched to, because they modify
12 the operation of the device when the user switches the filter criteria on or off
13 or adjusts their threshold values.

14 Now, Maxell tries to contrast these filters in Haitani with a
15 chapter-select reproducing function in the '848 Patent. And their argument
16 there is primarily that the threshold for the standard express and
17 superexpress reproducing modes in the '848 Patent, are preset on the device,
18 whereas in Haitani, the user may be selecting the filters, but this is a
19 distinction without a difference. What matters for the '848 Patent is not how
20 the filters are set. Indeed, the claims say nothing about how the modes are
21 created, but rather how the filter is used to create the multiple reproducing
22 modes.

23 The question is, is there something different happening on the
24 device with respect to reproducing images? That's what's taking place in the
25 '848 Patent. That's what's taking place in Haitani. The claims are met if the
26 device is capable of three different reproducing modes that control the

1 reproduction of image information.

2 JUDGE TROCK: Counsel, is there anything in the claims -- Judge
3 Trock again, sorry. Is there anything in the claims that precludes user
4 selection?

5 MR. JAY: No, there is not, Your Honor.

6 JUDGE TROCK: And is there anything that requires them being
7 preset?

8 MR. JAY: Absolutely not, Your Honor.

9 JUDGE TROCK: All right, thank you.

10 MR. JAY: Okay. And I know I'm running short on time so I'm
11 just going to cover a couple more things. So, I'm going to move to Slide 27
12 where the aspect of Claims 11 and 12 that require different reproducing
13 times. For this, depending on how broad or narrow your search is in Haitani,
14 the results will have different reproducing times as the claims require. More
15 filters will provide a narrower set of results, meaning, a smaller set of
16 images, and thus a shorter reproducing time.

17 We see on Slide 28, this is an excerpt from the deposition of
18 Maxell's expert, Dr. Balakrishnan, and he in fact confirmed that it typically
19 takes more time to reproduce two images than one image. So, where filter
20 modes return larger or smaller sets of images, a POSITA would have
21 understood that disclosure to cover longer and shorter reproducing times as
22 well.

23 And then, the last thing I'm going to cover --

24 JUDGE TROCK: So, Counsel?

25 MR. JAY: Yes.

26 JUDGE TROCK: Sorry to interrupt.

1 MR. JAY: No, it's okay.

2 JUDGE TROCK: I just want to make sure I got --

3 MR. JAY: Please.

4 JUDGE TROCK: -- the evidence here correct.

5 MR. JAY: Yes.

6 JUDGE TROCK: So, your expert, does your expert testify that
7 applying multiple filters results in these differentials in time for
8 reproducing?

9 MR. JAY: He absolutely does. And when I sit down, I will get the
10 exact paragraph numbers of his declaration for you that I will give to you on
11 my rebuttal.

12 JUDGE TROCK: All right, thank you.

13 MR. JAY: Sure. And last thing, I'm going to go to Slide 29,
14 which relates to the limitations for the different reproduced content, and the
15 concept here is the same. Depending on how broad or narrow the search is,
16 or the filters are in Haitani, the results will also have different reproduced
17 content as the claims require.

18 So, again, going back to Dr. Balakrishnan's testimony, he
19 confirmed that one mode that reproduces a superset of information, and
20 another mode that reproduces a subset of that same information meets the
21 limitations of Claims 11 and 12. That's exactly what Haitani discloses and
22 would be implemented on the Nozaki/Haitani combination.

23 So, I'm going to stop there and reserve the remainder of my time,
24 unless Your Honors have any additional questions at this moment.

25 JUDGE POWELL: No, thank you. You may approach, and I will
26 take one. Thank you. Would you like to reserve time?

1 MR. PLUTA: Yes, Your Honor, 15 minutes, please.

2 JUDGE POWELL: Fifteen minutes, okay. Ready when you are.

3 MR. PLUTA: Thank you, Your Honor. May it please the Board,
4 Robert Pluta, on behalf of Maxell. I have two broad points I'd like to
5 discuss. First, Petitioner is relying on misapplication of the plain meaning of
6 'mode'. In their reply, they concede that they don't necessarily object to the
7 concept of mode as an operational state, but their application of the prior art
8 to that language does not fit, and the prior art, itself, highlights that
9 Petitioner's use of Haitani's filters do not disclose the first, second, and third
10 reproducing modes of Claims 11 and 12. Second, even where Petitioner's
11 apply Haitani's filters to the three reproducing modes of Claims 11 and 12,
12 Petitioner's analysis fails because it's filled with improper hindsight and
13 inconsistently applies Haitani's filters to the claim language.

14 I'd like to skip ahead to Slide 9. So, based on the petition's attempt
15 to apply Haitani's filters to the claim reproducing mode, we offered a
16 construction of the term 'mode' in our papers, and the proposed construction
17 as the proper meaning of 'mode' to a person of ordinary skill in the art, and
18 this construction does not encompass filters as disclosed in Haitani. I heard
19 my colleague say that they're not equating Haitani's filters to the claimed
20 modes, their papers suggest otherwise. And Petitioners concede, again, that
21 they don't object to the plain meaning of 'mode' as an operational state, but
22 the disagreement lies in whether Haitani's filters can be characterized
23 modes. They are not. And we know this for several reasons.

24 JUDGE TROCK: Counsel?

25 MR. PLUTA: Yeah.

26 JUDGE TROCK: Judge Trock. So --

1 MR. PLUTA: Yes -- yes, Your Honor.

2 JUDGE TROCK: -- you're framing the dispute differently than the
3 way Petitioner's framing it. Petitioner's framing it saying that the use of
4 filtering in Haitani can lead to the result of different modes, different
5 reproducing modes, and you're arguing that the filters themselves are the
6 modes. So, it's almost like we have two ships passing in the night here.

7 MR. PLUTA: Your Honor --

8 JUDGE TROCK: So, are -- because I'm just having difficulty
9 here, understanding why on the one hand, you're arguing that they're saying
10 that the filters are modes, and on the other hand, they're arguing that, no,
11 we're not saying that. We're saying that the use of the filters in Haitani lead
12 to these different modes, or, in other words, they're like switches being
13 selected for the different modes. So, it would be helpful to us if the two
14 sides would get on the same page here as to what the actual dispute is.

15 MR. PLUTA: Yes, Your Honor.

16 JUDGE TROCK: If you could clarify that for me, I'd appreciate it.

17 MR. PLUTA: Yes, and there may be three ships passing in the
18 night here. Because when we read the petition and the rest of Petitioner's
19 papers, it's pretty clear that they're saying that a filter in Haitani, whichever
20 it is, whether it's a narrow filter, a broad filter, or even narrower filter, is one
21 of the first reproducing, second reproducing, third reproducing modes. And
22 the way you framed it, the claim and the specification, the device selects the
23 mode first, and then the processor runs through the program, okay? And the
24 intrinsic record supports that view of mode. The '848 never uses the term
25 filter for any of its disclosed operational states, nor is the threshold disclosed
26 at Figure 10 of the '848 equivalent to Haitani's filters, certainly if they're

1 being viewed as modes, thus the construction of mode does not exclude any
2 embodiment from the scope of the claim reproducing mode.

3 JUDGE TROCK: Counsel, this is Judge Trock. Well, would you
4 agree with the Petitioner that Figure 10, step 22, is acting as a filter?

5 MR. PLUTA: We are not arguing that thresholds can never be
6 filters. The threshold is different in the '848 Patent. It is not a user-selected
7 filter to selectively reproduce video chapters.

8 JUDGE TROCK: Well, let's remove the user selection issue out of
9 this, and let's just talk about these threshold values, where the patent is
10 picking thresholds 1 through 5 to apply to these different chapters,
11 depending upon how often a particular recognized face shows up in these
12 different sections of video. And then, it's got these different reproducing
13 modes: express, standard, superexpress, and so forth, and it then
14 incorporates, or displays for the user the result of that, based upon these
15 numbers 1, 2, 3, 4, 5 that have been applied. So, would you agree that in
16 that situation that's acting as a filter? It could be a bypass filter, high-pass,
17 low-pass filter, but to the extent it is limiting what the result is, does it not?

18 MR. PLUTA: When you frame it that way, the threshold limits the
19 ultimate result, but the threshold in the '848 Patent is predetermined values.
20 They're not user selected.

21 JUDGE TROCK: So, the issue then -- what I'm hearing you say, is
22 that the issue is whether it's predetermined or user selected, not whether or
23 not that's a filtering step?

24 MR. PLUTA: The way I look at it -- and I was trying to think of
25 this with respect to the thresholds is, if we look at a car, for example, some
26 cars have different modes: eco mode, or sport mode, and there may be

1 different thresholds in the different operational modes controlled by the CPU
2 in a car, for example. You know, throttle response, holding of gears,
3 adjusting suspension, things like that. But, for example, in the sport mode,
4 which might increase the throttle response, hold gears a little longer, provide
5 a more aggressive driving experience, as compared to the eco mode, for
6 example, that might have a slower throttle response, shift gears sooner,
7 probably have a smoother drive, increased gas mileage. That's similar to the
8 '848 Patent where you have different operational states, the modes:
9 superexpress, express, and standard, which are chosen -- selected with
10 different thresholds within those modes, and that's apparent in Claims 11 and
11 12, which is markedly different than Haitani, where, at most, you have a
12 single mode with multiple thresholds. And Haitani never, for example,
13 discloses thresholds, and the '848 Patent never discloses filters.

14 So, I can understand -- I mean, the thresholds act to output certain
15 information based on the mode that you're in, and there's multiple modes
16 that are disclosed in the '848 Patent, and that's why we're proposing as
17 'mode' an operational state, because each particular mode that the '848 is in,
18 superexpress, express, or standard, is an operational state of that device.

19 JUDGE TROCK: Well, putting aside the terminology, whether it's
20 filter or whether it's threshold, functionally, isn't that step SP22 achieving a
21 particular result? Some things are getting through, other things are not.

22 MR. PLUTA: Correct.

23 JUDGE TROCK: And that decision is based on a criteria?

24 MR. PLUTA: Correct. And it's the predetermined value. So, for
25 example, if --

26 JUDGE TROCK: Well, predetermined or not. We've agreed, at

1 least for purposes of our discussion right here, to set aside whether it's
2 predetermined or whether it's user selected, so we're going to remove that
3 from our current discussion. My question is -- and then, also we're going to
4 put aside the label, filter or threshold, and let's just look at that step 22.
5 What is it doing? Is it allowing certain things through and other things not
6 through based upon some comparison to a value? And that's my question.

7 MR. PLUTA: SP22 --

8 JUDGE TROCK: And isn't that the same thing that Haitani does
9 even though it may use different words?

10 MR. PLUTA: I'll answer the last question first. No, it's not the
11 same as Haitani, but SP22 takes the chapter importance level, which is
12 defined by how the pictures -- or how things were set in the program, and
13 compares that to a threshold level. So, if it doesn't meet that criteria, the
14 process goes back up to the start of Figure 10, for example. If it does meet
15 that criteria, or threshold, it reproduces the chapter.

16 JUDGE TROCK: And so, how is that different than Haitani?

17 MR. PLUTA: So, Haitani, for example -- well, stepping back,
18 Figure 10 discloses three modes: the standard mode, the express mode, the
19 superexpress mode. Petitioners frame Haitani as these various filters, but
20 when we look at the disclosure in Haitani, all that filtering is happening in
21 one single mode, what Haitani calls the review mode. And Haitani discloses
22 other modes, but the only time Haitani discloses the filtering is within one
23 review mode.

24 JUDGE TROCK: Right. But I believe the argument that
25 Petitioner is making is that, depending upon the result of the filtering in
26 Haitani, you create different -- what they call reproducing modes. The more

1 filters you use, the longer the time it takes, and that's one reproducing mode.
2 The smaller number of filters that you use, the faster the process is going to
3 take place, and that's another reproducing mode. I think that's what they're
4 arguing in their petition, is it not?

5 MR. PLUTA: That's generally how I understand it as well, and we
6 have some disagreement as to how they're applying those within the claims,
7 which we can discuss after we have our discussion here. That is how I am
8 understanding they're applying Haitani's filters. But, again, the intrinsic
9 record and the extrinsic record, all the prior art: Nozaki, Haitani, Dr.
10 Bederson's papers, all distinguish between modes and filters just like the
11 '848 Patent. So, the application of Haitani's filters to be equated to the
12 reproducing modes of the claims, and of the '848 Patent, is totally
13 inappropriate with respect to the intrinsic record and the extrinsic record.

14 JUDGE TROCK: And why would that be? Why is it totally
15 inappropriate?

16 MR. PLUTA: Well, one way to reference that is to look at Figure
17 10, for example. The process flow of the patent in Figure 10, the
18 reproducing mode is selected. After that mode is selected, a reproducing
19 operation start command is input, and this is column 10 of the patent at 9
20 through 15. Then, the chapter-select reproducing process begins, and the
21 system controller selects the first chapter at step SP21, and judges whether
22 the importance level of the chapter is predetermined threshold value or
23 smaller set to the present reproducing mode, the threshold that we were
24 discussing earlier. If that judgements no, it doesn't meet that criteria, the
25 process goes to SP24. If that's the case and another chapter exists, the
26 process returns.

1 So, when the process of Figure 10, and in the patent, the mode is
2 selected and the entire data set of all the data, or the photos, or the videos, or
3 whatever is processed, and it's whatever particular reproducing mode you're
4 in, based on the threshold values in Figure 10, applied to that mode setting,
5 whatever data that meets that criteria is presented. That's different than in
6 Haitani and Nozaki, frankly, where you have a single mode and that's it.
7 You're not operating from a --

8 JUDGE TROCK: I think I understand your position with respect
9 to what they're doing and your view. So, now, could you please point out to
10 me, in the claims, where this is articulated with respect to Figure 10? In
11 other words, how do the claims preclude what they're arguing with the
12 combination of Nozaki and Haitani, not whether or not their combination of
13 Nozaki and Haitani meets Figure 10?

14 MR. PLUTA: So, Figure -- I'm sorry, Claim 11, for example,
15 states: When the memory further stores instructions, that when executed by
16 the processor, caused the processor to control the reproduction of the image
17 information in a reproducing mode set from one of a first reproducing mode
18 and a second reproducing mode, of course, Claim 12 adds a third
19 reproducing mode. So, the setting of that mode is paramount in the claims
20 and it's based on the storing of the instructions. Haitani, the way they use
21 the filters -- and we disagree how they apply the filters, because they're not
22 using them in any consistent way -- Haitani's filters are not the reproducing
23 modes because they're not from instructions -- they're from one mode, the
24 review mode in Haitani. That's the disclosure in Haitani.

25 And there's a plain difference in the record between how a person
26 of ordinary skill in the art understands the term 'filter and mode'. And Dr.

1 Balakrishnan, in his deposition, testified that running a single algorithm,
2 where you're just switching out the filtering criteria, is not an indicator of a
3 different mode, and that's what's happening in Haitani. It's a single review
4 mode, applying some filters. And we already discussed our argument with
5 respect to the process flow as set forth in the '848 Patent.

6 And the prior art, again, uses mode consistent with Patent Owner's
7 construction and further distinguishes between modes and filters. Nozaki
8 references various modes, such as operations referenced as face registration
9 mode and operations such as face recognizing shooting mode. Petitioner
10 solely relies on the face registration mode.

11 And as Dr. Balakrishnan testified, that depending on which mode
12 the user selects, totally different processing operations are performed by the
13 CPU 26 in Nozaki. And as conceded in the petition, at page 8, Nozaki does
14 not explore the ways that the recorded information can be used to tailor the
15 reproduction and search process to produce broader or narrower results.
16 Instead, Nozaki simply discusses bringing up a mode selection screen where
17 a user can select between face registration mode and face recognizing
18 shooting mode.

19 Haitani, Exhibit 1007, also uses mode consistent with Patent
20 Owner's construction. For example, Haitani discloses, as we've been
21 discussing, a single review mode that organizes images into a virtual album
22 that also displays time and location filter menus that'll allow a user to filter
23 through the images stored by the portal device. Haitani uses the term 'mode'
24 in reference to operational states. At Haitani, at column 29, lines 61 through
25 64 it states: Device 10 may be arranged to operate in one or more position
26 determination modes, including, for example, standalone mode, mobile

1 station assisted mode and MS-based mode. And Dr. Bederson, Petitioner's
2 expert, admitted that Haitani does distinguish between modes and filters,
3 knowing that Haitani describes a graphical user interface, including both
4 filters and using modes. And he also admitted that Haitani operates in
5 various modes in Slide 24.

6 And Dr. Bederson also agrees with the definition of 'filter', as set
7 forth by Patent Owner -- this is Slide 25, and that definition is consistent
8 with how Haitani is using the word filter, namely, something that separates
9 data or signals in accordance with specified criteria.

10 And again, in Dr. Bederson's paper, submitted with the petition,
11 Exhibit 1012, he also distinguishes between modes and filters. In that paper,
12 he describes the device as operating in either zoom or select mode.

13 And he further explained -- Slide 27, at deposition, that in that
14 device, depending on which mode was selected, zoom or select mode, the
15 system would operate differently. So, for all these reasons, the prior art even
16 distinguishes between mode and filter, and Patent Owner's definition of
17 mode, which is the plain and ordinary meaning of mode, and supported by
18 the specification of the '848 Patent, would not include filters such as
19 Haitani's filters.

20 Now, unless the Board has any questions on the claim construction
21 issues, I'd actually like to jump ahead to Claim 11, given the time I have left,
22 if that's okay.

23 On Slide 34, so Claim 11[a] introduces a first reproducing mode
24 and a second reproducing mode, and Petitioner relies on Haitani's filters as
25 disclosing these modes. As we've discussed, our position is, Haitani's filters
26 are not the claimed first and second reproducing mode. Selecting different

1 filters does not put Haitani in two different operational states and thus
2 different modes. And Dr. Balakrishnan testifies to such at Exhibit 2030 at
3 paragraphs 97, 131, and 160.

4 On Slide 35, Haitani operates, again, in a single review mode state.
5 As shown in Figures 5 through 9, a user choosing various filters in Haitani
6 to display videos, or images, is operating in, at most, a single review mode
7 state. A user is at all times, in the picture and video interface with the option
8 of selecting one or more dropdown menus that filter images for video. Nor
9 is there any evidence in Haitani, on Slide 36, that Haitani's device operates
10 differently depending on the filtering dropdown options chosen.

11 In fact, the evidence is just the opposite. Haitani makes five
12 references to review mode. In each example given, the device is operating
13 in the same way. The portable device allows a user to create virtual photo
14 albums and assemble the images in various ways based on filters chosen by
15 a user. That's Exhibit 1007 at column 20, lines 63 through column 21, 20
16 through 34, examples 10 through 12 in Haitani.

17 And as shown in Figure 3 of Haitani, its process flow shows it's
18 filtering separate and apart from any modes. Figure 3 shows a basic filter
19 function over a couple of generic boxes, but such disclosure does not
20 demonstrate that the filtering function is the claimed first and second
21 reproducing modes as claimed in Limitation 11[a].

22 JUDGE TROCK: Counsel, I have a question for you. With
23 respect to the claims of the '848 Patent, what's the difference between the
24 recited first, second, and third reproduction modes?

25 MR. PLUTA: Your Honor, can I ask a clarifying question as to
26 what do you mean by the difference?

1 JUDGE TROCK: Well, the claims recite these reproduction
2 modes. For example, Claim 16 talked about two reproduction modes.

3 MR. PLUTA: Oh, sure. So --

4 JUDGE TROCK: And it talked about whether one mode is shorter
5 than another mode. Like, for example, Claim 19, reproducing time for a first
6 mode shorter than second mode. So, what are these different modes that are
7 being recited in these claims?

8 MR. PLUTA: Yes, Your Honor. And a way to answer that
9 question is to go back to the specification and put it in the context of the
10 specification. So, for example, and we were talking about the superexpress,
11 express, and standard modes disclosed in the '848 Patent, and for example,
12 the superexpress mode could be the first reproducing mode. The second
13 reproducing mode could be the express reproducing mode. And the third
14 reproducing mode would be the standard reproducing mode. And that is
15 fairly clear in the '848 Patent, and that is how Dr. Balakrishnan testified to
16 such at Exhibit 1018 at page 45, lines 5 through 14.

17 JUDGE TROCK: And so, with respect to the specification of the
18 patent, then how are the operation of these modes different? In other words,
19 if we compare what's going on in the standard mode, and in the express
20 mode, and in the superexpress mode, how are they operationally different?

21 MR. PLUTA: They're operationally different, Your Honor, by the
22 mode that is selected, and they're operationally different by the --

23 JUDGE TROCK: Hold on, that's a tautology. I'm asking you,
24 we've got three modes here, and you just equated them to super, express, and
25 standard. And now I'm asking you, how are these three operationally
26 different from each other? And you just told me because of which one you

1 selected. That's not what I want.

2 MR. PLUTA: Okay.

3 JUDGE TROCK: I want to know how super, express, and
4 standard are operationally different from each other because you said they're
5 different modes?

6 MR. PLUTA: Sure.

7 JUDGE TROCK: And I will tell you; I understand that we've got
8 different numbers that have been applied, 1, 2, 3, 4 5.

9 MR. PLUTA: Right.

10 JUDGE TROCK: And different modes are filtering -- I'm going to
11 use the word filtering. I know Petitioner uses it. I know you don't like it,
12 but I'm going to use the word filtering, or selecting, if you want to do that,
13 based upon what numbers are there for these chapters. So, I want you to tell
14 me how they're operationally different from each other.

15 MR. PLUTA: So, for example, in the express mode, if the express
16 mode is selected, for example, it's operationally different, because when it
17 goes through the process flow of Figure 10, for example, it will reproduce
18 the entire data set of data. The express mode is operationally different,
19 because when the express mode is chosen, it will take the entire data set and
20 put it through the process, and only the data set -- only the photos or data
21 that meet that criteria or threshold will be passed through. The other
22 chapters will not be, and the decision tree then will be, well, does more data
23 exist in this data set? If yes, then it returns.

24 JUDGE TROCK: Okay. So, setting aside the series of steps, are
25 not you describing a filtering process?

26 MR. PLUTA: No, the --

1 JUDGE TROCK: So, you're telling me, that the difference
2 between super, express, and standard is not a filtering process difference?

3 MR. PLUTA: It's not a filtering process because the system
4 selects the mode, and it says it in the claims. It's sort --

5 JUDGE TROCK: Okay. Now we're back to whether it's
6 predetermined or whether it's user selected, but that's not what I'm asking
7 you. I'm asking you, how these three modes, that are recited in these claims,
8 are operationally different from each other? And if what you're saying is,
9 that the only difference is in what they select, then I think what you're
10 describing is a filtering process.

11 MR. PLUTA: The threshold value at Figure 10 acts to examine
12 the data and determine which data passes.

13 JUDGE TROCK: I agree.

14 MR. PLUTA: That's a criteria. The patent doesn't use the term
15 'filter', but it's passing select data, depending on which mode you're in. But
16 the way Petitioners pass the petition, and the evidence that they've put in, is
17 that they would equate Haitani's filters then to the threshold of the '848
18 Patent, not the reproducing mode --

19 JUDGE TROCK: That's a fair argument, Mr. Pluta, and I wouldn't
20 necessarily disagree with you there, because I think that's close to what
21 they're doing. Because they're saying, look, with Haitani, whether you pick
22 time, or whether you pick date, or some other criteria, you're going to
23 separate out what images you see and what images you don't see. So, I think
24 that, functionally, what they're arguing with respect to Haitani, is very
25 similar to what you're saying. I don't necessarily disagree with that. The
26 issue I'm struggling with here is whether or not the two of you are describing

1 the same function, and that's the struggle I'm having here, with respect to the
2 way these claims are written, what's described in this patent, and what
3 they're arguing with respect to Haitani. So, that's what I need your
4 assistance in. Help me understand the distinction that's going on here.

5 MR. PLUTA: And I'm doing my best, Your Honor. And I guess
6 the way I would present it, is -- and I don't know that there would be any
7 disagreement here, but the reproducing modes, as in the claims, and in the
8 specification, are called the reproduction modes, and it's an operation, and
9 it's superexpress, express, or standard. That's in distinction to a filter, in
10 Haitani's filter, that as I was arguing, at best, are in one mode, and filtering,
11 however you want to describe it, within that one mode.

12 JUDGE TROCK: I hear you, Mr. Pluta, the review mode in
13 Haitani. I fully understand that. And I do understand that aspect of your
14 position. But the conundrum that I'm facing here is whether or not the two
15 of you are describing the same function.

16 MR. PLUTA: So, perhaps a way to get at it is to show how they're
17 applying Haitani's filters to the claims and why they need to juggle what
18 they're calling a first reproducing, second reproducing, and third reproducing
19 mode around, because the '848 Patent doesn't have to do that. As I
20 described, the various modes that are disclosed in the patent meet the claims,
21 if you read them that way.

22 But as we argued in our papers, Petitioner and Dr. Bederson kind
23 of substitute in and out what filters they want to apply to suit their purposes.
24 They have to switch out a broad filter for a narrow filter, depending on what
25 the specific claim language said, and we don't think that's appropriate. And
26 that's why they're not -- the modes are set in the '848 Patent. They're set in

1 the claims of the patent, Claims 11 and 12, and other claims, and Petitioners
2 have not made any attempt to set the modes. If they did, they would be
3 consistent throughout Claims 11 and 12 and all the elements disclosed
4 therein.

5 JUDGE TROCK: Well, I will tell you, Mr. Pluta, I am not -- as I
6 sit here now, particularly persuaded by what the Petitioner is arguing, that
7 the application of these filters in Haitani result in three different modes.
8 Because if you add in more criteria, it's going to take a longer time, and
9 that's one mode. Or if you have less criteria, that's another mode because
10 that'll be a faster amount of time. I'm not particularly persuaded by that
11 argument. But what I first want to try to understand is, whether or not the
12 two of you are really talking about a selection process, and whether or not
13 the core of the dispute here is what these three modes really are? What
14 constitutes them with respect to the language of the claims, and what's being
15 described in the specification, and whether or not this prior art can fit into
16 that? And that's kind of where I'm struggling here.

17 MR. PLUTA: And maybe we didn't do the best job. But what
18 we're trying to convey, and why we offered 'mode', and a description of what
19 the '848 Patent talks about, what the prior art presented in the petition talks
20 about, what Dr. Bederson has written about, how the prior art in the patent
21 describe 'mode', and how that is in stark contrast to Haitani's filters. Because
22 Haitani's filters, they're different. They're not modes as related into the
23 patent.

24 But also in the prior art, Petitioner even cites -- I mean, they make
25 no attempt to distinguish when Haitani is talking about various modes, for
26 example, the review mode, but also the standalone mode, the MS mode, the

1 various modes. And there are multiple of them disclosed in Haitani, and try
2 to say, like, well, ignore all those modes, use the filters as the claim
3 reproducing modes. I mean, to me, this reeks of hindsight. They just found
4 filters and say, okay, well, this meets that claim limitation. And I think that's
5 highlighted in Dr. Bederson's admission that -- well, the filters I apply in
6 Element 12[a], if I'm looking at 12[b], they'd actually have to be reversed.
7 That is hindsight. And that's why there's a problem with the use of filters
8 -- Haitani's filters, to try to describe the claims of the patent.

9 JUDGE TROCK: What's the citation to Bederson again, that you
10 were describing?

11 MR. PLUTA: Yes.

12 JUDGE TROCK: Again, if you don't have it at the tip of your
13 fingers, you can give it to me later.

14 MR. PLUTA: I have it at the tip of my fingers. Exhibit 2031,
15 page 65, line 11 through 66-7.

16 JUDGE TROCK: Okay, thank you.

17 MR. PLUTA: And just before I sit down, unless you have any
18 other questions, I'd like to draw the Board's attention to Slide 43, where
19 we've attempted to show why the application of these filters is such a
20 problem, because it's all over the place as to which mode is which, and
21 doesn't conform with the antecedent basis of the claims, and we think these
22 claims should be held patentable.

23 JUDGE TROCK: Well, Counsel, if my colleagues will indulge
24 me, because I've taken up so much of your time by asking you questions --

25 MR. PLUTA: (CROSSTALK) --

26 JUDGE TROCK: -- if you want to describe what's going on here

1 in Slides 42 and 43, I am all ears.

2 MR. PLUTA: Sure. Well, 42 is Dr. Bederson's testimony, where
3 he admits, that the three modes I gave you, for example, I gave examples for
4 regarding Limitation 12[a], would actually have to be reversed to meet the
5 Limitation 12[b]. I just want to make it clear, that filters one, two, three
6 from -- those are the first, second and third reproducing modes, as he
7 characterizes them from 12[a], were examples that met 12[a]. But if you
8 want to use those same examples for 12[b], well then, the third mode would
9 have to apply to the example where there was only one filter, not all three
10 modes. But in 12[a] and 12 [b], it's referencing the first, second, and third
11 mode just as it is in the 12[b], where it's referencing the first, second, and
12 third mode. You can't just be switching this around.

13 And this -- going to Slide 43 is, I think, a fair reading of how
14 they're presenting which mode is which, and which filter is applying to
15 which particular mode for Claims 11 and 12.

16 So, for example, in 11[a], they assign, as the first reproducing
17 mode, a broad filter, and a narrower filter for the second reproducing mode.
18 The third reproducing mode doesn't show up until Claim 12. For 11[b], they
19 switch horses and say, now, well, first reproducing mode is the narrower
20 filter, and the second reproducing mode is the broad filter, and so on.

21 JUDGE TROCK: Okay. Mr. Pluta, here's what would be helpful
22 with respect to your Slide 43. So, for 11[a], you're saying they're applying a
23 broad filter for the first mode and a narrow filter for the second mode.
24 What's the citation to the evidence that they're doing that? And then, 11[b],
25 you now say it's switched from a narrower to a broad. What's the citation to
26 the evidence where they're doing that? And the same thing for C, 12[a] and

1 12[b]? I need citations to evidence --

2 MR. PLUTA: Sure.

3 JUDGE TROCK: -- not just a demonstrative that says that's what
4 they're doing.

5 MR. PLUTA: Yes, Your Honor, and I will give that to you right
6 now, if --

7 JUDGE TROCK: Well, you can give it to me later. I don't want to
8 hold up everybody's day. But I will tell you that evidence is important in
9 making these decisions. And when I look at a slide like this, what I see is
10 attorney argument.

11 MR. PLUTA: So, the citation on the slide is correct, it's the
12 petition at pages 28 through 31. I can give you additional information where
13 Dr. Bederson actually testifies to this as well, but I would direct, Your
14 Honor, in a broad sense, to the petition itself on pages 28 through 31.

15 JUDGE TROCK: Okay. And if I go there and start reading it, I'm
16 going to see them apply something that's called a broad filter for 11[a] as the
17 first mode and a narrow filter as the second mode, or are these not just words
18 you put in there, characterizing their position?

19 MR. PLUTA: No, Your Honor, it's very clear. On page 28, they
20 say -- they arrange such that a first filter, quote, "may cover a broad range
21 followed by a second filter that is responsive to the first and customized to
22 display filter options that are narrower." In 11[b] they say, on page 29 of the
23 petition, a POSITA would have understood that the reproducing time for the
24 first mode; i.e., a narrower search that combines multiple filters, would be
25 shorter than a reproducing time for a second mode; i.e., a broad search that
26 uses a single filter as this limitation recites.

1 In Limitation 11[c] on page 30 of the petition they state: a
2 POSITA would have understood that the images/videos were produced in
3 the broad second mode, that uses a single search term, would include the
4 images/videos reproduced in the narrower first mode. And I could go on,
5 because they do the same thing for 12[a] and 12[b], and we were pretty clear
6 to take their words at face value and put them on the screen. I don't think
7 we'll have much disagreement from my friends on the other side.

8 JUDGE TROCK: Okay, thank you.

9 MR. PLUTA: Thank you, Your Honor.

10 JUDGE POWELL: We're ready when you are.

11 MR. JAY: Okay. Judge Trock, when I was doing my opening
12 remarks, you had asked where our expert talks about the '848 Patent, in
13 particular, the embodiment for reproducing modes, where he talks about that
14 being equivalent to a filter. And that is in Exhibit 1017, that's Dr.
15 Bederson's reply declaration, Exhibit 1017, paragraphs 15 and 16.

16 JUDGE TROCK: Okay, thank you.

17 MR. JAY: And you had also asked, I believe, where Dr. Bederson
18 had talked about the different reproducing times. I'm just going to get the
19 -- that's Exhibit 1005 at paragraphs 100 and 104. And then, I can't recall if
20 Your Honor had also asked for, where in Dr. Bederson's declaration he had
21 talked about reproducing different subsets of image information, but that's in
22 paragraph 101 of Exhibit 1005.

23 JUDGE TROCK: I thank you for that, Counsel, and I bet you can
24 guess what my next question's going to be to you.

25 MR. JAY: Sure. As Dr. Bederson --

26 JUDGE TROCK: Hold on. Hold on.

1 MR. JAY: Yeah.

2 JUDGE TROCK: And just to make sure we're on the same page,
3 I'm going to ask you to explain what the allegation here in Slide 43 is from
4 Patent Owner --

5 MR. JAY: Sure.

6 JUDGE TROCK: -- that you're essentially changing horses in the
7 middle of the stream, that for 11[a], you're claiming a first mode as a broad
8 filter and a second mode as a narrow filter, but when we get to 11[b], you've
9 now switched that.

10 MR. JAY: Sure.

11 JUDGE TROCK: They also argue that there are additional
12 inconsistencies here with respect to whether or not you're choosing a narrow
13 or a broad filter with respect to these reproducing modes. So, the floor is
14 yours.

15 MR. JAY: Sure. So, Your Honor, we see on Slide 42, when Dr.
16 Bederson's talking about this. What he's talking about, is that these are just
17 examples. And when I was talking about earlier, there are numerous ways
18 that you can apply the filters in Haitani, and the way it's discussed in the
19 petition, and the way that Dr. Bederson discusses it, these are just examples
20 -- that it would have been obvious to a POSITA that you could apply these
21 filters in many different ways to achieve what Claim 12 requires.

22 So, these are just examples here on Slide 43 of Patent Owner's
23 slides. You can certainly just flip these around, such that you could have
24 narrowest, narrow, or broad for both 12[a] and 12[b]; similarly, you could
25 flip things around, such that 11 would match 12. These were just examples
26 of applying the filters. These are not the absolute ways that it has to be done

1 in order to achieve the result. This just an example of narrower and broader,
2 how the filters can be applied.

3 JUDGE TROCK: Okay. But you can see the problem that Patent
4 Owner has, and I am concerned about this, is that, as you're applying this
5 prior art, and you're moving through the various limitations in the claims, are
6 you or are you not changing which filters you're using for these first, second,
7 and third reproducing modes?

8 MR. JAY: We are not. Yeah, sorry, sorry.

9 JUDGE TROCK: Okay then, then I need some kind of
10 explanation as to what's going on here.

11 MR. JAY: Sure. I think if we go back to the petition, when it's
12 discussing these limitations, and you also look at Dr. Bederson's declaration
13 on this, the way it describes it, is these are just examples that are numerous
14 ways that you can apply the filters of Haitani to achieve --

15 JUDGE TROCK: Yeah.

16 MR. JAY: -- sort of narrower or broader, such that the limitations
17 are met in terms of the different reproducing times. Yeah, essentially, you
18 could arrange it in different ways. It's just an example that a POSITA would
19 know that it would be obvious that in applying the filters in Nozaki, you
20 could apply them such that you would for the first reproducing mode have
21 narrowest, second reproducing mode have narrower, and the third
22 reproducing mode have broad filter, and you could do that for both 12[a] and
23 12[b]. And I think that the way that it's discussed in the petition, as well as
24 in Dr. Bederson's declaration is such that it's clear that these are just
25 examples of different ways that you can apply the Haitani filter in many
26 different ways to get modes that reproduce different subsets of information

1 that would also have the effect of creating different reproducing times, such
2 that the first reproducing mode would have a shorter reproducing time than
3 the second, and the second would have a shorter reproducing time than the
4 third.

5 JUDGE TROCK: So, are you saying that the examples that you're
6 providing in the petition are just somehow inconsistent when you move from
7 one limitation to the next?

8 MR. JAY: No. What I'm saying is, that the way that the petition
9 describes it, is that these are just examples, and that there are -- I think the
10 petition makes clear that there are numerous ways that you could arrange the
11 filters in Haitani, such that it would meet all of the limitations of both Claim
12 11 and Claim 12 consistently throughout.

13 JUDGE TROCK: Okay. The last question I have here with
14 respect to this, if you could just articulate for me one more time --

15 MR. JAY: Sure.

16 JUDGE TROCK: -- what these different reproducing modes are in
17 Haitani, and how Haitani achieves them, or discloses them?

18 MR. JAY: Sure. So, if I could -- I think we have -- all right. So,
19 this is actually their Slide, it's 35 of Exhibit 2032, but you can see it the same
20 here as you can see on our slide so I'm just going to use this.

21 So, Haitani allows --

22 JUDGE TROCK: Sorry, I can't see what you can see in
23 Alexandria.

24 MR. JAY: Oh, you cannot see this --

25 JUDGE TROCK: (CROSSTALK) --

26 MR. JAY: Okay, so.

1 JUDGE TROCK: If you could tell me what slide you're looking
2 at.

3 MR. JAY: Sure. So, Your Honor, this is Exhibit 2032, and I have
4 Slide 35 --

5 JUDGE TROCK: What is 2032? Can you --

6 MR. JAY: Sure, that's the Patent Owner's demonstratives.

7 JUDGE TROCK: That's a lot easier for me. Which number?

8 MR. JAY: Slide 35.

9 JUDGE TROCK: All right, I'm there.

10 MR. JAY: All right. So, you can see here, on Haitani, and this is
11 Figures 5 through 9, we had also put Figure 5 in our slide. You can see
12 Haitani allows -- it has different dropdown menus, right? So, it has a place
13 dropdown menu and a time dropdown menu. So, what happens is, you
14 select, for instance, any time, right? You can see that on the figure on the
15 top right, and there you can select -- it has different date ranges, it says, any
16 time, it says September 11 through 21st, 2006, and then after that is July, I
17 think, 8th through 19, 2005, and so on.

18 So, at that point, you can select one of those, right? So, say you
19 select September 11th through 21st, 2006, so, at that point, you select that,
20 and that Haitani will reproduce all of the images that fit within that date
21 range. So, it will exclude everything that's not within that date range and
22 reproduce everything that is within that date range, which is similar to what
23 we see in the embodiment of the '848 Patent, where when you have the
24 express mode, it reproduces only the chapters with a importance level of 1,
25 2, or 3 and excludes the chapters with the importance level of 4 or 5.

26 Another example of that would be -- here, you can see in, say, the

1 middle figure here, where it's talking about the places, right? And I think it
2 says France, and somewhere in New York. I'm having trouble reading it,
3 somewhere in Sunnyvale, California, Mountain View, California, et cetera.
4 The same thing, you could select a place, right? So, you could select
5 Mountain View, California, and then it would exclude everything -- all of
6 the images, and reproduce only those images that were taken in Mountain
7 View, California.

8 And then, another way you could do it is, you could first select
9 Mountain View, California, then you could also select time, you could select
10 July 8th through 19th, 2005, and you could apply both of those filters, and
11 then it would, only at that point, give you reproduced images that were taken
12 in Mountain View during that particular time in July of 2004, so that would
13 be an example of a different mode in Haitani. So --

14 JUDGE TROCK: All right. So, here's my question to you,
15 Counsel.

16 MR. JAY: Yes.

17 JUDGE TROCK: I understand how Haitani is applying its filters,
18 and I understand that there's a comparison, and they produce a data set as a
19 result of that filtering process.

20 MR. JAY: Yes.

21 JUDGE TROCK: The data set being the set of photographs that
22 you see there as thumbnails, correct?

23 MR. JAY: Correct.

24 JUDGE TROCK: All right. How are those different reproducing
25 modes if all you're doing is applying a filter?

26 MR. JAY: It is a reproducing mode in the way that the claims of

1 the '848 Patent talk about reproducing mode. So, it is a mode where it's
2 reproducing a different set of images than when you apply a different filter,
3 where in that instance it reproduces a different set of images. And we see
4 the same exact thing that has to be within the scope of the claims of the '848
5 Patent, given that the only embodiment in the '848 Patent is doing the exact
6 same thing.

7 And Your Honor has asked my colleague a number of questions
8 about the differences between what's going in Haitani and what's going in
9 the '848 Patent. And it seemed like it always came back to the idea that one
10 is sort of preset, or user selected, or predetermined, but as we discussed
11 before, and as Your Honor had pointed out, there is nothing in the claims
12 requiring that that cannot be a distinguishing feature for the -- that cannot be
13 a way to distinguish Haitani from what the claims require because that's not
14 an element of the claims. I don't know if that answers your question.

15 JUDGE TROCK: Well, it addresses it, but I don't know if it
16 answers it, because I'm still kind of confused here. So, let me ask this. How
17 do you respond to Patent Owner's argument that Haitani only has a review
18 mode, and it doesn't have other operational modes? Because this is kind of
19 the problem here. We've got this word 'mode' here --

20 MR. JAY: Yeah.

21 JUDGE TROCK: -- and we've got these operational states that the
22 Patent Owner says, well, that's what a 'mode' is, it's a different operational
23 state. But you say, no --

24 MR. JAY: Yeah.

25 JUDGE TROCK: -- in the sense. Your argument is no, that's not
26 what a 'mode' is. With respect to what the patent shows us, this 'mode' is

1 just a result.

2 MR. JAY: Right.

3 JUDGE TROCK: It's just a data set that gets produced. And then,
4 we get into this argument, well, in the patent it's preset because we've got
5 this express. We've got superexpress. We've got standard. And we go back
6 to Haitani, you're in review mode when you're adding these filters and
7 getting these results. So, this is difficult to put these two things together and
8 to see whether or not we're on the same page here, and what the answer is
9 going to be here. Because, frankly, for both of you, our job here is to get
10 this right, and this is a challenge based upon how these cases are being
11 presented here.

12 So, respond to Patent Owner's argument here that Haitani's only
13 got one mode, and that's the review mode. And in that review mode, the
14 user is selecting filters, and you get a resulting data set. But that's not a
15 different mode, that's just a different data set.

16 MR. JAY: Sure. So --

17 JUDGE TROCK: How are we to resolve this?

18 MR. JAY: I think what Haitani is talking about when it refers to
19 'mode,' is a different use of the word, 'mode' than is reflected in the '848
20 Patent when the '848 Patent talks about reproducing modes. And, again, I'll
21 just kind of go back to what I was saying earlier, where when we're looking
22 at what the plain and ordinary meaning of reproducing mode is in the
23 context of the '848 Patent, it must be the case that the scope of the claims of
24 the '848 Patent includes this only embodiment of the reproducing modes that
25 we see in Claim 10.

26 So, using that, what we need to look at, is not so much just what

1 word Haitani uses, but the results in Haitani. And if you look at the result of
2 applying the filters, what the result of that is the exact same as the result of
3 applying the express, superexpress, and I think it's standard mode in the one
4 embodiment in the '848 Patent.

5 JUDGE POWELL: Thank you. So, we ran two minutes and
6 change over on that. I'm going to increase Patent Owner's time
7 commensurately.

8 MR. PLUTA: I shouldn't need too long, unless there's --

9 JUDGE POWELL: All right.

10 MR. PLUTA: -- extensive questioning from the Board. Judge
11 Trock, you said your challenge is to get it right. I totally agree. With
12 respect to Claims 11 and 12, I think the tail is wagging the dog here. There,
13 he's saying, well, filters are just examples. Well, yeah, like, when you use
14 the claims as a roadmap, it's probably pretty easy to push things into what a
15 first reproducing mode and second reproducing mode is. But the fact is,
16 they took a position in their petition, which mode was which, and they
17 figured out that it was inconsistent with how the claims read, and they can't
18 fix it now. Dr. Bederson admitted that's what he did. And he was just
19 saying, well, you could just switch it out for Element 12 [a] and 12 [b]. That
20 is hindsight. That's the first point.

21 The second point is, Haitani's use of mode is entirely consistent. I
22 mean, Haitani -- I raised this earlier, but at Exhibit 1007, column 29, lines 61
23 through 64, Haitani says device 10 may be arranged to operate in one or
24 more position determination modes, including -- then it lists the modes.
25 Well, if -- assuming arguendo, a review mode is one of those modes that has
26 to operate, at most, they're showing there's one mode. Where are the other

1 ones? They can't be mixing and matching filters and modes, or modes and
2 filters to come up to the claimed patent. Again, that's entirely hindsight, and
3 we think it's a fairly clear case in that regard, that what they've done here is
4 not met their burden to show that Haitani's filters meet the limitations of at
5 least Claims 11 and 12.

6 Unless there's any more questions, Your Honors, I will sit down.

7 JUDGE TROCK: None from me.

8 MR. PLUTA: Thank you.

9 JUDGE POWELL: Thank you very much to both parties for your
10 time today. This case is submitted. We'll go off the record.

11 (Whereupon, the above-entitled matter went off the record at 4:19
12 p.m.)

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Patent 10,176,848 B2, C1

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