

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVATION MEDICAL, INC.,
Petitioner,

v.

EMKINETICS, INC.,
Patent Owner.

PGR2024-00043
Patent 11,844,943 B2

Record of Oral Hearing
Held: December 2, 2025

Before: BARRY L. GROSSMAN, RYAN H. FLAX, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

APPEARANCES:

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P R O C E E D I N G S

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JUDGE FLAX: All right. Everyone, we are here today for the final hearing in PGR2024-00043. The parties are Petitioner Avation Medical, Inc. versus Patent Owner EMKinetics, Inc. If I'm wrong with any of that, please let me know. The patent at issue is U.S. Patent 11,844,943.

If counsel for the parties could please introduce yourselves. And I don't -- I see you don't have anyone else here so if there are people are with you that show up on time, introduce them too, but please --

MR. TUCKER: Yes, Your Honor. Todd Tucker from Calfee, Halter & Griswold, Cleveland, Ohio, for Petitioner Avation Medical and with me is my colleague, Kyle Deighan.

MR. GERASIMOW: Thank you, Your Honor. My name is David Gerasimow. I'm with the law firm of Gerasimow Law. I represent Patent Owner EMKinetics. Thank you.

JUDGE FLAX: Okay. And if I am correct -- I'm Judge Flax, by the way - I will be new to the three of you. I'm joined today by Judges O'Hanlon and Grossman. I'm understanding that each party has requested 45 minutes of argument; is that correct?

MR. TUCKER: That's correct, Your Honor. I'd like to reserve about maybe 10 minutes or so for rebuttal if that's okay.

JUDGE FLAX: Okay. Mr. Gerasimow -- Gerasimow, am I saying that correctly?

MR. GERASIMOW: It's Gerasimow. Thank you.

JUDGE FLAX: Gerasimow? You also can reserve time; you don't

1 have to decide right now. If you want to tell me how much you want to
2 reserve when you get up to argue, that's fine.

3 MR. GERASIMOW: I guess I won't decide now.

4 JUDGE FLAX: Okay.

5 MR. GERASIMOW: Thank you.

6 JUDGE FLAX: All right. Well, Mr. Tucker, whenever you're
7 ready, you can begin.

8 MR. TUCKER: Okay.

9 JUDGE FLAX: And by the way, we have the full record in front
10 of us here on screens. We also have all of your demonstrative slides on our
11 screens too, so we can see it there. Please identify what slide you're on as
12 you progress through. And please, whenever you're referring to anything
13 that's in the record, identify the paper or identify the exhibit number so that
14 we can have a good transcript.

15 MR. TUCKER: Yes, Your Honor. Thank you. May it please the
16 Board. Again, I'm Todd Tucker, here on behalf of Petitioner Avation
17 Medical. And Your Honors, this is a fairly straightforward PGR because at
18 this point, there's really no -- or there's not really, there are no substantive
19 challenges to the Petitioner's invalidity grounds.

20 We set forth 10 grounds grouped into three pieces of prior art.
21 Grounds 1 through 4 relate to Svihra; Grounds 5 through 8, Amarenco; and
22 9 and 10, Burnett. None of the substantive showings, including our expert's
23 declaration -- our expert was not even deposed in this case -- none of those
24 have been challenged.

25 Next slide, please. All that we have are the limited issues of the

1 prior art status of the Svihra reference and the Amarenco reference. And
2 then finally, whether the Burnett Patent is prior art to the '943. The question
3 with Svihra and Amarenco is whether they're publicly accessible and thus
4 qualify as a printed publication. And the question with Burnett is, what
5 priority date is the '943 entitled to receive?

6 As the Board will see, the '943 has a broken priority chain and on
7 -- it's a multi-branched family tree. The key branch has a broken priority
8 claim. And the second -- a secondary branch has failed to meet the
9 requirements of 35 U.S.C. 120 as set forth in the Medtronic case, the
10 Encyclopedia Britannica case, where they've not done a specific reference
11 and identified the family relations.

12 Now, the key thing for the Board to remember is Petitioner does
13 not have to win on all three of these. We only have to win on one of these
14 three issues, and that will take down all the claims.

15 I'm going to start with the next slide discussing the two journal
16 articles, Svihra and Amarenco, in whether they are printed publications
17 qualifying as prior art. This is a pretty straightforward situation. It's, you
18 know, been long held that if something's publicly accessible, it's prior art.
19 And I think what's really critical here is Vidstream LLC v. Twitter, Inc, 981
20 F.3d 1060, 1065-66, that says if there's an established publisher, that's a
21 presumption of public accessibility. And here, for both Svihra and
22 Amarenco, there's an established publisher, the Bratislava Medical Journal,
23 which has been around since 1919; and for Svihra and for Amarenco, the
24 Journal of Urology. And I'll get into some more details.

25 The other thing that the Board should remember is the Hulu case in

1 there, which is Hulu, LLC v. Sound View Innovations as a precedential
2 opinion, IPR2018-0139, where the Board interpreting Federal Circuit case
3 law, it says that it's a totality of the circumstances test. So while having the
4 publisher gives us a presumption, when you look at the totality of the
5 circumstance of the evidence here, you're going to see -- and I think our
6 papers have demonstrated that both these references bear all the hallmarks
7 -- and virtually all of the hallmarks of a printed publication.

8 So Svihra, which is Exhibit 1004, it's -- it submits a prior art
9 printed publication; it bears all the hallmarks. There was no objection to its
10 authenticity or whether it was hearsay. Our expert, in his declaration, said it
11 was publicly available. The institution decision said it was more likely than
12 not that it was publicly available. And finally, in our reply, we submitted
13 corroborating references, three references: Sheriff 1085, Slovak 1086, and
14 Garcia 1087. These are later journal articles that all three cites Svihra with
15 the hallmarks of a printed publication in those citations. And I'll get to
16 another case, Parse Biosciences, in a minute, that says we can use that type
17 of corroborating evidence to show it was publicly available.

18 JUDGE FLAX: Does it matter that those corroborating exhibits
19 are dated much later than the --

20 MR. TUCKER: The Parse file? Yeah. Sorry for interrupting.
21 The Parse Biosciences case says that's acceptable because we're showing
22 how it's available. And this is one of those factors under the Hulu totality
23 test that would show us, hey, somebody was able to go find these and cite
24 these.

25 Svihra, let me run through the hallmarks pretty quickly here. The

1 journal name on the actual document says Bratisl Lek Listy, which is the
2 journal name of the Bratislava Medical Journal. This is a journal that the
3 Board noted has been published since 1919 by the Faculty of Medicine at
4 Comenius University in Slovakia. The document itself, on its face, has all
5 these hallmarks, a publication year of 2002, a volume 103 -- that's because
6 this journal has been out there so long - the number/edition, which is 12. It
7 also says, received May 30th, 2002, accepted December 9th, 2002; the 12
8 corresponds to the December acceptance date; and finally, the page
9 numbers.

10 Turning to Slide 7, it's been properly authenticated. There was no
11 objection. Our expert, Dr. Wingeier, said it was a published study. And I'll
12 move rather quickly here.

13 Let's get to Slide 8. And this comes back to, I think, your question,
14 Judge Flax. The Hulu case says that there's certain instances when we're
15 allowed to submit such corroborating evidence, and one of those is in a
16 reply. So in this PGR, we start by obviously filing our petition. Patent
17 Owner made their reply. In their reply, they brought up questions of
18 Svihra's public accessibility. The Board instituted -- and so our first
19 opportunity -- the Petitioner's first opportunity to address the Patent Owner's
20 challenges was in our response. And as 37 C.F.R. 42.108(c), 42.23, 42.123,
21 that says, you know, we have limited opportunities to put in evidence, such
22 as this corroborating evidence, but that's exactly one of them.

23 I know there's a motion to exclude -- this is not supplemental
24 information. Supplemental information would be something new related to
25 a new argument. This corroborating evidence is exactly set forth by the

1 CFR, is set forth by the PTAB trial guide. This was our first opportunity to
2 put that in, and we put it in.

3 Now, we go to the next slide. This is what I alluded to a second
4 ago. Parse Biosciences is just square on point here. Parse Biosciences
5 versus 10X Genomics, Inc., IPR2023-00958, Paper 48 at 19 through 20, it
6 follows Hulu. And when you read the fact pattern of Parse Biosciences, it's
7 very similar to what we have here. You have a petition put in, a Patent
8 Owner questioning whether a document is publicly available, on reply, Parse
9 Biosciences put in corroborating evidence -- and it was corroborating
10 evidence that was dated -- you know, postdated the actual the actual
11 reference.

12 It was a reference called McCloskey. And they put in a couple of
13 other references, including the biochemical genetics article and said, hey,
14 this is showing that someone was able to find this article and cite it in a later
15 article. And the Board there said, this type of evidence is the figurative nail
16 in the coffin of Patent Owner's argument that McCloskey is not a prior art
17 printed publication. The reason the Board is saying that is because when we
18 look at this corroborated evidence, we're seeing that someone who is clearly
19 able to go search this, find this, and cite it in a later article.

20 So here, for Svihra, when you just look at all of these hallmarks
21 that I first showed you, plus these articles, which on the next page are three:
22 Sherif Exhibit 1085, Slovak Exhibit 1086, and Garcia Exhibit 1087. And all
23 three of them have the exact citation that's on the cover page of Svihra.
24 Garcia even translates that it's from the Bratisl Lek Listy, which my
25 understanding is Slovakian. It translates that to the Bratislava Medical

1 Journal. And also, I note on Garcia was interesting. If you look there, it's in
2 kind of blue, it says Medline. So it appears that Garcia found this on
3 Medline, which, you know, I think a lot of people who have done work in
4 the medical device space know that Medline is an online search repository
5 for medical journal articles, so.

6 JUDGE FLAX: Mr. Tucker, just for the record, you're -- I think
7 you're focusing on your Slide 10.

8 MR. TUCKER: I'm sorry. Yes, Slide 10. Yes.

9 JUDGE FLAX: So yeah, unless we identify those slides, we're not
10 going to know -- we can hear what the words are and we can look at what
11 the words are in the transcript, but we don't know what slide you're referring
12 to.

13 MR. TUCKER: Thank you. I'll remember to do that. Thank you
14 for that, Your Honor. I'm just, you know, a little excited to be here and talk
15 to you guys about this, so I'm kind of storming ahead of things. It's also -- I
16 think it's my first in-person argument in about six or seven years or so. I've
17 had a bunch, but they've all been on video, so.

18 JUDGE FLAX: This is better.

19 MR. TUCKER: It's so much better, yeah. Actually, with a -- I
20 remember Your Honor, Judge Flax, right in the middle of COVID, you did
21 one. You presided over one for me, it's, like, six patents.

22 JUDGE FLAX: Oh, really? You got to see the inside of my home
23 office, huh?

24 MR. TUCKER: Yeah. Well, the overall hearing took about three
25 hours on video, and it was kind of painful having to do it that way. So yeah,

1 this is better.

2 So I'm going to just skip ahead very quickly then to Slide 11. This
3 is where the Board found Svihra is publicly accessible. All I would note is
4 Patent Owner has put forth no evidence to say Svihra is not publicly
5 accessible. It essentially, in its papers, just offers a critique with some
6 commentary that perhaps the Petitioner --even though all of this stuff was
7 submitted in the opening petition -- should have maybe, like, listed it better.
8 But it was attached and only after the Patent Owner made its response to the
9 petition did we realize this was going to be such a major issue, at least a
10 major issue for the Patent Owner. Because again, I submit that the Board
11 got it right at institution and nothing has changed.

12 They've put forth no evidence showing that any of this stuff is
13 wrong. They have nothing to overcome this. And then you layer in, as
14 Parse Biosciences allows us, the three corroborating references, one that
15 even indicates, hey, this is available on an online forum. I think -- you
16 know, as the Board said in Parse Biosciences, that is the nail in the coffin.

17 So let me move on to Amarenco on Slide 12. Amarenco is our
18 second reference and it's Exhibit 1005. And Amarenco is probably an even
19 more open and shut case of something that's publicly accessible for one
20 reason and one reason only. Patent Owner cited Amarenco to the patent
21 office. It's on the face of the '943 Patent. We overcame the 325(d)
22 argument. So I think it's a little bold for Patent Owner to say, hey, this
23 document is not publicly available when they were able to find it and cite it
24 to the patent office. So, you know, it appears on the '943 Patent's face, so I
25 think that argument's a little rich.

1 But without belaboring the point too much, Amarenco, if we go to
2 Slide 13, similar to Svihra, it has all the hallmarks of public accessibility,
3 with even a couple more. First off, similar to being an established publisher
4 -- this is from the Journal of Urology, a well-known publisher. So that
5 creates a presumption this is publicly available. It then has the publication
6 date of June 2003, the volume, 169, page numbers 2210-15. It also includes
7 a copyright, copyright 2003 by the American Urological Association, that's
8 the publisher, that's the known publisher.

9 And then very importantly, it also includes the DOI, the digital
10 object identifier. The digital object identifier is a unique alphanumeric code
11 for a journal article, similar to a VIN number on a car. And I can search just
12 off that DOI, and one would be able to find this article. So we have, first
13 off, the Patent Owner having this cited in their patent, we have an
14 established publisher, and we have a whole host of hallmarks.

15 JUDGE GROSSMAN: Mr. Tucker, on your Slide 13, is what you
16 refer to as the DOI, is that the number in the upper left-hand corner?

17 MR. TUCKER: Yes. It starts with 0022 --

18 JUDGE GROSSMAN: Yes.

19 MR. TUCKER: -- that's the DOI number. I'm sorry. No. Your
20 Honor, it's over on the right, I misspoke. See, on the right, underneath the
21 volumes here, where it says DOI?

22 JUDGE GROSSMAN: Yes.

23 MR. TUCKER: It's the 10.1097-01. What's in the left corner is
24 the -- I believe that's an internal number to the journal. The DOI is over on
25 the right.

1 JUDGE GROSSMAN: Thank you.

2 MR. TUCKER: Turning to Slide 14. Amarenco was properly
3 authenticated. There were no objections to authenticity or hearsay. And our
4 expert, who was not deposed in this case, he confirmed that it was published.

5 Let's skip to the -- let's get to Slide 16. And here is what I was
6 talking about. This is on the '943 Patent. There's Amarenco right there
7 -- Journal of Urology, volume 169, 2210 to 2215, June of 2003. I think
8 Patent Owner is very hard pressed to say something's not publicly available
9 when it's on the face of the very patent at issue in this PGR.

10 Now, turning to Slide 17. The Patent Owner did not make any
11 arguments about Amarenco in its response to the petition. Once the PGR
12 was instituted, however, I think when it realized it had no substantive attack
13 on Amarenco, then it called into question whether it was publicly available.
14 So similar to what we did with Svihra, we put in corroborating evidence.
15 But even before that, we put in the cover page of the Journal of Urology
16 with our Petitioner's reply to show where we got this from.

17 And you can see, so what we call Amarenco II, it's an exact copy
18 of what we submitted with the petition, with the cover sheet from the Journal
19 of Urology included. You can see that not only is it listed as the Journal of
20 Urology, if you look at the upper right corner of that snippet, you can see it
21 says Shawnee Mission Medical Center Medical Library, Library Date
22 Received May 13th, 2003. And that's the library where we ultimately
23 acquired this article from. So that's further evidence that this is catalogued
24 somewhere in the library.

25 If we go to Slide 19. Here is under the Parse Biosciences case,

1 here's where we're putting forth corroborating citations to this document.
2 There's five of them: Queralto (Exhibit 1016), Sherif (Exhibit 1085), Slovak
3 (Exhibit 1086), Guo (Exhibit 1089), and Garcia (Exhibit 1087). You'll note
4 that Sherif, Slovak, Garcia, those are the same three corroborating articles
5 that also cited Svihra. And similar to how Garcia was, Exhibit 1087; with
6 Svihra, again, it says Medline -- that it was able to find this article on
7 Medline.

8 So I think without issue, both Svihra and Amarenco are publicly
9 available, they're printed publications, and there's no substantive challenge
10 to them. So without issue, Counts 1 through 4 related to Svihra lead to the
11 patent being unpatentable and invalid. And then 5 through 8, the counts
12 related to Amarenco likewise render the patent invalid.

13 Additionally, we cited in our reply a series of other articles -- and
14 I'm now on Slide 20 -- Hermens, which is Exhibit 1028, Hasan (Exhibit
15 1030), Hof (Exhibit 1042), and Noordhout (Exhibit 1043). These are all
16 references that show background. They show state of the art. They may
17 show what a person of skill would understand certain things to be.

18 The only one that I think Patent Owner really complained about
19 was a little bit on Hasan. But Hasan, we also provided some corroborating
20 evidence of, where it likewise was cited by other articles including Slovak
21 (1086) and Guo (1089).

22 JUDGE FLAX: What is the relevance of the Hasan exhibit?

23 MR. TUCKER: I think, Your Honor, it's just there's the -- there's a
24 question, a little bit of what, like, the EMG would mean. And it's just to
25 provide background of what a person of skill in the art would understand

1 when they're reading that part of the patent. It's not necessarily needed in
2 combination with any reference. It's just providing some background
3 context.

4 And then if we turn to Slide 21, there were -- and I'm not going to
5 read them all, because it's lengthy. But there's just a bunch of other
6 references for background and state of the art that we also offered. And
7 these were offered with the reply, which is completely permissible.

8 So if we turn to Slide 22, where are we here? I think at this point,
9 it's established that Svihra is a printed publication and Amarenco is a printed
10 publication. The Patent Owner just lobs in some general complaints. But
11 they are not relying on the controlling case law. They're not using the right
12 Federal Circuit case law. The only thing that they really rely on is a non-
13 precedential Board opinion, Metasys, that's up on appeal to the Federal
14 Circuit. It's scheduled to be heard by the Federal Circuit on December 8th.

15 What we want to look at is the controlling law, both from the
16 Federal Circuit and this Board and the precedential opinion from this Board
17 on what's publicly accessible is the Hulu case. So with that, I'd like to turn
18 to the next part of my argument.

19 JUDGE GROSSMAN: Mr. Tucker, one question about Burnett.
20 The Burnett is a Daniel R. Burnett from San Francisco, who's also
21 -- somebody with that same name is named as an inventor in the '943 Patent.
22 Is there any evidentiary argument that those are the same people?

23 MR. TUCKER: I believe they're the same people. I'm not sure if
24 necessarily --

25 JUDGE GROSSMAN: The same person? There's a --

1 MR. TUCKER: The same person, yeah.

2 JUDGE GROSSMAN: Not sure if they were the same person.

3 MR. TUCKER: Yeah. I would submit, Your Honor, is -- I'll show
4 you on Slide 23, that doesn't really matter because you're going to see that in
5 this very convoluted family tree of all of EMK's patents. And this isn't even
6 all their patents, but these are the ones that are relevant here, that in the
7 center branch there is -- due to a lack of co-pendency, there is a broken chain
8 from the '493 -- excuse me, the '943 Patent all the way back to the '529
9 application. That's the middle chain.

10 And if I can just jump into it, the middle chain is clearly broken
11 and cannot be used to get a priority date earlier than the reference. I'm sorry,
12 I need to get the - what's the number of Burnett, please?

13 MR. DEIGHAN: Exhibit number 1006.

14 MR. TUCKER: So yeah. So the middle chain of Slide 23 cannot
15 be used to get a priority date to Burnett (1006). Because there's a break in
16 the chain between U.S. App. 12/508,529 and, ultimately, what becomes the
17 '943 Patent. And I don't think Petitioner -- or Patent Owner has even argued
18 that. What Patent Owner's arguing is that over on the left side, there is the
19 '936 application, which is, I believe, Exhibit 1044. And Patent Owner says
20 because the Exhibit 1044, the '936, and the '529 application were co-pending
21 that that gets them all the way back.

22 But there's a massive problem there, and that is, Your Honor, has
23 been set forth by a series of Federal Circuit cases going back a number of
24 years. You have to make a specific reference, and you have to give the
25 familial relationship in your patent filing that can either be in the

1 specification or in the ADS. But it has to be somewhere. And it has to be in
2 the patent at issue. So what that means is the -- somewhere in the '943, there
3 has to be a statement that the '936 relates back to the '529 in order to get the
4 priority date all the way back as Patent Owner would want. That statement
5 is missing. If we go to --

6 JUDGE FLAX: So to be clear, you're not saying that the '936
7 application is not related to the '529. You're saying that the disclosure on the
8 face of the patent and the disclosure at filing for Section 120 purposes was
9 deficient.

10 MR. TUCKER: Yes, Your Honor. If we go to -- we start with the
11 Droplets case, I think, in our briefing, and we say -- we cite the Federal
12 Circuit, that you have to identify the familial relationship, okay? And then if
13 you look at Medtronic Corevalve versus Edwards Life Sciences, which is
14 741 F.3d 1359, at 1366, the Federal Circuit is incredibly explicit there. And
15 it says the Patentee is the person best suited to understand the genealogy and
16 relationship of her application and has a requirement to disclose this
17 information. And that requirement presents no hardship for the Patentee.

18 The Federal Circuit goes on in that case to say, essentially, it's
19 unfair for the public to have to wade through these complicated family trees
20 when the Patent Owner has the information right there. Now, Encyclopedia
21 Britannica also is in the exact same vein. And then, as I was preparing for
22 this oral argument, I found two other cases: In re Eiler, U.S. Appellate;
23 Lexis, 23090 -- that's a Federal Circuit case. And then a case from Northern
24 District of California, where applying Droplets, both of those courts -- I'm
25 sorry, in the California cases, Lexis Media versus eBay, 772 F.Supp.3d

1 1042, both of those cases, applying Droplets and then also applying -- I
2 believe it's 37 C.F.R. 1.78(d), they say -- this is painfully clear -- you either
3 must in the body of the specification, make the statement linking the current
4 application with all the relationships of the later applications, or you have to
5 do it in the ADS.

6 So here, if we turn to Slide 25 -- and I didn't highlight all of it. But
7 in that right box, there's a recitation that U.S. Patent application serial
8 number 15/474,875, which is the ultimate priority date, is a continuation in
9 part of the '356. It says that - but it doesn't say that -- if we go back to Slide
10 23, what it doesn't say is that the '936 is related to the '529.

11 In the Droplets, Encyclopedia Britannica, Medtronic, and all their
12 progeny say that's the Patentee's job. This is not a hyper technical thing.
13 This is critical because it's the Patentee's job to tell the public what its date
14 is. You can't play games with this. You have to say what it is. And they
15 don't say it in the spec on Slide 25.

16 Then if we could go to Exhibit 1002, this is their ADS. And this is
17 -- can I get the page number from our -- this is Exhibit 1002, page 189. Is
18 that in our case file?

19 MR. DEIGHAN: 190.

20 MR. TUCKER: 190. Sorry, 190. In there, they say that the '936
21 is related to the '875. Can you get to where we're supposed to be
22 (INDISCERNIBLE)?

23 MR. DEIGHAN: Yes.

24 MR. TUCKER: Thanks. Okay. They say it's related to the '875,
25 but what they don't say is that it's related to the '529. And they have to do

1 that. That's a hard stop. You either have to do it in the specification, or you
2 have to do it here. They have two chances to do it, according to the Federal
3 Circuit, two chances to make the specific reference of a familial relationship,
4 and they miss both times. So because of that, they cannot use the -- can we
5 go back to Slide 23? They cannot use that left branch with the '936
6 application to get them to a priority date that would somehow eliminate
7 Burnett (1006) as prior art. It's fatal. And because of that --

8 JUDGE FLAX: Does Burnett have the same spec as the
9 challenged patent?

10 MR. TUCKER: Oh, boy.

11 JUDGE FLAX: I don't mean -- I mean, you don't have to certify
12 that it's identical. But is it basically the same?

13 MR. TUCKER: It's basically the same but you got CIPs in there
14 so that's why I want to be careful with what I say, Your Honor. But yeah,
15 it's -- I believe, on that one, it's just a straight continuation so it is the same
16 spec. And, you know, they didn't do it the right way. And you can't fix that
17 now, you know. You can't infer this. And that's what all those cases say.

18 So we submit Burnett is prior art. And because it's prior art, as
19 we've shown, there's no substantive challenge. It renders everything on all
20 claims unpatentable, in the '943.

21 JUDGE FLAX: Mr. Tucker, about -- it's not in your slides, but
22 about two screenshots ago you showed from Exhibit 1002 --

23 MR. TUCKER: Okay.

24 JUDGE FLAX: -- it was page 189 and 190.

25 MR. TUCKER: Yeah.

1 JUDGE FLAX: But we also were looking at page 191, which is
2 the actual application data sheet that was --

3 MR. TUCKER: This is the entirety; it goes on for pages.

4 JUDGE FLAX: Right. And that there is a reference. Looking at
5 the first page of it, Exhibit 1002, page 191, it does make reference about
6 halfway down to application number, the '936 application. But it's in the
7 context of claiming continuation based on the PCT that you have illustrated
8 in your family tree. And so it's not that they didn't reference the '936. I
9 think your argument is they didn't reference it in the context of going back to
10 the '875 or any of the patents that are in that middle branch.

11 MR. TUCKER: That's correct, Your Honor. And this even shows
12 they know how to do this the right way. I mean, they take it back to one part
13 of its -- one part, but they don't get it the other way. So the fact that the '936
14 might reference the '529 in the '936, that's irrelevant here. What matters is
15 the '943 specification or its ADS, and they don't do it there. We look at the
16 '943 as the controlling document in the '943 and its prosecution history.
17 They never tie the '936 back to the middle branch. So they can't do it now
18 because they can't tie it back to the middle branch. Burnett is prior art and
19 renders everything unpatentable. So that's -- if there's no further questions, I
20 think I'd just like to reserve the rest of my time.

21 JUDGE FLAX: Okay. Right. Well, you get an extra 40 seconds.

22 MR. TUCKER: Okay. Thank you.

23 JUDGE FLAX: All right. So since we're at a break, I'm going to
24 inform them that if their guests are still out there, they could walk in now,
25 unless you all object to that.

1 MR. DEIGHAN: You know, depending on who they are.

2 JUDGE FLAX: Well, let's find out. Oh, even better. All right.

3 We don't need to worry about them, so.

4 MR. TUCKER: What did he say?

5 JUDGE FLAX: That they were here for a different hearing.

6 MR. TUCKER: Oh, that makes sense.

7 JUDGE FLAX: Mr. Gerasimow, how many minutes, if any,

8 would you like to reserve for rebuttal time?

9 MR. DEIGHAN: I'm sorry.

10 JUDGE FLAX: Or do you just want to wing it?

11 MR. GERASIMOW: I'd like to wing it. I don't think I'm going to

12 take 45 minutes, Your Honor.

13 JUDGE FLAX: Okay.

14 MR. GERASIMOW: Oh, my, sorry.

15 JUDGE FLAX: Okay. Whenever you're ready. And we do have

16 your slides.

17 MR. GERASIMOW: Thank you, Your Honors. My name is

18 David Gerasimow. I'm with the law firm Gerasimow Law in Chicago,

19 Illinois, and I represent the Patent Owner, EMKinetics. I do appreciate that

20 you have my slides. I will be happy to go through them. But seeing as we

21 just got done with Patent Owner's presentation -- excuse me, Petitioner's

22 presentation, I was wondering first if there were any questions I could

23 address from the Board on any of the items that Mr. Tucker raised, before I

24 begin with my presentation.

25 JUDGE FLAX: Anything you disagree with?

1 MR. GERASIMOW: Yes, several things. I think -- I'll take them
2 in turn. There's the presentation -- excuse me, the public accessibility issue,
3 and then there's the priority issue. I'll note that their petition mentions an
4 enablement issue, but we didn't hear about it today. And I -- the institution
5 decision found that it was unlikely to succeed. And I understand that they're
6 not proceeding with it. But with respect to --

7 JUDGE FLAX: Mr. Gerasimow? Yeah. There are one or two
8 things that I'd like to clear up to see what you agree on and what you don't
9 -- so we don't have to focus on everything -- regarding the Patent Owner's
10 family tree diagram, is that an accurate representation of what you think the
11 priority chain is, is that the way it was presented at the patent office and the
12 prosecution history on the application data sheet and all that other stuff? Or
13 are there errors, or things that you dispute about that family tree diagram?

14 MR. GERASIMOW: I believe that what they showed was
15 accurate, but incomplete. And I have my own family tree. And if you have
16 my slide deck in front of you, I'm happy to point you to that family tree. It is
17 Slide 19. I'll bring it up on the screen as well.

18 JUDGE FLAX: So this is the same diagram that they provided.
19 And you've added some lines to it.

20 MR. GERASIMOW: Yes, sir. I've added one line. It's the blue
21 line --

22 JUDGE FLAX: Okay.

23 MR. GERASIMOW: -- labeled CIP and kind of the northwest of
24 the family tree.

25 JUDGE FLAX: Great. And I see that that blue line is connecting

1 the '936 application, as we're calling it for short, and saying that it was a CIP
2 of the '529 application, correct?

3 MR. GERASIMOW: Yes.

4 JUDGE FLAX: So even assuming that that is true, do you
5 disagree with their point that the patent on its face doesn't make that link,
6 and the filing papers with the challenged patent as filed don't make that link?

7 MR. GERASIMOW: I agree that both the specification and the
8 application data sheet do not explicitly make that one.

9 JUDGE FLAX: So, you know, I sympathize with your situation.
10 But how do you get around the Droplets case that says that the burden is on
11 the patent applicant -- the Patent Owner - to do it all right, to make sure it's
12 right in terms of identifying priority applications/patents and also identifying
13 their relationships.

14 MR. GERASIMOW: Sure. I respond to Droplets in two ways. I
15 think first, I don't know if it says -- Droplets says, you need to identify all
16 familial relationships. Certainly on the facts of Droplets, what you have
17 there is that the application to which priority was claimed was not mentioned
18 at all in either the specification or the ADS. That's a very different fact, of
19 course, than what we're seeing in this case. So I distinguish it easily --

20 JUDGE FLAX: I'll quote one thing from Droplets -- and this is in
21 Droplets page 1316. It says that the reference to the prior applications must
22 identify all of the prior applications and indicate the relationship --(i.e.,
23 continuation, divisional, or continuation in part) between each non-
24 provisional application in order to establish codependency throughout the
25 entire chain of prior applications. So are you saying that that is incorrect? It

1 doesn't have to establish it between each individual application/patent that's
2 in the chain?

3 MR. GERASIMOW: It is my contention that Section 120 of the
4 Patent Act does not require an identification of all familial relationships.
5 And I think that when I respond to Droplets, the source for the notion of
6 familial relationships is undeniable in the patent office regulations. 37
7 C.F.R. says you got to identify family relationships. Section 120 of the
8 Patent Act doesn't -- it says specific reference. And our argument is that the
9 statute is satisfied because there was specific reference to co-pending
10 applications.

11 With respect to the policy argument, there's another policy
12 argument made in Droplets, and it's that we shouldn't have challengers
13 having to fish around for what the priority date is. I would submit that on
14 this record, there was no fishing around. It was very clear that Patent Owner
15 claimed 2006 and that they knew what the claimed priority date was. What
16 Petitioner didn't want to do, because of the CIP history, was perform any
17 sort of written description, Section 112 analysis, that would challenge
18 priority or do anything like that. They just said, we'll attack the claim itself.

19 And as I'm trying to say, the Patent Act says specific reference.
20 And we submit that patent application numbers and filing dates are a
21 specific reference; and surely, within the policy of Droplets, put any patent
22 challenger on notice of what applications were relevant. I think the detail of
23 the tree that they're able to create shows that the ADS and the specification
24 in this case were certainly sufficient to put the public on notice of what my
25 client's claims were.

1 JUDGE FLAX: Okay. I understand your position.

2 MR. GERASIMOW: Okay. I'm happy also to address any
3 questions about publication, but maybe I'll --

4 JUDGE FLAX: Well, that's a good issue to get into. I mean,
5 you're not contending that the asserted prior art here -- or let's just call them
6 asserted references, for the sake of this argument -- Svihra, which is Exhibit
7 1004, and Amarenco, which is Exhibit 1005, you're not asserting that these
8 are somehow fabrications by Petitioner to make it appear as if they were
9 journal articles, when the reality is that they are not real journal articles.

10 MR. GERASIMOW: We accuse no forgery.

11 JUDGE FLAX: Okay. You're just asserting that they didn't go far
12 enough in identifying that they were publicly available, meaning some
13 firsthand knowledge by a witness or identification from a librarian that said
14 this journal is on the stacks. That's what you think is required?

15 MR. GERASIMOW: Yes. I think something more than the
16 document itself is required. And I don't think we have anything more than
17 that in this case, respectfully. I think we heard a lot about an attorney
18 declaration, an expert declaration, the Board's institution decision, but those
19 don't actually address the question of publication. The fact that an attorney
20 downloaded a document, you know, last year, that's just not probative of
21 whether or not it was available at the relevant time.

22 JUDGE FLAX: So is the Journal of Urology, is that an established
23 publisher?

24 MR. GERASIMOW: I can certainly say there's no record evidence
25 saying that it is.

1 JUDGE FLAX: Is there any level of a publisher that you would be
2 willing to accept would be established absent corroborating proof,
3 hypothetically speaking?

4 MR. GERASIMOW: The United States Government.

5 JUDGE FLAX: Like the Webster's Dictionary, is that an
6 established publisher?

7 MR. GERASIMOW: I think so, yes.

8 JUDGE FLAX: And so I presume that your answer would be the
9 same for the Bratisl Lek Listy journal -- that is not established as a
10 established publisher here?

11 MR. GERASIMOW: I can certainly say I've never heard of it
12 before these proceedings, and there's no record evidence saying that it is a
13 well-established journal. We certainly heard Counsel say that and tell us
14 about that journal during his oral argument. But that wasn't in the record,
15 and certainly not in the petition.

16 JUDGE FLAX: It does appear that the corroborating evidence
17 filed with the Petitioner's reply supports that people could find these two
18 articles, Svihra and Amarenco, later on, when they wanted to, including the
19 Patent Owner.

20 MR. GERASIMOW: Mm-hm. I'll address the Patent Owner point
21 first. That's a very unfortunate argument. I think that a Patent Owner has a
22 ex parte duty of candor to the patent office. And that if folks identify
23 alleged prior art to them, the decision for the Patent Owner should not be
24 -- if I tell the patent office about this, I'm going to be accused of having
25 admitted it was prior art. There is no admission of --

1 JUDGE FLAX: Well, not prior art per se, because filing an IDS
2 does not admit that anything is prior art. But it does support that the
3 references cited were available publicly. Are you contesting that fact?

4 MR. GERASIMOW: I am, that it's contesting that was publicly
5 available at the relevant time. The fact that it was cited many years later
6 doesn't actually get to that. To the point that was found, I actually have no
7 idea how that showed up on the face of the patent, I didn't prosecute, was not
8 involved with that.

9 But again, it's easy to explain that if it's to put it on IDS is not an
10 admission, that it's prior art, then it was on there because someone had
11 identified it as relevant; and it went in, in the interest of full disclosure, to
12 hold that against the Patent Owner. Now, I think it would cause Patent
13 Owners a lot of concern about what should we submit, do we have to do a
14 prior art analysis on everything before we even submit it on an IDS? I
15 submit no. And I worry that there -- that a ruling to the contrary would
16 dissuade Patent Owners from disclosing things that had been identified to
17 them at prior art, even if they disagreed.

18 JUDGE FLAX: So your opposing counsel mentioned at the very
19 beginning of their argument that you have not challenged the merits of the
20 patentability arguments being made in the petition; is that accurate?

21 MR. GERASIMOW: It's accurate for this proceeding. I think
22 we've alluded that there's two other patents, two other IPRs we do challenge.

23 JUDGE FLAX: Okay.

24 MR. GERASIMOW: And this is one of those other.

25 JUDGE FLAX: So taking that to be so, if we find that the Svihra

1 reference and the Amarenco reference do indeed appear to be published in
2 established publishers and that they do bear the hallmarks of being publicly
3 available prior art references, what does that do to your overall case?

4 MR. GERASIMOW: I certainly think that if Your Honor
5 concludes that they're prior art, Svihra and Amarenco, then I agree Petitioner
6 will win on, I believe, most grounds, if not all. We do dispute, though, that
7 they have carried that burden. And I think there's a lot of questions of what
8 do we dispute -- what we, as Patent Owner, dispute? What are we
9 challenging? We don't bear the burden on anything. I'm very clear that our
10 response was that this petition is deficient, that 30 xeroxes of alleged prior
11 art obtained last year just doesn't cut it.

12 With respect to the institution decision, the Board there noted, after
13 conducting its own research, some things that it believed to be true about
14 this Bratislavan journal. In my view, that institution decision gave Petitioner
15 a roadmap of how to supplement their petition with the information that
16 would actually show prior art. And they didn't do that. They didn't do that.

17 And now, we're here in a rather unusual procedural posture. And
18 they claim it's because, say, maybe Petitioner -- excuse me, Patent Owner,
19 didn't object. The failure to object doesn't change the burden of proof. And
20 even if evidence is admissible, it doesn't mean the Board has to afford it any
21 weight. Suppose hearsay were to come in, because there was no objection,
22 the Board doesn't have to automatically say, I agree, I believe hearsay.

23 In fact, because the Board being judges and educated, it doesn't
24 matter as much, because you all are capable of evaluating that evidence in a
25 way that a jury -- a lay jury, might not be. So whether it comes in and it's

1 admitted or the evidence is excluded, it has no probative value, even if it
2 comes in, because it's hearsay or because it is just a document hanging out
3 on its own. We certainly dispute that Petitioner included enough in the
4 petition to establish the public accessibility of the prior references. And
5 that's why we're responding on those grounds.

6 JUDGE GROSSMAN: Mr. Gerasimow, one question about
7 Amarenco -- and you acknowledge that you weren't involved in the
8 prosecution. But the Petitioner points out that it's cited on the face of the
9 patent, the '943 Patent. It's actually in an information disclosure statement
10 that was submitted by the applicant. It's Exhibit 1002, and it's on page 95 of
11 Exhibit 1002.

12 Why isn't that an admission by the applicant that Amarenco is a
13 publication, as based on the information that the applicant provided to the
14 Patent Office? This wasn't the examiner finding it to cite it. This was the
15 applicant listing several references. It was a long list of references, but
16 Amarenco was one of them that the applicant discovered and thought it was
17 important enough to submit to the Patent Office.

18 MR. GERASIMOW: Sure. I disagree. I don't think there's any
19 reference that applicant found it. I think as Counsel pointed out, we've seen
20 a large family tree, where things were cited and then cited elsewhere is not
21 clear from the record. So I don't know if Patent Owner found it and sent it to
22 the patent office.

23 JUDGE GROSSMAN: It's on a form that's labeled information
24 disclosure statement by applicant.

25 MR. GERASIMOW: Sure.

1 JUDGE GROSSMAN: So it wasn't found by the examiner. This
2 was submitted to the patent office. And the examiner, as they often do, will
3 go through that list of information and -- of information disclosure
4 statement, initial that they considered everything. And then that gets
5 included on the printed face of the patent, which is what happened here. So
6 that's what -- that's how it got there.

7 MR. GERASIMOW: Couldn't have an examiner, in a different
8 proceeding, identified it to the applicant and that's how it was found?

9 JUDGE GROSSMAN: Well, it was submitted in the application
10 that ended up maturing into the '943 Patent and --

11 MR. GERASIMOW: Yes. But that doesn't answer how it was
12 identified to Patent Owner.

13 JUDGE GROSSMAN: It was just included on the standard list,
14 and it was identified by exactly what you see on the printed face of the
15 patent.

16 MR. GERASIMOW: Sure.

17 JUDGE GROSSMAN: So they just -- the printer just takes what
18 was submitted and reprints it.

19 MR. GERASIMOW: Right. And that's -- it's -- I think that's part
20 of why it isn't a presumption that something identified on an IDS is prior art.

21 JUDGE GROSSMAN: And you're right. It's not an admission
22 that it's prior art, but it certainly suggests that the applicant identified it
23 correctly with a June 2003 date. That's what the applicant thought the date
24 was.

25 MR. GERASIMOW: I'm not sure I would go so far as to say that's

1 what the applicant thought the date was. I'd agree that's what was
2 reproduced. And I thought --

3 JUDGE GROSSMAN: Right. That was the information that the
4 applicant provided to the patent office under their duty of disclosure to
5 submit accurate information. So we assume that the applicant -- everything
6 on that list of -- it looks like a couple of 100 references was identified by the
7 applicant and presumed to be correct. But I think you've answered my -- the
8 question. Thank you.

9 MR. GERASIMOW: Sure. I think with -- I do want to continue
10 on the topic of that publication. Because I do think with respect to
11 hallmarks, the case law is that you need an established publisher in order to
12 start considering hallmarks of publication. And I think that Petitioner and its
13 challenge in its most recent articulation skips that step. They say it's an
14 established journal. They say it's well known. And then say, oh, we can
15 consider hallmarks. And I would submit, under the controlling law, it's not
16 appropriate to do that, that we would need some sort of record evidence of
17 established publisher before we could do that.

18 I think there was a suggestion in there -- in the presentation by
19 Petitioner as well -- that many of these references are just background
20 references that they're not used to supply missing claim elements. I
21 disagree. And I point out, in particular, Exhibit 1030. That's the Hasan
22 reference that was referenced during that original petition. If you look at the
23 Hasan reference, it's a website printout from 2023. It's relied on in the
24 petition to supply claim elements.

25 And as mentioned, it's a website printout. It's not even -- bears the

1 hallmarks, so to speak. So I disagree with the notion that even if there had
2 been a showing of well-established publication, that there were -- even that
3 there were hallmarks, because we see documents in the public -- in the
4 record that don't even bear those hallmarks, Exhibit 1030 is one of them.

5 JUDGE FLAX: What do you want to classify as the hallmarks we
6 should be looking for?

7 MR. GERASIMOW: Well, I think that's on Petitioner to do.

8 JUDGE FLAX: When you said they're not there, what's missing
9 from the Hasan reference, Exhibit 1030?

10 MR. GERASIMOW: It doesn't even look like a publication. It's a
11 website printout. I think that's what's missing on Hasan. And with respect
12 to Exhibit 1015, which is referenced in Patent Owner's demonstratives, what
13 is it missing? It appears to be a single page that was xeroxed out of a binder.
14 And that is insufficient hallmarks. I guess we would have publications --

15 JUDGE FLAX: For Stoller, you're saying, it looks like it.

16 MR. GERASIMOW: Yeah, for exhibit 1015? Yes, sir.

17 JUDGE FLAX: Right.

18 MR. GERASIMOW: Right. And 1030 are other examples. And I
19 began the conversation with that in their presence here --

20 JUDGE FLAX: If we agree with you that Stoller -- I mean, I don't
21 know that you've -- did you make this argument about Stoller in any briefing
22 before?

23 MR. GERASIMOW: 1015?

24 JUDGE FLAX: Yes.

25 MR. GERASIMOW: I believe so. I believe that Paper 15 at 5 to

1 6.

2 JUDGE FLAX: Okay. So I agree that looking at that Stoller
3 reference, it has less than all the other ones, you know. I don't see any
4 copyright date or identification of what this came from exactly, unless that
5 crest up in the corner of it means something.

6 MR. GERASIMOW: Your Honor is welcome to zoom in when he
7 gets back to his computer, but I was never able to discern it myself.

8 JUDGE FLAX: It says something about Denver. So maybe this
9 was something that was provided to some conference or something. But the
10 other reference that you were just referring to --

11 MR. GERASIMOW: 1030?

12 JUDGE FLAX: -- the Hasan reference, I mean, you're right, it's
13 not -- it doesn't look like a journal. But it does have a title, The Journal of
14 Urology, which other references here are purported to be published in. It has
15 an issue number and a volume number and a copyright date. So are those
16 things not hallmarks of publication?

17 MR. GERASIMOW: I think they're hallmarks. I don't think we
18 see you have to have X number of hallmarks. I don't know, I don't think the
19 law is that clear that we get beyond --

20 JUDGE FLAX: There's some sort of spectrum of hallmarks that
21 we could look to, to say, well, that -- this is enough and this is not enough.

22 MR. GERASIMOW: Once we're in hallmark land, I suppose, yes.

23 JUDGE FLAX: Okay. Counsel, one thing I noted from your
24 response brief, you had mentioned that Patent Owner may file an application
25 to reissue in an effort to deal with your priority claims. That hasn't

1 happened, has it?

2 MR. GERASIMOW: No.

3 JUDGE FLAX: Nothing else, no other similar things, no
4 certificate of correction or anything like that has been filed?

5 MR. GERASIMOW: No.

6 JUDGE FLAX: Okay. Thank you.

7 MR. GERASIMOW: I suppose Petitioner did mention the expert
8 declaration that somehow the expert suggests these documents were
9 published.

10 JUDGE FLAX: I did note that there was one sentence that said
11 they were publications.

12 MR. GERASIMOW: Yes. And I --

13 JUDGE FLAX: It's not exactly what you're looking for, I
14 understand.

15 MR. GERASIMOW: Okay. Thank you. That's a point I wanted
16 to make. And other than that, the expert offers no evidence that he's an
17 expert in publication. Another issue for printed publications is that we don't
18 have -- with respect to these documents that are said to be from 2006,
19 assuming the priority claim is credited under Section 120, then we'd have a
20 2006 priority date. But without further information, we don't have evidence
21 from Patent Owner on specific dates that would suggest that they are or are
22 not before that 2006 priority date claimed by the Patent Owner.

23 I think that's another complication that comes when we get 30
24 documents, we don't get specific priority -- sorry, priority dates alleged for
25 them and information supporting publication. And so it isn't just, you know,

1 Exhibit 1015 or Exhibit 1030. It's really the 30 or 20 or so that -- of printed
2 publications alleged that are submitted here that are problematic. They all
3 suffer from the same thing. And it's -- they are xeroxed sitting alone by
4 themselves.

5 JUDGE FLAX: If we were to agree with you that that Stoller
6 reference, Exhibit 1015 had insufficient hallmarks of publication, what
7 grounds does that affect?

8 MR. GERASIMOW: I think that's actually a question for
9 Petitioner because I don't think they clarify what necessarily -- how all these
10 references get used. If you look at Exhibit 1015, it's cited in the background
11 section of the petition, if you will, preceding the claim by claim element by
12 element analysis. So I think what that means is that it's said to inform the
13 state of the art at the time of the invention. And so I think where you have
14 obviousness grounds and that one's incorporated, that's an issue.

15 I'd also point to Exhibit 1030 as a very specific example, with
16 respect to Claim 6, as said to supply missing claim material not provided by
17 Svihra or Amarenco. And I think Exhibit 1030 suffers from the same
18 problems of 1015. And I think the consequence there is that if 1030 is
19 insufficient, then Claim 6 survives. A set of sides say the Burnett claim
20 grounds that are separate.

21 JUDGE FLAX: So Claim 6 relates to detecting a lack of electrical
22 conduction at a second portion of a patient's body, distant from the ankle,
23 let's say?

24 MR. GERASIMOW: Mm-hm.

25 JUDGE FLAX: And they were saying, they -- the Petitioner was

1 saying that, for example, the Amarenco reference, where it includes Figures
2 3 and Figures 4 and shows a graphing of EMG measurements was -- made
3 that obvious that those of skill in the art would see that and understand that
4 that's the measurement that was being made. Is that what you're referring
5 to?

6 MR. GERASIMOW: I don't believe so. I believe that Exhibit
7 1030 is cited at Paper 2 of the petition at pages 29 and 49, supply claim
8 elements missing from Claim 6.

9 JUDGE FLAX: Pages 29, okay. EMG, this is discussed in the
10 person of ordinary skill in the art's understanding of what EMG is and how
11 it's performed and what it measures, right?

12 MR. GERASIMOW: Mm-hm. Yes, sir. And I think that the
13 expert's testimony is just based on the Exhibit 1030. And that when that
14 fails, there's no personal knowledge left by the expert to say that this was
15 actually known at that relevant time. And so it's an example, I believe,
16 where this issue really does impact. I think it affects all the documents
17 submitted as being referenced, but I think those two are very clear.

18 I did want to touch the issue of the alleged corroboration submitted
19 in reply. Patent Owner's clear position should have been submitted with the
20 petition. There's talk that Patent Owner didn't do enough in the preliminary
21 response to put Petitioner on notice of what they needed to do to fix their
22 petition. My response is that can't be the case because a preliminary
23 response is optional and it can't -- there should -- there's no requirement for a
24 challenge in the preliminary response for the Board to say this is insufficient
25 as a petition.

1 And so I respond in that way on that issue and continue to focus on
2 -- this is always and always will be Petitioner's burden to establish this and
3 give the Board the evidence that it needs to proceed. And I think that we see
4 a petition that's pretty thin, and we pointed that out. And what they did in
5 reply was purported to provide more evidence. And we disagree that there's
6 this notion of just standard reply evidence that you submit to bolster your
7 case in chief, when the response is your petition is insufficient on its face,
8 you don't come back with more reply.

9 The way I think about proper reply of evidence is, suppose you
10 have a case in chief. Let's suppose it's a murder case. The case in chief is,
11 you know, the defendant was at the crime scene. The defendant opposes;
12 and he says, I wasn't at the crime scene. I was at the bar. I have an alibi.
13 The proper reply would allow reply evidence to challenge the defendant's
14 notion and his alibi that he was at the bar. Suppose, by contrast -- and that
15 would be proper reply evidence in my understanding of what reply would
16 be.

17 What we have here is different. My client did not respond with, I
18 have an alibi for Petitioner to attack. It was, sorry, your case in chief is
19 insufficient. And they say, no, it wasn't. Here's a bunch of more evidence.
20 So that's the way it came up on reply. And we submit that it should have
21 been much earlier than when we saw it in reply. And that it should be
22 excluded. And then with the corroboration, we don't really think it matters,
23 right, because not evidence of established publishers. So it doesn't matter on
24 the hallmarks. But even if that's where we get, then those hallmarks are
25 supplied by those alleged corroborating references.

1 And so the Board, like I had said at the outset and the institution, I
2 thought they have a good roadmap, saying these are the things you could put
3 in Petitioner to help us organize these proceedings and show this prior art
4 and move on to the merits. And they didn't do that. And that's where we're
5 at. There would have been very ample opportunity under the rules to do
6 that. And I think, like I said, the Board's decision said, hey, you know, we
7 think there's enough to get started, but this is the other things we needed to
8 do to show that this was publication, potentially.

9 And I don't know why Petitioner didn't follow up and undertake
10 those steps, why we didn't get a declaration saying, hey, of course, this DOI
11 number that I don't think was mentioned in the petition -- I'll be honest, I
12 don't think was mentioned in their replies; first time I've heard of it. But
13 suppose it's not, why don't we have a librarian telling us that instead of
14 Counsel, an expert telling us that instead of Counsel? We don't. And I
15 submit that the petition, as filed, was insufficient to show printed publication
16 of any of the documents, Svihra, Amarenco, 1015, 1030, many others. But
17 that is most definitely our position.

18 I don't believe I have any more to say on printed publication. I'm
19 happy to return to Section 120 or answer any questions that the Board may
20 have if we have some time.

21 JUDGE FLAX: I don't think -- I have no further questions. Do
22 you have any questions?

23 JUDGE GROSSMAN: No. No questions from me.

24 JUDGE FLAX: All right. So we'll save 13 minutes.

25 MR. GERASIMOW: Okay. Thank you.

1 JUDGE FLAX: Okay.

2 MR. TUCKER: Just a couple of things, Your Honors. A lot of
3 complaints, no answers. So let me give you some answers instead of just
4 lobbing out excuses. I want to start with just very quickly on Hasan, it looks
5 like we can brush that aside. That's not being -- we're not combining Hasan
6 to create a grounds. What we're saying is in our petition, which is document
7 2, page 29, we cite a number of references and say EMG was a conventional
8 technique. This is at the top 29, I mean, for Hasan.

9 EMG electrodes were typically placed at a second portion of a
10 patient's body away from the stimulation site. That's just providing some
11 background art. So that's it. So I think a lot of these complaints on Hasan
12 and Stoller --

13 JUDGE FLAX: I notice --you're looking hard at that screen as if
14 something's not showing up.

15 MR. TUCKER: Nope. I'm only going to use one slide unless you
16 have a question.

17 JUDGE FLAX: Okay. Yeah. We have everything here, so if need
18 to you could just tell us what to look at.

19 MR. TUCKER: Yup.

20 JUDGE FLAX: The fact that it's not there is not a big deal.

21 MR. TUCKER: So I think you kind of brushed that aside. I think
22 there's this constant complaint about corroborating evidence coming in on
23 reply. You can read our papers on the motion to exclude. You can read the
24 Hulu case. That's exactly the appropriate time, you know. We did
25 everything right. In contrast, virtually every complaint I heard about

1 -- Hasan, Stoller, Amarenco, and Svihra -- actually go to a lot of authenticity
2 and hearsay complaints.

3 I think my opponent was actually inviting the Board to find
4 hearsay on some of these. You have to make those objections within 10
5 business days of the institution. They didn't make them. So those are
6 waived.

7 JUDGE FLAX: On that Stoller reference, what are the hallmarks
8 of publication there?

9 MR. TUCKER: That's 1015, correct?

10 JUDGE FLAX: That is 1015.

11 MR. TUCKER: Your Honor, I need to look at that one.

12 JUDGE FLAX: And what is the real significance of Stoller? I
13 know it's supposedly, you know, much prior to the art that you're asserting,
14 sort of the prior state of the art before surface electrodes were being used.
15 So why do we care about this reference?

16 MR. TUCKER: It's just to give background and context. It really
17 -- to me, that's a complete red herring. To me, that's we have nothing else to
18 argue, so let's just pound the table about Stoller.

19 JUDGE FLAX: So if we don't consider Stoller for anything, is that
20 okay with you?

21 MR. TUCKER: I don't think it has any effect, Your Honor.

22 JUDGE FLAX: Okay.

23 MR. TUCKER: Now, the -- let me get to when we're talking -- I
24 want to just kind of level set things. And the Hulu case, again, it's -- you're
25 not -- literally, you do not hold that any particular indicia per se is sufficient.

1 Rather, the indicia on the face of the reference, such as printed dates and
2 stamps, are considered part of the totality, so --

3 JUDGE FLAX: What page are we talking about?

4 MR. TUCKER: I'm sorry, that is on pages 17 through 18. And
5 that is -- you know what? And there's two Hulus. That's the precedential
6 opinion, which is Paper 29, I'm looking at that. And we're not hearing any
7 evidence that Svihra -- Patent Owners, they didn't put on anything, but this is
8 not publicly available. They're just positing a bunch of questions versus
9 what we have on the record. We have all these hallmarks. We have the
10 journal name. We have that it's established. We have all these things. We
11 have other journal articles citing them. Other people were able to find these
12 articles and cite them with the exact same cites that are on the face of what
13 we submitted.

14 And then we interestingly have the Amarenco. Patent Owner
15 found Amarenco, somehow. Now, they're trying to walk away from that
16 now. It's like, poof, all of a sudden we have Amarenco, and we submit it.
17 And right, an IDS is not an admission of prior art. That's not the question
18 here. The question here is, can people find the article? And that IDS shows
19 yes, a very critical person to this proceeding was able to find it, the Patent
20 Owner. So I think it's really hard to walk away from that. And then -- Slide
21 23, this is a fascinating statement.

22 JUDGE FLAX: Is it your Slide 23?

23 MR. TUCKER: My Slide 23, Petitioner Slide 23, where my
24 opponent said, we want to avoid fishing around. Literally, that's what he
25 said. That's exactly what happened here. Patent Owner didn't bring up the

1 '936 application when it responded to the petition. Patent Owner itself had
2 to dig deep into this convoluted chain and fish around and find a co-
3 pendency to hopefully avoid Burnett. That's exactly what the Droplets
4 Court, the Medtronic Court, the Encyclopedia Britannica Court, in re Eiler,
5 the Lexos Court, that's exactly what we want to avoid.

6 Patent Owner themselves had to fish around. That's why -- and
7 this is from Droplets 1316. It says, "Although Section 120 might appear to
8 be a technical provision, courts have long recognized that it embodies
9 important public policy and thus have required strict adherence." Now, on
10 page 13 of Patent Owner's response, they admit there was not strict
11 adherence. They admit on page 13 that there's no statement tying the '936 to
12 the '875. And that seals the deal on that reference or on that priority date.
13 They're not entitled to the earlier date. Burnett is prior art and invalidates all
14 claims. Thank you, Your Honors.

15 MR. GERASIMOW: Your Honor, I'll be brief. Section 120 says
16 specific reference. It doesn't say familial references. Droplets, the case
17 there, the facts, the parent to which priority was claimed, not referenced by
18 number or anything else, not mentioned. That's different. So that's how I
19 respond on Section 120 issues.

20 And with respect to print publications and, again, alleged -- I don't
21 -- there isn't sufficient evidence of publication again on Amarengo. Nobody
22 knows how that was found. We don't have record evidence of that. I
23 certainly agree it was identified with the patent office by applicant. And I
24 would submit that to require -- to say that it must be prior art because Patent
25 Owner identified it on an IDS will have a chilling effect on disclosure on

1 prior art itself --

2 JUDGE FLAX: Counsel, I don't think that's what their argument
3 is, to be fair.

4 MR. GERASIMOW: Sure.

5 JUDGE FLAX: I think they are arguing it's prior art. But I don't
6 think they're saying that because it's on an IDS, that proves it is prior art. I
7 think what they're saying is that because it's on an IDS, it proves it was
8 publicly accessible, findable, by people that were interested in it --

9 MR. GERASIMOW: Sure.

10 JUDGE FLAX: -- which supports their case that it is prior art.

11 MR. GERASIMOW: It shows -- in that theory, wouldn't it show
12 only that it was accessible at the time that it was found and not irrelevant on
13 it?

14 JUDGE FLAX: Yes. I think that's right. I think you're right.

15 MR. GERASIMOW: Then --

16 JUDGE FLAX: But it is some support that it was findable at some
17 point.

18 MR. GERASIMOW: Sure.

19 JUDGE FLAX: Maybe not necessarily in 2003, but that it did
20 exist in the world. And it wasn't some sort of -- as you called it before, a
21 counterfeit document, which was the word I was trying to remember when I
22 was asking the question. So is it -- does that matter, the fact that it is
23 something that is publicly available now or when it was filed with an IDS or
24 when it was cited by the corroborating references that were filed with the
25 reply? Can't any of that really be considered as -- maybe not conclusive

1 evidence that it was publicly available in 2003, but as supporting evidence
2 that it is publicly available?

3 MR. GERASIMOW: I think the only relevant question is whether
4 the references were publicly available for the priority date. Can it be used to
5 show that with the things later? I believe that they can be. But with respect
6 to, for instance, the corroborating documents that are submitted here, they
7 have the exact same problems as the ones that were submitted. It's just more
8 xeroxes and more xeroxes. There's no evidence of the publication of those
9 either. And I get back to why didn't we do that? Why didn't Petitioner do
10 that with the petition? And that would have made that a lot more
11 straightforward.

12 JUDGE FLAX: Does the fact that we don't have the best evidence
13 of public accessibility available to us mean that the evidence that we do have
14 is insufficient? We don't have someone from the year 2003 saying, yes, I
15 subscribe to this journal, and I got it when they delivered it to me in my
16 normal course of receiving the journal, right? That would be the best, we
17 don't have that. So what about all this other stuff, you know, looked at as a
18 whole as Hulu says we should do?

19 MR. GERASIMOW: I actually don't think it's that much left, Your
20 Honor. It's the attorney declaration and the expert declaration. The attorney
21 declaration, I got this off the internet last year and the expert declaration that
22 it was published. And he only looks at the document, just as you are all
23 asked to look. There's no evidence.

24 I don't understand the notion of -- that there's this evidence of
25 public accessibility. It's our position that there is none. We have the

1 documents themselves, and that is it. And we submit that's insufficient.

2 And I don't have anything else, unless Your Honors have more questions.

3 JUDGE GROSSMAN: Does all that prior art analysis of what's
4 prior art depend on you getting the earlier filing date that you're arguing for,
5 the 2013 filing date?

6 MR. GERASIMOW: I don't believe so. I think if Your Honor is
7 saying -- I think if the Board finds that Svihra and Amarenco are prior art,
8 they're prior art to 2006. And so the priority date isn't going to matter as I
9 understand it. Did that answer Your Honor's question?

10 JUDGE GROSSMAN: Yes. Thank you.

11 MR. GERASIMOW: Thank you. Are there any further questions?

12 JUDGE FLAX: One other thing that -- I don't know if there's any
13 evidences of the references that are being asserted, being dialogs with an
14 intended audience. I know that's part of the Hulu case and part of Valve, the
15 Valve case, in addition to talking about the idea that if you have an
16 established publisher from VidStream, that's one thing. But if a publication
17 was published for the purpose of a dialog with an intended audience, has that
18 been brought up at all? Because the law says that if that's the case, then you
19 presume publication.

20 MR. GERASIMOW: To my knowledge, that hasn't been brought
21 up.

22 JUDGE FLAX: Okay.

23 MR. GERASIMOW: Thank you.

24 JUDGE FLAX: Okay. Well, thank you all. We appreciate your
25 arguments today. We'll take them into consideration with the record as a

- 1 whole. And the record is now closed.
- 2 (Whereupon, the above-entitled matter went off the record at 1:22
- 3 p.m.)

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