

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC and GOOGLE LLC,
Petitioner,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.,
Patent Owner.

IPR2025-00038
Patent 8,836,842 B2

Before KRISTEN L. DROESCH, ARTHUR M. PESLAK, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

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IPR2025-00038
Patent 8,836,842 B2

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P R O C E E D I N G S

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(9:00 a.m.)

JUDGE DROESCH: All right. Good morning. We're here for oral arguments for IPR2025-00038, challenging the patentability of some of the claims of Patent 8,836,842. I'm Judge Droesch. Joining me for this hearing in person is Judge Murphy, and joining us remotely on the screen is Judge Peslak. Unlike yesterday, we are going to do two separate hearings and two separate transcripts for this hearing, so I'm only going to need appearances for this particular hearing. The second hearing that we're going to have today at approximately 10:45 will have a different panel of judges.

Okay. So we'll get started with appearances for both parties today for this hearing. And if anybody else is attending in person or remotely, but will not be speaking, please identify them as well, such as in-house counsel. Counsel for Petitioner, will you please make your appearances?

MR. PEARCE: Hi, good morning, Your Honors. Vann Pearce representing Motorola Mobility, LLC. I'm presenting the argument on behalf of Petitioner this morning. With me is my colleague, Dana Sublett.

MR. ZEILBERGER: Good morning, Your Honor. Daniel Zeilberger on behalf of Google. I won't be presenting arguments today. I'm also joined by -- I won't be presenting arguments for this proceeding. I'm also joined by my colleague, Naveen Modi, along with a client representative, Tumur Engin.

JUDGE DROESCH: Okay. Thank you.

All right. Counsel for Patent Owner?

1 MR. SCHREINER: Good morning, Your Honors. Steve
2 Schreiner, here on behalf of Multifold International. I'll be arguing. I'm
3 joined by my colleague, Mitch Yang.

4 JUDGE DROESCH: All right. Thank you. All right. Per the
5 oral argument order, Petitioner has 45 minutes for its presentation and they
6 will go first. They may reserve some of this time for rebuttal, but that may
7 not exceed half of the 45 minutes. And following Petitioner's presentation,
8 Patent Owner will have 45 minutes as well, and may also reserve some of
9 this time for some rebuttal. And if you can, do your best to remember to
10 identify the demonstratives by the slide numbers, that would be very, very
11 good for recording of the transcript and for keeping us up to date. And then
12 please remember that your arguments should be only limited to those
13 arguments that have been presented in your briefs.

14 Okay. Counsel for Petitioner, would you like to reserve some
15 time for rebuttal?

16 MR. PEARCE: Yes, Your Honor. I'd like to reserve 10
17 minutes as time for rebuttal.

18 JUDGE DROESCH: All right. Counsel for Patent Owner, how
19 much time would you like to reserve for your rebuttal?

20 MR. SCHREINER: Yes, Your Honor. I'd like to reserve 10
21 minutes for sur-rebuttal.

22 JUDGE DROESCH: Okay. All right. Counsel for Petitioner,
23 you may proceed whenever you are ready.

24 MR. PEARCE: Thank you, Your Honor. Well, this was
25 working a moment ago. The screen, is it on? Okay, thank you.

1 May it please the board, again, Vann Pearce on behalf of the
2 petitioners in this proceeding. What I'd like to begin with, with Your
3 Honors' permission, is just an overview of the disputed issues in this
4 proceeding, and then go into some of the more specific arguments. I'll start
5 by moving to Slide 2 of my demonstratives. This slide just shows a
6 roadmap of the contested issues in the proceeding. We have four grounds
7 we presented: two based on the Chin reference, two based on the Whitehorn
8 reference, anticipation and obviousness for both references. With the Chin
9 reference, it's directed to all the challenge claims. The Whitehorn reference
10 is directed to some of the challenge claims. But what I'm showing here on
11 Demonstrative Number 2 are the disputed issues that have been presented by
12 Patent Owner in its response.

13 And the issue that I think is the most important, and we'll
14 probably spend the most time on, is the first limitation of this shown here,
15 which is this, "Wherein in each image capture mode, a display on the first or
16 second screen is different." If I move to Slide 5 in the demonstratives, when
17 we look at Claim 1 of the patent, the patent owner has not disputed our
18 showing that Chin and Whitehorn both teach all of the limitations of Claim
19 1, except for that final limitation. Now, as we'll go through today in my
20 presentation, that limitation is expressly taught in both the Chin and
21 Whitehorn references. Also, there's, if not expressly taught, a very clear cut
22 and straightforward obviousness argument for why that reference would be
23 at least obvious in view of the disclosures of both Chin and Whitehorn.
24 Now, beyond that limitation, there are a number of other elements that the
25 patent owner has brought up that are directed to some but not all of the
26 claims. And I'll go through this as well. Patent Owner's positions on those

1 limitations are also not supported. The (inaudible) limitation in Claim 1
2 appears in essentially identical form in the other independent claims as well.

3 So if I turn to look at the prior art in a little bit more detail, first,
4 just going to Slide 9 of the demonstratives, the 842 patent that's shown here,
5 it generally deals with a device that is a portable device of some kind, an
6 electronic device that has two screens, and that also can capture images.
7 Now, Chin, the first prior art reference, going to Slide 10, also is a portable
8 device. There's no dispute that Chin is, in fact, prior art. And as you can see
9 here from the image that's on the cover page of the patent, Chin also is a
10 device that has two screens, it's a device that has a camera, and it's a device
11 that can take images and move into different imaging modes.

12 Going to Slide 12, here we have Claim 1. We've highlighted
13 the key disputed language, this, "Wherein in each image capture mode, a
14 display on the first or second screen is different." The preceding language in
15 Claim 1 talks about how, the device must determine to enter into one or
16 more image capture modes based on one or more various criteria. That
17 limitation is not disputed. So there's no dispute that Chin, in fact, does enter
18 into image capture modes and does it based on these different types of
19 criteria. The only dispute is whether Chin meets this limitation about the
20 display on the first or second screen being different in each image capture
21 mode.

22 I'd like to go to Slide 15 and really look closely at what Chin
23 discloses both in its figures, and also in its --

24 JUDGE MURPHY: Well, Counsel, before you do that can we
25 focus on the claim construction of Limitation 1E, please?

26 MR. PEARCE: Sure.

1 JUDGE MURPHY: And in particular, is Patent Owner --
2 excuse me, is Petitioner taking any position in response to Patent Owner's
3 construction?

4 MR. PEARCE: The position we've taken, we have -- we did
5 not -- I think it's fair to say in our briefing, we did not expressly dispute their
6 construction, because we found that it was not necessary for the board to
7 construe that term beyond what is already in the claim language. And the
8 reason for that is, no matter how you look at the prior art, both the Chin and
9 the Whitehorn references, the prior art discloses this limitation. So we did
10 not say that the board needed to construe that limitation, we did not
11 expressly respond to their construction because we believe the prior art
12 shows that the limitation is met regardless.

13 JUDGE MURPHY: And so does the petition address the prior
14 art, Chin and Whitehorn, in terms of anticipation or obviousness, in view of
15 Patent Owner's construction?

16 MR. PEARCE: Yes, absolutely. So if you look at, for
17 example, Page 30 of the petition, that's the Chin reference. And I can go to
18 one of the demonstratives as well to look at that. Let's go to Demonstrative
19 19. So the patent owner's position, as I understand it, is that in one image
20 capture mode a screen shows one thing, and in another image capture mode
21 a screen shows something different, and at least one of the screens in the
22 device, in the dual screen device, must change between mode one to mode
23 two. Now, what we showed in our -- and addressed our petition is that in the
24 Chin reference, let's start with Chin, both screens change between both
25 image capture modes. If we go to -- let's go to Slide 17.

26 JUDGE MURPHY: I'm sorry, 17?

1 MR. PEARCE: 17, Your Honor. Yes. So this is showing
2 Figure 9 from Chin. Figure 9 is really the key disclosure from Chin. Figure
3 9 and accompanying text. What we see in Figure 9 is there is a flow chart
4 of how the device operates in the image capture modes. At S150, there's a
5 choice: is the device in a self-photographing mode or not? There are two
6 image capture modes in Chin: a self-photographing mode, and then a mode
7 that isn't given a name, but it's essentially an outward facing image mode
8 where the camera is facing away from the user. That's a yes or no
9 determination. Based on that determination, the device changes what is
10 displayed. If it's a self-photographing mode, it displays images on one
11 display unit, which is the display that's facing towards the user, so you can
12 see yourself. And in the other mode, the display is on the other screen. So
13 what that means is both screens are changing between both modes. And if I
14 go back to --

15 JUDGE DROESCH: Counsel, I have a question for you, and --
16 is the Chin reference -- does the Chin reference explicitly say what is
17 displayed on the first display when it's in the self-photographing mode?

18 MR. PEARCE: The Chin reference says which -- it says where
19 the preview is being displayed. So we believe that that is an explicit
20 disclosure of what is displayed on both of the screens, because otherwise,
21 the Chin reference doesn't make sense. If Chin was saying, well, the
22 preview could be on both screens at all times, then this flow chart would
23 have no meaning. In fact, if you look at -- we illustrated this on the next
24 Demonstrative Number 18, this is basically what Patent Owner is saying.
25 It's saying that when you're -- you reach this point, yes or no in the self-
26 photographing mode, what could be happening is that the display is of

1 images on both units, so both of these paths are the same. That's not a
2 sensible reading of Chin. So we think that what Chin does disclose is
3 explicitly disclosing that the display on the screen that's not facing the user
4 is not showing the preview image. Because otherwise, the disclosure of
5 Chin wouldn't make sense.

6 JUDGE MURPHY: Well, I mean, if you look at either Figure 5
7 or Figure 6 in Chin, it's -- it only has one image. It has, I guess, the preview
8 screen, or however you want to characterize it. And I thought Patent Owner,
9 one of their positions is there's just no disclosure of what is on the other
10 screen. So how do you meet the claim limitation?

11 MR. PEARCE: So I would agree that Chin doesn't have an
12 express -- or the images of Chin, rather, the figures of Chin don't show both
13 screens at the same time in, let's say, the self-photographing mode. So that's
14 why we looked at the disclosure of Chin, and we look at what it says in the
15 figure, and we look at what it says in the specification. And if we turn to the
16 specification, I'm going to go to Slide 15 now.

17 JUDGE DROESCH: So, yeah. I was going to ask you,
18 Counsel, as far as the relative strengths of the anticipation challenge versus
19 the obviousness challenge, which one is stronger?

20 MR. PEARCE: Well, I'll give the answer which I think you'd
21 expect, we think both of them are strong. In terms of the obviousness
22 challenge, I can -- I'm happy to talk about that, because I don't see really any
23 way in which the patent owner has even really responded substantively to
24 our obviousness challenge. So I'm happy to walk through that now if we --
25 if you'd like me to do that. Let me go to slide -- I'll go to Slide 21. We'll
26 start looking at obviousness based on Chin. So as I mentioned, you know, in

1 our view, if you read the disclosure of Chin, it's clear that there is not a
2 preview being shown on both screens at the same time. However, if we
3 want to look at that from the perspective of obviousness, what we have here
4 on Slide 21 is a step-by-step obviousness analysis we set forth in our
5 petition. And we can go through this one piece at a time and show that at
6 every step of this analysis, the testimony of both experts supports
7 obviousness. And we think there's a very clear cut case for obviousness
8 here.

9 So let's look at step 1. If we accept Patent Owner's theory,
10 Patent Owner is not saying that both screens in Chin would have to be
11 showing a display at all times. And going to Slide 22 now, Patent Owner is
12 saying, well, that other screen that is facing away from the user could be
13 showing a display or it could not be showing a display. Those are both
14 options. So that's step 1.

15 Step 2, then, is that a person of ordinary skill in the art, I'm on
16 Slide 23 now, would know, at minimum, that the display in Chin that's not
17 facing the user could be in one of two states: it could be on, or it could be
18 off. And I want to focus on this because this is an important point. Part of
19 Patent Owner's argument is to say that we haven't shown anywhere in the
20 prior art that there is -- it was known to have a screen facing away from the
21 user that was off. Now, that's not really the right way to look at the inquiry,
22 but even if you look at things that way, they're wrong about that. Because
23 their expert has said, and this is his testimony here on the right-hand side of
24 Slide 23, their expert agreed that a person skilled in the art, looking at Chin,
25 would know that that first display facing away from the user could be off.
26 So that is something that is in the prior art. It's in the prior art, the two main

1 references as a person of ordinary skill in the art would understand them.
2 And that's a fairly straightforward thing to understand. A screen in its
3 default state would be off in a device. You have to turn it on.

4 JUDGE MURPHY: Well, so let me play devil's advocate. It
5 says, his testimony says "could be".

6 MR. PEARCE: Correct.

7 JUDGE MURPHY: Why would it be? What's the motivation
8 for why it would be?

9 MR. PEARCE: So there's a couple -- I'm sorry, Your Honor.
10 Didn't mean to interrupt you.

11 JUDGE MURPHY: No, go ahead.

12 MR. PEARCE: So a couple of reasons why the screen would
13 be off. The first is everyone understood, particularly back in 2011, around
14 the time of the alleged invention, that in a mobile device, battery life was
15 limited. Battery life is a consideration. It's important to make sure that
16 you're conserving battery life and not wasting it, because I think we've all
17 experienced you have to charge up the phone or a portable device, and the
18 battery drains quickly sometimes. So one reason why you would have a
19 screen off that's not facing the user is because you would save battery life by
20 not having the screen on. And that screen is, because it's not facing the user,
21 is not what the user sees. So imagine the self-photographing mode of Chin.
22 In the self-photographing mode, you're holding up the device, the camera is
23 pointing towards you. You see on the screen, yourself, so you can take a
24 picture of yourself. Why does that screen on the other side of the device that
25 you're not looking at need to be on? It wouldn't need to be on in that mode.
26 So --

1 JUDGE MURPHY: So you're saying in selfie mode, that the
2 other screen is -- it doesn't need to be functioning?

3 MR. PEARCE: Correct. Right. It doesn't need to be
4 functioning because it's not what the user is seeing. So by turning that
5 screen off, you're saving battery life, you're not missing any functionality
6 that you need. And the same would be true for the other mode. If you're
7 thinking about the outward facing imaging mode, I'm holding up the device,
8 I'm seeing what the camera is seeing because the camera is pointing away
9 from me. The screen that's on the other side of the device. I don't see that
10 screen, I don't need to have it on. So why would I have it on when that's
11 going to drain the battery and serve no purpose in that context?

12 JUDGE MURPHY: And let's -- if we assume your premise,
13 why does that satisfy the claim limitation at issue?

14 MR. PEARCE: That satisfies the claim limitation at issue,
15 again, regardless of how you look at this limitation, let's start with the way
16 that Patent Owner is looking at it. In Mode 1, the self-photographing mode,
17 Screen 1, I'm going to call it Screen 1, is the one facing me. It's on, it's
18 displaying a preview image. Screen 2 is on the other side. It is not
19 displaying the preview image. It's off. Then we switch modes, we turn the
20 device around. Screen 2 is now facing me. Screen 2 is now showing a
21 preview image. Screen 1 is now off and showing no image. So between the
22 self mode and the outward facing mode, Screen 1 has changed from a
23 preview image to no image. Screen 2 has changed from no image to a
24 preview image.

25 Between the two imaging modes, both the first and second
26 screens have changed their display. That would be Patent Owner's

1 construction. If you were to look at the claims and say, well, actually, I
2 think what we really should be looking at is, are the screens different within
3 one mode? They are different within one mode in both of those modes.
4 You have one screen on, one screen off. So that meets the claim limitation,
5 again, regardless of how you look at it, which is why we haven't really said
6 that the board needs to construe that limitation.

7 The one point I want to emphasize as well about the
8 obviousness analysis is when we go through the steps of the analysis that I
9 set forth, we have the patent owner's expert's testimony, just completely in
10 line with their expert's testimony at every step of the analysis. And this is
11 something that the patent owner doesn't really address in the reply brief, but
12 the patent owner's expert agreed that the screens could be on or off. The
13 patent owner's expert agreed that battery life was limited in mobile devices,
14 agreed that in some circumstances, you might want to turn off a screen that's
15 not being viewed to save battery life. So there's not really a dispute about
16 the factual underpinnings of the obvious analysis here.

17 I did want to address this, I'm now moving to Slide 26. I did
18 want to address some of the points that Patent Owner did raise in response to
19 obviousness for Chin. The first was that, and this was in the patent owner's
20 response, Patent Owner suggested that we would need to modify Chin to
21 have some sort of complicated facial recognition technology in order for this
22 obviousness combination to work. That's not the modification we're
23 proposing. That's not necessary. Because Chin, remember, and I'm going to
24 Slide 27 now, if we go to the Step S150 of Chin, Chin already knows to
25 enter into a self-photographing mode or not. That's not disputed. We don't

1 need to have facial recognition technology in order to determine whether or
2 not to enter the self-photographing mode. That's already taught by Chin.

3 Going back to Slide 26, the second argument Patent Owner
4 made was that we did not address reasonable expectation of success for this
5 obviousness analysis in the petition. That's just simply not the case. If you
6 go to Slide 28, we have some citations here: the petition at Page 55, the reply
7 at 22 to 23. That also cited to our expert's declaration, where we did
8 explicitly address that not only would it have been known to turn off a
9 screen, but a person skilled in the art would have been able to do that with a
10 reasonable expectation of success. Indeed, a screen on a device would have
11 to be turned on before anything happens. It's -- the default state is off, so we
12 don't think that that's really an issue here.

13 The final point is, going again back to Slide 26, is that the
14 patent owner really argues against an obviousness theory that we weren't
15 making. A lot of what they said was, while there were other references that
16 our expert discussed in this declaration as part of just the background of the
17 art, we didn't combine Chin with any of those references, and we didn't show
18 that those other references taught the limitation at issue here, so therefore,
19 we haven't shown obviousness. But the ground here is not Chin in
20 combination with some other reference, it's obviousness based on Chin.
21 That is permissible under the Federal Circuit case law. We've cited some
22 cases to that effect in our brief. You can have obviousness based on a
23 reference, and here, that's the argument we presented. And given the factual
24 evidence we've put forward, we think it shows at least, at a minimum, that a
25 person skilled in the art reading Chin would understand that one option

1 would have been for the screen facing away from the user to be off, and that
2 meets the claim language.

3 So that's Chin, and this Limitation 1A. If there -- if Your
4 Honors had other questions about that, I'm happy to address them.
5 Otherwise, I can move on to some of the other topics.

6 JUDGE DROESCH: I don't believe there's any additional
7 questions.

8 MR. PEARCE: Thank you. Since we're talking about this
9 limitation, let me just briefly discuss the Whitehorn reference with respect to
10 this limitation in Grounds 3 and 4. And I'm going to move forward to Slide
11 45. So just to orient Your Honors to Whitehorn, this is showing Figures 4
12 and 5, and we've labeled here on Slide 45 the two different screens that are
13 at issue. One is a small screen interface, just kind of a smaller circular
14 screen that you can see through when the device is closed. And then the
15 device can then be opened and rotated, so it's kind of like a clamshell, but
16 you can rotate it. When you rotate the device open, you see that top large
17 screen interface.

18 JUDGE MURPHY: I see. So Small Screen Interface 118, it's
19 that sort of circular tube?

20 MR. PEARCE: Right. So I think if you look at it like you're
21 holding it up to your eye, the camera is on the other side, which you can't see
22 here, but it's basically opposite of this interface, and so you're imagining
23 holding it up kind of close to your face. Versus then, in the other mode, you
24 open it up and you have the larger screen in front of you. So going to Slide
25 46, Whitehorn, like Chin, has a flow chart that expressly says there are two
26 different image capture modes. In the first mode, you display information

1 on that small screen interface, that tube. In the second mode, you display
2 information on the large screen interface.

3 The arguments here are quite similar to Chin, but there are a
4 couple of things about Whitehorn that I wanted to draw to Your Honors'
5 attention that I think are relevant. The first is in Whitehorn, and I'm showing
6 on Slide 47, some of the disclosures from Paragraphs 27 and 29, Whitehorn
7 actually talks about why users would want to look and have that display be
8 on one screen or another. You might want to have that small screen mode
9 because, as shown here on Paragraph 27, that might be more convenient in
10 certain circumstances, or because the bright lighting conditions might make
11 it hard to see the bigger screen. And then in Paragraph 29, Whitehorn talks
12 about why you might want to be viewing images through that large screen
13 interface. There might be times where that's more convenient than the small
14 screen. And I emphasize these limitations to show that -- excuse me, these
15 disclosures, to show that none of this content would really make sense if
16 what was happening in Whitehorn was that you had the screens on at all
17 times in both modes.

18 The other point I'll make about Whitehorn, and I'm moving to
19 Slide --

20 JUDGE MURPHY: So is the theory essentially the same --

21 MR. PEARCE: The theory is essentially the same.

22 JUDGE MURPHY: -- as the -- with respect to Chin?

23 MR. PEARCE: Yes. And I think the response is effectively
24 the same. And then we have, again, with Whitehorn, both the anticipation
25 and obviousness. And the obviousness arguments are very similar in terms
26 of, you know, what would be obvious, why it would be obvious?

1 There is an express disclosure, however, in Whitehorn, that I
2 wanted to draw to the board's attention. This is on Slide 52. Paragraph 31
3 of Whitehorn says explicitly that a person skilled in the art would know that
4 the -- I'm going to the third line here, "Information displayed and/or received
5 on the screen interfaces as discussed herein are preferred but not required.
6 Other embodiments of the present invention may vary those elements to fit
7 any particular design." And we asked Patent Owner's expert about this. He
8 acknowledged this disclosure. And then going to Slide 53, he acknowledged
9 that Whitehorn certainly allows for the device to be modified to either
10 display or not display information on a particular screen. So Whitehorn,
11 even though we don't have to show an express teaching or suggestion to
12 modify --

13 JUDGE MURPHY: Well, I mean, his testimony says, "I don't
14 think it teaches that, but it certainly allows for that."

15 MR. PEARCE: That's right.

16 JUDGE MURPHY: And so isn't that a -- an important
17 distinction?

18 MR. PEARCE: It's an important distinction in the sense --
19 we're not saying that he necessarily gave up the whole game on this, but
20 what he did admit was that Whitehorn does allow for the screen to be
21 modified. Even if you accept his view of Whitehorn as the screen being on
22 at all times, he's admitting that Whitehorn expressly allows for some sort of
23 a modification where, for example, you're displaying something different on
24 the screen, like the screen being off. So that's why that testimony is in line
25 with what Whitehorn itself says, and is in line with our obviousness
26 argument.

1 JUDGE MURPHY: Thank you.

2 MR. PEARCE: Let me just briefly address some of the other
3 limitations that were disputed. If we turn back to the Chin reference, I'm
4 going to go to Slide 29 of the demonstratives. So with respect to Dependent
5 Claim 10, and then this first limitation, Limitation 11A of Claim 11, both of
6 these are similar, where Claim 10 says that the screen presents controls, and
7 then Limitation 11A says that the first screen includes a first gesture capture
8 region. And the parties address these terms similarly, because really the
9 issue was whether Chin discloses or renders obvious some sort of a
10 touchscreen interface.

11 Now, if we look at what Chin discloses, I'm moving to Slide 30,
12 Chin says first that the displays, like Display 51 shown here in Figure 6,
13 could be an LCD, liquid crystal display. Chin also says that a liquid crystal
14 display could be a touchscreen, that's on -- in Paragraph 61. Chin discloses
15 that there's a -- in one embodiment, the depicted embodiment, there's a
16 button, a physical button that can be used for inputting, taking a picture, for
17 example. But Chin says that the structure of that button isn't limited to
18 what's disclosed in the figures, and it could be embodied using a different
19 component such as a touchscreen LCD. So we look at these disclosures
20 together, and Chin is disclosing that its display could be an LCD, it could be
21 a touchscreen, and that could include the button that's used for input.

22 JUDGE DROESCH: And Counsel, this is for anticipation?

23 MR. PEARCE: It's for both anticipation and obviousness. So I
24 think if you look at -- because Chin is describing one embodiment but saying
25 that the embodiment isn't limited to what's depicted, that the embodiment
26 could have the button in the touchscreen LCD. That would meet

1 anticipation. If we look at it from an obviousness perspective, we're really
2 combining what's already disclosed in Chin. To the extent we feel like that
3 needs to be an obviousness argument, you're combining what's already
4 disclosed in the reference in a way that is already suggested by the reference.

5 JUDGE DROESCH: Is the modification making the plain LCD
6 that is, say, Display 51, that it's silent about being a touchscreen, is the
7 modification making that plain LCD for Display 51 now to be a
8 touchscreen?

9 MR. PEARCE: I think -- well, first of all, I think the reference
10 says that the LCD can be a touchscreen, so I think that's explicitly disclosed.
11 If that needed to be a modification, then, okay, then that can be part of the
12 modification as well. I think the way the issue was disputed was more about
13 whether the button, which would be input, do we need to have a
14 modification for that to be embodied as a touchscreen LCD? The patent
15 owner's argument was you wouldn't do that, because it's contrary to the
16 principle of operation of Chin to have a button incorporated within the
17 screen. You need to have a physical button. So I think that was what the
18 dispute was more about.

19 Now, that's not really an accurate way of looking at Chin,
20 though, because -- I'm just going to flip ahead to Slide 36. I want to be clear
21 about what our obviousness theory was. Our obviousness theory was not
22 that you would take Chin's device that's shown in the figures, remove a
23 button from the outside, and then add the button functionality to a
24 touchscreen. We're not removing anything from Chin. We're adding
25 another input option. We're adding the touchscreen button if we need to
26 modify Chin to add it. And that would've been a known modification,

1 touchscreen inputs obviously were known at the time, I don't think there's
2 any dispute about that. Chin talks about that. And you're adding another
3 input option that some users might think is desirable. You can imagine in
4 the selfie mode, you might feel like it's easier just to touch the screen to take
5 a picture, rather than try to touch a button. This doesn't contradict any sort
6 of principle of operation of Chin.

7 Moving to Slide 38. Patent Owner's argument cited, I believe,
8 this Paragraph 9 of Chin that said, well, if you have a device that's folded so
9 that the display isn't exposed, you may not be able to touch the buttons
10 easily, so you want to have a button that's kind of on the top on -- or on the
11 hinge, I guess, of the device. That's what they say is Chin's principle of
12 operation. But in this modification we're talking about, first, we're not
13 removing that top button. And secondly, the screens are externally exposed.
14 And that's what their expert acknowledged in Figures 5 and 6 of Chin. You
15 can see the screen, so you could touch the screen. It doesn't in any way
16 contradict any sort of principle of operation of Chin. So that's the
17 touchscreen issue. If Your Honors had any other questions about that, I'm
18 happy to address them.

19 JUDGE MURPHY: I did. Just -- I want to go back to the
20 anticipation theory.

21 MR. PEARCE: Yes, Your Honor.

22 JUDGE MURPHY: If I'm understanding the briefs correctly --

23 MR. PEARCE: Sure.

24 JUDGE MURPHY: -- Patent Owner is taking the position that
25 -- for that, at least for the Button 33A embodiment, and possibly for the

1 touchscreen or the Screen 51, you're relying on the immediately envisaged
2 test that was first raised in the reply? Am I getting that confused or --

3 MR. PEARCE: I think they -- I think Patent Owner -- well, I
4 think we cited a case in our reply.

5 JUDGE MURPHY: The Kennametal case. Yeah.

6 MR. PEARCE: Yeah, with respect to the other issue.

7 JUDGE MURPHY: Ah. Okay.

8 MR. PEARCE: The imaging issue, not the button issue.

9 JUDGE MURPHY: Okay.

10 MR. PEARCE: Yeah. And we cited that case, I think, really
11 for the -- what I think is the unremarkable proposition that you look at a
12 reference, and for purposes of anticipation, you look at it from the
13 perspective of a person skilled in the art, what would a person skilled in the
14 art understand from the reference? Even if you're not using exactly the same
15 language as what's in the claim, that's not a new theory, it's not a new
16 argument to cite case law in support of anticipation theory we already raised.

17 JUDGE MURPHY: Well, that's debatable, but I take your
18 point. In any event, you're -- is there any issue that, I guess, Display Screen
19 51 is an express disclosure in Chin that it can be a touchscreen?

20 MR. PEARCE: So I would go back to what we looked at
21 previously with Chin, where we're looking at Paragraph 61. It does say that
22 the button can be implemented using a touchscreen liquid crystal display. I
23 think in connection with the prior discussion in Chin where it talks about the
24 display being a liquid crystal display --

25 JUDGE MURPHY: Yeah.

1 MR. PEARCE: -- we're talking about the same embodiment, so
2 I don't think it's fair, like, to look at those two in complete isolation and say
3 that, well, when we were talking about an LCD before, we also talk about
4 how that can be a touchscreen LCD, that first reference would not be
5 potentially a touchscreen LCD just because we didn't say touchscreen in the
6 earlier paragraph. We're talking about one disclosure, about one
7 embodiment. But to the extent that that might seem like perhaps a bridge
8 too far, that's why we say, well, at least at minimum, this would have been
9 very obvious to implement a touchscreen, as Chin itself teaches.

10 JUDGE MURPHY: Thank you. Yeah.

11 MR. PEARCE: So I have just a few minutes left. I wanted to
12 touch on a few of the other arguments, specifically with respect to the
13 Whitehorn reference, because there were a few different points that were
14 raised there. This was going to Claim 11 of Whitehorn, going to Slide 55.
15 It's the second limitation here that says that there's a second screen, and the
16 second screen faces in an opposite direction from the first screen when the
17 device is closed, and also that there's an image capture lens associated with
18 the second screen. Patent Owner has raised a few different objections to our
19 showing of unpatentability for this limitation.

20 The first, as I understand it, and I'm going now to Slide 56,
21 Patent Owner has said, well, when the device is closed in Whitehorn, the
22 two screens are not facing in opposite directions because they're facing each
23 other. Patent Owner has said that they basically have to be both facing
24 outward to meet the claim limitation. We don't think that that's a supported
25 interpretation of the claim. If we think about ourselves right now, we're
26 facing each other, and if I'm facing north, you're facing south. We're facing

1 in opposite directions if we're face to face. That's what's shown here in
2 Whitehorn. We think that clearly meets the claim language.

3 The other argument Patent Owner has made here is to say that
4 the lens is not associated with the second screen. As we've shown here, the
5 lens, which is what takes the picture, is associated with the second screen in
6 the sense that when you're in this open state, you can see what the lens is
7 pointing to on the top screen interface. That's an association. There's no
8 limitation in the patent, there's no special definition of association that would
9 have some sort of narrower construction that would require the lens and the
10 screen to be part of the same component of the device, or otherwise would
11 not meet this claim language. So we think both of those limitations are
12 satisfied.

13 JUDGE PESLAK: Counsel?

14 MR. PEARCE: Oh, I'm sorry. Yes, Your Honor.

15 JUDGE PESLAK: Back to the second screen facing in
16 opposite direction, I'm having a little problem visualizing that. It looks like
17 the first screen, that little circle is, for lack of a better term, facing into the
18 page, and isn't the second screen facing to the right then? How is that in the
19 opposite direction?

20 MR. PEARCE: Oh, right. Yeah. So for purposes of this -- for
21 this limitation, we're -- the first screen and the second screen, there's actually
22 a screen on the inside of Whitehorn's -- this Figure 120. So there's -- White -
23 - Whitehorn has three screens, basically. There's the little screen, and then
24 there's the big top screen interface, and then there's another screen that's on
25 the inside of what's shown here as 120. You can't see those two screens in

1 this image because the device is closed, they're folded up, and so they're
2 facing each other.

3 JUDGE PESLAK: Okay. I understand what you're saying.

4 JUDGE MURPHY: Is that in the next slide, Slide 57? Does
5 that -- is that --

6 MR. PEARCE: Yes. Thank you, Your Honor. That's right.
7 So looking at Slide 57, when you open up Whitehorn, you can see here, this
8 is Figure 5 from Whitehorn, you can actually see both of the screens that are
9 facing each other when they're closed.

10 The last limitation that -- if there are no further questions on
11 that issue, the last one on Whitehorn, Claim 4. Claim 4 reads, is a dependent
12 claim that reads that the device is in a landscape or portrait orientation.
13 Figure 3 of Whitehorn shows that. It shows that the device here is in a
14 portrait orientation, the height is greater than the width. The argument that
15 Patent Owner has raised in response to this is to say that we have to show
16 that the display, the small screen interface is in a landscape or portrait
17 orientation, but that's not the argument we presented to the petition. That's
18 not what the claim says. The claim says that the device is in a landscape or
19 portrait orientation, and I don't think there's any dispute that the device
20 meets that limitation.

21 JUDGE MURPHY: Well, I don't know. Explain that to me.
22 How does that work? How does the device have a portrait orientation versus
23 landscape?

24 MR. PEARCE: The patent --

25 JUDGE MURPHY: If not referring to the display?

1 MR. PEARCE: Sure. The patent talks about, it says what a
2 portrait and a landscape is, and it's basically the ordinary meaning as you
3 would probably commonly use it. A portrait is taller than it is wider, and
4 landscape is the opposite of that. And here, the device is being held in a way
5 and shown in a way that it is in a portrait orientation, because the height is
6 greater than the width. I take your point that typically, a lot of times we're
7 talking about that in the context of a screen, but here, the claim is talking
8 about the device being in that orientation. And if you look at the 842 patent
9 itself, it talks about the device being in different configurations. It can be in
10 an open or closed. It can be rotated. It can be 45 degrees. There's all sorts
11 of different orientations for the device, including a landscape or portrait
12 orientation, and that's what this claim is talking about.

13 I see that I've gone over my time, so I -- do you have any
14 further questions, Your Honor?

15 JUDGE MURPHY: No, thanks.

16 MR. PEARCE: Okay. Thank you.

17 JUDGE DROESCH: Thank you.

18 MR. SCHREINER: Good morning, Your Honors. Thank you
19 for accommodating me as I arranged the logistics of my computer and my
20 various copies of patents and references. What I plan to do here today is,
21 there's a lot of issues, obviously, that were briefed in the parties' papers. We
22 have this main issue that runs throughout about Limitation 1E, regarding
23 there being a different display on the first screen or a different display on the
24 second screens between image capture modes, but we have a number of
25 other limitations that are at issue, both in the independent claims as well as

1 dependent claims. So what I'm going to try to cover today is I'm going to
2 touch first, briefly, on claim construction.

3 I think at the end of the day, I don't think there's really a dispute
4 between the parties on the construction of Limitation 1E, the different
5 displays on the first screen or second screen. Then I'd like to touch on Chin,
6 anticipation with respect to that Limitation, Limitation 1E. Then I'll discuss
7 Chin, the obviousness argument for Chin, focusing again on that limitation
8 1E. And then I'll turn to Whitehorn, which is similar to Chin, and basically
9 it's a similar argument as to anticipation regarding Whitehorn. And then
10 fifth, I'll talk about Whitehorn with respect to Claim 4, which my friend just
11 spoke about, where it states that the display is in a portrait or a landscape
12 orientation. And then lastly, if I get through all of that, I will talk about the
13 argument as far as Whitehorn, obviousness under 103, focusing again on this
14 Limitation 1E.

15 Now starting with -- before I dive into anticipation with Chin, I
16 think it's helpful to remind ourselves that the standard for anticipation is an
17 exacting one. And we all know the case law, but I'm going to just repeat it
18 just to baseline ourselves again, because a lot of Petitioner's arguments for
19 anticipation in Ground 1 and Ground 3 are really obviousness arguments
20 dressed up as anticipation arguments. So we know the case law states, for
21 example, this is *King Pharma v. Eon Labs*, Federal Circuit 2010, "A claim
22 is anticipated if each and every limitation is found either expressly or
23 inherently in the reference."

24 Similarly, in *Verdegaal Brothers v. Union Oil*, Federal Circuit
25 1987, "A claim is anticipated only if each and every element as set forth in
26 the claim is found either expressly or inherently." So to prevail on their

1 anticipation arguments in Ground 1 and Ground 3, they have to meet this
2 high standard that each limitation is expressly or inherently disclosed in the
3 reference. It's not enough to say that a POSITA might envisage that the
4 limitation is met or it would be -- it just makes common sense that this other
5 display would be displaying nothing or be would be disabled. But just with
6 -- I just wanted to set that as a -- as a reminder for us.

7 Now, turning to Slide 8, Slide 8 discusses this Limitation 1E
8 that runs throughout the briefing. So Limitation 1E states, "Entering one or
9 more image capture modes wherein each image capture mode display on the
10 first screen or second screen is different." Now, the patent owner took the
11 position that this means that there must be a different display on the first
12 screen between image capture modes, and or a different display on the
13 second screen between image capture modes. The board really didn't take a
14 position at the DI stage, but ultimately after all the briefing was provided
15 and Patent Owner provided the -- explained the plain and ordinary meaning
16 of the language, and provided six different embodiments from the
17 specifications supporting its construction, on reply, it didn't seem like the
18 petitioner really disputed that construction. So I'm not going to go through
19 all the specification support and so forth for Patent Owner's construction for
20 that term, unless Your Honors want me to undertake that.

21 JUDGE MURPHY: No, but I do have -- I have one question
22 for you on the claim construction.

23 MR. SCHREINER: Yes, Your Honor.

24 JUDGE MURPHY: All right. And Limitation 1D, which is the
25 previous limitation in Claim 1, it includes an element that reads, "Entering
26 one of one or more image capture modes." And my question is, does that

1 claim -- is that claim broad enough to include an embodiment where you
2 only have one image capture mode?

3 MR. SCHREINER: I'll agree with Your Honor that Limitation
4 1D, as we see with many patents, the language is a little bit anomalous in
5 1D, but I think a POSITA reading that claim as a whole would understand
6 that this device that has a first screen and a second screen can enter into a
7 plurality of image capture modes, and different image capture modes,
8 meaning that the display on the first screen between the image capture
9 modes --

10 JUDGE MURPHY: The claim doesn't say plurality. It says
11 "one of one or more". So if it's one, there's only one with two screens, in
12 which case each screen is different, and that would be within the scope of
13 the claim.

14 MR. SCHREINER: Yeah. Again, I -- the claim is certainly
15 saying that the device can enter into one or more image capture modes for a
16 particular configuration, okay? If we look back at Limitation 1C, there's
17 three parameters that are determined: one is the image function
18 configuration, so outward facing versus self -- self-photograph mode, for
19 example, device orientation, for example, portrait or landscape orientation
20 for the display, and device state, for example, open or closed. And then it
21 states that that based on those three parameters, one or more image capture
22 modes could be entered. I think what that's saying is, it's possible to have
23 the device with the same set of three parameters could enter into two
24 different image capture modes, and that's why I think it says one or more
25 image capture modes in Limitation 1D.

26 JUDGE MURPHY: Well, but even --

1 JUDGE DROESCH: I was going to say, I think at minimum,
2 the claim requires just one image capture mode, but it could include more
3 than one. I don't think there's a requirement for a plurality; is that correct?

4 MR. SCHREINER: I think there is a requirement for a
5 plurality, because it states that the image capture -- wherein -- it's -- it refers
6 to "one or more image capture modes wherein each image capture mode, a
7 display on the first screen and second screen is different," and that clearly
8 contemplates that there's multiple image capture modes. Because the
9 display on the first screen in one image capture mode has to be different
10 from the display on the first screen in another image capture mode, and or
11 the display on the second screen must be different from the display on the
12 second screen as between the two example -- exemplary two image capture
13 modes. But I think the important thing here is the petitioner, at the end of
14 the day, in their reply, doesn't dispute this construction. And I think my
15 friend, when he was asked the question earlier today, didn't really dispute the
16 construction.

17 JUDGE MURPHY: Right. But the point is, we have to decide
18 whether there is a need to construe the claim. That's all. So that's what my
19 correct -- my question was directed to.

20 MR. SCHREINER: Yeah. Understood, Your Honor. And
21 Patent Owner's position is that the claim does entail multiple image capture
22 modes, and that Limitation 1E provides that those image capture modes are
23 different, because the display on the first screen, and or the second screen,
24 differs between image capture modes.

25 JUDGE MURPHY: Well, I understand the position.

1 MR. SCHREINER: Yeah, understood. I'd like to turn now to
2 anticipation under Chin, and we'll go to Slide 23. So we're dealing with the
3 same limitation, Limitation 1E, and let me go to Slide 24. So we -- so Slide
4 24 is looking at the self-photographing mode of Chin. And in the self-
5 photographing mode of Chin, Chin expressly discloses that Second Display
6 52 presents a photo preview. That's -- the parties agree on that, and it is
7 crystal clear in Chin. Now, as far as the opposing screen, Display 51 on the
8 other side of the device, Chin doesn't disclose anything. Chin does not
9 disclose what that display presents or doesn't present.

10 Likewise, turning to the other image capture mode in Chin,
11 Figure 6, the so-called outward facing image, Chin discloses that the First
12 Display Unit 51 shows a photo preview. The parties agree on that. And
13 Chin does not --

14 JUDGE MURPHY: Referring to -- is it Slide 25?

15 MR. SCHREINER: I'm sorry, this was Slide -- I'm sorry. I
16 should've moved the -- actually, before I was on Slide -- let me go back.
17 Slide 24 refers to Figure 5, the self-photographing mode. And so just to
18 make sure I was clear about it, Chin discloses that Display 52 provides a
19 photo preview. Chin does not disclose anything about what Display 51 on
20 the opposite side displays or does not display. Chin is completely silent.

21 Then turning to Slide 25, we're now looking at Figure 6, the
22 other mode that the petitioner focuses on, the supposed outward facing
23 mode. The -- there, Chin discloses that the First Display Unit 51 provides a
24 photo preview. You can see in Petitioner's rendition, it's showing a picture
25 of a dog. Now, as far as the opposing screens, Second Display Unit 52 on
26 the other side of the device, Chin is completely silent. It doesn't -- Chin

1 doesn't disclose anything about what that display shows or doesn't show. So
2 there can't be any anticipation by Chin, because in each of the two modes,
3 there's a display where Chin provides no disclosure whatsoever.

4 Now, Petitioner doesn't make an inherency argument. But even
5 if you were to think about an inherency argument for the sake of it, like I
6 said, it should be waived, we know that inherency requires that the limitation
7 must necessarily be present in the reference. But we know, and this is
8 established by Petitioner's Expert's testimony that, for example, in Figure 5,
9 the opposing screen -- going back to -- this is going back to Slide 24, the
10 opposing screen Display Unit 51, that could be displaying a photo preview.
11 And likewise, if we go to --

12 JUDGE MURPHY: Sorry, you referred to the expert, is it
13 deposition testimony or declaration testimony?

14 MR. SCHREINER: His declaration testimony. His deposition
15 testimony that was cited is really not meaningful. He just had conceded that
16 the display could be on or off, that those are both within the realm of
17 possibility. But for purposes of anticipation here, he provided testimony that
18 the opposing screen in Figure 5 could be displaying a photo preview. And
19 likewise, he testified in his declaration, this is going back to Slide 25, Figure
20 6, that the Opposing Screen 52 in that case could be providing a photo
21 preview. So it being the case that Chin doesn't disclose in Figure 5 and
22 Figure 6 what one of the two displays presents or doesn't present, and
23 furthermore, that it's demonstrable that it's not inherent that they provide
24 screens that are different from their counterpart screens in the other mode,
25 there can't be any anticipation.

1 JUDGE MURPHY: And the testimony you're referring to, is
2 that cited in your -- Patent Owner's response?

3 MR. SCHREINER: It is cited in Patent Owner's response,
4 Your Honor. I'll -- if you give me a moment, I'll see if I can --

5 JUDGE MURPHY: No, that's all right.

6 MR. SCHREINER: Okay.

7 JUDGE MURPHY: Thank you.

8 MR. SCHREINER: So then next, I'd like to go to -- so that's
9 Chin with respect to anticipation. Chin is completely silent on what is
10 displayed on the -- one display in each of the two modes, and therefore, it
11 cannot be established that Chin expressly meets Limitation 1E. And for that
12 reason, the independent claims, Claim 1, Claim 11, and Claim 16, are all
13 patentable over Chin from a 102 standpoint.

14 I'd like to turn now to the obviousness argument for Chin, and
15 I'll take Your Honors to Slide 38. So we're dealing with the same limitation,
16 Limitation 1 -- 1E. And if I could now take Your Honors to Slide 40, the
17 petitioner's argument for obviousness for Chin is that for the -- for the
18 display in each of the two modes of Chin where there's no disclosure, the
19 petitioner's argument is that Chin would be modified or combined with the
20 feature of a POSITA turning off or disabling a screen that is not facing the
21 user. And this is in Petitioner's expert declaration. You can see it here on
22 Slide 40, it's Rodriguez's declaration in Paragraph 258.

23 So -- and the petitioner's expert explicitly states that this was
24 common knowledge or this was well-known in the art in 2011, but it's pure
25 ipse dixit testimony. There's no reference that is cited in support of that
26 testimony. And it is permissible to find obviousness -- Your Honor?

1 JUDGE MURPHY: Well, I was just going to say, I mean, so I -
2 - I'm just trying to understand the -- both sides' positions on this. They have
3 expert testimony from a qualified expert. That's evidence.

4 MR. SCHREINER: And it's ipse dixit testimony. He doesn't
5 cite a single reference.

6 JUDGE MURPHY: I understand. You're saying he hasn't
7 corroborated it with documentary evidence, but his testimony from the
8 position of a qualified expert, I mean, it's evidence. What weight we give to
9 it is a different question.

10 MR. SCHREINER: I would -- I think there's Federal Circuit
11 authority that suggests, even holds that the Petitioner's mere ipse dixit
12 testimony shouldn't be given weight, that it needs to be corroborated. So for
13 example, there is a case that holds, a Federal Circuit case that holds that you
14 can find obviousness based on a combination with common knowledge in
15 the art, and that's the Philips v. Google case from 2020. It's -- the cite is 948
16 F.3d 1330, endpoint cite is 1338. And there, the expert was proposing a
17 combination with a common knowledge of pipelining, and so that was the
18 feature to be combined with the stated reference, and he supported that with
19 a reference named Hua. So in that case, the Federal Circuit found that that
20 was a proper obviousness combination, and the expert's testimony did
21 establish that that was a known feature in the art at the relevant priority date.
22 But here, we have an expert that is not providing any corroborating
23 evidence. There's -- it's not tethered to any other evidence.

24 JUDGE DROESCH: Counsel --

25 MR. SCHREINER: We also have the TQ Delta case --

1 JUDGE DROESCH: Counsel, may I interrupt you? Does -- is
2 it Patent Owner's position that what the expert testified -- is there a dispute
3 about what the expert testified, or is the dispute more about form versus
4 function?

5 MR. SCHREINER: No, there's no dispute about what the
6 expert testified to. If I can turn to Slide 41, this shows Paragraph 258 of
7 Petitioner's Expert -- petitioner's Expert's declaration. And he says that, "In
8 and around 2011, a POSITA would turn off or disable a screen that is not
9 facing the user to save power." He goes on to say that, "Turning off power
10 to one screen in a multi-screen device was a known design option to a
11 POSITA in 2011." But he doesn't cite any corroborating evidence.

12 The -- I -- I'd like to refer to the TQ Delta case. These are cited
13 in the papers, but it's worth mentioning now. TQ Delta, this is Federal
14 Circuit 2019, 942 F.3d 1352. The Court said that, "The ipse dixit
15 declaration, which is untethered to any supporting evidence," close quote,
16 should be given no weight. And that's exactly the case here.

17 And if I could turn to Slide 42, it's even worse when read in
18 context, the expert's assertion that this was a known feature in 2011, because
19 he cites five references earlier in his declaration as allegedly defining the
20 state of the art from -- for multi-screen devices in 2011, yet he cites none of
21 those references as supporting or disclosing this feature of turning off or
22 disabling a screen not facing a user. I asked him about it in deposition, and
23 he conceded that he didn't cite to any of those references. So what you have
24 on the one hand is Petitioner's Expert's ipse dixit testimony untethered to any
25 evidence. The burden is on the petitioner to establish that that was common
26 knowledge in 2011, they didn't do so.

1 And furthermore, Patent Owner's Expert came back and
2 provided an affirmative testimony that it was not a common knowledge of
3 the art in 2011 to turn off or disable a screen not facing the user, and Patent
4 Owner's expert cited a reference. It's the Beach (phonetic) reference, Exhibit
5 2009. So on that basis, the petitioner's proposed combination of modify or
6 combining Chin with this supposed feature of turning off or disabling a
7 screen not facing the user, that's not sustainable, because that feature is not
8 established as being common knowledge in the art as of 2011. And for that
9 reason, the petitioner's obviousness case based on Chin is not viable. And
10 all of the independent claims, Claims 1, 11, and 16, are patentable over
11 Chin.

12 JUDGE PESLAK: Counsel?

13 MR. SCHREINER: I --

14 JUDGE PESLAK: I have a question, and maybe I'm just
15 missing something here, but -- and this is in connection with Petitioner's
16 argument about, I guess it's Figure 9 in Chin. If you go to Step S140, okay,
17 it says you activate the camera operating button. So -- and then in the next
18 step, you're displaying images on one or the other of the screens. So isn't it
19 implicit from that that for the screens to -- one of the screens to come on, it
20 has to be activated first? And then in Step 150, you're selecting which unit
21 it's going to display the preview, the image on it, so isn't it implicit that it's
22 not displayed on the second screen from Figure 9?

23 MR. SCHREINER: Yes, Your Honor. I have two answers to
24 that. First, Patent Owner's Expert provided unrebutted testimony explaining
25 that the opposing screen that's not disclosed in the text of Chin could be
26 displaying a photo preview. It's unrebutted testimony. Secondly, if you

1 look at Figure 9, okay, let's take it through. We have the decision block
2 S150, self-photographing mode. So if it's -- we're in the self-photographing
3 mode, then that takes us to S160, and it says "display a photo preview on
4 Display -- second Display Unit 52." That's Figure 5. It doesn't say anything
5 about Display Unit 51 there. It's completely silent.

6 And likewise, if you take the other path, okay, self-
7 photographing mode, no, and we go to the right and we go to S170, which is
8 the outward facing mode of Figure 6, it states "display images on First
9 Display Unit 51." So that's a photo preview on Display Unit 51, but it's
10 completely silent about Display Unit 52. So you have the same problem that
11 we discussed before, which is that Chin is completely silent as to what is on
12 the opposing screen in both Figure 5 and Figure 6. And to establish
13 anticipation, there has to be an express disclosure of the limitation, and that
14 simply isn't here in Chin, Your Honor.

15 JUDGE PESLAK: And you're saying -- and what was the
16 un rebutted testimony you mentioned just before you explained that?

17 MR. SCHREINER: Sure. Patent Owner's Expert, Dr. Surati,
18 provided testimony in his declaration that in Chin, the opposing screen that's
19 not disclosed could be disclosed -- could be providing a photo preview. So
20 for example, in Figure 5 of Chin, the opposing Screen 50 -- the opposing
21 Screen 51 could be disclosing -- presenting a photo preview. And in Figure
22 6, he testified that the opposing Screen 52 could be disclosing a photo
23 preview. That being the case, then the corresponding screens are not
24 different. They're both providing photo previews, and therefore Limitation
25 1E isn't met. So that testimony establishes that it's not even inherent that
26 Chin meets Limitation 1E, Your Honor.

1 JUDGE PESLAK: Okay. I understand what you're saying.

2 MR. SCHREINER: Thank you.

3 JUDGE MURPHY: Counsel, I want to follow up on the ipse
4 dixit --

5 MR. SCHREINER: Yes, Your Honor.

6 JUDGE MURPHY: -- and the impact we should or shouldn't
7 give to that. In the reply brief, in particular on Page 19, in response to that
8 argument in the patent owner's response, the petitioner cites deposition
9 testimony of the patent owner's expert, Dr. Surati, at Page 85-86, indicating
10 that Patent Owner's Expert agreed with Petitioner's Expert, Dr. Rodriguez,
11 that it was known -- well-known in 2011 that the battery capacity of mobile
12 devices was limited, and it might be a reason, in certain circumstances, to
13 turn off a screen that's not being used or viewed. I -- you don't have to agree
14 with it. My question --

15 MR. SCHREINER: Yes.

16 JUDGE MURPHY: -- is, is that a sufficient response to cure
17 what you argued to be --

18 MR. SCHREINER: The -- I don't think so. First, the issue of
19 battery life, that goes to motivation. But that's not the -- that's not the
20 material issue here. The material issue here is the feature of turning off or
21 disabling a screen not facing a user. Was that common knowledge in 2011?
22 And Patent Owner's Expert testified in his declaration that it was not, and
23 Patent Owner's Expert in deposition, at most he said, yeah, it was known to
24 turn a display on or off. He never conceded that the feature of turning off or
25 disabling a screen not -- because it's not facing the user, was known in 2011.
26 He said the very opposite in his declaration testimony, and he's -- he, unlike

1 the petitioner's expert, cited to a reference in support of that testimony, Your
2 Honor.

3 JUDGE MURPHY: And I'll ask Petitioner's Counsel in
4 rebuttal, but is there any other testimony in the record to support Dr.
5 Rodriguez's testimony in Paragraph 258?

6 MR. SCHREINER: No, there's not. I mean, to be honest with
7 you, I expected Petitioner would come back on reply with a supplemental
8 expert declaration, where Dr. Rodriguez clarified his testimony by citing to
9 some evidence to support it, instead of presenting ipse dixit, but he didn't. I
10 expected that if not that, then Petitioner would come back with a list of
11 references showing that the feature of turning off or disabling a display not
12 facing the user was known in 2011. That wasn't in the reply. So ultimately,
13 I think that point is almost undisputed, that the petitioner failed to establish
14 that the feature that it's proposing in its combination, they failed to establish
15 that it was known in the art in 2011.

16 JUDGE MURPHY: Well, it's disputed. The question is, what
17 does the evidence show? And we'll have to determine that.

18 MR. SCHREINER: Yeah -- yes. Fair enough, Your Honor.
19 Yes.

20 I'd like to go ahead and turn to Whitehorn now, anticipation,
21 and we'll go to Slide 46. So again, we have our old friend Limitation 1E,
22 you know, being really the focal point of the main distinction. And what we
23 have in Whitehorn, turning to Slide 47, the petitioner focused on two capture
24 modes. There's a first capture mode in Whitehorn where the device is
25 folded, and as my friend explained, the user looks through a small display
26 shown in Figure 3, and there's a camera lens on the other side, and the user

1 can take a picture in that first capture mode. Then there's a second capture
2 mode that's shown in Figure 5, and there, the photo preview is shown in Top
3 Screen 128, which has been basically folded out.

4 Now, with Whitehorn, you have the same problem you have
5 with Chin with respect to this Large Display 128. When it comes to the first
6 capture mode, Whitehorn does not say that the first capture mode displays --
7 provides no display, or that it's disabled when it's in the first capture mode
8 orientation. So in Figure 5, Whitehorn discloses for sure that large screen
9 128 provides a photo preview, but when it comes to the Figure 1
10 embodiment, the first display mode, there's no disclosure. And you can see
11 this in Paragraph 27 of Whitehorn.

12 So we have the same issue as we had with Chin where, going
13 back to Slide 47, the petitioner is focusing on the second capture mode and
14 this large -- top large screen 128 as allegedly being the screen that's
15 providing a different display in that mode as compared to the first mode.
16 But in the first mode, Whitehorn does not state anything about what that Top
17 Screen 128 displays or not displays. And concededly, the device is folded in
18 that scenario, and large screen 128 is not visible to the user, but there's no
19 disclosure that it's not displaying anything.

20 And the patent owner's expert, turning to Slide 49, the patent
21 owner's expert went through an exercise where he explained that, for
22 example, if the user was operating the device in the second mode where Top
23 Screen 128 is folded out and showing a photo preview, that's shown on the
24 left-hand side of Slide 49, the user could then transition to the first mode
25 where the device is folded. And our expert testified that that large screen
26 128 could continue to display a photo preview. You know, for example, the

1 designer might not want to have to recode or change firmware to turn that
2 display off when it's folded. It might just need to continue to display a photo
3 preview. And for that reason, you -- we don't have anticipation based on
4 Whitehorn. Again, I go back to the -- you know, the case law, which states
5 that the standard for anticipation is a high standard. It has to be explicit
6 disclosure of limitation or inherent disclosure of the limitation, and neither
7 has been established.

8 If I could go to Slide 50, the petition makes no inherency
9 argument as for Whitehorn and anticipation, it's Ground 3, and so it should
10 be deemed waived. But as I just explained with Dr. Surati's evidence in his
11 declaration, he explains that that large screen interface could continue to
12 provide a display in that first capture mode of Figure 1. For that reason, it
13 shows that it's not even inherent that Limitation 1E is met by Whitehorn.

14 I'd like to now go to Claim 4, Slide 53. So Claim 4 is a
15 dependent claim that depends off of Claim 1, and it recites, "wherein the
16 device is in a landscape or portrait orientation." Now, the petitioner has
17 taken the position that it means that the physical device, like the housing, is
18 in a landscape or portrait orientation. There seems to be a claim
19 construction issue lurking here. I'm not sure, after you read the papers,
20 whether Petitioner really sticks to its position that it's saying that the device
21 is in a landscape or portrait orientation. Certainly Patent Owner's position is
22 that a POSITA would understand that it's saying that the device has a display
23 that's in a landscape or portrait orientation.

24 And in fact, if you go to Slide -- I don't have it here, but if you
25 look at the disclosure in the specification in Column 3 where it describes
26 portrait orientation and landscape orientation, it discusses it in terms of a

1 display. So I think that pushes aside any notion that Claim 4 isn't reciting
2 that the device has a display that's in a landscape or portrait orientation.

3 If I could go to Slide 54, the petitioners present two theories
4 based on Whitehorn for Figure -- for Claim 4. Their first theory in the
5 petition was based on Figure 3. So if Your Honors have Figure 3 available
6 of Whitehorn, it shows there's a -- an image capture device 116 at the top.
7 It's a little circular lens. It's a camera lens. It's not a display. So Petitioner's
8 first theory is that camera lens 116 in Figure 3 shows the device is in a
9 portrait orientation.

10 Now, their second theory, when they realized, I think, that there
11 was an oversight in the petition, they changed on reply to relying on Figure
12 4. Figure 4 of Whitehorn shows a small screen interface 118, a little circular
13 interface at the top of the device. That indeed is a display, but that argument
14 based on Figure 4 that was first presented on reply should be deemed
15 waived.

16 But starting with the first argument based on Figure 3, there's
17 multiple defects with this argument. First, the image capture lens 116, it's
18 not a display, it's a camera lens, so it can't meet the limitation of Claim 4.
19 Secondly, if you look at the disclosure in the specification in Column 3,
20 Lines 41 through 56, it describes what a portrait orientation is, and it
21 describes a portrait orientation as meaning that the display has a
22 substantially horizontal dimension, and it's got a substantially vertical
23 dimension.

24 Now, if you look at this image capture device 116 in Figure 3
25 of Whitehorn, it's circular. There is no substantially horizontal dimension or
26 substantially vertical dimension. Additionally, the definition --

1 JUDGE PESLAK: Counsel?

2 MR. SCHREINER: Yes, Your Honor?

3 JUDGE PESLAK: Isn't the screen on the -- just on the opposite
4 side from the lens 116? So --

5 MR. SCHREINER: The -- 116 is designated in Whitehorn as
6 the image capture device. So it's basically the camera lens. Your Honor --

7 JUDGE PESLAK: Yes, but --

8 MR. SCHREINER: Yes?

9 JUDGE PESLAK: But you're saying that's not a display. But
10 isn't that just on the opposite side of the device from the display 118?

11 MR. SCHREINER: Yes, Your Honor. That's in Figure 4, and
12 118 is -- small screen interface 118, indeed, that is a display, and that's
13 Petitioner's backup theory that they put forward first -- for the first time on
14 reply. And I will discuss that. I can discuss it immediately now if Your
15 Honor would wish.

16 JUDGE PESLAK: I -- maybe -- well, I guess the other
17 question I have about this. No matter how you interpret this claim, isn't it
18 just dependent on how you hold the device? I mean, I don't -- I'm having
19 trouble understanding the claim itself. Whether it's, you treat it as the device
20 or, you know, the display, isn't landscape versus portrait just dependent on
21 how you hold the device?

22 MR. SCHREINER: I think that's correct, Your Honor. And if
23 you look at the specification of the '842 patent, like Figures 1A and 1B -- let
24 me see if I can find a better example. We can look at Figure 3A of the
25 specification of the '842 patent. It shows the device in a variety of different
26 modes, and one would be a portrait mode, such as the one that's designated

1 as 100, where the device is being held so that the display is in a portrait
2 orientation. And yes, the device can be rotated so that it's in a landscape
3 orientation, and that will be shown, for example, as item -- it's not
4 designated on Figure 3A, but in the lower-left-hand side of Figure 3A, you
5 can see that the disclosed device is now in the horizontal orientation.

6 So I don't dispute Your Honor's point that whether a device --
7 the device has a display in a portrait or horizontal orientation may depend on
8 how the user is holding the device. I agree with that.

9 JUDGE PESLAK: So wouldn't any device meet the claim
10 then? Because as long as it --

11 MR. SCHREINER: No.

12 JUDGE PESLAK: As long as it has a rectangular display, isn't
13 it going to meet the claim?

14 MR. SCHREINER: No. I don't think so, because the device
15 could be in orientations other than portrait or landscape. As Your Honor just
16 indicated, it may depend on how the user holds the device. So if the device
17 is, let's say a portrait device, as I'm kind of trying to show with my hands,
18 let's say the user pivoted it around 45 degrees, you know, then it's in a mode
19 that I think a POSITA wouldn't consider it to be either portrait or landscape.
20 So I don't think the claim encompasses every possible orientation of the
21 device, Your Honor.

22 JUDGE PESLAK: Well, no, no, no, no. That wasn't my point.
23 My point is, isn't any -- if you have a device with a rectangular display, isn't
24 it capable of being in either a portrait or a landscape mode?

25 MR. SCHREINER: If the device can operate in both modes, I
26 think the answer is yes. I think there would be devices that are designed so

1 that they just operate in the portrait mode. I -- that -- this has nothing to do
2 with what the claim is saying, but I'm just saying as a general proposition,
3 there could be a device that could only operate in the portrait mode. But
4 what's not disputed, Your Honor, is if you look at Figure 4, this is
5 Petitioner's second argument that was first presented on reply, and I'm
6 referring now to Slide 55. The display here, 118, that's circular or at best
7 oval. It's not a rectangular display.

8 JUDGE PESLAK: Okay. Okay. I get your point then. Okay.
9 I -- now I understand.

10 MR. SCHREINER: Okay. So that -- just to hit my notes on
11 this particular slide, that is a display, but it doesn't have a substantially
12 rectangular dimension. It doesn't have a substantially vertical.

13 JUDGE MURPHY: And you're arguing here under anticipation
14 because we only have --

15 MR. SCHREINER: Yes, this is under anticipation.

16 JUDGE MURPHY: All right. Okay.

17 MR. SCHREINER: The petitioner doesn't make a separate
18 argument under obviousness for this particular claim.

19 JUDGE MURPHY: They do not?

20 MR. SCHREINER: I -- not that I recall. And --

21 JUDGE DROESCH: All right. So you're actually over your
22 time.

23 MR. SCHREINER: Okay. I'll finish up quickly. I'll go to
24 Slide 58. So now this is Whitehorn obviousness, and turning to Slide 59, the
25 petitioner makes the same argument that it makes for Chin. The petitioner
26 asserts through its expert that it was known in the art in 2011 to turn off or

1 disable a screen that is not facing the user. And we have the same -- so it's a
2 modification of Whitehorn, just the way they propose modifying or
3 combining Chin.

4 And the same defects exist. The petitioner's expert's testimony
5 is ipse dixit testimony; it does not cite a single reference. His expert
6 declaration -- again, this, I think, is important. He cited five references as
7 defining the state of the art for multi-screen devices, and he admitted that in
8 deposition, yet he didn't cite to any one of those references as disclosing this
9 allegedly well-known feature in 2011. And the patent owner's expert has
10 affirmative testimony going the other way. We have that cited at the bottom
11 of Slide 59. It's the Surati declaration, Paragraphs 251 through 252, which
12 cites a reference, the Beach reference, Exhibit 2009.

13 I know I'm over my time, Your Honor. I'm happy to indulge
14 any other questions before I step aside.

15 JUDGE DROESCH: I don't believe there's any additional
16 questions.

17 MR. SCHREINER: Thank you, Your Honors.

18 JUDGE DROESCH: Thank you.

19 MR. PEARCE: Ready? So if I may, I'd like to just start by
20 briefly addressing the issue with Claim 4. Turn -- let's turn to the claim
21 language. The claim language here makes clear that when Claim 4 says,
22 "the device is in a landscape or portrait orientation," it's talking about the
23 device and not a display. That has -- Claim 4 depends on Claim 3. Claim 3
24 says the device -- "wherein the device is in a closed state." So it's talking
25 about the device being closed. It's not talking about the display. The display
26 being closed wouldn't make sense.

1 And of course, this depends from Claim 1. Claim 1 talks about
2 providing a device having at least first and second screens, and then those
3 screens can display things. So the device in Claim 4 is the same device in
4 Claim 3 and Claim 1. It is the device that is in a portrait mode. That's what
5 we argued in the petition. We didn't change our argument. If you look at
6 Petition Page 73, we said that Whitehorn discloses a device used in portrait
7 orientation, i.e., where the width is less than the height, as illustrated in
8 Figure 3. It's also illustrated in Figure 4 because I believe, as Your Honor
9 pointed out, it's just the same device, just in a different orientation. So we
10 think that's pretty clear if you just look at the claim language.

11 I'd like to address the obviousness point for both Chin and
12 Whitehorn since a lot of the discussion from Patent Owner's counsel focused
13 on that. First of all, let -- let's be clear about what we're arguing here. What
14 we're arguing is that at minimum, based on the disclosures of Chin and of
15 Whitehorn, it would have been obvious that the second screen, the screen
16 that's not being looked at, could have been off.

17 There's already a screen that is facing away from the user or
18 otherwise not shown. In Chin, it's flipped away from the user. In
19 Whitehorn, that screen might be completely shut so you can't even see it.
20 That's already present in the reference. And the question is, would it have
21 been obvious, based on the disclosures of the reference, for that screen to be
22 off? That does not require a combination with any other reference because
23 that is what a person skilled in the art already would have known from the
24 reference itself.

25 And that is supported by not only our expert's testimony
26 understanding the reference, but also by Patent Owner's expert. We saw the

1 slides from his deposition earlier. He admitted as he'd have to. I mean, of
2 course a screen and a device could be off. And if the screen isn't -- if the
3 device isn't turned on, the screen is off.

4 You have to do something to turn the screen off. They pointed
5 to Whitehorn and said, well, maybe what you could have done in Whitehorn
6 is had it be open, and then if you closed it, this screen is still on.

7 I'll -- let's set aside for a minute that there's no reason to have a
8 screen on that you're not looking at. Well, what about the contrary scenario
9 where you start with the device closed and then you open it? Why would
10 you have the screen on when the device is closed at the beginning? There's
11 certainly, at minimum, a reason why a person skilled in the art would have
12 understood, yes, that screen could have been off.

13 So I do want to point out, as we reference in our petition, there's
14 case law supporting this point. We cited, for example, the unification
15 technologies case, this is on Page 52 of our petition, that said that
16 inappropriate circumstances, a patent can be obvious in light of a single prior
17 art reference. And specifically in that case, the board had relied on the
18 expert not to supply limitations that were missing from the prior reference,
19 but to inform the board's analysis as to how a skilled artisan would have
20 understood the disclosures of the prior art itself. That's what we're doing
21 here. Dr. Rodriguez and Dr. Surati, their expert, both agreed that a screen as
22 shown in Chin or on Whitehorn could have been off, and then we've walked
23 through ample reasons why it would have at least been obvious for that
24 screen to be off.

25 So respectfully, the argument that Patent Owner is making and
26 repeated that this isn't common knowledge or it's not shown in any other

1 reference, is not really responsive to the argument we're making in the
2 petition, and it's not really responsive to the evidence, including the
3 testimony from their own expert.

4 One other point on obviousness, he said a number of times that
5 our expert cited other references as to defining the state of the art. That's not
6 an accurate characterization of what the expert said in his declaration. What
7 he said in his declaration was, here's some other references that show that
8 there were a number of different multi-screen handheld devices that were
9 known, and then I'm going to focus on Chin and Whitehorn.

10 He didn't say that these other references are the state of the art,
11 and I -- again, we're not using those in a combination.

12 I'll briefly --

13 JUDGE MURPHY: But what about the technical legal
14 argument that's being made, right? That the motive -- the petition relies on
15 motivation for preserving battery life in order to turn the screen off or
16 disable, the screen that's not being used? And Counsel's saying, as I
17 understand the argument, as a matter of law, you can't rely only on an
18 expert's uncorroborated declaration testimony. So if -- I think the facts aren't
19 in dispute. It's a question of what do we do with that?

20 MR. PEARCE: Well, Your Honor, I have two responses to that
21 question. The first response is, I think he's just not correct about the law.
22 And I would go back, for example, to the case that I just mentioned, which
23 we cited in our petition, which -- so let's look at two different inquiries.
24 There's the inquiry of motivation to combine, and expectation of success,
25 and then there's the inquiry of just the, you know, obviousness combination
26 itself.

1 When it comes to motivation to combine, I believe Counsel
2 said, I'm sure he'll correct me if I'm wrong, but I believe he said that's not
3 really what they're driving towards with their position, because I think
4 certainly, an expert can talk about why it would've been reasonable and
5 understood by a person skilled in the art that they could have modified or
6 combined or even understood a reference in a certain way, such as there
7 would be a reason to not have a screen on to save battery life.

8 I think that's the proper use of expert testimony, and it's
9 supported by both of the experts here. Certainly, we don't need to show an
10 express teaching suggestion or motivation in a prior art reference to support
11 motivation to combine, even though we actually do have a Chin and a
12 Whitehorn reference, recall that I talked about earlier.

13 So that's one piece of it. On the other piece of it, when we talk
14 about the disclosure of the prior art itself, which is what I believe their
15 argument is more carried towards, I would go back to the case we just
16 looked at, and that's one example where an expert who explains what a
17 person's skilled in the art would understand from a reference, that's
18 appropriate for the board to rely on to find obviousness based on that
19 reference. And that's the argument we're presenting here. So we think that's
20 completely aligned with the Federal Circuit case law.

21 JUDGE MURPHY: And I -- I'm trying to -- I can't find it.
22 Does Patent Owner raise that issue in the response or is that in the --
23 surreply, this legal issue about the insufficiency of uncorroborated expert
24 testimony?

25 MR. PEARCE: I hesitate to characterize, I guess, their
26 response or surreply. I think they -- they've generally tried to argue in both

1 papers that our evidence was insufficient because they say, you know, the
2 reference is silent about what the other screen is doing and we haven't done
3 enough. Whether they've elaborated on that surreply, I don't -- I don't know
4 that I necessarily characterize what they're saying, but I do think the
5 evidence we presented is in the petition, it's in our expert's declaration, and it
6 was only supported by what we put it under reply once we were able to
7 depose their expert.

8 I did want to briefly address also the anticipation argument, if I
9 could, because, you know, repeatedly, Counsel for Patent Owner was saying
10 that there was no disclosure whatsoever in Chin of what would happen on
11 the other screen. First, it's not correct to say that their expert's testimony was
12 un rebutted about what Chin or Whitehorn disclosed. Our expert addressed
13 that in his declaration, explained why, as he understands Chin and
14 Whitehorn. The screen that is not being viewed would be off. So it's not
15 un rebutted testimony, first of all.

16 Secondly, I -- there isn't really a good response, I think, on the
17 patenter side, to figure nine from Chin and also the figure six from
18 Whitehorn, which Your Honor I believe pointed us to earlier. What does
19 this figure mean if it does not mean that there's a change in what's being
20 displayed between the two screens in the different image capture modes?
21 And I'm looking at Slide 17.

22 There's a clear yes or no, there's a clear teaching, in fact, that's
23 the only thing that's different between the two modes that's shown in figure
24 nine is that there's a change in what images are displayed, which screen
25 they're being displayed on, and we would submit that that is an express

1 teaching that would support anticipation and at bare minimum, it certainly
2 would have been obvious that the other screen would be off.

3 I see the amount of time, so unless Your Honors have further
4 questions, I'll sit down.

5 JUDGE DROESCH: I don't think so. Thank you.

6 MR. PEARCE: Thank you.

7 MR. SCHREINER: I'll be brief here. Counsel said that the
8 obvious argument was that it's obvious that the opposing screen could be on
9 or off, and they argue it's obvious that it could be off, but that's not the
10 petitioner's argument. The petitioner's argument is one that was set forth in
11 the petition, and it's articulated in the petitioner's expert's declaration that we
12 have here, that it was -- that it was known in 2011 to turn off or disable a
13 display not facing the user. That was the argument that was made, and this
14 fact is not in dispute. The petitioner's expert didn't provide any
15 corroborating evidence. This was called out clearly in the patent owner
16 response. Petitioner had every opportunity to cure its expert's declaration
17 with a supplemental declaration. That would be the normal course of events.
18 Or at a minimum, to cite corroborating art to support its expert's ipse dixit
19 assertion, but they chose not to do that.

20 I can only infer that they couldn't find prior art establishing that
21 was a known feature in 2011, because the issue was clearly raised in Patent
22 Owner's response.

23 JUDGE MURPHY: Can you give me a cite for that, please, in
24 the response if you --

25 MR. SCHREINER: Oh, in the patent owner response?

26 JUDGE MURPHY: In the patent owner response.

1 MR. SCHREINER: I have to refer to my map here. In the
2 patent owner response, pages 54 to 58.

3 JUDGE MURPHY: Yes. Thank you.

4 MR. SCHREINER: You -- you're welcome, Your Honor. So
5 what's not in dispute is that petitioner's expert provides ipse dixit testimony
6 for this feature being common knowledge in 2011. It's also not disputed that
7 Patent Owner's expert provided counter testimony to that. Patent owner's
8 expert provided corroborated testimony that it was not a commonly known
9 feature in 2011 to turn off a disabled screen in -- that's not facing the user.
10 This is the Surati declaration, Paragraphs 194 through 197, with respect to
11 the Chin, obviousness ground two, and Paragraphs 251 through 252, with
12 respect to the Whitehorn obviousness ground four.

13 Petitioner -- Counsel for Petitioner also said, well, the expert
14 was just merely explaining how POSITA would understand the reference,
15 you know, understand what Chin reference teaches or what the Whitehorn
16 reference teaches.

17 He may have had some description about that in his declaration,
18 and he certainly did, but the relevant part here is that he was asserting that
19 this was a feature known in 2011, it was common knowledge. And as I said,
20 that was not established. And for that reason alone, the obviousness grounds
21 2 and 4, based on Chin and Whitehorn, are not sustainable.

22 And if Your Honors have no further questions I have no --

23 JUDGE MURPHY: I do have -- I'm just looking at those pages
24 in the response. I don't see the cases that you referenced earlier in your
25 argument. I see cases related to the reasonable expectation of success, but
26 not the motivation.

1 MR. SCHREINER: The cases might be in the surreply, Your
2 Honor.

3 JUDGE MURPHY: Okay.

4 MR. SCHREINER: I'll -- let me go back to those cases, see if I
5 can find them here to give you the cites again. So the TQ Delta case, it's TQ
6 Delta v. Cisco, 942 F.3d 1352, pinpoint cites 1360 and 1362, Federal
7 Circuit 2019. And again, the holding there was the expert's quote, "Ipse
8 dixit declaration, which is untethered to any supporting evidence," should be
9 given no weight. I'm almost certain that was cited, if not in our patent
10 response, our surreply. The other case I cited, and I don't recall whether this
11 one was cited in our papers, but it was Phillips v. Google 948 F.3d 1330,
12 pinpoint cite 1338, Federal Circuit 2020, and that's the one where the Court
13 found that there was obviousness based on a combination with -- of common
14 knowledge of pipelining. And that was supported by an expert who
15 corroborated with a reference named Hua.

16 And I was distinguishing that case from here, where we don't
17 have any corroborating effort evidence from the petitioner's expert. And
18 again, he had every opportunity to do so.

19 JUDGE MURPHY: Well, I -- I'm not seeing those citations in
20 the table of authorities for the surreply. It said TQ Delta and the other was
21 Phillips v. Google, right?

22 MR. SCHREINER: Yeah. TQ Delta is cited on page 47 of the
23 certified --

24 JUDGE MURPHY: Yes. That I see.

25 MR. SCHREINER: The other one I conceded to as I was
26 reintroducing it here, I -- I'm not sure that that one was cited.

1 JUDGE MURPHY: The --

2 MR. SCHREINER: That's the Phillips v. Google case, but it
3 certainly is on point. And again, it's not just that their expert doesn't have
4 any corroborating evidence. You've got opposing evidence from the patent
5 owner's expert on the point. The patent owner is -- expert is testifying. This
6 was not common knowledge in 2011, and it's not -- not only opposing the
7 petitioner's expert's testimony, but our -- the patent owner's expert cited
8 corroborating evidence with the Beach reference, Exhibit 2009, which was
9 never disputed.

10 JUDGE MURPHY: But they're also citing his -- your expert's
11 deposition testimony, so we'll weigh that testimony.

12 MR. SCHREINER: Yeah, I think if you look at it closely,
13 you'll see that our expert is conceding a truism, which is that the device can
14 be turned on or off. He's not conceding that that feature, that's the basis for
15 the petitioner's combination, was known in the argument 2011, Your Honor.
16 Thank you. Thank you very much.

17 JUDGE DROESCH: Thank you. All right that adjourns our
18 proceedings. We will reconvene at approximately 10:45 for the next
19 hearing.

20 (Whereupon, the above-entitled matter went off the record at
21 3:05 signature having not been waived.)

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Patent 8,836,842 B2

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