

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.
PETITIONER,

v.

JAMES B. GOODMAN
PATENT OWNER

Case IPR2017-01994
Patent 6,243,315 B1

Record of Oral Hearing
Held: November 16, 2018

Before JUDGES BRIAN J. McNAMARA, PATRICK BOUCHER, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

Case IPR2017-01994
Patent 6,243,315 B1

APPEARANCES

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The above-entitled matter came on for hearing on Friday, November 16, 2018, commencing at 10:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

1 PROCEEDINGS

2 JUDGE McNAMARA: Please be seated.

3 All right. Good morning, everybody. This is the
4 trial hearing at HP Inc. vs. James B. Goodman, IPR2017-01994.

5 I am Judge McNamara. Judges McGraw and Boucher are
6 participating remotely. So, therefore, I'd like to remind
7 the parties to use the microphone at the podium, and to
8 identify any demonstrative or document that you might be
9 referring to by page number, so that the Judges can find it
10 in the record.

11 Beginning with the Petitioner, would, Counsel,
12 please introduce themselves.

13 MR. SHELTON: Good morning, Your Honor. Barry
14 Shelton of Shelton, Coburn LLP, Lead Counsel for HP Inc.

15 MR. BACA: And, good morning. My name is Tony
16 Baca. I'm HP Inc.'s In-house Counsel.

17 JUDGE McNAMARA: Thank you. And you are?

18 MR. FINK: Good morning, Your Honor. David Fink,
19 for the Patent Owner and inventor.

20 JUDGE McNAMARA: All right. Well, welcome to the
21 Patent Trial and Appeal Board. Thank you all very much.

22 The parties have agreed this morning to 30 minutes
23 of argument per side, and we will begin with the Petitioner,
24 and then we will hear any opposition from the patent
25 owner. The Petitioner will then get an opportunity to

1 reserve some -- use whatever time is reserved for reply, and
2 the Patent Owner may reserve time for a sur-reply.

3 Okay. Is everybody ready to begin?

4 MR. SHELTON: Yes, Your Honor.

5 JUDGE McNAMARA: All right. So let's begin with
6 the Petitioner.

7 And do you want me to alert you to some amount of
8 time remaining?

9 MR. SHELTON: Yes, Your Honor. We reserve five
10 minutes for rebuttal.

11 JUDGE McNAMARA: All right.

12 MR. SHELTON: And with the Board's approval, Mr.
13 Baca will argue one of the points.

14 JUDGE McNAMARA: That's perfectly fine.

15 MR. SHELTON: Very good, your Honor.

16 And so we'll argue for 25 minutes total.

17 JUDGE McNAMARA: All right. I will let you know
18 when the 25 minutes is up.

19 MR. SHELTON: Thank you, Your Honor.

20 There are two grounds for the challenged claims.

21 There are four challenged claims here. Those would be

22 1, 5, 10, and 16. I'll argue the issues with regard to ground

23 1, and Mr. Baca will argue the sole issue with remain -- with

24 regard to ground 2; and the combination of the Schaefer and

25 Qureshi references, which are alleged to invalidate claims 1

1 and 5 of the '315 patent.

2 So there are only three issues that are in dispute
3 before this panel today; and the first is, whether the
4 combination of Schaefer and Qureshi discloses the control
5 device of claim 1, independent claim 1. And the issue within
6 that larger phrase is whether the combination of those two
7 patent -- prior references, meets the selectively
8 electrically isolating element of claim 1.

9 And then the second issue is, whether the
10 combination of those same two references discloses the memory
11 access enable control device of independent claim 1.

12 Now, this case is probably unusual for this panel
13 in that the Patent Owner has not proffered any evidence
14 whatsoever. The only thing that the patent offer -- patent
15 owner has done, is to provide attorney argument in response
16 to the Petition, and then after the institution decision.

17 The Patent Owner, therefore, under the rules of the
18 Patent Trial and Appeal Board, of course, has waived any
19 other basis for disputing the two grounds in the Petition.

20 The Patent Owner did not dispute that the three
21 prior references used in these two grounds, are actually
22 prior to the '315 patent.

23 The Patent Owner didn't adduce any evidence
24 whatsoever in the two Responses. The only two exhibits that
25 were proffered by the Patent Owner relate to claim

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