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ROUGH DRAFT TRANSCRIPT

7/13/20 PHONE HEARING

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JUDGE TROCK: This is in the matter of IPR 2020-00204, Apple versus Maxell. Counsel, were you able to get a court reporter?

MR. SEITZ: Yes.

JUDGE TROCK: Counsel for Petitioner, who is going to speak for you today?

MR. SEITZ: Yes, your Honor. This is Adam Seitz for Petitioner Apple.

25 MR. PLUTA: And good afternoon,

2

1 your Honor. This is Robert Pluta on behalf of
2 patent owner.

3 JUDGE TROCK: Welcome, counsel.

4 Well, we have this call today because we received
5 an email from Mr. Seitz on Thursday regarding this
6 case, in particular having to do with the issue of
7 a jury trial in the District Court proceeding so
8 counsel for Petitioner.

9 Why don't you go ahead and state your
10 position first.

11 MR. SEITZ: Thank you, your Honor.

12 As you're aware, as we've briefed in our reply and
13 Maxell has briefed in its sur-reply, Fintiv Factor
14 4 looks at the overlap between litigation and the
15 IPR and examines the fact whether there will be
16 inconsistent decisions between the District Court
17 and the board. After the parties had briefed in
18 the replies and the sur-replies, the question of
19 Fintiv, Maxell filed a summary judgment motion
20 with the court on the '586 patent seeking to
21 prevent the jury from hearing the invalidity
22 questions in the District Court for that patent
23 while at the same time arguing to this board that

24 the jury would already hear the same issues and
25 that that should be an independent basis for

3

1 denial under Fintiv.

2 Apple sent its email to the board to
3 inform you of this new development and to ensure
4 that the record accurately reflected the facts
5 behind this motion because I know the question of
6 Fintiv and overlap has been a hotly disputed
7 issue.

8 And fundamentally your Honor Maxell is
9 accusing Apple of gamesmanship and manipulation
10 of the process here in our selection of prior
11 art. Now, that simply is not the case and this
12 summary judgment briefing further highlights the
13 issues in Maxell's arguments.

14 The brief bit of background, the District
15 Court as your Honor is surely are aware parties
16 constantly engage in a court mandated narrowing
17 of their case. This includes asserted claims as
18 well as the invalidity series. Those are then
19 whittled down more when we go to trial. You have
20 a limited amount of time to present the court
21 here to a jury.

22 Apple in this case has made a Kirkup the

23 primary reference in this IPR for the board to
24 analyze because Apple wanted the expertise of the
25 board to analyze the question of invalidity.

4

1 This was the very same rationale that was made by
2 the board in the Apple versus seven networks
3 case, IPR 202156 at page 19 where that panel
4 noted that there were considerations with what a
5 party could reasonably present to a jury and made
6 strategic decisions on presenting a case to the
7 board where they could present or would have much
8 more time to present and time to examine the
9 issues of the invalidity questions. That's what
10 happened here.

11 Apple also made a substantive decision to
12 not present the Kirkup combination before the
13 board to the District Court in its final
14 narrowing of prior art. Instead in the District
15 Court litigation Apple is using the Schiffer S C
16 H I F F E R reference. The Schiffer reference is
17 not used at all)) in Apple's invalidity
18 challenges in the P tab not certainly as part of
19 our combinations or grounds. The only place it
20 appears is a passing reference in the background
21 section of our expert's declaration. In its

22 sur-reply briefing in this case Maxell argued
23 that a jury will decide substantially the same
24 issues and invited the board to institute based
25 on that factual with this recent filing of a

5

1 summary judgment motion Maxell is now arguing to
2 the district court that the jury should be
3 prevented from hearing any one of two 102
4 invalidity case on the '586 patent. The only
5 arguments that Apple has in the District Court at
6 this point all center around Schiffer on the '586
7 patent.

8 Now, Maxell's motion which the board does
9 not have before it which I would be happy to
10 provide as an exhibit for this proceeding
11 Maxell's summary judgment motion is based on a
12 single issue, one issue only and it's four pages
13 in substantive length for substantive argument.
14 That argues the question is whether Schiffer
15 teaches a limitation in all independent claims
16 requiring memory in a first device that stores
17 information about a second device. That's the
18 summary judgment motion at page four.

19 Maxell's summary judgment motion expressly
20 depends on the facts that Apple's district court

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