

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,  
Petitioner,

v.

INTERDIGITAL PATENT HOLDINGS, INC.,  
Patent Owner.

Case IPR2024-00305  
U.S. Patent No. 8,737,933

Title: DATA TRANSFER BETWEEN WIRELESS DEVICES

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**PETITIONER'S REPLY TO THE  
PATENT OWNER PRELIMINARY RESPONSE**

**LIST OF EXHIBITS**

**LIST OF NEWLY FILED EXHIBITS**

Exhibits concurrently filed with Petitioner's Reply To The Patent Owner

Preliminary Response:

| <b>No.</b> | <b>Description</b>                                                                                                                |
|------------|-----------------------------------------------------------------------------------------------------------------------------------|
| 1081       | Defendant Lenovo's Supplemental Notice Regarding Prior Art Invalidity Grounds, Document No. 96, Case No. 5:23-cv-00493 (E.D.N.C.) |
| 1082       | United States District Courts Judicial Caseload Profile                                                                           |

**LIST OF PREVIOUSLY FILED EXHIBITS**

| <b>No.</b> | <b>Description</b>                                                                                                                                                           |
|------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1001       | U.S. Patent No. 8,737,933 (" <b>the '933 Patent</b> ")                                                                                                                       |
| 1002       | File History of U.S. Patent No. 8,737,933                                                                                                                                    |
| 1003       | Declaration of Peter Rysavy, dated December 20, 2023 (" <b>Rysavy Decl.</b> ")                                                                                               |
| 1004       | U.S. Patent Application Pub. No. 2009/0298419 to Ahya et al. (" <b>Ahya</b> ")                                                                                               |
| 1005       | U.S. Patent Application Pub. No. 2008/0166967 to Christopher D. McKillop (" <b>McKillop</b> ")                                                                               |
| 1006       | International Patent Application Pub. No. WO 2005/1072895 to Peter Hoddie (" <b>Hoddie</b> ")                                                                                |
| 1007       | U.S. Patent Application Pub. No. 2007/0191028 to Hinckley et al. (" <b>Hinckley</b> ")                                                                                       |
| 1008       | Sidhu et al., <i>Emerging Wireless Standards – WiFi, ZigBee and WiMAX</i> , International Journal of Electronics and Communication Engineering Vol. 1 No. 1, at 43-48 (2007) |

| No.  | Description                                                                                                                                                                                                                                                 |
|------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1009 | Harry Newton, Newton's Telecom Dictionary, 20 <sup>th</sup> Updated and Expanded Edition (excerpted) (2004)                                                                                                                                                 |
| 1010 | U.S. Patent Application Pub. No. 2009/0034498 to Banerjea et al. (" <b>Banerjea</b> ")                                                                                                                                                                      |
| 1011 | N/A                                                                                                                                                                                                                                                         |
| 1012 | U.S. Patent Application Pub. No. 2007/0135046 to Kapur et al. (" <b>Kapur</b> ")                                                                                                                                                                            |
| 1013 | U.S. Patent Application Pub. No. 2009/0215398 to Adler et al. (" <b>Adler</b> ")                                                                                                                                                                            |
| 1014 | Bluetooth Specification Version 1.1, Vol. 2, "Profiles" (Feb. 22, 2001)                                                                                                                                                                                     |
| 1015 | Megowan et al., Infrared Data Association® (IrDA®) Object Exchange Protocol OBEX™ Version 1.3 (Jan. 3, 2003).                                                                                                                                               |
| 1016 | Postel et al., RFC 959, File Transfer Protocol (FTP) (Oct. 1985)                                                                                                                                                                                            |
| 1017 | K. Sollins, RFC 1350, The TFTP Protocol (Revision 2) (Jul. 1992)                                                                                                                                                                                            |
| 1018 | Frodigh et al., <i>Wireless ad hoc networking—The art of networking without a network</i> , Ericsson Review No. 4, at 248-263 (2000)                                                                                                                        |
| 1019 | U.S. Patent Application Pub. No. 2007/0146347 to Louis B. Rosenberg (" <b>Rosenberg</b> ")                                                                                                                                                                  |
| 1020 | Cheverst et al., <i>Exploring Bluetooth based Mobile Phone Interaction with the Hermes Photo Display</i> , Proceedings of the 7 <sup>th</sup> International Conference on Human Computer Interaction with Mobile Devices and Services, at 47-54 (Sep. 2005) |
| 1021 | User's Guide for Nokia N72 (2006)                                                                                                                                                                                                                           |
| 1022 | U.S. Patent No. 7,356,347 to David Kammer (" <b>Kammer</b> ")                                                                                                                                                                                               |
| 1023 | Phil Karn, <i>MACA - A New Channel Access Method for Packet Radio</i> , The Proceedings of the 9 <sup>th</sup> ARRL Computer Networking Conference, at 134-140 (1990)                                                                                       |

| No.  | Description                                                                                                                                                                                                         |
|------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1024 | Chatzimisios et al., <i>Optimisation of RTS/CTS handshake in IEEE 802.11 Wireless LANs for maximum performance</i> , IEEE Communications Society Globecom 2004 Workshops, at 270-275 (2004)                         |
| 1025 | Nokia 9500 Communicator User Guide (2004-2005)                                                                                                                                                                      |
| 1026 | User's Guide for Nokia N95 (2007)                                                                                                                                                                                   |
| 1027 | U.S. Patent Application Pub. No. 2005/0113079 to Hui Guo (" <b>Guo</b> ")                                                                                                                                           |
| 1028 | U.K. Patent Application Pub. No. GB 2,439,364 to Turner et al. (" <b>Turner</b> ")                                                                                                                                  |
| 1029 | U.S. Patent Application Pub. No. 2004/0242216 to Demetrios Boutsikakis (" <b>Boutsikakis</b> ")                                                                                                                     |
| 1030 | U.S. Patent No. 7,043,548 to Stephane Bouet (" <b>Bouet</b> ")                                                                                                                                                      |
| 1031 | Brad A. Myers, The Importance of Percent-Done Progress Indicators for Computer-Human Interfaces, Proceedings of the SIGCHI Conference on Human Factors in Computing Systems (Apr. 1985)                             |
| 1032 | U.S. Patent Application Pub. No. 2009/0140986 to Karkkainen et al. (" <b>Karkkainen</b> ")                                                                                                                          |
| 1033 | U.S. Patent Application Pub. No. 2007/0124503 to Ramos et al. (" <b>Ramos</b> ")                                                                                                                                    |
| 1034 | U.S. Patent No. 8,059,111 to Phil Harrison (" <b>Harrison</b> ")                                                                                                                                                    |
| 1035 | U.S. Patent Application Pub. No. 2006/0026521 to Hotelling et al. (" <b>Hotelling '521</b> ")                                                                                                                       |
| 1036 | Westerman et al., <i>Multi-Touch: A New Tactile 2-D Gesture Interface For Human-Computer Interaction</i> , Proceedings of the Human Factor and Ergonomic Society 45 <sup>th</sup> Annual Meeting, at 632-636 (2001) |
| 1037 | Jun Rekimoto, <i>Pick-and-Drop: A Direct Manipulation Technique for Multiple Computer Environments</i> , Proceedings of the 10th                                                                                    |

| No.  | Description                                                                                        |
|------|----------------------------------------------------------------------------------------------------|
|      | annual ACM symposium on User interface software and technology, at 31-39 (1997)                    |
| 1038 | U.S. Patent Application Pub. No. 2008/0009309 to Hwang-hyeon Gha (“ <b>Gha</b> ”)                  |
| 1039 | Pravin Bhagwat, <i>Bluetooth: Technology for Short-Range Wireless Apps</i> , at 96-103 (Jun. 2001) |
| 1040 | N/A                                                                                                |
| 1041 | N/A                                                                                                |
| 1042 | U.S. Patent Application Pub. No. 2003/0134629 to Ollis et al. (“ <b>Ollis</b> ”)                   |
| 1043 | N/A                                                                                                |
| 1044 | U.S. Patent Application Pub. No. 2006/0097991 to Hotelling et al., (“ <b>Hotelling ’991</b> ”)     |
| 1045 | U.S. Patent Application Pub. No. 2008/0168384 to Platzer et al. (“ <b>Platzer</b> ”)               |
| 1046 | U.S. Patent No. 7,479,949 to Jobs et al., (“ <b>Jobs</b> ”)                                        |
| 1047 | U.S. Patent Application Pub. No. 2008/0143685 to Lee et al. (“ <b>Lee</b> ”)                       |
| 1048 | File History of U.S. Patent No. 8,200,265                                                          |
| 1049 | U.S. Patent No. 8,200,265 to Carlton et al. (“ <b>the ’265 patent</b> ”)                           |
| 1050 | File History of U.S. Patent No. 8,478,207                                                          |
| 1051 | U.S. Patent No. 8,478,207 to Carlton et al. (“ <b>the ’207 patent</b> ”)                           |
| 1052 | N/A                                                                                                |
| 1053 | Bluetooth Specification Version 1.1, Vol. 1, “Core” (Feb. 22, 2001)                                |
| 1054 | European Patent Application Pub. No. 1,489,783 to Anders Angela (“ <b>Angelhag</b> ”)              |

| No.  | Description                                                                                                                                                                                       |
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| 1055 | U.S. Patent Application Pub. No. 2005/0289195 to Lehtola et al. (“ <b>Lehtola</b> ”)                                                                                                              |
| 1056 | N/A                                                                                                                                                                                               |
| 1057 | Information Disclosure Statement for Lehtola filed June 23, 2004                                                                                                                                  |
| 1058 | Affidavit of Nathaniel E. Frank-White, Records Request Processor at the Internet Archive (“Frank-White”) Authenticating Exhibits 1014-1015, 1053, and 1060-1062                                   |
| 1059 | Affidavit of Scott Delman, Director of Publication at the Association for Computing Machinery Authenticating Exhibit 1020                                                                         |
| 1060 | User Guide for Nokia N91 (2006)                                                                                                                                                                   |
| 1061 | User Guide for Nokia N75 (2006)                                                                                                                                                                   |
| 1062 | User Guide for Nokia 9300 (2005)                                                                                                                                                                  |
| 1063 | N/A                                                                                                                                                                                               |
| 1064 | User Guide for the Sony CLIE (2001)                                                                                                                                                               |
| 1065 | David Pogue, iPhone The Missing Manual (1 <sup>st</sup> ed. Aug. 2007)                                                                                                                            |
| 1066 | U.S. Provisional Patent Application No. 61/140,126 to Carlton et al. (“ <b>the ’126 provisional</b> ”)                                                                                            |
| 1067 | U.S. Patent Application Pub. No. 2007/0011335 to Burns et al. (“ <b>Burns</b> ”)                                                                                                                  |
| 1068 | Yardena Arar, <i>Bluetooth to work with Wi-Fi</i> , NetworkWorld (February 12, 2008)                                                                                                              |
| 1069 | Staff’s Proposed Claim Constructions, <i>Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, And Components Thereof</i> , Inv. No. 337-TA-1373 (Dec. 4, 2023)         |
| 1070 | InterDigital’s Proposed Claim Constructions, <i>Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, And Components Thereof</i> , Inv. No. 337-TA-1373 (Nov. 30, 2023) |

| No.  | Description                                                                                                                                                        |
|------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1071 | U.S. Patent No. 7,102,640 to Aholainen et al. (“ <b>Aholainen</b> ”)                                                                                               |
| 1072 | U.S. Patent Application No. 12/128,497 to Ahya et al. (“ <b>As-Filed Ahya Application</b> ”)                                                                       |
| 1073 | Full Claims Listing (1-9, 11, 13-14, 20-31, 33, 35-36, 42-44)                                                                                                      |
| 1074 | U.S. Patent Application Pub. No. 2005/0281237 to Heinonen et al. (“ <b>Heinonen</b> ”)                                                                             |
| 1075 | International Patent Application Pub. No. WO 2006/092505 to Olivier Chouraki (“ <b>Chouraki</b> ”)                                                                 |
| 1076 | U.S. Patent Application Pub. No. US 2003/0018744 to Johanson et al. (“ <b>Johanson</b> ”)                                                                          |
| 1077 | BLUETOOTH TECHNOLOGY TO HARNESS THE SPEED OF 802.11, Bluetooth SIG Press Release (Feb. 11, 2008) (Archived by Internet Archive’s Wayback Machine on Feb. 14, 2008) |
| 1078 | Megowan et al., Infrared Data Association® (IrDA®) Object Exchange Protocol OBEX™ Version 1.5 (Aug. 14, 2009).                                                     |
| 1079 | U.S. Patent No. 7,333,514 to Anehem et al. (“ <b>Anehem</b> ”)                                                                                                     |
| 1080 | U.S. Patent Application No. 11/804,359 to McKillop et al. (“ <b>As-Filed McKillop Application</b> ”)                                                               |

Pursuant to the Board email of April 16, 2024, Petitioner submits this Reply to the POPR (Paper 9). Contrary to the POPR's assertions, *Fintiv* factors 2-4 and 6 each weighs against discretionary denial. As these factors together greatly outweigh Factor 5 (same parties), and Factor 1 is neutral, the Board should institute IPR.

***Factor 2 (trial date)*** strongly favors institution because no trial date has been set and any trial would take place April 2026 or later, roughly ten months after the projected final written decision date of June 2025. The most recent median time-to-trial in the Eastern District of North Carolina is 31.2 months. EX1082, 21. For a complaint filed September 1, 2023 (*e.g.*, Paper 9, 14), the expected trial date is thus April 2026. Given the June 28, 2024, institution decision deadline, an FWD would be due here by June 28, 2025. 35 USC §§ 314(b), 316(a)(11). An FWD roughly 10 months before the expected district court trial weights factor 2 against denial. *E.g.*, *Apple Inc., v. Fintiv, Inc.*, IPR2022-00976, Paper 9 at 10-11 (Nov. 15, 2022); USPTO Memo., Interim Procedure for Discretionary Denials (June 21, 2022) (“Vidal Memo,” filed as EX2002), 9. The POPR notes the ITC proceeding (*e.g.*, Paper 9 at 13), but that has no bearing on the *Fintiv* analysis. Vidal Memo, 3.

***Factor 3 (investment in the district court)*** favors institution given the limited investment in these patents in the district court and the prompt filing of the petition.

The parties “have prepared and exchanged infringement and invalidity contentions [and] presented initial disclosures” (POPR, 14), but the exchanged

contentions are preliminary in nature and require much further investment by the parties, thus disfavoring denial. Patent Owner does not allege that depositions have taken place or that significant document production has occurred. Close of fact discovery is triggered 90 days after the court's claim construction order (EX2003, 2) and the POPR does not even speculate when that might issue. The expert discovery schedule remains undetermined. Given this minimal investment in the district court, factor 3 strongly favors institution. *E.g.*, *NetNut LTD. v. Bright Data LTD.*, IPR2021-01492, Paper 12 at 11-12 (Mar. 21, 2022); *PEAG LLC v. VARTA Microbattery GmbH*, IPR2020-01212, Paper 8 at 17-20 (Jan. 6, 2021).

Moreover, factor 3 weighs against denial because Petitioner filed the petition "promptly," less than three weeks after infringement contentions and roughly three months after service of the complaint. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 11 (Mar. 20, 2020) (precedential); Petition, 3.

While the POPR cites *Markman* briefing and argument (POPR, 14), it fails to reveal that the '933 and '054 patents are not a part of the *Markman* process. The only claim terms being briefed and argued in district court are from other asserted patents that involve unrelated video CODEC technology.<sup>1</sup> Thus, the *Markman* process will

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<sup>1</sup> Petitioner requested to file the Joint Claim Construction Statements (Documents 78 and 88 in Case No. 5:23-cv-00493 (E.D.N.C.) but was not given leave to do so.

not decide any issues or expend any time or resources related to the '933 patent challenged in this IPR, further weighting Factor 3 against discretionary denial.

**Factor 4 (overlap of issues)** favors institution because district court defendant Lenovo filed a stipulation agreeing not to raise the same prior art grounds in district court if IPR is instituted. EX1081; *Sand Rev. II, LLC v. Cont'l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 (Jun. 16, 2020) (informative).

**Factor 6 (other factors)** need not be evaluated, as the balance of Factors 1-5 weigh against discretionary denial. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4-5 (Feb. 27, 2023) (precedential). If the Board considers Factor 6, compelling merits favor institution. The POPR's failure to identify any alleged deficiency in the petition's prior art grounds shows that "the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable." *Id.* at 3-4 (quoting Vidal Memo at 4).

For Factor 6, the POPR relies on a faulty secondary considerations argument regarding alleged success, praise, and copying of third party Apple AirDrop technology. POPR, 17. Setting aside that AirDrop released before the '933 named inventors thought to describe the claimed invention (Petition, 12-13) and many other deficiencies, this argument fails at least for a lack of nexus to the challenged claims.

The POPR does not allege a presumption of nexus. *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019).

The POPR purports to show nexus with supposed claim mappings to Apple AirPods Products (POPR, 21-44) but even *arguendo* taking these mappings at face value, that is insufficient for nexus. The POPR does not show that any of AirPods's alleged commercial success and industry praise are "the 'direct result of the unique characteristics of *the claimed invention*.'" *Fox Factory*, 944 F.3d at 1374 (emphasis added) (citations omitted). The POPR alludes to a license with Apple,<sup>2</sup> urging that it shows success of the claimed technology. POPR, 43-44. But no license is of record, much less a license to the '933 patent. And contrary to the POPR, Patent Owner's exhibits suggest that any Apple license (if one even exists) pre-dates the '933 patent and includes thousands of other patents. EX2019, 2-3 ("Apple has been our licensee since 2007"); EX2018, 4 ("portfolio of approximately 28,800 patents").

In any event, supposed secondary considerations do not undermine the compelling challenge presented by the Petition. Factor 6 weighs against discretionary denial and IPR should be instituted.

Respectfully submitted,

Dated: April 22, 2024

By: /Andrew M. Mason/

Andrew M. Mason (Reg. No. 64,034)

andrew.mason@klarquist.com

KLARQUIST SPARKMAN, LLP

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<sup>2</sup> Petitioner is not a party to the ITC proceeding and has not received this license or any related interrogatory responses, which presumably fall under a protective order.

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Tel: 503-595-5300  
Fax: 503-595-5301

Counsel for Petitioner

**CERTIFICATE OF SERVICE  
IN COMPLIANCE WITH 37 C.F.R. § 42.6 (E)(4)**

The undersigned certifies that on April 22, 2024, a complete copy of  
**PETITIONER'S REPLY TO THE PATENT OWNER PRELIMINARY  
RESPONSE** was served on counsel for the Patent Owner via electronic mail as  
follows:

Scott W. Hejny  
Richard A. Kamprath  
McKool Smith P.C.  
300 Crescent Court, Suite 1200  
Dallas, TX 75201  
Email: shejny@mckoolsmith.com  
rkamprath@mckoolsmith.com

George T. Fishback, Jr.  
McKool Smith P.C.  
303 Colorado Street, Suite 2100  
Austin, TX 78701  
Email: gfishback@mckoolsmith.com

By: /Andrew M. Mason/  
Andrew M. Mason (Reg. No. 64,034)  
andrew.mason@klarquist.com  
KLARQUIST SPARKMAN, LLP  
One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Tel: 503-595-5300  
Fax: 503-595-5301

Counsel for Petitioner