UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,

PETITIONER

vs.

PROMPTU SYSTEMS CORPORATION,

PATENT OWNER.

Case IPR2018-00344

Patent 7,047,196

Wednesday, March 24, 2021

CONFERENCE CALL

BEFORE ADMINISTRATIVE PATENT JUDGES

JULIET MITCHELL DIRBA

JAMESON LEE

ROBERT L. KINDER

Reported By:

KATHLEEN WILKINS, STENOGRAPHIC REPORTER, CSR 10068

RPR-RMR-CRR-CCRR-CLR-CRC

Conference call before Administrative Patent Judges Juliet Mitchell Dirba, Jameson Lee, Robert L. Kinder, on Wednesday, March 24, 2021, commencing at the hour of 2:01 p.m. Eastern time thereof, telephonically, before me, Kathleen A. Wilkins, RPR-RMR-CRR-CCRR-CLR-CRC, a Certified Stenographic Shorthand Reporter, in and for the State of California.

APPEARANCES OF COUNSEL

FOR THE PETITIONER:

FARELLA, BRAUN & MARTEL, LLP
235 Montgomery Street, 17th Floor
San Francisco, California 94104
BY: JAMES L. DAY, ESQ.
Telephone: (415) 954-4414
Email: Jday@fbm.com

- and -

KEKER, VAN NEST & PETERS
633 Battery Street
San Francisco, California 94111
BY: LEO L. LAM, ESQ.
Telephone: (415) 676-2246
Email: Llam@keker.com

FOR THE PATENT OWNER:

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
901 New York Avenue, NW
Washington, DC 20001-4413
BY: JOSHUA L. GOLDBERG, ESQ.
Telephone: (202) 408 6092
Email: Joshua.goldberg@finnegan.com

- and -

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
Stanford Research Park
3300 Hillview Avenue, 2nd Floor
Palo Alto, California 94304-1203
BY: JACOB A. SCHROEDER, ESQ.
Telephone: (650) 849 6765
Email: Jacob.schroeder@finnegan.com

MARCH 24, 2021 2:01 P.M. EASTERN TIME.

P R O C E E D I N G S

AFTERNOON SESSION

JUDGE DIRBA: Good afternoon. This is Judge Dirba. This is a conference call in case IPR2018-00344 relating to U.S. Patent Number 7,047,196. I am joined today by my colleagues, Judges Lee and Kinder. The purpose of the call today is to discuss our remand procedure for this case.

Do we have someone on the line for petitioner?

MR. DAY: Yes, your Honor. This is James Day on behalf of petitioner.

JUDGE DIRBA: Mr. Day, is there anyone else on the line for petitioner?

MR. LAM: Yes, your Honor. Leo Lam on behalf of petitioner as well. Good afternoon or good morning, depending upon where you are.

JUDGE DIRBA: Good afternoon, I think. Yes.

And then do we have counsel for patent owner on the call?

MR. GOLDBERG: Yes, your Honor. Good

afternoon. This is Josua Goldberg for patent owner. I also have my cocounsel, Jacob Schroeder, on the line, and we also arranged for a court reporter that's also on the line.

JUDGE DIRBA: Thank you. You answered my next question.

Is there anyone else on the call?

Very good. So as I mentioned, the purpose of the call today is to discuss the remand procedure for this IPR.

Did the parties have a meet and confer in advance of this conference call today?

MR. GOLDBERG: Yes, your Honor.

JUDGE DIRBA: And did the parties reach agreement?

MR. SCHROEDER: Your Honor, this is James Day. I believe the parties are in agreement that further briefing would be useful. The two areas that we've discussed and I believe we've agreed on are, one, discussing how the construction of the term "received back channel" that the federal circuit confirmed or adopted applies to the arguments that the parties made and how that applies to the final written decision that was issued. And then the second area would be to, essentially, point out subsequent federal circuit or PTAB decisions that might have some bearing on either the final written decision or the arguments that the parties made that weren't addressed to the final written decision.

JUDGE DIRBA: And I have a few questions about the second point you raised, Mr. Day. The cases that you'd like to point out about substantive issues, are those cases that were decided after the parties briefing? Is that why you're proposing to discuss them now, or has something changed in this proceeding? Or could you give me more background on that additional information?

MR. DAY: Yes. So what I'm suggesting and what I think we've agreed is it would be cases that that postdate the final written decision, though it would be -- I can give an example. There was a parallel IPR that the final written decision issued several months later than this one that we think impacts the analysis in this IPR. I know that patent owner has some arguments based on later -- or, in fact, the same federal circuit decision that remanded this case. So it's information the board would not have had when it issued the written final decision but we think is now relevant.

JUDGE DIRBA: Okay. Before I ask additional questions about that, Mr. Goldberg, do you agree with Mr. Day's summary?

MR. GOLDBERG: I think generally, yes, your Honor. Our overall view is that we think, as Mr. Day was mentioning, that there are some issues in the federal circuit decision that issued in this case and the related 345 case that are relevant and would be worthwhile to raise to your Honors in some additional briefing. And beyond that, we don't have strong feelings on additional briefing, but we are okay with the additional briefing that petitioners have proposed.

I think that the one other part of our agreement that we had reached among the parties is that there would not be any additional briefing on whether or not the Murdock reference qualifies as prior art.

JUDGE DIRBA: And, Mr. Day, do you agree with that?

MR. DAY: I do agree with that, your Honor. The only caveat is I guess we would reserve the right to respond if there was any sort of an argument on that, but I don't expect that. And I do think the parties agree that we would set that aside.

JUDGE DIRBA: Okay. So if I'm understanding correctly, Mr. Day, it's petitioner, primarily, who seeks this additional briefing, and if I understand Mr. Goldberg, patent owner is amenable to, won't object to the additional briefing but wouldn't independently request it. Is that correct, Mr. Day?

And then I'll ask you, Mr. Goldberg.

MR. DAY: It's correct that I think we want additional briefing. I suspect the patent owner also wants additional briefing.

JUDGE DIRBA: Mr. Goldberg, do you also want additional briefing? I understood your comments to indicate that you were amenable to it, that you wouldn't object to additional briefing, but you also had no objection to not having any additional briefing.

MR. GOLDBERG: Yes, that's correct, your Honor. I think that the only issue that we wanted to make you aware of at all is that other decision in the 345 is out there, but we don't need additional briefing on it and would be okay if there was not any additional briefing. But you'll -- your Honors can see for themselves that in the briefing at the federal circuit, there was the decision that issued and a request for rehearing on it. And we don't need to get into the details here unless you'd like to hear. But our view would be that that decision is something that matters.

JUDGE DIRBA: And to make sure I understand your position, Mr. Goldberg, you believe that that decision matters because of -- because of what it says and how it relates to the issues here? In other words, if I'm understanding you correctly, it is clear the ways in which it matters in this proceeding?

MR. GOLDBERG: Yes, your Honor. We had sought rehearing on the decision and articulated the reasons. To just make it very simple for you now, our basic position is that there's going to be issue preclusion created by what happened in the 345 case that's going to be relevant to the 344 case. And that is something that merely us telling you that that exists as far as we're concerned would be sufficient and we don't need briefing on it, but it is something that we would brief if we were -- if you were going to give briefing in this case in general.

JUDGE DIRBA: And petitioner, Mr. Day, you mentioned in your discussion -- I'd like to drill in a little bit and understand better what topics you would like to address in this additional briefing. It does sound -- or it's my understanding you agree that the briefing would be limited to only certain issues. And I'd like to better understand which issues you believe require or need additional briefing.

MR. DAY: Sure, your Honor. One, if patent owner is going to make an issue preclusion argument, we'd like to respond to that. But I think, getting back to the two topics that I started with, the term that the federal circuit construed, or confirmed our construction, appears in several different limitations in the claims that were not addressed in the final written decision, and we think it would be useful to point that out. Frankly, it doesn't require a bunch of argument. It's just, you know, that decision impacts more than just the limitation that was addressed in the final written decision.

Also, the second ground that we asserted, the Murdock ground, was rejected based on that limitation. So it's -- again, I don't think it takes much argument. It would just be pointing out those other places where the same term impacts either the arguments that were made and were not addressed or the final written decision that may not, you know, be readily apparent and are not apparent from the federal circuit decision itself.

On the second topic, I -- again, if patent owner is going to make some sort of legal argument based on a federal circuit decision on a different IPR, I would like to be able to respond to that.

And then there was an IPR decision in a related patent that issued later than this one that addressed several of the dependent claims that have virtually either identical or virtually identical language of the dependent claims at issue here. And we think that decision is relevant. Again, I don't think it takes a lot of argument, but it's something that we think the board should be aware of.

JUDGE DIRBA: That's very helpful.

Patent owner, if I understood -- or Mr. Goldberg, if I understood you correctly, you referenced an issue preclusion argument created by the 345 case which I haven't -- I haven't looked at in sufficient detail to know automatically what it is that you're referencing.

Are you of the opinion that you need

additional briefing to make that argument? Is it your position that the board should respond to determine whether or not issue preclusion applies in this case? Did you previously argue the issue preclusion in the case? Can you give me a little bit more information about your position on that?

MR. GOLDBERG: Yes, your Honor. There are -- there are claims in the 345 patent -- in the 345 proceeding that relates to the same patent that's at issue in the 344 proceeding. And there are some claims that have the same limitation in them. And in the -- in both proceedings at the board, we had argued that the claims were not unpatentable because of that limitation.

And in the 345 proceeding, the board found the claims were not unpatentable because of that limitation and the federal circuit subsequently affirmed.

The same limitation exists in Claim 27 and its dependent claims in the 344 proceeding, but the board in the original final written decision did not address that issue because it found all of the claims got unpatentable for other reasons.

So the issue -- preclusion issue is essentially that this particular limitation that was already fought about in the other IPR that the board found warranted finding the claims not unpatentable and that the federal circuit then affirmed made the claims not unpatentable also applies in this proceeding.

And the reason that I say we don't feel that there necessarily needs to be any briefing about this is because the details of what I just said in a lot more detail are already set forth in a request for rehearing that we had filed at the federal circuit. And the Court in that request for rehearing essentially just said to go back down for the board to deal with it. The details of these -- of this issue are already set forth. But we --

JUDGE DIRBA: And the request for -- go ahead.

MR. GOLDBERG: That was a request for rehearing of the federal circuit decision, because in the federal circuit decision that issued -- so the 344 and the 345 cases, they were consolidated for purposes of appeal. So there's only a single decision that addressed both cases. And in the 344, we had pointed out to the federal circuit this issue. And in the federal circuit's decision, they just didn't address it, for whatever reason. So our request for rehearing said, you guys didn't address this, can you please address it now? And then they essentially said go back and talk to the board about it.

JUDGE DIRBA: Okay. I don't believe that I have a copy of that request for rehearing, Mr. Goldberg. I'll just make you aware of that.

MR. GOLDBERG: Yes.

JUDGE DIRBA: So I can't consider it if I don't have a copy of it. But that's helpful information. I appreciate that.

Is it your argument, then, that based on what happened, that we -- that the board is precluded from making a different decision than it did before, or are you simply arguing that based on the analysis and the reasoning we had in that other case, that that would apply to the limitations here, and so, therefore, we should come up to the same conclusion here as we did in the other case?

MR. GOLDBERG: It's both. And to be clear, because I just want to make sure that I'm not misrepresenting anything, when I keep saying the board -- the court decision on the request for rehearing was, go back and talk to the board, it was just, they denied our request for rehearing. There wasn't a long opinion that said that. I just -- as practical matter, when they denied our request for rehearing, that means we're coming and talking to you.

MR. DAY: Your Honor, may I add one point?

JUDGE DIRBA: Absolutely.

MR. DAY: I just want to make the point that Promptu filed this request for rehearing, and we did not respond to that. So one side of this issue has been briefed, but the other side has not. And so that's part of why we think if this is going to be an issue the board considers, we ought to be granted some briefing to respond.

JUDGE DIRBA: I understand that.

Mr. Day, do you have a proposal for how you would like to handle the additional briefing that you are contemplating?

MR. DAY: Yes, your Honor. So the parties have talked about two alternatives, and we don't necessarily agree on which is our favorite. But the two alternatives are, option 1, both parties file an opening brief simultaneously of up to ten pages, and then both parties file simultaneously an opposition brief of up to ten pages. Second alternative, option 2, would be sequential briefing where petitioner goes first, patent owner, and then a reply, and then a surreply.

Again, we've talked about a ten-page limit, but we didn't really agree on that across the board. But I think those are the two sequential -- the two approaches to briefing that we've discussed.

JUDGE DIRBA: And for the simultaneous briefing option where both parties file an opening brief and both parties file a response brief, are you proposing that the petitioner's opening brief would be directed to the issues that you raise, how -- let's see. I'm going back to my notes here -- how the other federal circuit decision impacts other limitations and how the -- how that decision is otherwise relevant to the case, and that the patent owner's opening brief would address the issue preclusion argument; is that correct? Or did you have a different idea in mind for how to split up the topics?

MR. DAY: No. That's correct, your Honor. I was thinking that both parties would make, you know, whatever arguments they were going to make, the ones we've articulated to you, and then each party would have a chance to respond.

JUDGE DIRBA: What timeline for that

briefing would you propose?

MR. DAY: You know, we did not discuss that. I would like to -- I'd like to have some time. Maybe, say, three or four weeks to get the briefs ready and then three or four weeks to respond. But, again, we did not discuss that.

JUDGE DIRBA: And, Mr. Goldberg, what would your -- if we were to authorize additional briefing here, what would your proposal be for the specific briefing procedure?

MR. GOLDBERG: I think, as Mr. Day had mentioned, that we had kind of talked through the two possibilities. Our preferred option would be to have the petitioner file a first brief, and then us to file a response to that, and then for petitioner to file a reply, and then for us to file a surreply. And as far as page limits go, we think ten pages makes sense for the first brief that the parties file in either the sequential or simultaneous scenario. I think our view would be that five pages would be sufficient for whatever the second brief filed by each party, either in the sequential or simultaneous framework.

MR. DAY: And, your Honor, we disagree with the limitation to five pages for responding to an argument that was made in ten pages. We feel like we should get ten pages for a response.

JUDGE DIRBA: And that's directed to the issue preclusion argument that the patent owner has referenced, correct?

MR. DAY: Yeah. That's the only argument we know that they're going to make. But, yes, if it took them ten pages to lay out that argument, which seems doubtful, but it did, it doesn't seem fair that we would be responding to that in five pages.

JUDGE DIRBA: Okay. Let me take a few moments.

(Pause in proceedings.)

JUDGE DIRBA: Thank you for your patience.

Mr. Goldberg, I have an additional question regarding your arguments regarding issue preclusion or -- you referenced some arguments also around that same issue that you had made in your request for a hearing to the federal circuit.

Do any of those issues relate to the arguments that petitioner is proposing that we address? In other words, is there a relationship between the topics of petitioner you want to address, which is namely how the CAFC decision impacts other limitations in these claims, and your argument that issue preclusion applies from some aspect of what the federal circuit decided?

MR. GOLDBERG: I hesitate in answering just because I think this is one of those points where it just depends on your perspective, because when -- when we talk about petitioner's arguments concerning the impact of the federal circuit decision on other limitations, I could say, well, yes, what we're talking about is the same thing because the federal circuit decision addresses another limitation, and we are going to be talking about that other limitation when we say that that's why the claims are not unpatentable here as well. It's all -- has its genesis in the federal circuit's decision.

So in that sense, yes, it's the same thing. But I think, you know, they're going to focus on other parts of the decision that we would focus on.

MR. DAY: Your Honor, may I offer -- sorry.

JUDGE DIRBA: Let me ask an additional question, Mr. Goldberg.

Are there any other -- the federal circuit decision we're speaking of is the decision from this proceeding, which, as you mentioned, that the federal circuit was consulted with the 345 IPR. Is that the only federal circuit decision that's relevant?

MR. GOLDBERG: That's the only decision that is relevant in the sense that it creates binding -- what we would view as binding authority on this issue. Now, in addressing how this issue preclusion works, there may be issues that, just like in the sense that they're case law, maybe would get cited in explaining this issue to the board. But that would be the only case that is -- I guess I would characterize it as the law of the case. I'm sure that petitioner's counsel would disagree with me on that, but that's kind of the way I would frame it.

JUDGE DIRBA: Mr. Day, a response?

MR. DAY: Yes, your Honor. I don't disagree that it's in the same category. We also would like to update the board on subsequent authority with a category similar. But if the question was getting at who would raise this, it's we would not raise this issue in an opening brief, and they -- and I believe patent owner would not argue it in response to anything that we would say in an opening brief.

So their laying out their position would have nothing to do with anything we said in an opening brief. And so that's why, if we went in a sequential order, we would be -- it would be a new argument unrelated to the arguments we had made in our first opening brief.

And so that's -- that's my concern about a reply being very short, you know, short, half as long, is we would be responding to what might be an extensive argument, I don't know, in half the pages.

JUDGE DIRBA: Okay. Mr. Day, anything further that you want to say on this topic?

MR. DAY: No, your Honor.

JUDGE DIRBA: Mr. Goldberg?

MR. GOLDBERG: No, your Honor.

JUDGE DIRBA: Okay. The panel has conferred. We'll grant additional briefing as the parties request. We're inclined to -- we decided to grant a simultaneous opening brief and then a simultaneous response brief. Both of those briefs -- or I suppose all four of those briefs will be ten pages each. They're all limited generally to discussing the issues that we addressed today. In particular, or I suppose, for example, someone had mentioned not having any additional briefing on whether Murdock qualifies as prior art. The topics -- and we'll issue an order in due course laying this out. But the topics should be limited to the impacts of the federal circuit decision that we have in this case on this case, as well as additional authority that is particularly relevant to the arguments made during the proceeding. Each of the briefs I mentioned would be ten pages. We'll allow three weeks for both parties to file their opening briefs, and then an additional three weeks for both parties to file their response brief.

Mr. Day, are there any questions?

MR. DAY: No, your Honor.

JUDGE DIRBA: Mr. Goldberg?

MR. GOLDBERG: Not for your Honor. But if I can just give my colleague, Jacob, a moment to see if he has any.

MR. SCHROEDER: No, I do not. This is Jacob Schroeder. Thank you.

JUDGE DIRBA: Thank you. And one additional clarification for Mr. Day. I would expect the petitioner would not address the issue of preclusion arguments that patent owner has discussed today in his opening brief. Rather, I would expect the petitioner would address those arguments after patent owner has had a chance to articulate those arguments in its opening brief. Petitioner would address the response to those in its responsive brief.

MR. DAY: Understood, your Honor.

JUDGE DIRBA: Is there anything further from either party?

MR. DAY: Your Honor, I did have one other thing I wanted to ask about.

JUDGE DIRBA: Go ahead. And who is this speaking?

MR. DAY: Sorry. Mr. Day for petitioner.

The parties filed, each side filed a motion to exclude. And in the final decision, both of those motions were denied as moot. So my question is just whether the panel would like us to refile those, mention them in this briefing, or is there anything else we can do just to, you know, get those on your radar again?

JUDGE DIRBA: We will take that under advisement. I don't suspect that we will need additional briefing. I'm assuming that the issues are the same; you're just saying that the motion is perhaps no longer moot because we might resolve things differently in this proceeding; is that correct?

MR. DAY: That is correct, your Honor. But I'm not suggesting further briefing.

JUDGE DIRBA: Okay. We will consider that and I'll address that in the order.

MR. DAY: Thank you, your Honor.

JUDGE DIRBA: Okay. Final request for Mr. Goldberg. Please file as an exhibit a copy of the transcript from this proceeding or this hearing as soon as it's available.

MR. GOLDBERG: Will do. Thank you, your Honor.

JUDGE DIRBA: Excellent. Thank you all. We're adjourned.

MR. DAY: Thank you.

MR. SCHROEDER: Thank you. Have a good day.

(Proceedings concluded at 2:32 p.m.)

CERTIFICATE OF REPORTER

I, Kathleen A. Wilkins, Registered Professional Reporter in and for the State of California, County of Contra Costa, the officer before whom the proceedings were taken, do hereby certify that the foregoing transcript is a true and accurate record of these proceedings; that said proceedings were taken in Stenotype note by me on the 24th day of March, 2021, commencing at 2:01 p.m. and ending at 2:32 p.m.

I further certify that present on behalf of Party Promptu Systems Corporation, Patent Owner, was Joshua L. Goldberg, Esq. and Jacob A. Schroeder, Esq., Finnegan, Henderson, Farabow, Garrett & Dunner, and on behalf of Comcast Cable Communications, LLC, Petitioner, was James L. Day, Esq., of Farella, Braun & Martel, LLP and Leo L. Lam, Esq., of Keker, Van Nest & Peters.

I, further certify that I am not related to, nor associated with any of the parties or their attorneys, nor do I have any disqualifying interest, personal or financial in the actions within.

Dated this 26th day of March, 2021, at Contra Costa County, California.

Kathleen A. Wilkins
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(Reporter's signature)