

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

S.M.R INNOVATIONS LTD AND Y.M.R TECH LTD,
Patent Owner.

IPR2024-01048
Patent 10,547,648 B2

Record of Oral Hearing
Held: October 28, 2025

Before: STACEY G. WHITE, CHRISTOPHER L. OGDEN, and
MARY C. HOFFMAN, *Administrative Patent Judges*.

IPR2024-01048
Patent 10,547,648 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

PAUL HART, ESQ.
Erise IP
717 17th Street, Suite 1400
Denver, CO 80202
(720) 689-5441
paul.hart@eriseip.com

ON BEHALF OF THE PATENT OWNER:

CORTNEY ALEXANDER, ESQ.
Kent & Risley LLC
5755 N Point Parkway, Suite 57
Alpharetta, GA 30022
(404) 855-3867
cortneyalexander@kentrisley.com

The above-entitled matter came on for hearing on October 28, 2025,
commencing at 1:30 p.m., via video teleconference.

P R O C E E D I N G S

- - - - -

JUDGE HOFFMAN: Good afternoon, all. This is the hearing of IPR2024-01048 involving U.S. Patent Number 10,547,648. I'm Judge Hoffman. Appearing with me is Judge Ogden and Judge White, who are both remote.

I'd like to welcome both the Petitioner and the Patent Owner. Today, starting with appearances for Petitioner, who is arguing on behalf of Petitioner today?

MR. HART: Thank you, Your Honor. Paul Hart, lead counsel for Petitioner, Apple. With me today as back-up counsel, Adam Seitz, as well as client rep, Natalie Pous.

JUDGE WHITE: Okay. Excuse me, Counsel. Was the green light on? I couldn't hear you very well. When you go, you've got to speak into that so I can hear you.

MR. HART: Sure. It is now on. Would you like me to redo the introductions?

JUDGE WHITE: Yes, please.

MR. HART: Okay. Absolutely. I'm Paul Hart with Erise IP. Lead counsel for petitioner, Apple Inc. With me today is back-up counsel, Adam Seitz, also with Erise IP, and client rep, Natalie Pous, from Apple.

JUDGE HOFFMAN: All right. Thank you. And who do we have for Patent Owner?

MR. ALEXANDER: Good afternoon, Your Honor. This is Cortney Alexander for the Patent Owners.

1 JUDGE HOFFMAN: Okay. Thank you, Mr. Alexander. Again,
2 welcome to USPTO's Alexandria headquarters. A few housekeeping items
3 before we begin. Recording of any PTAB hearing is prohibited. The court
4 reporter will provide a transcript of the hearing. That will become available
5 and part of the record at a later date.

6 To ensure that the transcript of this hearing is clear, we ask you to
7 speak directly into the microphone when talking and identify your specific
8 slide numbers, the numbering in any figures, and any other pertinent
9 identifying information when you refer to your demonstratives.

10 We have allotted 45 minutes per side. Petitioner will begin the
11 argument and may reserve rebuttal time. Patent Owner will then respond to
12 Petitioner's arguments and may also reserve rebuttal time.

13 When you are arguing, please speak slowly, and if you hear
14 another voice, particularly one of the Judges -- remote, sometimes it's hard
15 to hear, please stop talking so that we do not talk over each other.

16 I will maintain the clock. Our hearing room has this timer behind
17 me that I will set up for each party with the requested time allotment.

18 With that, I'll ask Counsel for Petitioner and Patent Owner if there
19 are any other preliminary matters you'd like to discuss before we go into
20 arguments?

21 MR. HART: Nothing from Petitioner, Your Honor.

22 MR. ALEXANDER: No, Your Honor.

23 JUDGE HOFFMAN: Okay. Thank you very much. Mr. Hart, do
24 you wish to reserve any rebuttal time?

25 MR. HART: Yes, I'll reserve 10 minutes.

1 JUDGE HOFFMAN: Ten minutes. Okay. Let me set the timer.
2 Okay. You may begin when ready.

3 MR. HART: Thank you. Just make sure this flat screen -- it's not
4 my fault. It looks like it's working here. Here we go. Okay. Very good.

5 There are two key disputes for the Board to resolve in this
6 proceeding. First, there remains in dispute over whether Steps 1(b) and 1(d)
7 must be performed sequentially. Step 1(b) recites identifying one or more
8 available devices and Step 1(d) recites signaling the one or more available
9 devices.

10 At institution, the Board performed an in-depth analysis correctly
11 determining that the record does not support requiring Steps 1(b) and 1(d)
12 performed in any order. It also correctly found that even if an order were
13 imposed the proposed ground satisfy the claim because Step 1(b) does not
14 require actually confirming which devices are available. It simply requires
15 identifying one or more devices that happen to be available. The developed
16 record does not provide any rationale for deviating from those preliminary
17 findings at institution.

18 The developed record has introduced a new independent basis for
19 finding in favor of Petitioner on the Step 1(b), 1(d) issue. On cross-
20 examination, Patent Owner's expert testified that based on his interpretation
21 of the claim term available, Step 1(b) does not require identifying devices
22 that are currently free and immediately available to receive re-routed media.

23 Instead, his interpretation of available in Step 1(b) requires only
24 identifying devices that are turned on and connected to the network. The
25 proposed combination satisfies this interpretation regardless of whether an

1 order is mandated between Steps 1(b) and 1(d).

2 The second key dispute for resolution in this proceeding relates to
3 an unclaimed implementation detail. This issue was first introduced in the
4 Patent Owner response, which argued that Petitioner had failed to establish
5 that the proposed grounds hardware were capable of transcoding voice data.

6 Now, the claims do not require transcoding voice data. They don't
7 require media transformation of any kind. So Patent Owner's critique is
8 simply that when the proposed grounds route a phone call, as the Petition
9 proposes they do, Zhang's hardware, the mobile phone in the proposed
10 grounds, must be capable of converting voice data from the cellular standard
11 to the local area network standard.

12 Now, curiously, Patent Owner does not identify any technical
13 reason why the proposed grounds hardware would be incapable of
14 transcoding voice data when rerouting a phone call from the cellular network
15 to that local area network. There are no allegations that Zhang's hardware is
16 incompatible with voice transcoding. There's no suggestion that voice
17 transcoding was unusually difficult or under-developed at the time.

18 In fact, the '648 Patent, although it doesn't claim any form of media
19 transformation, it does discuss media transformation. And what it says
20 about media transformation is that it was well understood and available via
21 commercial software packages.

22 The reply demonstrated that not only was voice transcoding
23 routine -- sorry, Your Honors. Not only was voice transcoding routine, but
24 the hardware and the proposed combination specifically supported voice
25 transcoding when implemented pursuant to HomeRF, which was one of the

1 two wireless local area network standards that Petitioner backed in the
2 petition.

3 The sur-reply applied largely abandons a focus on voice
4 transcoding and it shifts its focus to an allegation that Zhang's local area
5 network might have been deployed without a router at all, an intermediate
6 routing device. Now, Petitioner has not yet had an opportunity to address
7 that new argument that shifted focus on this unclaimed implementation
8 detail, but as I will cover in detail today, it fares no better than Patent
9 Owner's initial focus on voice transcoding.

10 Before I dig deeper into the specifics of these remaining
11 arguments, I do just want to lay the groundwork a bit, in part, to remind the
12 Board just how closely the prior aligns with the '648 patent and its claims.
13 The core concept in the '648 Patent is a recognition that mobile devices,
14 while ubiquitous, often had diminished capacities with respect to
15 input/output devices, memory, battery power. The real focus of the
16 embodiments in the '648 Patent are on input/outputs such as speakers,
17 microphones, and displays.

18 The embodiment that is most applicable to this proceeding is
19 rerouting a phone call. The '648 Patent recognizes that the
20 speaker/microphone on a mobile device were often insufficient and it
21 proposed finding a local wirelessly connected alternative, such as a tabletop
22 phone or speaker phone and rerouting the audio to that local wirelessly
23 connected speaker phone to improve the user experience.

24 Claim 1 is the claim that the parties had focused on for most of the
25 disputes in the case. As we see here, it's fairly straightforward. It really is

1 just talking about locating devices, informing devices of media on a mobile
2 device that is able to be or ready to be rerouted. And it has a couple
3 important limitations. The local area network, the wireless connection needs
4 to be a WLAN that uses an intermediate routing device. So the common
5 example that we think of is a Wi-Fi router. Every Wi-Fi network has an
6 intermediate router device. All communications go through that
7 intermediate routing device.

8 The other specific limitations that are worth noting, the media in
9 Claim 1 has to be either audio or video and it has to originate from outside
10 the wireless local area network. So, in our example in our proposed
11 grounds, that is a phone call that comes in from the cellular network and gets
12 passed off to a local speaker and microphone on the wireless local area
13 network.

14 The proposed grounds, four of them here, all four are based on this
15 core combination.

16 JUDGE OGDEN: Sorry to interrupt you. I was wondering if you
17 could please let us know what slide you're on so that we, remotely, can
18 follow along?

19 MR. HART: Thank you, Judge Ogden, and I absolutely will. So
20 turning to DX4, this just summarizes the four grounds in this case. All four
21 are based on this core combination of Zhang, Fillebrown, and Pasanen.
22 Zhang's helper network is really the focus in all grounds here. Zhang
23 describes -- and I have a couple slides on Zhang specifically, but it describes
24 a local area network that wirelessly connects devices, such as Mobile Device
25 32 and Audio Helper Server 28. It connects those via an intermediate

1 routing device network. The two examples it provides are Wi-Fi, which is
2 AIDA 2.11 (PHONETIC) and HomeRF.

3 Fillebrown, in the combination, really serves a limited role. It just
4 provides an express teaching of an intermediate routing device. It also
5 identifies both Wi-Fi and HomeRF as two exemplary, you know, star
6 topology, wireless local area networks.

7 And then Pasanen has a very limited role in the proposed
8 combination. It is really just there for the use case of receiving a cell phone
9 call to your mobile device and passing the audio off to a wireless speaker
10 and microphone to improve the user experience.

11 So clicking to DX6, Zhang's helper environment, I really wanted to
12 cover just the basics here to highlight how similar the problem identified and
13 the proposed solution are between Zhang in the '648 Patent. Zhang, like the
14 '648 Patent, identifies the problem that, while ubiquitous, mobile devices are
15 generally limited in their capacities. It identifies various types of limitations,
16 such as input and output, just like the '648 Patent, and it also proposes that
17 mobile devices should find helper services, other helper devices, on a local
18 wireless network and pass off their media in order to improve the user
19 experience for those media sessions.

20 DX7, Zhang teaches a set of essential steps that he uses to find
21 appropriate helper servers to improve the user experience. Figure 4 is really
22 the figure that the parties have focused most on in this case.

23 Here we see that the mobile device finds local devices connected
24 to the network, creates a list of those local devices that are compatible with a
25 given media it wants to pass off, and then one by one, it signals each of

1 those devices and says, here's what I have. Are you currently free and
2 available to handle this media if I reroute it to you. And as soon as it gets a
3 yes, I am available response from the helper server, it creates a session and
4 transfers the data and control signals over that session.

5 Just very quickly, Fillebrown is relied upon for that intermediate
6 routing device, a Wi-Fi router or HomeRF control point. Fillebrown also
7 acknowledges that these local area networks are useful for exchanging audio
8 and video between devices that are connected on the networks.

9 And finally, Pasanen, again, is the use case. Pasanen has the
10 express teaching of receiving a phone call. Here, it's to Mobile Station 1 in
11 blue, and passing off the audio from Mobile Station 1 in blue to a Wireless
12 Audio Interface 12 in red to use the speaker and microphone on Wireless
13 Audio Interface 12 to improve the user experience for that phone call. So
14 classic, it is not expressly Bluetooth, but in today's world we think of pairing
15 with our Bluetooth wireless headset in order to use that for the audio on a
16 phone call.

17 Remaining grounds. Skinner in Ground 2 adds in some alert --

18 JUDGE HOFFMAN: Mr. Hart?

19 MR. HART: Yes, Your Honor?

20 JUDGE HOFFMAN: Just a reminder to reference the slide
21 numbers.

22 MR. HART: Thank you, Your Honor. I will try to not do that
23 again. DX10 summarizes the remaining grounds. Skinner in Ground 2 adds
24 in concepts of flashing lights and ring to alert the user of available media.

25 Ground 3, relies on Rofheart for the feature of creating a list of

1 compatible and available devices on the network from which the user can
2 choose, so again, it's the -- rather than just choosing and using the very first
3 helper server that is available and compatible as Zhang does in its native
4 process, Rofheart allows the user to see what devices are out there and to
5 choose a specific device. Finally, Ground 4, Angelo has some
6 encryption concepts relevant to Claim 13.

7 The remaining questions on DX11 in this case, the first two, I've
8 already covered. The first one relates to Steps 1(b) and 1(d). Must the
9 mobile device confirm a receiving device is available before signaling it?
10 Must 1(b) conclude before 1(d) picks up? No. As the Board found in
11 institution, there is no order mandated. But even if there were an order
12 mandated, Ground 1 satisfies the claims because Step 1(b) does not require
13 affirmatively determining which devices are available, just identifying
14 devices that happen to be available.

15 Second question for the Board, is Zhang's hardware incapable of
16 transcoding voice. This is the unclaimed implementation detail. As I
17 covered briefly earlier, Zhang's HomeRF implementation has native voice
18 transcoding functionality.

19 The remaining disputes touch on independent's Claim 5 and 6, and
20 independent Claim 19. I'll get to those later in the slides. I want to jump
21 straight to the key disputes for the Board to resolve.

22 So turning to DX12, this is the first major dispute between the
23 parties that relates to Limitations 1(b) and 1(d). Patent Owner's position is
24 that Step 1(b), identifying one or more available devices requires the mobile
25 device confirm that a device is available before signaling it in Step 1(d).

1 Now, there's really three interpretations of the claims that have
2 been discussed in advance in this case. The first was presented in the
3 Petition, that does not require an order. Petitioner proposed that Steps 1(b)
4 and 1(d) can be performed in any order or simultaneously. So in Zhang's
5 process, it identifies devices, it tells them -- it signals them to let them know
6 it has media to reroute, and then when they confirm their availability, it
7 establishes that session in order to set up that data communication between
8 the helper service and the device. So 1(b) and 1(d) are occurring together in
9 Petitioner's initial mapping.

10 Now, the Board correctly held that no order was mandated by the
11 intrinsic record here. But it also held, importantly, that even if an order were
12 mandated, even if 1(b) was required to occur and complete before 1(d), 1(b)
13 merely requires identifying devices that happen to be available. It does not
14 require confirming that a device is available before then signaling it. And
15 so, under that interpretation, that the Board analyzed at institution, Zhang is
16 also sufficient, even if an order is mandated.

17 Again, the third interpretation is based on Patent Owner's expert's
18 explanation on cross-examination that available just means the device is on
19 and connected to the network, not that it is necessarily free and available to
20 receive rerouted media in the moment. So under Patent Owner's
21 interpretation of available, Zhang also satisfies these claims, even if an order
22 is mandated.

23 Antecedent basis is largely the focus of Patent Owner's arguments
24 regarding mandating an order for Steps (b) and (d). The case law is clear on
25 this. Unless the steps of a method actually recite an order -- and I'm on

1 DX13, and I'm quoting *Altiris v. Symantic*, 318 F.3d 1363, "Unless the steps
2 of a method actually recite an order, the steps are not ordinarily construed to
3 require one."

4 The PTAB in *Apple v. Seven Networks*, IPR2020-00156, Paper
5 10, explain that "[t]he court engages in an extensive analysis to determine if
6 logic dictates a sequential order without relying on antecedent basis as a
7 strong indicator," or really, any indicator of a mandatory order.

8 Now, it is true, and we've cited a couple examples, that there are
9 method claims where there is a one-to-one relationship between an element
10 in one step and an element in a second step that requires the first step to
11 conclude before the second step can pick up. Wi-LAN is probably the
12 clearest example.

13 Wi-LAN dealt with producing modulated data symbols in a first
14 method set, and then combining the modulated data symbols in a second
15 method set. So it uses antecedent basis to tie those together, but there is a
16 logical reason one has to conclude before the other. You have to produce
17 them before you can combine them.

18 There is no similar relationship between the steps in 1(b) and 1(d).
19 They do use antecedent basis. They are the same devices. But there is no
20 reason that identified one or more available devices must conclude before
21 wirelessly signaling the one or more available devices. And this is on
22 DX14, where I've summarized the dispute here.

23 As the Board observed in institution, identifying one or more
24 available devices, which is the claim language, is not the same as identifying
25 one or more devices as available. So Step 1(b) does not require identifying

1 which of those devices are currently and actively available. It simply
2 requires identifying one or more devices, one or more of which are, in fact,
3 available.

4 So as long as at least one device that is available is both identified
5 and also signaled, Steps 1(b) and 1(d) are satisfied. 1(b) does not mandate
6 that the system determines which devices are available. Step 1(d) does not
7 limit the wirelessly signaling to only currently available devices. The claim
8 language is open-ended, allowing for both available and unavailable devices
9 to be identified and signaled as the Board currently held at institution.

10 JUDGE OGDEN: Counsel, what does identify mean in this
11 context?

12 MR. HART: Identifying means locating, pinpointing such that the
13 mobile device understands what that device is and is able to communicate
14 with that device. So in Zhang's system, it is looking up registration records
15 that are kept by that central component. Every helper service in Zhang's
16 network registers when it comes online and is an active device able to be
17 used. It uploads its media compatibility, and the mobile device checks that,
18 identifies which devices are on and able to be signaled, and that is how the
19 identifying step occurs in 1(b) in our combination.

20 And so, here, we are --

21 JUDGE OGDEN: So there has to be some sort of selection of a
22 device of some sort? Is that what you're saying?

23 MR. HART: So there is no selection in Claim 1, and that's an
24 important point. If I scroll back to the entire claim here, I can walk through
25 it with you. The Claim 1 is really about informing a device about

1 availability of media content effectively to be routed. It's not until
2 dependent Claim 5 that we get to the step of receiving a response back from
3 a device and then setting up a session to send that device media.

4 So Claim 1 is arguably agnostic as to which device ultimately
5 receives that media. This is just about signaling the device in order to tell it
6 there is media available to be rerouted at the mobile device.

7 JUDGE OGDEN: Is that part of the construction dispute as far as
8 you're aware? And I'm not asking you to speak for Patent Owner, but I
9 think, is this the part -- is there meaning in here in the word "identifying"
10 that we should pay attention to? Or are we more focusing on the available
11 devices?

12 MR. HART: We're really more focused on available devices and
13 what it means to identify an available device. The big dispute is, as the
14 Board acknowledged at institution, identifying an available device is
15 different from identifying a device as available. In former, you were looking
16 for devices that may be available and the latter, you were looking for the
17 status of a device as available.

18 And so here, the claim language, and this is distinct from some of
19 the other patents in the SMR portfolio that the PTAB has looked at that are
20 not part of active IBRs right now, this language puts the available as a
21 modifier of the device, and you're looking for, you're trying to identify the
22 actual device, not its status as available or not.

23 On DX15, just very briefly, Patent Owner relies heavily on
24 antecedent basis, which I've noted. There is a confusing use of antecedents
25 in the claim that weighs against crediting antecedent basis as a rationale for

1 imposing an order here. As we see in the claims, the preamble introduces
2 informing a device about an availability of media content. 1(b) identifying
3 one or more devices compatible to handle the media content, and then 1(d)
4 reverts back to A, indicating an availability of a media content.

5 So introduce “media content” in the preamble, “the media content”
6 in 1(b) and then back to “a media content” in 1(d). It's not entirely clear
7 whether this was intentional or what the Patentee was attempting to convey
8 with this odd use of antecedents, but it certainly cautions against placing too
9 much weight on antecedent basis as a justification for imposing an order
10 because their antecedents are reversed in limitations 1(b) and 1(d) with
11 respect to devices and media content.

12 Patent Owner has pointed to the prosecution history at length,
13 claiming that this is evidence that the applicant intended for 1(b) and 1(d) to
14 be performed in order. As a matter of fact, there was just a poorly drafted
15 claim that was the issue here. We got a 112 rejection. The examiner said,
16 look, in 1(b) you've introduced one or more available devices. In 1(d), you
17 refer to the one or more devices. That's not clear if those are the same
18 devices or not.

19 And so, in an office action response, claim amendments clarify that
20 they are, in fact, tied together. Neither the office action nor the office action
21 response said anything about the order of those steps. And the parties don't
22 dispute that the devices in 1(b) and 1(d) are the same devices.

23 Very briefly, DX18 through DX20, I want to align the process in
24 Zhang with the embodiments in the '648 Patent just briefly. So as I've
25 covered earlier, Zhang's process identifies what devices are out there, which

1 ones are compatible with media it wants to reroute, and then one by one, it
2 says, here's what I would like to route to you, are you currently free to
3 handle it? And when it finally gets a yes, it establishes a connection with
4 that device.

5 The disclosed embodiment in the '648 Patent is Scenario 3, Option
6 A, that starts at a Column 11, Line 47, and ends in Line 60, and this is
7 describing a cell phone being received on a mobile device. The mobile
8 device going one-by-one from tabletop phone to tabletop phone to see if it
9 can find a currently free and available speaker phone to pass that media off
10 to.

11 As we see here in Step 4(a), the person points his phone at one of
12 the landlines, the cell phone detects that phone is busy, and so it moves on to
13 the next tabletop phone. And when it finds one that is free, it routes the
14 audio to that currently free tabletop phone.

15 I asked Patent Owner's expert about this. He confirmed that that
16 example in the '648 Patent is consistent with Claim 1. He also confirmed
17 that it is no problem with Claim 1 that the mobile phone goes through a line
18 and communicates with multiple unavailable devices before finally finding
19 an available device. So this consistent embodiment with Claim 1 works
20 exactly like Zhang's process. And therefore, Zhang's process also satisfies
21 the claims.

22 JUDGE HOFFMAN: Mr. Hart, what would you say to the
23 example you just spoke to, Option A, the cell phone detects the phone as
24 busy, and then further down it would detect it as available -- so what would
25 you say in terms of the claim -- Patent Owner's argument is that it should be

1 interpreted as available and here in the spec, that seems to support that?

2 MR. HART: It is consistent with a process that is checking to
3 figure out whether it is communicating or signaling that phone to determine
4 whether it is currently free and available to receive the media. And so, it is
5 doing that kind of on a one-by-one basis in the same way Zhang is doing that
6 on a one-by-one basis. So I think that is consistent with a read of the claims
7 where identifying devices as available is something that is checked in that
8 initial back and forth.

9 But it is also consistent with a process where you are checking
10 -- you are signaling that tabletop phone in order to determine whether it is, in
11 fact, busy or not, which is exactly what Zhang does.

12 JUDGE HOFFMAN: Okay. Thank you.

13 MR. HART: And a lot of the specification is common between
14 this patent and the other patents, as I alluded to earlier. Some of the other
15 patents reframe what you're identifying as identifying as available or
16 identifying the availability of a device. And so this would be consistent with
17 that read, as well, and that is not the claim language we have in the '648
18 Patent.

19 JUDGE HOFFMAN: Okay. Thank you.

20 MR. HART: DX21, as I touched on briefly, the Board analyzed
21 the meaning of Limitation 1(b) at institution and held that identifying
22 available devices is not the same as identifying devices as available. The
23 claim does not appear to require identifying or determining whether
24 individual devices are available, but merely requires identifying devices that
25 happen to be available.

1 And so, this is what I alluded to earlier. Even if you impose an
2 order between Steps 1(b) and 1(d), if you are identifying devices and then
3 signaling those devices, if one of those devices happened to be available and
4 signaled, even if you did not confirm its availability in Step 1(b), the claims
5 are still satisfied.

6 And that's bringing that back to Dependent Claim 5, that is
7 consistent with the structure of these claims. Claim 1 does not actually get
8 to the point where you're choosing a device and routing media to it. That
9 doesn't come until Claim 5. And so, it is consistent. The Board's analysis
10 here is consistent with a structure of the claims where 1(b) is really just
11 figuring out what devices are out there. It's not making that final
12 determination as to which of these devices is currently free and available for
13 rerouting.

14 Slides 22 and 23 capture Patent Owner's expert's alternative
15 interpretation of the term "available." He testified on cross that to be
16 available, you don't have to be free and currently able to receive media. It's
17 just a matter of finding devices that are turned on and connected to the
18 network.

19 Turning to DX23, Petitioner's expert, Dr. Kiaei, in a supplemental
20 declaration, Exhibit 1037, analyzed that interpretation of the claims and
21 provided an extensive analysis demonstrating that Zhang's system does, in
22 fact, identify devices that are on and available to communicate before it ever
23 signals them, indicating that it has media available to reroute. So under
24 Patent Owner's interpretation, Zhang satisfies the claims even if Steps 1(b)
25 and 1(d) must be performed in order.

1 DX24 through 30 address the second major dispute between the
2 parties. Raised in the Patent Owner response for the first time, Patent Owner
3 argued the Petitioner had failed to show Zhang's hardware was capable of
4 transcoding voice. That is converting voice data from a form that it receives
5 from the cellular network into something that is compatible with the audio
6 devices on that local area network.

7 As I noted before, there is no claim limitation that requires
8 transcoding voice. There's no media transformation in these claims at all.
9 So the argument is simply that in order for Zhang's system to perform a case
10 example that the Petition describes, Zhang's cell phone must be capable of
11 converting audio from one form to another.

12 Now this argument fails for two key reasons. First, the record
13 demonstrates that transcoding was routine. Patent Owner does not identify
14 any technical reasons why Zhang's hardware would have been incapable of
15 transcoding voice data. There are no allegations that the hardware's
16 incompatible with voice transcoding, nor is there a suggestion that voice
17 transcoding was unusually difficult or under-developed. In fact, the Patent
18 itself acknowledges that media transformation was well understood and was
19 available via commercial software packages.

20 The second key reason why this argument fails is that Zhang
21 expressly contemplates a HomeRF deployment of its network. HomeRF has
22 native voice call support. That native voice call support includes voice
23 transcoding, and I'll get into the actual HomeRF standard that our expert
24 analyzed in his supplemental declaration to show you what that looks like in
25 the art.

1 Turning to DX25, briefly, the first reason this argument fails is
2 because voice transcoding was routine. Now, the '648 Patent doesn't
3 actually disclose voice transcoding or any kind of transcoding, but it does
4 acknowledge that media is often required to be transformed to match the
5 requirements of a receiving device. It doesn't describe any details about how
6 that works, but it explains that commercial software packages were available
7 at the time and that they were well known and commercially available.

8 So this was a well-understood concept, voice transcoding that was
9 widely deployed and available commercially. So there were no technical
10 barriers to ensuring Zhang's mobile phone had this capability to transform
11 the voice.

12 The Federal Circuit has addressed what it means when a patent is
13 silent on an important issue or a claimed issue. The Federal Circuit in *Uber*
14 *Techs v. X One*, 957 F.3d 1334 explain that the specification is silent on a
15 claim function suggesting that a person of ordinary skill in the art was more
16 than capable of selecting between the known methods to accomplish the
17 function.

18 Here, the patent is not silent. The patent expressly calls out media
19 transformation and it says, this is a well-understood concept that is available
20 via commercial software packages. So we are far removed from even the
21 situation the Federal Circuit analyzed in *Uber Techs*.

22 Turning to DX26, we cover this quite a bit in our reply and
23 supplemental expert declaration, but Zhang's HomeRF embodiment -- recall
24 we meant both a Wi-Fi option and a HomeRF option. Those are the two
25 router-based wireless local area networks that Zhang expressly describes and

1 those are the two embodiments of the wireless local area network that we
2 have relied upon and preserved in our petition.

3 The big difference Wi-Fi and HomeRF is HomeRF's voice support.
4 HomeRF was very similar to Wi-Fi in many respects for data
5 communications, but it had this additional toll quality voice functionality
6 that set it apart from Wi-Fi at the time. As our expert explained in his
7 supplemental declaration, paragraph 13, Exhibit 1037, Zhang expressly
8 contemplates HomeRF as its local wireless network in its devices in such
9 deployment would be HomeRF-compliant. HomeRF has voice encoding,
10 was companding, and an ADPCM voice transcoder.

11 He concluded HomeRF would indeed have provided the
12 functionality for transmitting the phone call audio from Zhang's mobile
13 device -- sorry , to Zhang's helper server via a wireless router such as that
14 taught by Fillebrown, which also teaches HomeRF. So he's explaining that
15 in Zhang's deployment that we are relying on and have described in the
16 Petition, where you have Fillebrown's router in the middle, you have a
17 mobile device that communicates to a wireless speaker and microphone
18 through that router, those devices would have had all of this audio
19 transcoded functionality built in via their support for HomeRF.

20 On Slide DX27 -- and I'll pick up the pace since I'm running out of
21 time here. We see on the lower left, Figure 1 in Negus Exhibit 1039, this is
22 an example of a HomeRF network. The isochronous clients -- isochronous
23 is HomeRF's terminology for voice calls, distinct from pure data sessions.
24 So in a voice call, as Negus Exhibit 1039 explains, HomeRF isochronous
25 clients are always bound to that central control point, that is the Fillebrown

1 central router in our combination.

2 It describes devices such as handsets, phones, wireless phones,
3 headsets, the person with the hat on is intended to depict a wireless headset
4 that can be connected to use during a phone call.

5 DX28, our expert explained that HomeRF systems always rely on
6 that intermediate routing device to route phone calls, and he refers back to
7 Negus' figure, which depicts that central HomeRF control point that is the
8 conduit between a wireless headset and a cordless telephone in the
9 combination.

10 DX29, DX30, cover some of the voice processing. These are
11 citations to Exhibit 1037, supplemental declaration, and Exhibit 1038, the
12 HomeRF specification, which walk through some of the voice processing
13 that is inherent in all isochronous devices on a HomeRF network, including
14 the devices in Zhang's HomeRF deployment.

15 Now, one last point I want to make here, I alluded to this earlier.
16 Patent Owner's sur-reply largely abandons its focus on voice transcoding and
17 newly focuses on that intermediate routing component. The intermediate
18 routing component in HomeRF is necessary for voice calls. Patent Owner
19 does not have any expert testimony on this point, but through attorney
20 argument, it has suggested in the sur-reply that the most natural read of
21 Zhang is that Zhang would be deployed without an intermediate routing
22 component at all and therefore, incapable of applying all this voice
23 processing and supporting voice calls.

24 The sur-reply never wrestles with the fact that our proposed
25 combination uses Fillebrown specifically to limit Zhang's deployment to

1 central routing device deployments. That's the whole purpose of Fillebrown
2 in our combination is to ensure that there is always that intermediate routing
3 device and that intermediate routing device is the key to these voice
4 functionalities, including the voice transcoding.

5 And as I've highlighted in these slides, DX26 through 29, the
6 existence of that intermediate routing component as a HomeRF control
7 point, was really central to Dr. Kiaei's analysis of what Zhang's system
8 would look like in a detailed form when deployed using HomeRF. So we
9 see DX26 references to a centralized wireless router as taught by Fillebrown,
10 that connects the mobile phone to the helper service. Here, we've
11 highlighted the HomeRF control point as that central component that
12 connects the audio devices in HomeRF.

13 Again, HomeRF systems use an intermediate routing device to
14 route the phone call. So this new argument that we've never had a chance to
15 address in our papers suggests there might not be an intermediate routing
16 device, but that just ignores the very nature of our proposed combination.

17 JUDGE HOFFMAN: All right.

18 MR. HART: I will very quickly walk through -- and I know I'm
19 going to eat into my time, so I'll go ahead and eat just a few minutes into my
20 rebuttal time. Claim 5 is really a procedural critique. Patent Owner has
21 argued that our expert, Dr. Kiaei, was insufficiently precise about what
22 portion of Claim 1 he was relying on for his Claim 5 opinion. So I
23 summarize that on DX31.

24 DX32 is his Claim 5 mapping here. He explains that the phone
25 would be routed to an available server after receiving that response back,

1 saying yes, I'm available, you can send the call to me, and he points to the
2 Claim 1 mapping. And specifically, to the Claim 1 mapping describing
3 Zhang's several essential steps. So if we go back to Claim 1, there is only
4 one place in the Claim 1 mapping where those essential steps are described.

5 There are two references to essential steps in his declaration. One
6 here, starting at paragraph 113, Zhang teaches several essential steps, and a
7 second in Claim 5, where he is referring back to those essential steps. So the
8 procedural challenge that he was insufficiently precise falls apart because
9 the essential steps are really only in two places. Once for Claim 1, and
10 again, cross-referencing that in Claim 5.

11 Claim 6, the critiques here, and this is DX34, are really based on a
12 misunderstanding of the theories we've advanced for dependant Claim 6.
13 Claim 6 requires routing a call while that call is ongoing. We advance two
14 theories, one is that a POSITA would have found it helpful to allow a user to
15 invoke the call initially on the phone, and then take a temperature as to
16 whether the quality was good enough. And if not, make a decision to
17 offload that call to the wireless speaker and microphone. So it's really that
18 user engagement, that user choice, of whether or not to invoke a helper
19 server that is the core of that first theory for Claim 6.

20 The second theory for Claim 6 does not rely on user engagement or
21 user choice at all. It is based on Zhang's express teaching of a remote ability
22 environment, a wireless mobility environment, where the call is
23 automatically passed from helper server to helper server as the user moves
24 through the environment. It becomes too far away from a first and closer to
25 a second.

1 The main argument Patent Owner has advanced here, it argues that
2 we were obligated to rely on Rofheart's teachings for Claim 6 because we
3 relied on Rofheart's teachings in Ground 3. The big difference there is
4 Ground 3 was all about allowing the user to choose which specific device it
5 wanted. Claim 6 and Ground 1 is only about whether or not to invoke a
6 helper service at all. So Claim 6 does not implicate the same concerns that
7 Ground 3 does. It does not need Rofheart's teachings about selecting a
8 specific device. It's just the user control of actually choosing whether to
9 reroute that call to a wireless speaker and headphone.

10 I'll make this last point. Zhang has native user control so the
11 infrastructure necessary to allow a user to choose whether to reroute that call
12 is part of Zhang's expressed teachings, which I have summarized here on
13 DX36.

14 Claim 19 has a limitation where you are informing the user of the
15 receiving device that you have an available media on the mobile device to be
16 rerouted via lights, rings, loud speaker. Patent Owner's argument here is
17 simply that Claim 19 should be construed to require a ring before route
18 arrangement, such that you are ringing that receiving device before you have
19 routed the call there, allowing the user an option of choosing whether or not
20 to accept the call.

21 So the Board rejected that at institution. The Board found that
22 there does not appear to be any requirement in Claim 19 of giving the user a
23 choice of whether to accept or reject that call and that was the correct
24 conclusion. It is also a conclusion that aligns with the intrinsic record.
25 Patent Owner has pointed to the Scenario 3, Option C example in the Patent

1 on DX39 as an example consistent with -- it alleges ring before route.

2 But as we see here in the highlighting, the phone call arrives at the
3 cell phone, the call is automatically routed, and only then does the nearby
4 phone ring, flash, or indicate the rerouted call. So this example is actually
5 describing a route then ring, which is the opposite of Patent Owner's
6 interpretation of Claim 19.

7 Just to have a little bit of time left at the end, I'm going to conclude
8 my opening remarks, unless there are any questions?

9 JUDGE HOFFMAN: I just have a quick question about what you
10 said. And so, when the call is routing, your position is that the media is
11 available at the mobile phone?

12 MR. HART: The media is available at the mobile phone -- well, I
13 think, first of all, the limitation does not require retaining media at the
14 mobile phone when the receiving phone is routed. But the intrinsic record is
15 teaching that the call is routed before the ultimate phone -- the destination
16 phone rings.

17 Another important point on that interpretation, these are all phone
18 calls. So a phone call comes into your cell phone, you reroute the audio, that
19 phone call is a continuous media session. And so, when the phone rings on
20 the destination, or alert is on the destination device, you still have media on
21 that phone the whole time. In fact, when you connect to the wireless speaker
22 and microphone and you are conducting the call through the wireless
23 speaker and microphone, there is a continuous stream of media through the
24 phone.

25 So there is always media available on the cell phone in our

1 proposed combination, which satisfies any interpretation that Patent Owner
2 has proposed for Claim 19.

3 JUDGE HOFFMAN: Okay. Thank you very much, Mr. Hart.

4 MR. HART: Thank you, Your Honor.

5 JUDGE HOFFMAN: And so, Mr. Hart, I will put down four
6 minutes of rebuttal as remaining.

7 MR. HART: Okay. Thank you, Your Honor.

8 JUDGE HOFFMAN: All right. Thank you very much. And with
9 that, Mr. Alexander. When you are ready, please let us know how much
10 time you'd like to reserve for sur-rebuttal.

11 MR. ALEXANDER: Ten minutes, Your Honor.

12 JUDGE HOFFMAN: All right, Mr. Alexander, you may begin
13 when ready.

14 MR. ALEXANDER: Good afternoon, Your Honors. I want to
15 start by addressing a procedural issue. My understanding is that the
16 Petitioner has to make its case in the Petition, and that it's not allowed to
17 introduce new arguments as part of its final argument at this proceeding
18 today. But that's exactly what Petitioner has done as it relates to the
19 argument on this issue about whether the Zhang reference could -- or
20 whether Zhang actually discloses an isochronous HomeRF network.

21 Let me step back for a moment. In the Petition, there is no
22 discussion of Zhang implementing an isochronous HomeRF network.
23 There's hardly any discussion of HomeRF at all. Zhang itself mentions
24 HomeRF just a single time. There is no explanation of -- or no discussion at
25 all of the required control point in a HomeRF isochronous network. There's

1 no discussion of the transcoding that would have to go on in order for
2 Zhang's cellular phone to receive an incoming cellular call, and then route it
3 over a local wireless network.

4 So, in Patent Owner's response, Patent Owner's expert addressed
5 that failing in Petitioner's Petition, that what Petitioner has said is that they
6 conceded that Zhang -- even though it discloses a cell phone, they conceded
7 that Zhang does not disclose receiving a cell phone call and routing that call
8 over a local wireless network. Zhang doesn't say a word about that, and
9 there's no dispute about that.

10 In Patent Owner's response, Patent Owner cited its expert to
11 discuss this issue that would have to occur, this transcoding issue. There
12 doesn't appear to be any dispute that that would have to occur.

13 Now, Petitioner says the claims don't specifically require
14 transcoding, but that's not the issue. The issue is Petitioner built a proposed
15 combination, this hypothetical combination of references, and I didn't hear
16 any dispute that in order for its combination to work, that transcoding would
17 have to occur, just like Patent Owner's expert said.

18 Now, Petitioner said that the Patent Owner's response and the
19 corresponding expert declaration didn't have a discussion about the HomeRF
20 isochronous control point, and that's true. That's not mentioned in Patent
21 Owner's expert declaration. It's true because the Petition didn't raise that
22 issue. They didn't explain how this transcoding would supposedly occur.
23 And Zhang says nothing about it.

24 So what they did in their reply brief, as their entitled to do, they put
25 in a supplemental declaration from their expert where he presented new

1 arguments to address how the transcoding would occur. And this is set forth
2 in his declaration in detail. He says, here's how the transcoding would
3 occur. He said, that in a HomeRF isochronous network, you would have
4 certain capabilities to receive a phone call.

5 Now, that's not a cell phone call. Zhang is a cell phone. In
6 HomeRF, the dec network is talking about receiving PSTN calls, so landline
7 calls. So their expert, in his reply, tries to take HomeRF's isochronous
8 network and its -- keeps support for routing landline calls and saying that
9 Zhang's cell phone would have that capability.

10 Now, what he overlooks, or what he doesn't address, but is
11 addressed in Patent Owner's sur-reply, is that HomeRF has multiple different
12 implementations, and isochronous implementation is one example, but there
13 are also asynchronous implementations, and asynchronous implementations
14 are for data services, whereas isochronous implementations are for handling
15 voice services, specifically, landline voice services to receive a landline call
16 and route it.

17 Zhang doesn't say anything about receiving the landline call. And
18 it really doesn't make sense, since we're talking about Zhang's cellular
19 phone. So there's no reason to believe that Zhang discloses an isochronous
20 HomeRF implementation. And there's more support for that because as they
21 appear to now concede, Zhang does not disclose the control point that would
22 be necessary to manage an isochronous network.

23 Now, in their expert's supplemental declaration, where he's
24 hypothesizing that Zhang would, in fact, implement an isochronous
25 HomeRF implementation without addressing the more realistic view that if

1 anything, it would implement asynchronous HomeRF implementation
2 because that would fit the actual functionality that Zhang discloses that
3 would align well with an asynchronous implementation as set forth in Patent
4 Owner's sur-reply. He doesn't address that. He just assumes that Zhang
5 would have to implement an asynchronous HomeRF implementation, even
6 though that's all optional.

7 You only need that if you're handling voice, which Zhang does not
8 disclose. So he assumes that Zhang is implementing an asynchronous
9 network, but he knows that an asynchronous HomeRF network has to have a
10 control point. And he knows that Zhang doesn't actually disclose one.
11 There's not a word in Zhang about a control point that would be required for
12 the very, very specific requirements placed on a HomeRF control point.

13 But in his supplemental declaration, he tries to get around the
14 failure of Zhang to discuss this at all by saying in two locations in his
15 supplemental expert declaration, that the control point would be Zhang's
16 mobile device itself. He says that in paragraph 12, and he says that in
17 paragraph 19.

18 Now, I'm going to go ahead and plug in my presentation here, and
19 I'll walk through some of the requirements that are placed on the HomeRF
20 control points, so bear with me for one moment and I'll get this up.

21 So here we see -- this is an excerpt from the HomeRF
22 specification. This is one of the many places that says an asynchronous
23 HomeRF implementation requires the presence of a connection point.

24 JUDGE OGDEN: Sir, which slide are you looking at?

25 MR. ALEXANDER: Slide 8, Your Honor.

1 JUDGE HOFFMAN: Mr. Alexander, I have a question.

2 MR. ALEXANDER: Yes?

3 JUDGE HOFFMAN: What would you say to -- help me
4 understand why these implementation concepts that we're discussing
5 wouldn't be something that a person of ordinary skill in the art would have
6 understood how to do, to combine these references?

7 MR. ALEXANDER: That's not the issue, Your Honor, because
8 -- and Petitioner made this very clear in its reply brief, that it is relying on
9 Zhang's existing hardware and software. That it's saying that Zhang's
10 cellular phone, would have this capability. I believe it's at pages 21 and 22
11 of their reply brief, where that's set forth. And I believe they picked that
12 position, Your Honor, because they'd didn't propose modifying Zhang to
13 build in additional hardware or software.

14 Now, the problem with that is, Petitioner's Counsel suggested that
15 transcoding was well known in the art, that sort of thing, but they didn't put
16 in any references and they didn't argue -- the proposed combination does not
17 involve taking Zhang's cell phone and adding hardware and/or software to
18 provide that capability. That's nowhere in the petition.

19 So, since they're not allowed to change the proposed combination,
20 they're not allowed to add new references in a reply, so instead, they took the
21 position in their sur-reply that Zhang's existing hardware would have this
22 functionality, but there's no support for that and that's what I'm walking
23 through here.

24 So, we see, for example -- this is Slide 16. This is another excerpt
25 from the HomeRF specification, and this is a place where it says connection

1 point, that's another term, this is set forth in our sur-reply, that the HomeRF
2 specification basically uses connection point and control point
3 synonymously, and there's a supporting citation in our sur-reply for that.
4 But it says that the connection point provides connectivity to the PSTN,
5 that's the landline telephone system, and a host PC. Zhang's cellular phone
6 does not do that.

7 So it doesn't make sense that Zhang's cell phone, as Petitioner's
8 Expert asserted in his supplemental declaration -- it doesn't make sense that
9 the cell phone would be the control point.

10 The HomeRF specification -- this is Slide 17. The HomeRF
11 specification says that the control point has to support certain mandatory
12 procedures even when the PC that it's connected to appears to be switched
13 off. This is not anything that Zhang's cell phone has. At Slide 18, we have a
14 whole host of requirements that a connection point has to support various
15 sorts of call services and other functionality that the control point has to
16 support, that again, there is no indication that Zhang's cell phone would
17 support this functionality.

18 So in the deposition of Petitioner's expert on his supplemental
19 declaration, towards the end of his deposition, he actually changed his
20 testimony. So in both of those paragraphs, 12 and 19 of his supplemental
21 declaration that I refer to, where he says Zhang's cell phone would have been
22 a control point in an asynchronous network, he says that was a mistake and it
23 was a typo to refer to Zhang's cellular phone as the mobile phone. And
24 instead, he said he should've just written HomeRF. But that doesn't really
25 make sense because the control point is a component in a HomeRF

1 isochronous network. It doesn't make sense to say that the control point is
2 HomeRF.

3 Now, the procedural issue that I referenced at the outset of my
4 presentation is that twice in Petitioner's presentation, he said that the control
5 point in their combination is Fillebrown, but that is a wholly new argument
6 that we are hearing today for the first time.

7 Petitioner relied on Fillebrown as a routing device, but a simple
8 routing device is not a HomeRF control point. And there's no discussion in
9 Fillebrown that I'm aware of that a simple routing device would satisfy the
10 requirements of a HomeRF control point.

11 So as a procedural matter, where we're left with on the briefing and
12 the evidence of record, is that petitioner has acknowledged that HomeRF
13 would require this control point in order to perform the transcoding, as part
14 of the process, right? Because they're saying, well, Zhang's cell phone
15 would definitely be able to do that transcoding because Zhang is
16 implementing the HomeRF asynchronous network. Like I said, that that
17 ignores the fact that the HomeRF asynchronous network is handling landline
18 calls, not cellular calls, so that's a big problem.

19 But even leaving that aside, there is no disclosure on Zhang about
20 an asynchronous HomeRF network. There's no disclosure about a control
21 point. It certainly would not work for the cell phone to be the control point.
22 It seems that they've understood that now, and instead, are arguing that
23 Fillebrown's routing device is the control point. I don't think that works on
24 Fillebrown. I don't think there's disclosure in Fillebrown to support that
25 argument. Even if it was, that's a new argument and they're not allowed to

1 make that new argument here.

2 Do Your Honors have any questions on the HomeRF issue as it
3 relates to the control point?

4 JUDGE OGDEN: Yeah. Counsel, to the extent that Petitioner is
5 rebutting solely on the, you know, the hardware of Zhang, but just, you
6 know, maybe elaborating on what that hardware would have included in the
7 reply. Is it your position that that's an improper response to your Patent
8 Owner response?

9 MR. ALEXANDER: Was your question whether the supplemental
10 expert declaration and the reply brief was out of bounds in explaining how
11 they allege that Zhang would have handled the transcoding?

12 JUDGE OGDEN: Right. If we're just talking about, you know,
13 what would a person with appropriate skill in the art would have understand
14 is happening in Zhang? Is that an improper argument in a reply brief?

15 MR. ALEXANDER: Your Honor, the Patent Owners are not
16 arguing that it was improper for Petitioner to argue that Zhang's cellular
17 phone could be a control point. On that, we're arguing that aside from the
18 fact that Zhang doesn't say it's a control point, there's no reason to decide
19 that Zhang's cell phone could be a control point. So we think that argument
20 is without basis and wrong. We're not arguing that it was an improper new
21 argument.

22 Now, what I am arguing is that -- the position that Fillebrown's
23 router is HomeRF control point, that is a new argument that I think is
24 improper.

25 JUDGE OGDEN: Okay. Thanks for clarifying that.

1 MR. ALEXANDER: I want to now address some of the
2 Petitioner's arguments relating to the issue of the availability. And I've got
3 on Slide 22 excerpts from the prosecution history of the '648 Patent, because
4 there is a pretty clear dispute about the importance of this passage. So
5 what's on the screen here is the applicant's response to the examiner's 112
6 rejection. And here, they refer to the issue that the examiner raised. And
7 they say the examiner indicated that it is not clear whether the claimed one
8 or more devices -- indicates the one or more available devices or different
9 one or more devices.

10 And they go on to say Applicant amended the claim to recite one
11 or more available devices and not one or more devices. So Petitioner has
12 taken the position that in Claims 1(b) and 1(d), there is no logical flow
13 between those two. There's no reason to think that Claim 1(d) is referring to
14 the one or more available devices that were identified in Claim 1(b) with the
15 same issue carrying through to Claim 15

16 The Applicant's approach here refutes that, because if the
17 Applicants intended that Claim 1(d) could take place before or apart from
18 the identifying, then the logical approach would have been to take the other
19 route here, and instead, say signaling one or more devices, rather than saying
20 signaling the one or more available devices. By taking the approach that
21 they did, they confirmed what was already, in Patent Owner's view, the
22 logical flow of the claim that the devices that were signaled were the one or
23 more available devices identified in the proceeding claim element.

24 Now, there's been some discussion about whether, you know,
25 identifying one or more available devices is different than identifying one or

1 more devices as available. The Patent Owners put in evidence from the
2 Cambridge Grammer of the English Language support Patent Owner's view
3 that those phrasings are effectively synonymous. And in response, the
4 Petitioner, they could have put in reply evidence if they thought that was
5 wrong. They could've put in evidence to rebut that if they had a different
6 grammar that took a different position.

7 They had the opportunity to do that, but they didn't. They made
8 the attorney argument that, as we addressed in the sur-reply, which we
9 believe didn't actually comply with dictates of English grammar, but the left
10 un rebutted this evidence that we cited that goes into pretty excruciating
11 detail about the different uses of adjectives, and says that when certain
12 conditions are satisfied, they have the same meaning. And we walk through
13 that in our briefing, and that's un rebutted.

14 So this is a proceeding on the evidence and when the un rebutted
15 evidence supports the view that the phrase "one or more available devices"
16 has basically the same meaning as identifying one or more devices as
17 available, Patent Owners respectfully submit that we should go with the
18 evidence.

19 I want to address the issue of the deposition testimony of Patent
20 Owner's expert. So in Patent Owner's response, in connection with that, the
21 Patent Owner submitted an expert declaration supporting Patent Owner's
22 argument on the availability issue. That expert declaration did not put forth
23 a construction of the term "available." It wasn't necessary for Patent
24 Owner's expert to do so because there had been no dispute raised about the
25 meaning of the term "available."

1 And there's a little bit of confusion in the Petitioner's reply brief. It
2 suggests that it did put forth a construction and that the Board adopted that
3 in the institution decision, but that's an error. The Petition said that it was
4 applying plain and ordinary meaning Patent Owner's response also applied
5 plain and ordinary meaning to that issue of available. So Patent Owner's
6 expert didn't opine on the specific construction of "available." And
7 consistent as reflected in Exhibit 2008, Patent Owner's position in the
8 litigation was that plain and ordinary meaning should apply there.

9 So the Patent Owner's expert didn't need to offer a construction of
10 available because the issue was that in the Petition for Claim 1(d), Petitioner
11 relied on an event that occurred after the -- I'm sorry, for 1(b) it was relying
12 on an event that occurred after the event that it was relying on for 1(d). So
13 Patent Owner's expert put in a declaration supporting Patent Owner's view
14 that that's not how the claim works. That's not how a person of ordinary
15 skill in the art would understand the watchable flow of the claim.

16 At his deposition, he indicated that he hadn't offered a construction
17 of available. Patent Owner's Counsel objected a number of times to the
18 questions about the question of available as being outside the scope. Patent
19 Owner's expert went ahead and gave some testimony. The issue is,
20 Petitioner continues to try to force that testimony onto Patent Owners, when
21 Patent Owner has never adopted it. And, like I said, Patent Owner's expert
22 was also explicit in saying he wasn't offering a construction of available.

23 So that's an argument, not only as a claim construction that wasn't
24 advanced in the Petition, so Patent Owners didn't respond to it. It's also a
25 construction that the Petitioner explicitly disagrees with. It says that in its

1 own reply brief. In Exhibit 2008 you can see its litigation position.

2 JUDGE HOFFMAN: Mr. Alexander?

3 MR. ALEXANDER: Yes?

4 JUDGE HOFFMAN: So just to clarify, Patent Owner's position is
5 that available, the plain and ordinary meaning of "available," is something
6 more than what Patent Owner's expert indicated, which was on and
7 connected?

8 MR. ALEXANDER: So I would say that Patent Owners don't
9 disagree that -- it certainly is more than just on and -- I'm sorry. I was going
10 to say, it boils down to what is connected mean?

11 JUDGE HOFFMAN: Connected to the -- I think, it was connected
12 to the network.

13 MR. ALEXANDER: So I want to be careful about taking claim
14 construction positions on the fly. I'm going to disconnect the presentation if
15 you don't mind and pull up the claim language, just so I can be very precise
16 in answering you.

17 JUDGE HOFFMAN: Sure.

18 MR. ALEXANDER: Yes, Your Honor. I would agree that
19 available requires more than being on and connected.

20 JUDGE HOFFMAN: Okay. Thank you.

21 MR. ALEXANDER: Does that answer your question?

22 JUDGE HOFFMAN: Yes, thank you.

23 JUDGE WHITE: I guess, in that vein, do you have an ordinary
24 meaning of available?

25 MR. ALEXANDER: I'm sorry, Your Honor. Could you repeat

1 that?

2 JUDGE WHITE: I said, just sort of continue in that vein, do you
3 have a plain and ordinary meaning of available that is your understanding of
4 it?

5 MR. ALEXANDER: Your Honor, I don't have different words to
6 use for you today. But I think to answer the issues that are before us in this
7 proceeding, you could simply look to how the Petition maps claims to Zhang
8 and go with that reading. Because they also assume that available meant
9 something more than on and connected. That's why they mapped it the way
10 they did. If they didn't, they would've, presumably, mapped it differently in
11 a way that didn't bring this issue to the forefront.

12 So their assumption was that they needed to look to Zhang -- I
13 believe it's the response to the service request where they said, okay, now,
14 Zhang's cellular phone knows that the helper device is available. So I think
15 for our issues today, their mapping is the understanding that should control
16 here.

17 I want to address a couple of other arguments that Petitioner made
18 in the presentation today. On this issue of the availability, Petitioner says
19 that the claim allows signaling unavailable devices, but I don't think that's
20 really the issue in dispute. There is no claim limitation that says the device
21 cannot signal unavailable devices. What Claim 1(d) requires is wirelessly
22 signaling the one or more available devices.

23 So if a device happened to do some extraneous issues that weren't
24 addressed by the claim, that's really irrelevant. What is relevant is what does
25 the claim require? And it requires wirelessly signaling the one or more

1 available devices.

2 JUDGE HOFFMAN: To clarify what you just said, is your
3 position that the claim would not preclude identifying one or more
4 unavailable devices and wirelessly signaling the one or more unavailable
5 devices?

6 MR. ALEXANDER: Could you repeat that, Your Honor?

7 JUDGE HOFFMAN: Sure. Essentially, adding claim language to
8 Limitations 1(b) and 1(d), unavailable devices, would that be precluded?

9 MR. ALEXANDER: Well, I don't think it'd be appropriate to add
10 claim language or add language to the claims. I'm saying that, you know,
11 when you're talking about what a -- in this case, what a combination would
12 have to do to satisfy the claim language, I think it's a mistake to look at,
13 well, is there other actions. They just are simply unaddressed in the claim.
14 And that's what I'm saying. The issue of signaling unavailable devices is not
15 an issue that's addressed in the claim. The claim is signaling the one or more
16 available devices.

17 JUDGE HOFFMAN: Understood. But because the claim is a
18 comprising claim, if the combination is identifying unavailable devices, as
19 well as available devices, under that understanding of what available and
20 unavailable mean, would the claim preclude unavailable devices?

21 MR. ALEXANDER: The claim wouldn't -- like, Your Honor, you
22 asked Petitioner's Counsel about example, I think it's 3(a) in the specification
23 where it referred to identifying a device as busy. And so, Patent Owners
24 would take that as you have not identified one or more available devices in
25 that instance. You identified an unavailable device.

1 So that reference to it -- that example of identifying a device as
2 busy would not satisfy Claim 1(b) identifying one or more of available
3 devices. The claim doesn't preclude additional actions, such as identifying
4 one or more unavailable devices, it just -- it's not a limitation in the claim.

5 JUDGE HOFFMAN: Okay. Thank you.

6 MR. ALEXANDER: I'd like to address something that Petitioner's
7 Counsel referenced a couple times in this proceeding today. He said that
8 there's nothing that prevents Claim 1(b) and Claim 1(d) as being performed
9 together, and I believe he characterized Petitioner's own mapping as them
10 being performed together, and I would object to that as a new argument,
11 because I believe the petition is quite straightforward, that the action they're
12 relying on for 1(b) occurs after the event that is occurring before 1(b).

13 So I don't believe the issue before us involves a simultaneous
14 mapping. I would also say that I don't believe they sufficiently addressed
15 how that would even be possible for those two things to happen as part of a
16 single event.

17 And with that, I'll reserve the remainder of time. Your Honors
18 have any questions?

19 JUDGE HOFFMAN: Okay. Thank you very much. And then we
20 have Mr. Hart with four minutes of rebuttal, and I'll start the timer whenever
21 you're ready.

22 MR. HART: All right. Thanks very much, Your Honor. Let me
23 make sure you can see my screen here. All right. Very good. I'm ready. So
24 I do just have a few points, but I wanted to start by asking, are there any
25 points that Your Honors would like me to address? Any lingering confusion

1 or concerns that I can help clarify?

2 JUDGE HOFFMAN: I do have one question, and it's about
3 something we haven't chatted about, but I just wanted to ask you. In your
4 reply, you did not address Patent Owner's arguments regarding the proposed
5 level of skill in the art. And so, is that an issue that you concede on? Or at
6 least concede that Petitioner's challenges don't hinge on whether we accept
7 Patent Owner's proposal level of skill?

8 MR. HART: The latter. There was a lengthy discussion, as you
9 saw, trying to establish that simply having a bachelor's degree is good
10 enough to be a POSITA in this case. We decided not to raise a challenge to
11 Patent Owner's expert. He does only have a bachelor's degree that was
12 obtained over 20-plus years. We thought focusing on the merits of his
13 opinion, rather than his qualifications was the better use of the Court's time.

14 JUDGE HOFFMAN: Okay. Thank you.

15 MR. HART: Sure.

16 MR. OGDEN: I've got a question. I was wondering if you could
17 respond to Patent Owner's argument that your argument that Limitations
18 1(b) and 1(d) could be simultaneous, that that was not an argument made in
19 the petition?

20 MR. HART: Yes, I actually wanted to address all the arguments
21 suggesting that we introduced, new arguments or new bases in our reply.
22 None of those hold water. So what we map from Zhang's process is a
23 process where Zhang's mobile device first locates devices, determines which
24 ones are compatible, then reaches out to them one-by-one to say, here's what
25 I have. Are you currently available to receive it, gets a response. It's that

1 response that tells Zhang's mobile device that the target device is currently
2 free and able to receive media.

3 So the narrowest interpretation of the claims is 1(b) requires
4 confirming availability. So the Steps 1(b) and 1(d) occur over a period of
5 time, through multiple different signals. The first process begins by
6 identifying which devices you have, then checking to see their compatibility,
7 finally signaling them, satisfying Claim 1(d). And then, after that, receiving
8 a response back to learn whether or not they are available. That is the theory
9 we presented. It is that 1(b) and 1(d) can be performed together as part of
10 this same back-and-forth process in Zhang.

11 And so, that was certainly the theory that was presented in the
12 petition. It does depend on 1(b) and 1(d) not mandating a particular order.

13 JUDGE HOFFMAN: Okay. Just one minute remaining.

14 MR. HART: I have to stop speaking in such a slow cadence and
15 reply. Brain is going to prevent that. But I do want to touch on the meaning
16 of available, because Patent Owner touched on this. So here are two
17 examples of how available is claimed in this patent family. The top, we
18 have the '648 claims that we're dealing with, identifying one or more
19 available devices. That does not require, as the Board observed at
20 institution, confirming whether or not a device is then available. It's just
21 identifying devices, that may or may not be available.

22 When the Patentee wants to claim the process of formally and
23 affirmatively determining the availability, this is the language the Patentee
24 used, "Identify and determine availability of compatible equipment."
25 There's a stark difference between these two limitations. The upper is what

1 we're dealing with in this case. The lower is not at issue at PTAB right now.
2 And the upper does not require, as the Board correctly observed,
3 affirmatively determining whether or not a device is available.

4 Fillebrown, one last clarification because I don't want you to go to
5 your final written decision thinking we introduced a new theory in the reply.
6 Fillebrown was absolutely flagged as the central intermediate routing
7 component in a HomeRF deployment of Zhang's process. Here on DX26,
8 that was discussed in paragraph 13 of Dr. Kiaei's supplemental declaration,
9 as well as a number of other portions in his supplemental declaration that I
10 discussed. Slides 26 through 29.

11 Thank you all very much for your time.

12 JUDGE HOFFMAN: Thank you very much, Mr. Hart. Before
13 we move on, actually, do we have any further questions from my panelists
14 for Mr. Hart?

15 JUDGE OGDEN: I don't have any.

16 JUDGE WHITE: Nothing from me.

17 JUDGE HOFFMAN: All right. Thank you very much. We now
18 have Mr. Alexander for 10 minutes. Let me put that on the clock. I will
19 start your time when you being speaking.

20 MR. ALEXANDER: Your Honors, let me begin by asking if you
21 have any questions for me?

22 JUDGE HOFFMAN: I have question regarding the presentation
23 you gave with the HomeRF and the implementation details. Could you
24 characterize your argument in a more broader way for us? Is the argument
25 that Zhang is not sufficiently enabling? Or are you arguing your references

1 aren't operable, or just so that we -- or are you arguing that petitioner just
2 didn't lay out its case? Can you just speak to that?

3 MR. ALEXANDER: Yes, Your Honor. If you'll give me a
4 moment, I will pull up our sur-reply where I believe we address these. I
5 think it was also addressed in our response brief. But I'll -- if you give me a
6 moment, I'll direct you exactly to where we lay out the legal basis for that
7 argument.

8 So if you look, at your convenience, at page 25 of Patent Owner's
9 response, we cite several cases that address a challenger's duty in making out
10 an obviousness combination. And so, for example, here we've got a quote
11 from Broadcom versus Emulex Corp., 732 F.3d 1325, that's a Federal
12 Circuit decision that talks about the need for an explanation as to why the
13 prior references would've worked together.

14 Another very relevant case is Active Video Networks versus
15 Verizon, another Federal Circuit case, 694 F.3d 1312. In Active Video, one
16 of the failures that the Federal Circuit identified in that case was the failure
17 of the challenger to provide an explanation as to how any specific
18 combination would operate. And I think that sums up the argument that
19 Patent Owners are making here.

20 JUDGE OGDEN: The Petition will need to, of course, explain
21 how the prior combination that they're relying on operates to fulfill all the
22 claim limitations, right? But we're talking about some things that are not
23 explicitly in the claim limitations. You know, the claims don't refer to an
24 isochronous HomeRF network or a transcoding. So I'm wondering if your
25 argument goes more to the idea of whether petitioner has made a case that

1 there's a reasonable expectation of success in the combination?

2 MR. ALEXANDER: That language gets used in the same context,
3 in the Active Video case that we have a block quotation on page 26 of Patent
4 Owner's response brief, and it addresses that in the same context, so I do
5 believe that is part of the issue. But there's a quote there where it says, "The
6 expert failed to explain how specific references could be combined, which
7 combination of elements and specific references would yield a predictable
8 result, or how any specific combination would operate or read on the
9 asserted claims."

10 And so, that's what we're saying the Petitioner failed to do here,
11 because the way they say their proposed combination would read on the
12 challenged claims is Zhang would receive a cellular phone call and then
13 route that phone call over a local wireless network. And as they
14 acknowledge, some of the dependent claims actually do get into that specific
15 use case of relating to the phone call.

16 But that's their combination. This is what they say the
17 combination would do. And so, what the cases we cite indicate is, you have
18 to explain how that works. And so we challenge that in Patent Owner's
19 response and the reply that they gave, by introducing the supplemental
20 expert declaration, was here's what would happen. Here's how that works.
21 One, we're only relying on Zhang's existing hardware. And in the
22 supplemental declaration, the expert said that Zhang's cell phone would be a
23 control point.

24 So that's how they said this was happening. They didn't deny that
25 the transcoding would need to happen for their combination to work. They

1 said that it would work because Zhang was implementing an isochronous
2 HomeRF network with the cell phone being the control point.

3 And so, our sur-reply challenged that, pointing out all the ways
4 that that failed, including no mention of a control point anywhere in Zhang.
5 And certainly, there's no reason to believe that Zhang's cell phone met all the
6 various requirements of a control point.

7 So what happened today is, now they say that Fillebrown would be
8 the control point and they reference paragraph 13 of the supplemental expert
9 declaration and that expert declaration, at paragraph 13, does reference
10 Fillebrown, but it does not say that Fillebrown's router is serving as a
11 HomeRF control point. Their expert was very specific on that. He said the
12 cellular phone was serving as the control point.

13 At his deposition, he retracted that, but at no point did he say that
14 Fillebrown's router would have the functionality of a control point. A
15 control point is not simply a router, and in our sur-reply, we go through in
16 detail about all the various requirements that that would involve. And like I
17 said, there's no evidence of record that Fillebrown's router would have all of
18 that functionality. Certainly, the Petitioner didn't present that argument.

19 So back to your question. I think they're trying to shift the
20 direction to make this an enabling argument, but the cases that we cited in
21 support of our position, they didn't turn on enablement. They turned on the
22 failure of a petitioner to make out its case about how the combination would
23 operate. Respectfully, what I believe Petitioner is trying to do is, in a
24 backdoor way, modify its obviousness combination so that it would be
25 effectively modifying Zhang's cellular phone, it's disclosure as a whole, such

1 that it was a HomeRF isochronous implementation.

2 Now, I guess they want to say that Fillebrown's router could be a
3 control point, but that's not what the combination said. The HomeRF's
4 specification wasn't part of it. These optional isochronous implementation
5 details were not part of their obviousness combination. None of this was
6 there.

7 Also, like I said, there's an important fact that the isochronous
8 HomeRF implementation is for receiving of landline calls and routing those.
9 That has gone unrebutted today. Those are the types of calls HomeRF is
10 routing, is landline calls. That's not what Zhang is doing. So that's another
11 major failure with this new theory that they put forward in the supplemental
12 expert declaration. But none of that's in the original Petition, and there's no
13 disclosure in Zhang to support the idea that its cell phone or any other device
14 is a control point.

15 Have I addressed your question on that, Your Honor?

16 JUDGE OGDEN: Yes. Thank you.

17 JUDGE HOFFMAN: One minute remaining.

18 MR ALEXANDER: So I'll briefly address the issue about
19 availability in Claims 1(b) and 1(d). I believe Petitioner's Counsel
20 acknowledged that their mapping does require what they relied on for 1(b)
21 occurred after the event that they were relied on for Claim 1(d).

22 Now, I believe that Petitioner's Counsel put up on the screen some
23 language. I'm not sure if it was from a different related patent. I don't
24 believe there was much explanation for where that came from. Perhaps I
25 missed it. But contrasting the limitation at issue in this patent to those in,

1 perhaps, another patent, I don't believe that argument was made so it
2 shouldn't be the basis of a decision here.

3 JUDGE HOFFMAN: All right. Thank you very much.

4 MR. ALEXANDER: Thank you, Your Honor.

5 JUDGE HOFFMAN: Are there any further questions from my co-
6 panelists for Mr. Alexander?

7 JUDGE WHITE: Nothing from me.

8 JUDGE OGDEN: Nothing from me.

9 JUDGE HOFFMAN: Okay. Well, Counsel, thank you so very
10 much. We appreciate your level of preparedness today. I believe it was
11 very helpful for us and we will be taking this case under advisement and
12 issue our final written decision in due course.

13 The panel will be leaving now, but please remain in the room to
14 confer with the court reporter on spellings. Again, thank you.

15 (Whereupon, the above-entitled matter went off the record at 3:07
16 p.m.)

IPR2024-01048
Patent 10,547,648 B2

PETITIONER:

Paul Hart
Kevin Rongish
Adam Seitz
ERISE IP, P.A.
paul.hart@eriseip.com
kevin.rongish@eriseip.com
adam.seitz@eriseip.com

PATENT OWNER:

Cortney Alexander
Olivia Marbutt
KENT & RISLEY LLC
cortneyalexander@kentrisley.com
oliviamarbutt@kentrisley.com