

MORRISON FOERSTER

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Speaker 1 (00:01):

The United States Court of Appeals for the Federal Circuit is now open and in session. God save the United States and this honorable court. Ready to proceed, Your Honor.

Judge 1 (00:16):

Okay. Thank you, first argued case this morning is number 191720 Google LLC against Netlist Incorporated. Ms. Heinz, please proceed.

Doris Hines (00:26):

Thank you very much, Your Honor. May it please the court Doris Hines on behalf of the appellants. Netlist arguments in this appeal demonstrate two things—why the claim, why claim construction was necessary and why the board's decision did not comply with the APA and how the board's priority analysis was incorrect. Let me address claim construction first. Netlist on page 41 of its brief addresses the logic elements and its claim construction. And that list says by requiring a logic element that responds to all four enumerated signals, the claims cover a logic element that responds to all four of the enumerated signals, at least some of the time. And that “at least some of the time” is important.

Doris Hines (01:28):

The construction that Google argued was that the claim phrase, at least in part, and, at least, required a disjunctive construction. And Netlist, by its argument, appears to agree. If—if the claims cover a logic element that at least some of the time does not respond to all four enumerated signals, that's the disjunctive construction. Then, the claims are invalid based on what the board has already found. The board found that immediate discloses generating output chips select signals based on input chips select signals and a row address signal. And that's confirmed at appendix 1-23 to 24 and addressed, and Google's main brief at pages 48 through 49.

Judge Bryson (02:25):

Miss Hines, this is Judge Bryson. Your argument beginning with the “at least in part” does that argument—is that argument the same with respect to the claims that do not contain that language?

Doris Hines (02:31):

Correct, Your Honor. And two points on that.

Judge Bryson (02:35):

Would that be since you're relying on that particular phrase, which I gather is not present in some of the claims?

Doris Hines (02:41):

Well, the claims—all the appealed claims either require “at least” or “at least in part,” and Google's position is that the construction is the same, whether the language is “at least in part” or “at least.” I'd also point out that the board in its rehearing decision found that claim one is representative of all of the other claims. Claim one does include the language “at least in part.” So, in our view, the construction of the logic element and whether it is disjunctive or not does not change depending on that variation in the claims.

Judge O'Malley (03:33):

Counsel, I'm not sure I agree with your characterization of Netlist's argument, and certainly they'll correct me if I'm wrong. But I understand what Netlist's saying is that it must respond to all four at the same time to infringe, but it doesn't have to always be in an infringing mode. Is that different from what you described?

Doris Hines (04:03):

Well, I think at the very least it's unclear. And what Google's position is, is that the board, after Netlist amended his claims in 2016 to include this language, and to fundamentally change the claims, the board was required to perform a claim construction analysis. And so, the confusion that's generated by the arguments that Netflix—Netlist, excuse me, is making on appeal really just confirms why the board should have done claim construction in the first place.

Judge O'Malley (04:40):

It's important, what the board said, not what Netlist characterizes it as. I mean, the board definitely said that it was in the conjunctive, and that it had to respond to all four period and said that the plain language of the claims got them there. Isn't that enough?

Doris Hines (05:03):

It is correct, Your Honor, that the board said there was a conjunctive construction, but the problem here is when Netlist amended its claims, the original claims before 2016 through the reexamination required that the logic element received certain signals. Netlist amended its claims in 2016 to require that the logic element generates signals in response to those input signals. The board recognized that shift in the claims and much of its second decision is directed to that issue.

Doris Hines (05:38):

What the board did not do and failed to do was to address the roles of the signals, the roles of those input signals in the generation and perform claim construction, recognizing that shift in the claims. So while it is true that the board said it was a conjunctive construction, the board never explained how that could be so or what the role of the input signals was. And that's particularly important with respect to the bank address signals. The bank address signals, as the parties recognize discussed a lot in the record, can have two different functions. It can either be—

Judge O'Malley (06:20):

It sounds like you're going down a written description road. That's different from what the claims assert, right?

Doris Hines (06:33):

What, Your Honor—

Judge O'Malley (06:37):

What would it have to explain everything about how the system works when all it's doing is trying to decide if that language requires disjunctive or conjunctive examination of the four signals.

Doris Hines (06:52):

Well, because construing the claims must do it and—looking at the specification—must be consistent with the specification and the specification must be examined. So, we are not making a written description argument. But we are arguing is that in construing the claims the board was required to look at the specification, and, in looking at the generating operation, what was, and, in what circumstances, can both a bank address signal or bank address signals and a row address signal be used to generate those output, output signals that are claimed? And what's the role of those in that generation? Now what the board implicitly found when looking at the prior art was that the bank address signals have the same function as the row address signal. And the board makes that point on appendix 1-36. They cite to earlier the earlier board decision at appendix 69 and 67.

Doris Hines (07:59):

So it appears that the board found that the bank address signals will be density bits. They will have that role in memory expansion, similar to the row address signal. Now, the problem with that is that construction and requiring both the input bank address signals and the row address signal to perform that function is not consistent with the specification. The specification explains that it is the row address, column address, or internal bank address that that acts as a density transition bed. It is not all of them. It is one of them. And that's a column 12 lines 29 through 32. And table one is consistent with that. Table one identifies what signals are used to generate the output signals. And table one shows that it is chip select signals and the row address signal. And the bank address signals are not shown at all. And a Netlist expert agreed with that.

Doris Hines (09:14):

At the very beginning of the reexamination, he described the operation of table one. The logic element 40 generates the appropriate chip select signals in response to the input chip select signals, the row address bit, and the command signal. And that's appendix 9-50 at paragraph 97. Netlist's expert, in explaining table one, recognize a little bit—

Judge O'Malley (09:43):

Part of the problem that your entire argument, with respect to this language, was about three sentences long. And the board found that to the extent that you wanted them to look beyond the plain language of the claims or the clear references to those limitations in the claims you had waived that right.

Doris Hines (10:08):

Well, we respectfully disagree that—and we addressed this in our reply brief. The arguments were longer than three sentences. The arguments were raised at the appropriate time. As soon as the claims were amended at the first opportunity, Google raised this issue.

Doris Hines (10:26):

And, and re-raised it again, raise the issue twice. There is no—and Netlists has not argued that there's any issue of waiver. It was presented and requested argument that Google made, but that the board did not address. And we continue to raise the argument now. The disjunctive, or excuse me, conjunctive construction is not supported by the specification. It's not supported by any language that addresses how output signals are generated. And when Netlist amended its claims to change the claims from ones that receive input signals to a logic element that generates input signals that was important. And the board spent a lot of its time addressing that issue. And it should have been addressed with respect to the claim construction as well. And let me discuss the prior art. In the prior art, the parties agree and the board found that the [inaudible] does disclose the disjunctive construction and would meet the claim elements if construed in that way.

Doris Hines (11:47):

The Dell 2 reference teaches use of bank signals in memory expansion. It teaches directing bank addresses signals to a logic element. So they are received. Multiple bank address signals are received. Biologic element by the combination of a median Dell 2. Now, on appeal, Netlist points out that the board—points out the board's decision for the proposition that in looking at the 912 patent and the logic element in the 912 patent, each input signal to the logic element 1A—in figure 1A must be used in some manner whether directly or indirectly to generate the recited output signals. And in fact—

Judge O'Malley (12:38):

Is it your position that if we agree with your claim constructions, we simply reverse the board? Or would we need to remand?

Doris Hines (12:37):

If the court agrees with our claim construction, you can reverse, because the board has already found that [inaudible] discloses the disjunctive construction and the combinations of [inaudible] would meet all the claim elements. So the court can reverse on that basis.

Judge O'Malley (12:58):

Any more questions from your time?

Doris Hines (13:03):

No. Thank you, Your Honor.

Judge 1 (13:03):

Okay. All right. Thank you. [inaudible] We'll hear from Mr. Lloyd.

Seth Lloyd (13:08):

Yes, Your Honor. May it please the court, Seth Lloyd for Netlist. The board correctly found Netlist's claims patentable after nearly 10 years of re-examination. It correctly gave the claim term and its plain conjunctive meaning, and it made many well-supported findings on patentability, including resolving the battle of the experts. On claim construction, "and" plainly means "and." It's conjunctive. Nothing about "at least in part" or "at least" transforms "and" into "or." As the board explained at appendix 77 and 88 to 91, "at least in part" makes clear that each of the specified signals must be used in some way or in some fashion to generate the output. But other signals may also be used. Other claim language confirms the plain meaning that claims require that the logic element receive all four of the specified signals, although it may also receive other signals, and it must receive those signals because it must use them in generating the output.

Seth Lloyd (14:23):

That's also what the specification shows. That figure 1A it shows a logic element that receives all four of the specified signals and generates output in response to them. And contrary to what counsel for the other side says. At appendix at columns 7-9, the specification explains how the logic element uses each of those signals. It can, for example, respond directly to the input chip select signals and the row address signal and indirectly to the bank address in PLL clock signals in generating the output.

Judge O'Malley (14:51):

Counsel, it is a little disconcerting that when you have different language that is employed, that we are not to assume that there's a difference between the two phrases. So, what is your position with—with "at least in part" and that addition into the claim.

Seth Lloyd (15:13):

To be clear, Judge O'Malley, Google has agreed, as you heard, that nothing in this appeal turns on the difference between "at least in part" and "at least." I think the board did give meaning to both of those phrases. "At least in part" does two—does at least two things.

Seth Lloyd (15:37):

I think "at least in part" makes clear that other signals can be used. That's the first thing. And second, it makes clear how the signal must be used, that the signal can be used in some way in part directly or indirectly. I think for a claim that doesn't have the end part, you'd have to look to other claim language to determine whether the second of those still applies, but at least "in part" makes clear that the signal can be used in some fashion or in some way. And that was the board's understanding. The board did explain that contrary to what Google says when it rejected an argument by INFI at appendix 77, that "at least in part" was ambiguous. And it also rejected an argument by INFI that there was a lack of written description challenge for "at least in part." And the board said, as I did just now, that "at least in part" requires—simply requires that the signal be used in some fashion or in some way or directly or indirectly.

Seth Lloyd (16:33):

I think that explanation is more than adequate under the APA. As the court has already noted that the board was express in adopting its construction, that it was conjunctive and that was more than enough to resolve Google's—the issue Google raised, which was simply Google quoted the claim language and said it's [inaudible] disjunctive. The APA does not require the board to do more than that, but the board

did do more than that because it also explained how we understood the term “at least in part.” I'm happy to answer more questions on claim construction. But if the court has none, I'll proceed to obviousness. Under the board's claim construction, the board made numerous—found many gaps between the prior art and the claims. It was not simply a difference between one or multiple signals. None of the prior art, the board found, discloses the claim logic element. And Google and INFI relied on their experts to try to supply the missing limitation, but the board repeatedly refused to credit their experts.

Seth Lloyd (17:41):

For example, it found that INFI expert gave near assertions that he offered unsupported beliefs that said appendix 83 to 84, and that his testimony was not persuasive. That's at appendix at [inaudible]128. Google's expert, the board found, gave testimony that was directly contradicted by the references. That's at appendix 100. His testimony conflicted with Google's own position. That's at appendix 138. And his testimony clashed with his earlier testimony. That's at appendix 140. In contrast, the board credited our expert, Dr. Ciechon, on key issues, including finding that, at least, in one part, his testimony was un rebutted. That type of dispute between the experts and the choice between which expert to credit on competing issues is exactly the type of decision that was for the board to make. The board did make it. It explained why it found the testimony unpersuasive from the other side. And that's the type of issue that this court defers to the board on. In terms of some of the points that we heard from the other side—

Judge O'Malley (18:52):

Counsel, what is your response to the point that Google makes that the expert testimony was mostly with respect to a previous version of the claims, and so why should that testimony would be relevant to these claims?

Seth Lloyd (19:11):

It's not correct, Judge O'Malley, that expert testimony was at least, for our expert, that it was in reference to the previous version of the claims. Our expert gave three different declarations. And the third of those was after the final amendment in which he walked through the specific reasons why the amended claim language was different and rendered the claims patentable over the prior art. Google, for its part, chose not to—it had the option, but Google did not put in an additional expert report after we amended the claims. INFI did, but the board found that expert testimony unpersuasive. So that the testimony was directly on point, and the board in its final decision cited that third declaration multiple times. And, in reference to some of what Google said, our expert, in his first declaration—this is at appendix 9-46 to 9-50. He did explain how the logic element uses all four input signals. He explained table one, but he went on to explain how the logic element of our patent also responds to input bank address signals and a POL clock signal. And, in doing so, achieves something that none of the prior art was able to achieve.

Seth Lloyd (20:29):

Google also has suggested that there was some ambiguity about the role that input signals have to play in generation, but the board was express in what role the signals have to play. It was the earlier claims, Judge O'Malley, in terms of the difference of the claims. Claim one previously required a logic element that generates output “in response at least in part to” a bank address signal. So that the “in response at least in part to” language was always there. At least at that point, that the only change was to add

additional signals joined by the conjunction and, and in interpreting that earlier language in response, at least in part to a bank address signal, the board explained how the signal must be used, excuse me. It must be used in some way, or in some fashion, there was no limit based on whether the signal was a density transition or not—simply must be used in some way, according to the board.

Judge O'Malley (21:39):

Okay. Thank you

Seth Lloyd (21:49):

I think those are the points I had on the merits of obviousness and unclaimed construction. I'm happy to answer any additional questions from if the court has them otherwise, we would ask that you affirm.

Judge Bryson (21:54):

Let me ask you a question, if I may? Going back to your claim construction argument. And I understand that it is in part predicated on the prosecution history. And could you walk me through the particular portion of the prosecution history that you think supports the claim construction that the board adopted?

Seth Lloyd (22:20):

Yes. So the, I think there are a couple parts. I think that the main and most important part, Judge Bryson, is the portion I just said. And the board recognizes this appendix 1-22. That claim one previously resided—This is if you're, if you're following along in the appendix—

Judge Bryson (22:48):

I'm grabbing my appendix now. Figuratively speaking. All right. 1-22. Yeah.

Seth Lloyd (22:52):

So appendix 1-22, the last full paragraph there. The sentence starting with "moreover" the board says, "Moreover, claim one previously recited the logic element generates gated column access, strokes signals, or chips-like signals in response, at least in part to a bank address signal." So it recognizes the claim already. We already looked at the language of "in response, at least in part to" a bank address signal. And the only difference here, the board continues, that the claim did not recite that the cast signals or chips signals were in response to bank address signals as well as signals one, three, and four as now are cited.

Judge Bryson (23:32):

So it's the "as well as language" that really you are finding the most compelling, I take it?

Seth Lloyd (23:40):

It's the, "as well as" and the "and," Judge Bryson, that the board recognized—"Look, we already interpreted 'in response, at least in part to.'" We said, "It simply requires using the signal in some way directly or indirectly." And the only change now to the claims is that you've added additional signals joined by the conjunction "and." Given that prosecution history and the board's own prior explanations, I think the only reasonable reading of this claim language is that you must use all four of these signals,

although you can also use other signals, and you must use them in some way in part to generate the output.

Judge O'Malley (24:17):

Counsel. The prosecution history. I mean, how, how can we actually say such a thing as prosecution history when the prosecution isn't closed?

Seth Lloyd (24:32):

Your Honor, I think just at the simple high level that we're just talking about here, in terms of the board had already said, "This is how I understand the claim language." We then built on the board's own understanding of the claim language. I think that that's just kind of relevant additional evidence, but of course I think that the plain claim language and the specification on their own already require the same results. I think we could have an academic debate about whether there could be something like disclaimer or disavowal in this context where prosecution is ongoing, but we did. We made numerous statements to the board, repeatedly, that our claims require a conjunctive construction, which I think, you know, is just sort of the cherry-on-top of all of the other intrinsic evidence, which points only one direction here.

Judge 1 (25:24):

Any more questions for Mr. Lloyd?

Judge Bryson(25:30):

Nope.

Judge O'Malley(25:30):

No.

Judge 1 (25:36):

Thank you. Then we'll hear from Ms. Hines. And we ran over a little bit, so please extend the rebuttal time [inaudible] Make it six minutes.

Unidentified Male (25:41):

Perfect, your honor.

Judge 1 (25:42):

Okay, please proceed.

Doris Hines (25:44):

Thank you very much. Let me address appendix 1-22, that counsel just addressed. And there the board was addressing the previous claims, and the claims were amended and that's important. Yes, the claims previously cited the bank address signal and that gated cast or chips select signal were generated in response to that, but the claims were amended and that's important, and the claim amendments required—and the board discusses that on the next page and appendix 1-23, that the logic element, as amended, must generate output chip select signals, gated cast signals, now in response to all four signals. And what the board says, that appendix 1-23, however, has now claimed, recognizing the

difference between what was previously claimed and the claim center is now on appeal. Claim one generates—recites the logic element, generates chips select signals in response to signals one through four, recognizing and highlighting the distinctions between the previous and new claims.

Doris Hines (27:06):

And that generation is important. And what the board did not address is the impact that claim change made on the construction and looking at the specification and how the specification addresses the generation in response to input signals. What the board found in looking at the prior art is that bank address signals operate the same way as row, row address signals, and that they operate as density transition bits. And Google's position is that apparent construction and along with a conjunctive construction is not supported by the specification, that that construction is inconsistent with the specification. Counsel also said that as long as the signal is used in some fashion or in some way—but that's not what the board said. What the board said and looking at the prior art and, and the question the board asked is, “Do the bank address signals operate as deputy transition bits?”

Doris Hines (28:11):

“Do they operate in the same way as the row address signals in [inaudible]?” That's how they were looking at them. And that analysis is incorrect. It's inconsistent with the specification. One other point with respect to the prior arts, the board and its original decision was looking at figure 1A, and council referenced figure 1A for showing a receipt and also generation of the output signals. And the board was confronted with an argument that, “Well, figure 1A is just a black box.” And the board said, “No signals that enter the logic element 40, have some purpose and effect the output signals.” The board said that at appendix 91. The board also recognized that the prior art shows bank address signals, row address signal, clock signal, all those signals. All of the recited signals are input to a logic element; the prior art discloses that.

Doris Hines (29:16):

So if it's true, with respect to the specification, that signals that enter logic element 40, have some purpose and effect the output signals, the very same thing should be true for the prior art. Instead, the board said that there wasn't sufficient evidence that to address why one skilled in the art would have recognized the logic element like [inaudible] generates chip select signals. And the board said that at appendix 1-26. But again, in looking at the specifications and the disclosure there and figure 1A, which council referenced, the board said, “well, just seeing that they are received by the logic element, accepting that they are, the fact that they enter the logic element, they would have some purpose and effect the output signals.” The same should be true with all of the pieces of prior art. And Netlist can confirm that page 37 of its brief.

Doris Hines (30:20):

Netlists relies on the board's decision at appendix 88 to 91 for the proposition that each input signal to the logic element 1A and of the 912 patent must be used in some manner, whether directly or indirectly, to generate the output signals. If that's true for the 912 patent specification and the board found it was, the same should be true as for the prior art as well. Unless there are any further questions, I have nothing more.

Judge 1 (31:00):

Any more questions for Miss Hines?

Judge Bryson(31:02):

No.

Judge 1 (31:04):

Okay. Thank you both. The case is taken under submission.

Doris Hines (31:09):

Thank you, Your Honor.