

1 A P P E A R A N C E S: (Via Telephone)
2
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6 BY: JOHN C. PHILLIPS, ESQ.
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8 For the Petitioner
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15 DENISE W. DeFRANCO, ESQ.
16 For the Patent Owner
17
18 ALSO PRESENT:
19 RANDALL BERMAN
20 Philips IP&S
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1 JUDGE MEDLEY: Good afternoon, this
2 is Judge Medley. I have with me on-line Judge
3 Quinn. I'd like to take a roll call first.
4 This is in reference to
5 IPR2013-00609, 612, 613, 615, 616 and 618. I'd like
6 to begin with Petitioner.
7 MR. JAKES: Good afternoon, this is
8 Mike Jakes for Philips. I think I jumped the gun
9 there. I think you wanted the Petitioner first, but
10 we had asked for the call.
11 JUDGE MEDLEY: Okay, Mr. Jakes,
12 that's fine. Do you have anybody with you?
13 MR. JAKES: Yes, Denise DeFranco from
14 my firm is with me and Randall Berman from Philips,
15 the Patent Owner, is also on the line.
16 JUDGE MEDLEY: Okay. And they're --
17 but they are not listed as counsel?
18 MR. JAKES: No.
19 JUDGE MEDLEY: Okay. Petitioner?
20 MR. PHILLIPS: Petitioner, John
21 Phillips, lead counsel for Fish & Richardson is
22 here, along with John Dragseth, who I believe has
23 made an appearance as well, from Fish & Richardson.
24 JUDGE MEDLEY: Okay. All right.
25 So we understand that Patent Owner

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1 requested the call and just before we get started,
2 do we have a court reporter?
3 THE REPORTER: Yes, we do. My name
4 is Nancy Bendish.
5 JUDGE MEDLEY: Okay. Thank you,
6 Nancy.
7 And I'd also like to clarify, we got
8 the notification that this was in respect to just
9 six of the cases? Because there are eight.
10 MR. JAKES: That's right. This is in
11 respect to just six of them for this particular
12 motion that we want to file.
13 JUDGE MEDLEY: Okay. Then we'll hear
14 from Patent Owner, please.
15 MR. JAKES: This is Mike Jakes for
16 the Patent Owner, Philips.
17 We're asking permission to file a
18 motion to dismiss these six IPRs under 35 U.S.C.
19 315(b). There is another litigation that was not
20 identified in the petition that involves these six
21 patents. We identified it in our mandatory
22 disclosures. That's a case that's pending in the
23 District of Massachusetts and it involved these same
24 six patents. The complaint in that case was filed
25 and served in October of 2010.

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1 The defendant in that case is Zoll
2 Medical Corporation and that's the parent
3 corporation of the Petitioner in this case, Zoll
4 Lifecor. That complaint that was filed in October
5 of 2010 alleged infringement of these six patents
6 and we actually have a trial scheduled to begin next
7 month.
8 As we understand the decisions of
9 this Board, it doesn't matter that there was a later
10 complaint filed against Zoll Lifecor, who is the
11 Petitioner in this case. There was a case of like
12 universal remote, which was decided in August of
13 this year.
14 So the only issue that really appears
15 to be is whether Zoll Medical, the parent of Zoll
16 Lifecor, is a privy of the Petitioner since it was
17 served with a complaint under 315(b). And so, in
18 other words, if Zoll Medical, which is the defendant
19 in the Massachusetts case, was a privy of Zoll
20 Lifecor, the Petitioner, then there is no standing
21 to bring these IPRs.
22 I understand that the privy issue
23 can be a fact-dependant question, but the public
24 record here is, I think, conclusive that Zoll
25 Medical is a privy of Zoll Lifecor. It's the parent

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<p>1 corporation. Zoll Lifecor is a wholly-owned 2 subsidiary. There is public information, such as a 3 press release, that says that Zoll will operate the 4 Lifecor business through its Zoll Lifecor 5 subsidiary. There are SEC filings that say Zoll 6 manufacturers and markets a wearable defibrillator 7 system through its subsidiary, Zoll Lifecor. And 8 there are the same, many of the same people 9 involved, same law firms, same general counsel. The 10 president and COO of Zoll Lifecor is an officer -- 11 JUDGE MEDLEY: Okay, let me just 12 interrupt you, please. This is Judge Medley. I 13 just want to interrupt you. 14 Today we're just here to decide 15 procedurally how to go forward. We don't really 16 need to hear the merits of the case or what you plan 17 to argue, so I just wanted to direct us back to, how 18 do we proceed procedurally. What's the appropriate 19 thing to do here. 20 And so I have a question for you 21 before we turn it over to hear from Petitioner. Why 22 can't we just run the one case just like we did the 23 other case, in that you have an opportunity to file 24 a preliminary response and in that response you can 25 include why no inter parte review should be</p> <p style="text-align: right;">[Page 6]</p>	<p>1 JUDGE MEDLEY: Okay. I'd like to 2 hear from Petitioner now, please. 3 MR. PHILLIPS: Yes, this is John 4 Phillips from Fish & Richardson. If we get into the 5 factual history, I'd like to get help from John 6 Dragseth, who knows the history better than I do. 7 But to respond to some of the points, 8 I don't believe the petitions are facially 9 deficient. They identify the relevant parties. 10 Zoll Lifecor and Zoll Medical are separate corporate 11 entities. Philips has treated them as separate 12 corporate entities in the past by suing them as 13 separate corporate entities on the same patents. 14 If there are multiple -- we don't 15 oppose the filing of the motions. If the filing of 16 the motions is granted, as opposed to putting forth 17 the privity arguments in the preliminary response, 18 we think it would be equitable for us patent 19 owner -- I'm sorry, Petitioner, to get a response to 20 the privy argument, because there are two sides to 21 the position and we feel we're in the better 22 position to respond. 23 If the preliminary response is filed, 24 we would not get the -- absent a motion to respond 25 to oppose that -- those arguments, we wouldn't get</p> <p style="text-align: right;">[Page 8]</p>
<p>1 instituted? 2 So you have every opportunity there 3 to file your response and address the 315(b) issue 4 in that context and, therefore, we're kind of at -- 5 I guess puzzled a little bit that you'd want 6 separate briefings and in the form of a motion to 7 dismiss, as we see it as not necessary. 8 MR. JAKES: Your Honor, and for the 9 benefit of the court reporter, this is Mike Jakes 10 again on behalf of Phillips. 11 The petitions are really facially 12 deficient for failing to identify all the 13 litigation. This really is a standing issue which 14 we think can, for efficiency, be taken up before we 15 have to file a preliminary response. 16 In our preliminary response we would 17 also have to address the merits of their petition 18 and in view of the public record it seems very clear 19 that there was a privity issue. They were in 20 privity. The complaint was filed that for 21 efficiency it would be better to just file these 22 motions and dispose of the six IPRs on that ground 23 before the Patent Owner is put to the burden and 24 expense of having to respond on the merits in the 25 preliminary response.</p> <p style="text-align: right;">[Page 7]</p>	<p>1 an opportunity to present the other side of the 2 argument. 3 JUDGE MEDLEY: Okay. Well, I think 4 the Board on occasion has authorized a response to 5 the preliminary filing, so I don't think it's 6 necessarily, you know, that you would never get to 7 respond to a preliminary response, which it is the 8 status quo not to. 9 All right, do you have anything else, 10 Mr. Phillips? 11 MR. PHILLIPS: I don't. John 12 Dragseth, did you want to add any facts, relevant 13 facts to this? 14 MR. DRAGSETH: I think you hit it 15 well. I don't know that any more facts are relevant 16 at this stage. 17 JUDGE MEDLEY: Okay. I will 18 conference with my co-worker and then we'll get back 19 with you in just a minute. 20 (Pause.) 21 JUDGE MEDLEY: Okay, this is Judge 22 Medley. I'm back. 23 The panel has conferred and we are 24 not persuaded that we need to deviate from the norm 25 in this case. So we would prefer that these</p> <p style="text-align: right;">[Page 9]</p>

<p>1 arguments come in the form of a preliminary 2 response. In that respect, you know, that you would 3 be confined to the page limit but circumventing the 4 page limit.</p> <p>5 And I do appreciate and understand 6 that Philips doesn't want to maybe address the 7 merits of the case if this were to go away under the 8 315(b) issue. However, I will point out, a 9 preliminary response is totally optional for the 10 Patent Owner and so you can use that tool as you see 11 fit (indiscernible), even address the merits of the 12 case if you don't want to. So we're not persuaded 13 by that argument either.</p> <p>14 The Board will send out a short order 15 memorializing the conference call approximately 16 tomorrow. Any questions or comments?</p> <p>17 MR. PHILLIPS: Your Honor, John 18 Phillips for the Petitioner.</p> <p>19 At what point -- if the preliminary 20 response does include the 315(b) arguments, at what 21 point would it be appropriate for us to seek a 22 response to those arguments?</p> <p>23 JUDGE MEDLEY: I think you should see 24 what they say first.</p> <p>25 MR. PHILLIPS: Fair enough.</p> <p style="text-align: right;">[Page 10]</p>	<p>1 where we were earlier, and this has been raised in a 2 couple of cases that the Board has had and this is a 3 way to proceed it through the normal channels of 4 briefing.</p> <p>5 Any other questions or comments? 6 MR. JAKES: Not from the Patent 7 Owner.</p> <p>8 MR. PHILLIPS: Not from Petitioner. 9 Thank you, Your Honor.</p> <p>10 JUDGE MEDLEY: Okay. And who 11 received the court reporting? 12 MS. DeFRANCO: Petitioner did -- 13 excuse me, Patent Owner did.</p> <p>14 JUDGE MEDLEY: Okay, Patent Owner, 15 when would you be able to file that? 16 MS. DeFRANCO: We haven't consulted 17 with the court reporter. 18 Ms. Court Reporter, can you help us 19 answer that question.</p> <p>20 THE REPORTER: It's not very lengthy. 21 When do you need it? I can do it pretty quickly.</p> <p>22 JUDGE MEDLEY: I don't think that the 23 Board will hold up the order. Tomorrow would be 24 great, file it tomorrow.</p> <p>25 And it should be filed as a paper, a</p> <p style="text-align: right;">[Page 12]</p>
<p>1 JUDGE MEDLEY: All right. Any other 2 questions or comments?</p> <p>3 MS. DeFRANCO: Your Honor, this is 4 Denise DeFranco. I'm going to ask for permission to 5 make two further points to Your Honor.</p> <p>6 JUDGE MEDLEY: Okay.</p> <p>7 MS. DeFRANCO: On behalf of Philips. 8 I just would like to direct your 9 attention to Section 312(a)(2) of the patent statute 10 which says that the petition cannot even be 11 considered unless the Petitioner identifies all real 12 parties in interest. I think that that is what 13 makes the petition facially deficient.</p> <p>14 I'd also like to note for the record 15 that the Petitioner did not oppose our request for 16 an opportunity to file a motion.</p> <p>17 JUDGE MEDLEY: Right, okay. I 18 understand that and I understand 312(a)(2), but the 19 way I understand it, Petitioner is under the 20 impression that they did list all the real parties 21 in interest. So this issue is controversial between 22 the parties, correct?</p> <p>23 MR. PHILLIPS: That's correct from 24 Petitioner's view, yes.</p> <p>25 JUDGE MEDLEY: So then we're back to</p> <p style="text-align: right;">[Page 11]</p>	<p>1 quick paragraph or sentence that says transcript of 2 the conference call.</p> <p>3 Okay. Any other questions or 4 comments? All right. Thank you very much. 5 (End of Phone Conference 1:14 p.m.) 6 -o0o- 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25</p> <p style="text-align: right;">[Page 13]</p>

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CERTIFICATE

I, NANCY C. BENDISH, a Certified Court Reporter and Notary Public of the States of New York and New Jersey, do hereby certify that the foregoing is a true and accurate transcript of the telephonic proceedings as taken stenographically by and before me at the time, place, and on the date hereinbefore set forth.

I DO FURTHER CERTIFY that I am neither a relative nor employee nor attorney nor counsel of any party in this action and that I am neither a relative nor employee of such attorney or counsel, and that I am not financially interested in the event nor outcome of this action.

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