

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

INTERDIGITAL PATENT HOLDINGS, INC.,
Patent Owner.

IPR2024-00537
Patent 8,737,933 B2

Before JAMESON LEE, JOHN F. HORVATH, and LISA A. MURRAY,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Microsoft Corporation (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–9, 11, 13, 14, 20–31, 33, 35, 36, and 42–44 (“the challenged claims”) of U.S. Patent No. 8,737,933 B2 (Ex. 1001, “the ’933 patent”). Paper 3 (“Pet.”), 1. Interdigital Patent Holdings, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With Board authorization, Petitioner filed a Preliminary Reply (Paper 8, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-Reply (Paper 9, “Prelim. Sur-Reply”).¹ We have jurisdiction and authority under 35 U.S.C. §§ 6, 314 and 37 C.F.R. § 42.4.

Upon consideration of the Petition, Preliminary Response, Preliminary Reply, and Preliminary Sur-Reply, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’933 patent. Accordingly, we institute *inter partes* review of all challenged claims on all grounds raised.

¹ Our authorization limited the Preliminary Reply to a discussion of the relevance of Lenovo’s *Sand II* stipulation, the presence or absence of a district court trial date, the district court’s median time-to-trial statistics, and any alleged inaccuracies in the *Fintiv* analysis presented in the Preliminary Response. *See* Ex. 2013, 1. Petitioner exceeded that scope by including a rebuttal of Patent Owner’s written description support argument. *See* Prelim. Reply, 2–4. However, instead of moving to strike the Preliminary Reply, Patent Owner addressed its merits. *See* Prelim. Sur-Reply, 1–3. In this decision, we do not consider the improper written description rebuttal arguments raised in the Preliminary Reply. Further, we caution the parties that filing papers exceeding Board authorization can result in the imposition of an appropriate sanction, including striking the offending paper. *See* 37 C.F.R. §§ 42.12(a)(1), (b)(2).

B. Real Parties-in-Interest

Petitioner identifies itself, Lenovo, Inc., Lenovo PC HK Ltd., Lenovo Group, Ltd., and Motorola Mobility, LLC, as real parties-in-interest. Pet., xiii. Patent Owner identifies itself, InterDigital, Inc., InterDigital VC Holdings, Inc., and InterDigital Madison Patent Holdings SAS as real parties-in-interest. Paper 5, 2.

C. Related Matters

Petitioner identifies *Interdigital, Inc. v. Lenovo Group, Ltd.*, 5:23-cv-00493 (E.D.N.C.), as a district court proceeding; *Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, and Components Thereof*, 337-TA-1373 (ITC) as an International Trade Commission proceeding, and *Microsoft Corp. v. InterDigital Patent Holdings, Inc.*, IPR2024-00305 as a Patent Office proceeding that can affect or be affected by this proceeding. Pet., xii; Paper 8, 1. Patent Owner identifies the same proceedings. Paper 4, 2. We identify IPR2024-00306 and IPR2024-00538 as additional relevant Patent Office proceedings.

D. The '933 Patent

The '933 patent is directed to “[a] method for controlling communication of data in wireless communications.” Ex. 1201, 1:46–47. A portion of the method is illustrated in Figure 4, which is reproduced below.

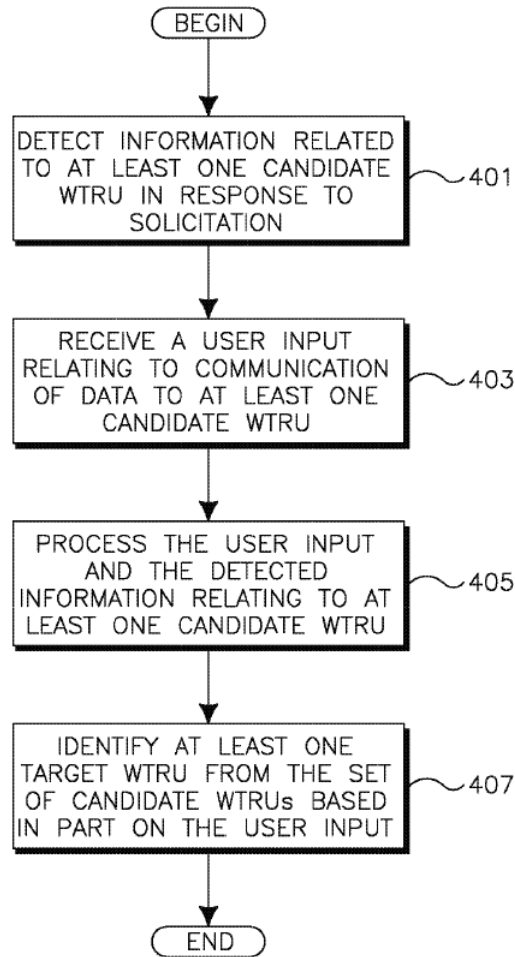


FIG. 4

Figure 4 is “a block diagram of a method of communicating data between wireless devices.” *Id.* at 2:8–9. Per the method, a user device’s wireless transmit/receive unit (WTRU) 101 solicits and receives information from at least one candidate WTRU 101c in its vicinity. *Id.* at 7:8–11 (step 401). WTRU 101 then receives user input “related to the communication of data from the sending WTRU 101 to at least one candidate WTRU 101c.” *Id.* at 7:11–15 (step 403). The user input and information are processed (step 405) to identify a target WTRU 101c,t (step 407). *Id.* at 7:15–22. WTRU 101 then sends selected data to WTRU 101c,t. *Id.* at 8:46–50.

E. Illustrative Claim

Claims 1 and 23 are independent and recite, respectively, a method performed by a WTRU and a WTRU configured to perform the method. Ex. 1001, 10:54–67, 12:8–21. Claims 2–9, 11, 13, 14, and 20–22 depend directly or indirectly from claim 1 and claims 24–31, 33, 35, 36, and 42–44 depend directly or indirectly from claim 23. *Id.* at 11:1–13:27. Claim 1, which is illustrative of the challenged claims, is reproduced below.

1. A method performed by a wireless transmit/receive unit (WTRU), the method comprising:

processing, by the WTRU, a touchscreen input to select a media element;

detecting, by the WTRU using Bluetooth, a plurality of WTRUs in proximity to the WTRU;

processing, by the WTRU, another touchscreen input to select a WTRU of the plurality of WTRUs;

sending, by the WTRU, a message to transfer the selected media element to the selected WTRU;

receiving, by the WTRU, an acceptance to transfer the selected media element to the selected WTRU; and

transferring, by the WTRU using a WiFi communication, the selected media element to the selected WTRU.

Id. at 10:54–67.

F. Evidence

Reference		Effective Date	Exhibit
Forutanpour	US 2011/0083111 A1	Apr. 7, 2011	1204
Hoddie	WO 2005/107285 A1	Nov. 10, 2005	1206
Hinckley	US 2007/0191028 A1	Aug. 16, 2007	1207
Heinonen	US 2005/0281237 A1	Dec. 22, 2005	1274

Petitioner also relies upon the Declaration of Peter Rysavy. Ex.1203.
Patent Owner relies on the Declaration of George Edwards. Ex. 2001.

G. Asserted Grounds

Petitioner asserts the challenged claims are unpatentable on the following grounds:

Ground	Claims	35 U.S.C. §	References
1	1, 3–8, 11, 13, 14, 20–23, 25–30, 33, 35, 36, 42–44	102	Forutanpour
2	1–9, 11, 13, 14, 20–31, 33, 35, 36, 42–44	103	Forutanpour
3	2, 24	103	Forutanpour, Hinckley
4	11, 33	103	Forutanpour, Hoddie
5	9, 31	103	Forutanpour, Heinonen

II. ANALYSIS

A. Discretionary Denial

We have discretion under § 314(a) to deny any petition for *inter partes* review. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)).

In exercising discretion under 35 U.S.C. § 314(a), the Board may consider “events in other proceedings related to the same patent.” Consolidated Trial Practice Guide November 2019² at 58. When a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding, the Board considers and balances several factors

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

affecting system efficiency, fairness, and patent quality. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). These include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 6. “[I]n evaluating these factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* The Director has provided guidance on applying the *Fintiv* factors. *See* Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) (“*Fintiv Memo*”).³

Petitioner argues its Petition should not be discretionarily denied because “the district court complaint was served less than five months ago . . . and there is not yet a trial date” and because Patent Owner first asserted

³ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

dependent claims “just over two months before the filing of this [P]etition.”

Pet. 3. Patent Owner argues we should discretionarily deny the Petition because “Petitioner and its real-party-in-interest, Lenovo, are seeking four bites at the validity apple” by filing two IPR petitions as well as challenging the ’933 patent’s validity in the ITC and district court cases. Prelim. Resp. 7–8. For the reasons explained below, we decline to exercise our discretion to deny institution of *inter partes* review.

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Patent Owner argues that because Petitioner’s RPI has not filed IPRs “against all of the patents in suit in the district court case” it is “unlikely that the court would stay the case.” Prelim. Resp. 10; Prelim. Sur-Reply 4. Thus, Patent Owner contends, this factor weighs in favor of discretionary denial. *Id.* Petitioner contends this factor “is neutral at best.” Prelim. Reply 1.

Neither party has introduced evidence that a stay of the district court proceeding was requested, granted, or denied, and we will not speculate on whether a stay would be granted or denied should one be requested. Accordingly, we find factor 1 is neutral.

2. proximity of the District Court’s trial date to the Board’s projected statutory deadline for a final written decision

Patent Owner argues this factor is neutral because “[a] trial date has not been set by the Court in the Eastern District of North Carolina” and because “Petitioner is asking the Board to speculate as to the trial date.” Prelim. Resp. 10; Prelim. Sur-Reply 4. Petitioner argues this factor “strongly favors institution because no trial date has been set” and, given the complaint’s filing date and the district court’s median time-to-trial statistics,

the most likely trial date is in “April 2026, roughly eight months after an FWD [final written decision], assuming an August 28, 2024, institution” date. Prelim. Reply 1 (citing Ex. 1284, 21).

We find this factor weighs heavily against exercising discretion to deny institution. *Fintiv* seeks to “minimize potential conflict between the Patent Trial and Appeal Board (PTAB) and district court proceedings.” *Fintiv* Memo, 1; *see also Fintiv*, Paper 11 at 5 (introducing factors to weigh “[w]hen the patent owner raises an argument for discretionary denial . . . *due to an earlier trial date*”) (emphasis added). Because the district court has not set a trial date, and the trial court statistics indicate any trial is likely to occur months after a Final Written Decision in this proceeding, we see little potential for conflicting Board and district court decisions.

3. *investment in the parallel proceeding by the court and the parties*

Patent Owner argues this factor weighs in favor of discretionary denial because the parties “have prepared and exchanged infringement and invalidity contentions, presented initial disclosures, and are in the midst of fact discovery and motion practice.” Prelim. Resp. 11 (citing Ex. 2003, 15); Prelim. Sur-Reply 4. Patent Owner further argues this factor weighs in favor of denying institution because the parties will have completed claim construction briefing by May 23, 2024⁴ and, although “the court has not set a date for a claim construction hearing,” such a hearing is likely to “take place prior to an institution decision in this case.” *Id.*

Petitioner argues this factor weighs against discretionary denial because the district court “has not issued a *Markman* order and thus no set

⁴ Although Patent Owner’s Preliminary Response was filed on May 28, 2024, the Response did not indicate whether the parties had, in fact, completed claim construction briefing by May 23, 2024.

dates exist for the close of fact or expert discovery or the filing of dispositive motions” and because “Patent Owner does not allege that depositions have taken place or that significant document production has occurred.” Prelim. Reply 2 (citing Ex. 2003, 8, 15–16).

We find this factor weighs against discretionary denial. As set forth in the district court’s scheduling order, dispositive motions in that case “shall be filed 30 days after the close of expert discovery,” which begins “30 days after the close of fact discovery,” which ends “90 days after entry of [a] claim construction order.” Ex. 2003, 8, 15–16. Because the district court has yet to issue a claim construction order, no set dates exist for the close of fact or expert discovery, or the filing of dispositive motions. Thus, this factor weighs against discretionary denial. *See Fintiv*, Paper 11 at 10 (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.”).

4. *overlap between issues raised in the petition and in the parallel proceeding*

Patent Owner argues that although Petitioner’s RPI filed a *Sand Revolution*⁵ type stipulation in the district court case, this factor weighs “only slightly against discretionary denial” because “Petitioner could raise substantially the same arguments in district court using prior art references that did not ‘form[] the basis of any instituted ground’” in this proceeding. Prelim. Resp. 12–13 (quoting *Samsung Electronics Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01092, Paper 11 at 15–17 (PTAB, Jan. 8, 20024); Prelim. Sur-Reply 4. Petitioner argues this factor weighs against

⁵ *Sand Rev. II, LLC v. Cont’l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative).

discretionary denial because its RPI “filed a stipulation agreeing not to raise the same prior art grounds in district court if IPR is instituted.” Prelim. Reply 2 (citing Ex. 1283).

We find this factor weighs against discretionary denial. Although Petitioner’s RPI has stipulated that “should the PTAB institute IPR in IPR2024-00537 . . . [it] will not pursue the same grounds in district court litigation for the ’933 patent as are presented in IPR2024-00537,” the stipulation leaves open the possibility that Petitioner’s RPI will challenge the claims of the ’933 patent on substantially similar grounds. Consequently, although the stipulation “mitigates to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” it does not entirely eliminate these concerns. *See Sand Revolution II*, Paper 24 at 12.

5. *whether the petitioner and the defendant in the parallel proceeding are the same party*

Patent Owner argues “this factor weighs in favor [o]f denying institution” because Petitioner and its “identified real-party-in-interest, Lenovo, are the same parties in the related district court litigation.” Prelim. Resp. 13 (citing *Fintiv*, Paper 11 at 15). Petitioner does not address this factor. Prelim. Reply 2.

We find this factor weighs slightly in favor of discretionary denial. This factor moderates the other *Fintiv* factors based on whether petitioner and the district court defendant are the same or related parties. For example, if a district court denied a stay request, factor 1 would weigh in favor of discretionary denial if the parties were the same or related, but would be neutral if the parties were not. In the latter case, a district court decision denying the stay of an unrelated party’s litigation would not impede an

independent petitioner's right to challenge the patentability of the same claims in an IPR proceeding. Here, because the district court defendants and Petitioner are RPIs, this factor slightly favors discretionary denial.

6. other circumstances that impact the Board's exercise of discretion, including the merits

Patent Owner argues this factor weighs in favor of denying institution because "there is no 'compelling challenge' of invalidity on the merits of the Petition." Prelim. Resp. 13–14. Petitioner argues this factor "need not be evaluated since Factors 1-5 weigh against discretionary denial." Prelim. Reply 2. Petitioner further argues that, should we consider it, factor 6 weighs against discretionary denial because Patent Owner "does not dispute that the asserted art (Forutanpour) satisfies all claim elements" but, instead, incorrectly contends "that Forutanpour is not prior art because the challenged claims are entitled to . . . [an] earlier filing date." *Id.* at 2–3. Patent Owner argues this argument is a straw man because "Forutanpour is, without question, not prior art to the '933 . . . Patent[]." Prelim. Sur-Reply, 1.

We find this factor weighs against discretionary denial. Factor 6 does not always require a compelling merits analysis because, like the other factors, it is "part of a balanced assessment of all the relevant circumstances in the case." *Fintiv*, Paper 11 at 14. The goal of that assessment is to determine "whether efficiency and integrity of the system are best served by denying or instituting review." *Id.* at 6. Per factor 6, this requires a consideration of the merits, but that "is not to suggest that a full merits analysis is necessary." *Id.* at 15. Instead, "the strengths or weaknesses regarding the merits" are considered as part of the balanced assessment of all factors. *Id.* at 15–16. A compelling merits analysis is only needed when the

other *Fintiv* factors favor discretionary denial because “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” *Fintiv* Memo at 5. Here, because we do not find *Fintiv* factors 1–5 favor discretionary denial, we need not perform a compelling merits analysis. Nonetheless, because we find Petitioner has demonstrated a reasonable likelihood of showing one or more claims of the ’933 patent unpatentable for the reasons stated below, we find factor 6 weighs against discretionary denial.

7. *Conclusion regarding discretionary denial*

For the reasons explained above, we find factor 1 is neutral, factor 2 weighs heavily against discretionary denial, factors 3, 4, and 6 weigh against discretionary denial, and factor 5 weighs slightly in favor of discretionary denial. Weighed together, we find the *Fintiv* factors weigh against discretionary denial and, accordingly, deny Patent Owner’s request for discretionary denial.

B. *Level of Ordinary Skill in the Art*

Petitioner identifies a person of ordinary skill in the art (“POSITA”) at the time of the invention as someone that would have had “a bachelor’s degree in computer science, electrical engineering, computer engineering, or a closely related field, and one to three years of experience working with wirelessly connected mobile devices that used common wireless communications protocols such as Bluetooth and 802.11.” Pet. 17 (citing Ex. 1203 ¶¶ 29–32). Petitioner also contends that this description “would not differ materially between December 2008 and June 2013,” the earliest possible priority date for the ’933 patent and the priority date alleged by Petitioner, respectively. Petitioner further contends that more education “would compensate for less work experience and vice versa.” *Id.* Patent

Owner does not dispute Petitioner’s definition of a POSITA at this stage of the proceeding or offer an alternative. Prelim. Resp. 7.

“[T]he level of skill in the art is a prism or lens through which a judge, jury, or the Board views the prior art and the claimed invention.” *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). At this stage of the proceeding, we find Petitioner’s assessment of the level of skill in the art to be reasonable and commensurate with the problems and solutions disclosed in the prior art. *See In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Accordingly, for purposes of this Decision, we adopt Petitioner’s description as our own.

C. Claim Construction

In *inter partes* reviews, we interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). Under this standard, a claim is construed “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* Only claim terms which are in controversy need to be construed and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner construes the claims to have their “plain and ordinary meaning” and contends “that no terms invoke means-plus-function analysis.” Pet. 17–18. Patent Owner does not contend that any terms require construction. Prelim. Resp. 7. At this stage of the proceeding, because the parties do not dispute the meaning of any claim terms and none appear to require construction, we offer no express constructions for any claim terms. *See Nidec Motor*, 868 F.3d at 1017.

D. Earliest Effective Priority Date of the Challenged Claims

All of the challenged claims recite the following limitations: a WTRU detecting or configured to detect “using Bluetooth, a plurality of WTRUs in proximity to the WTRU” and transferring or configured to transfer “using a WiFi communication, [a] selected media element to [a] selected WTRU.” Ex. 1001, 10:58–59, 10:66–67, 12:11–12, 12:20–21.

Petitioner argues Forutanpour, published on April 7, 2011, is prior art to the challenged claims under 35 U.S.C. § 102(a)(1) because “Patent Owner cannot show entitlement to an effective filing date earlier than the June 28, 2013, filing date of the application that led to the ’933 patent.” Pet. 18, 72. Specifically, Petitioner argues that Patent Owner cannot show the inventors were in “possession of the claimed method that requires using Bluetooth to detect nearby devices and then using WiFi to transfer a media element to one of the detected devices.” *Id.* at 19. Patent Owner disagrees, arguing the challenged claims “are entitled to a priority date of at least as early as December 22, 2009,” the date the ’933’s grandparent application⁶ was filed. Prelim. Resp. 14. Therefore, Patent Owner argues, “all of Petitioner’s Grounds—which rely on Forutanpour as the primary reference—fail.” *Id.*

At this stage of the proceeding, Petitioner bears the burden of demonstrating a reasonable likelihood of prevailing with respect to at least one challenged claim. 35 U.S.C. § 316(e). To meet that burden, Petitioner must initially produce and apply art that “existed as of the date of invention, presumed to be the filing date of the [challenged patent] until an earlier date is proved.” *Bausch & Lomb, Inc. v. Barnes–Hind/Hydrocurve, Inc.*, 796

⁶ U.S. Application No. 12/644,948 (hereafter, the “grandparent application” or “the ’948 application”).

F.2d 443, 449 (Fed. Cir. 1986); *see also Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015) (finding petitioner met its initial burden of production by asserting art having an effective date that was before the filing date of the challenged patent).

As noted above, Petitioner contends the challenged claims have an effective priority date of June 28, 2013, the date the '933 patent was filed, and are anticipated by or rendered obvious over Forutanpour, an application that was published on April 7, 2011. Petitioner, therefore, meets its initial burden of production, and a “burden of going forward with evidence and argument to the contrary” shifts to Patent Owner. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1329 (Fed. Cir. 2008). Patent Owner can meet this burden by providing evidence and argument that Forutanpour does not anticipate or render obvious the challenged claims or that Forutanpour is not prior art because the challenged claims are “entitled to the benefit of a filing date prior to the alleged prior art.” *Id.* at 1327; *see also In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011) (“[A] patent’s claims are not entitled to an earlier priority date merely because the patentee claims priority. . . . Rather . . . the patentee must demonstrate that the claims meet the requirements of 35 U.S.C. § 120.”).

To demonstrate the challenged claims are entitled to an earlier effective priority date, Patent Owner must introduce evidence and arguments showing “the written description in the earlier application supports the [challenged] claim[s].” *Tech. Licensing*, 545 F.3d at 1327; *id.* at 1326 (“[A] claim in a later application receives the benefit of the filing date of an earlier application so long as the disclosure in the earlier application meets the requirements of 35 U.S.C. § 112, ¶ 1, including the written description requirement, with respect to that claim.”). To satisfy the written description

requirement, the earlier application must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in *possession of the invention*.” *Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed.Cir.1991) (emphasis in original). This “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). The earlier application must describe the claimed invention in sufficient detail that a skilled artisan would understand “the inventor actually invented the invention claimed.” *Id.* For each claim limitation, the skilled artisan must be able to “immediately discern the limitation” from the disclosure in the earlier application. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). That said,

While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, *all the limitations must appear in the specification*. The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.

Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571–72 (Fed. Cir. 1997) (emphasis added). In other words, “[e]ntitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed.” *Id.*

“Whether the description requirement is met is a question of fact.” *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir.

1985); *see also In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1318 (Fed. Cir. 2011) (“Written description is a factual inquiry.”). Although Patent Owner bears the burden of producing evidence and argument supporting its priority claim, Petitioner retains the burden of persuasion that the claims are anticipated by or rendered obvious over Foruntapour. *See Tech. Licensing*, 545 F.3d at 1328 (Once Patent Owner produces “evidence and argument in support of the earlier filing date . . . the burden of going forward again shifts to [Ppetitioner] to convince the [Board] that [Patent Owner] is not entitled to the benefit of the earlier filing date.”). Thus, Petitioner retains the burden of demonstrating a reasonable likelihood of showing Foruntapour is prior art to the challenged claims.

Patent Owner sets forth several arguments, based on disclosures in the ’933’s grandparent application, that the challenged claims are entitled to claim priority to the grandparent’s December 22, 2009 filing date. *See* Prelim. Resp. 14–46. First, Patent Owner argues the grandparent discloses a WTRU whose communication peripheral 107 can be “implemented as a wireless personal area network (WPAN) device, for example Bluetooth®, Wireless Universal Serial Bus (W-USB) or WiFi® in an ad-hoc mode.” Prelim. Resp. 17 (quoting Ex. 1282 ¶ 24). Moreover, the grandparent discloses the peripheral can include “technologies such as a third generation partnership (3GPP) second or third generation standards (2G/3G) modem, Bluetooth® or WiFi®” and that “[a]ny combination or all of these communication technologies may be implemented in a single component design.” *Id.* at 17–18 (quoting Ex. 1282 ¶ 24). Patent Owner further argues the grandparent discloses software that can be “configured to implement a method of data transfer” between sending and receiving WTRUs. *Id.* at 17 (quoting Ex. 1282 ¶ 24). Patent Owner argues these “disclosure[s] alone

satisf[y] the written description requirement of § 112” and “demonstrate[] that the inventors were in possession of the claimed invention . . . because the ’948 Application contemplates using a combination of Bluetooth and WiFi in a ‘single component design.’” *Id.* at 18–19.

Next, Patent Owner argues the grandparent application discloses the WTRU can discover environmental information “via a service discovery protocol (SDP) such as currently available in protocols such as Bluetooth®” and discover device services, such as the data transfer application services supported “by other WTRUs operating in the local environment.” Prelim. Resp. 19 (quoting Ex. 1282 ¶ 34). Moreover, the grandparent discloses using this discovered environmental information “to develop configuration information and transmission instructions ‘for implementing the transfer of data through specific components in the communication peripheral.’” *Id.* at 19 (quoting Ex. 1282 ¶ 39). Patent Owner argues a person skilled in the art would have known that these transmission instructions could have “indicate[d] that WiFi should be used to transfer data to the target” because the grandparent discloses the WTRU’s peripheral device can implement any combination of 3GPP, Bluetooth, or WiFi “in a single component design.” *Id.* at 21 (quoting Ex. 1282 ¶ 24, citing Ex. 2001 ¶¶ 80–81). Patent Owner argues this is so because a skilled artisan would have known that environmental information could have been gathered “from a low-power communication protocol like Bluetooth” and that “WiFi offered better transmission speeds as an advantage over Bluetooth.” *Id.* at 21–22 (citing Ex. 2001 ¶¶ 82–83).

Lastly, Patent Owner argues that when one of the inventors of the ’933 patent was deposed in the related ITC proceeding, his testimony demonstrated that “the inventors of the ’948 Application and ’933 Patent

clearly contemplated Bluetooth detection of nearby WTRUs, WiFi data transfer . . . between a sending WTRU and a receiving (target) WTRU, and the use of both Bluetooth detection and WiFi transfer [sic] within a single method or device.” Prelim. Resp. 26. Patent Owner argues the inventor’s testimony is relevant because “[t]he Federal Circuit has held that ‘[a]n inventor is a competent witness to explain the invention and what was intended to be conveyed by the specification and covered by the claims.’” *Id.* at 23 (quoting *Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1044 (Fed. Cir. 2019)).

Patent Owner argues that the inventor, in his ITC testimony, identified cellular (e.g., 2G/3G) and WiFi as known ways to perform data transfer and Zigbee and Bluetooth as known ways to perform proximity detection. *Id.* at 24–25 (citing Ex. 2006, 58:14–59:9, 64:2–17). Patent Owner further argues that the inventor, when asked about “using Bluetooth for detecting target WTRUs and WiFi for transferring data,” testified that “the way I am looking at the problem we’re trying to solve here, right, Bluetooth is usually more of a proximity technology. This paragraph refers to a data transmission technology. I think, for that, we would be leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth.” *Id.* at 25–26 (quoting Ex. 2006, 155:18–156:6) (emphasis omitted).

At this stage of the proceeding, we do not find the evidence and argument presented by Patent Owner sufficient to find Petitioner has failed to demonstrate a reasonable likelihood that it will be able to show Foruntapour is prior art. First, Petitioner has not had the opportunity to rebut Patent Owner’s evidence and argument regarding the effective filing date of the claimed invention, which due process requires because Petitioner bears

the ultimate burden of proof on this issue. *See Tech. Licensing*, 545 F.3d at 1328.

Second, our preliminary understanding of paragraphs 24, 34, and 39 of the grandparent application is that they disclose a WTRU having a communication peripheral that can (a) operate in Bluetooth or WiFi mode, (b) use Bluetooth to discover nearby devices and services, (c) transfer data to nearby devices, and (d) use discovered environmental information to determine which components are needed to effect data transfer. But they do not expressly disclose using Bluetooth to discover a nearby WTRU and WiFi to transfer data to that WTRU.

Although a person skilled in the art may have found it obvious from the disclosures in the grandparent application identified by Patent Owner to use Bluetooth for device discovery and WiFi for data transfer, written description support requires actual disclosure of a claimed invention, not disclosure that would render the invention obvious. *See Lockwood*, 107 F.3d at 1572 (“One shows that one is ‘in possession’ of the *invention* by describing the *invention*, with all its claimed limitations, not that which makes it obvious.”); *id.* (“It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”); *Hyatt v. Boone*, 146 F.3d 1348, 1353–54 (Fed. Cir. 1998) (“It is ‘not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure.... Rather, it is a question whether the application necessarily discloses that particular device.’”) (citations omitted).

Third, our preliminary understanding of the inventor’s ITC testimony is that it does not indicate the grandparent application discloses using Bluetooth for device detection and WiFi for data transfer. For example, although the inventor identified WiFi as a known method of data transfer, he did so in response to the question “What were the known ways to transfer data that he^[7] refers to?” rather than in response to any question regarding disclosures in the grandparent application. Ex. 2006, 58:14–20. We note the term “WiFi” appears only three times in the grandparent application, and not once does the application disclose using WiFi to transfer data, let alone to transfer data to a device discovered using Bluetooth. *See* Ex. 1282 ¶¶ 24, 31. Moreover, when the inventor was asked whether it was fair to characterize the application as not specifically disclosing “using WiFi to transfer data,” the inventor responded affirmatively: “If you’re saying that WiFi is not specifically mentioned, no, it’s not specifically mentioned.” Ex. 2006, 155:2–11. Instead, the inventor testified that the way he now reads the application: “WiFi is certainly one of the things we had in mind.” *Id.* at 155:12–16. But written description support is not based on what an inventor “had in mind” or intended to convey in an application. Instead, it is based on what an inventor actually disclosed in the application. *See Lockwood*, 107 F.3d at 1571–72.

For all of the reasons discussed above, at this stage of the proceeding, we find Petitioner is reasonably likely to demonstrate that the challenged claims are only entitled to claim priority to the June 28, 2013 filing date of

⁷ We note that Patent Owner has provided only several pages of the inventor’s deposition transcript. Thus, we do not know who “he” refers to in this question. Nor do we have a complete understanding of the full scope of the question.

the '933 patent and that Forutanpour is prior art to the challenged claims under 35 U.S.C. § 102(a)(1).

E. Anticipation / Obviousness over Forutanpour

Petitioner contends claims 1, 3–8, 11, 13, 14, 20–23, 25–30, 33, 35, 36, and 42–44 are anticipated by and/or obvious over Forutanpour and claims 2, 9, 24, and 31 are obvious over Forutanpour. Pet. 36–55. Patent Owner argues Forutanpour is not prior art to the challenged claims, which are entitled to an effective filing date of December 22, 2009. Prelim. Resp. 7–46. At this stage of the proceeding, we disagree with Patent Owner’s contentions and find Petitioner demonstrates a reasonable likelihood of showing Forutanpour is prior art to the challenged claims for the reasons discussed above. Moreover, we find Petitioner demonstrates a reasonable likelihood of showing the challenged claims are anticipated by or obvious over Forutanpour for the reasons discussed below.

1. Forutanpour

Forutanpour discloses “a gesture based user interface for activating a file sharing function.” Ex. 1204 ¶ 2. The interface is shown, for example, in Figure 9, which is reproduced below.

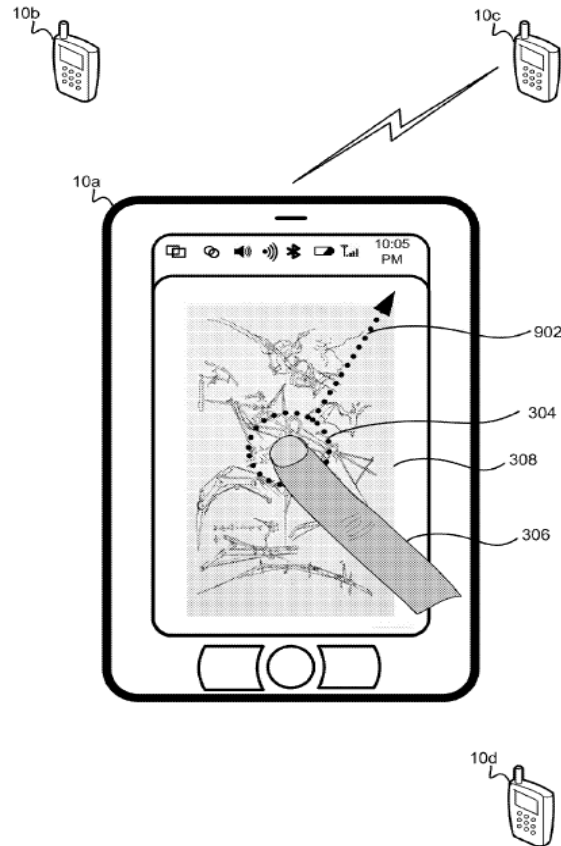


FIG. 9

Figure 9 of Forutanpour, reproduced above, illustrates “a portable computing device . . . transmitting files using flick gestures.” *Id.* ¶ 22.

Computing device 10a can activate “file sharing functionality . . . in response to a specific user input.” *Id.* ¶ 70. For example, the device’s “user interface may present a menu, list, or thumbnail display of files from which the user can select a file by, for example, touching it on a touchscreen display.” *Id.* ¶ 71. This activation “may prompt the computing device to discover nearby computing devices using a wireless communication link by using, for example, Bluetooth® or Zigbee® wireless communication technologies.” *Id.* In discovering nearby devices, computing device 10a “may receive the locations of the nearby computing devices,” for example, “by receiving precise latitude and longitude coordinates . . . from Global

Positioning System (GPS) receivers within the [nearby] computing devices” or by “using signal strength and time-of-arrival information from received RF signals and triangulation calculations.” *Id.* ¶ 73. Once nearby devices are discovered, computing device 10a can “map the locations of nearby computing devices and display the map in a display GUI.” *Id.* ¶¶ 74, 109, Fig. 18.

Computing device 10a can determine that its “user wishes to share the selected file with another computing device by detecting a file transfer gesture,” such as a “flick gesture in the direction of another device.” *Id.* ¶¶ 75–76, 98. For example, as shown in Figure 9, “computing device 10a may be configured to identify the targeted computing device 10c based on the flick gesture and initiate transmission of the selected file to that other computing device 10c.” *Id.* ¶¶ 77, 98, Fig. 9. Other recognizable gestures can be multi-finger gestures such as “opening all fingers on the touchscreen . . . to send files [to] all nearby computing devices or closing fingers together to receive files from all nearby computing devices.” *Id.* ¶ 76.

Computing device 10a can “prompt a user to confirm or authorize sharing [a] selected file with the targeted computing device” and “receive a message from the targeted recipient . . . indicating whether the [targeted] device will accept the file.” *Id.* ¶¶ 5, 79. Targeted computing device 10c can also send “access data” to computing device 10a, such as “an IP address that the transmitting computing device [10a] can use to address the file for transmission.” *Id.* ¶¶ 5, 81. The access data may “identify a preferred communication method and communication network to be used for transmitting the file,” including “a direct communication link, such as an NFC, Bluetooth or WiFi direct communication link.” *Id.* Moreover, although the initial and existing wireless link between computing devices

10a and 10c may be a Bluetooth link, “the determined wireless communication link used to transmit the file [can] use[] a wireless technology that is different than the established wireless link technology.” *Id.* ¶ 5. Once authorized, computing device 10a can “transmit the selected file to the targeted device [10c] using [the] identified access data and communication network.” *Id.* ¶ 82.

2. Claims 1 and 23

Claim 1 recites a method performed by a WTRU that includes processing a touchscreen input to select a media element. Ex. 1001, 10:54–57. The ’933 patent identifies a WTRU as “a user equipment (UE), a communications device, a mobile station, a fixed or mobile subscriber unit, a pager, a cellular telephone, a personal digital assistant (PDA), a computer, or any other type of device capable of operating in a wireless environment.” Ex. 1001, 2:26–32.

At this stage of the proceeding, Petitioner reasonably demonstrates how Forutanpour teaches or suggests this limitation. *See* Pet. 36–38 (citing Ex. 1204 ¶¶ 3, 9, 69–84, 90, 150–156, Figs. 1, 2A, 2B, 3, 47).⁸ Patent Owner does not contend otherwise. *See* Prelim. Resp. 14–46. Foruntapour discloses a portable computing device having a processor, memory, touchscreen input device, and wireless transceivers that implements a file-sharing method. Ex. 1204 ¶¶ 70, 150. The file sharing method “may enable the user to identify a file to be shared with another computing device” by allowing the user to select a thumbnail display of the file by “touching it on

⁸ Because Petitioner demonstrates how Forutanpour discloses the preamble, we need not decide whether the preamble is limiting.

a touchscreen display.” *Id.* ¶ 71. The file to be shared can be a media element, such as a “picture[] or video[].” *Id.* ¶ 3.

Claim 1 further requires the WTRU to use Bluetooth to detect a plurality of proximal WTRUs. Ex. 1001, 10:58–59. At this stage of the proceeding, Petitioner reasonably demonstrates how Foruntapour teaches or suggests this limitation. Pet. 38 (citing Ex. 1204 ¶¶ 68, 72, 86, 96, 128, Figs. 8, 35). Patent Owner does not contend otherwise. *See* Prelim. Resp. 14–46. Foruntapour discloses its portable computing device detects the presence of nearby devices using Bluetooth. Ex. 1204 ¶¶ 72, 86.

Claim 1 further requires the WTRU to process another touchscreen input to select a WTRU of the plurality of proximal WTRUs. Ex. 1001, 10:60–61. At this stage of the proceeding, Petitioner reasonably demonstrates how Foruntapour teaches this limitation. Pet. 38–39 (citing Ex. 1204 ¶¶ 61, 68, 75–77, 98, 107, 108, Fig. 9). Patent Owner does not contend otherwise. *See* Prelim. Resp. 14–46. Foruntapour discloses that once the computing device’s file sharing method is activated (e.g., by selecting a file), nearby computing devices are discovered, their locations are determined and displayed on the touchscreen, and the computing device determines whether “to share the selected file with another computing device by detecting a file transfer gesture . . . based upon user touches on [the] touchscreen.” *Id.* ¶¶ 71–75. Foruntapour further discloses identifying “computing devices to which the user intends to send the selected file based upon information regarding the file transfer gesture.” *Id.* ¶¶ 76–77.

Claim 1 further requires the WTRU to send a message to transfer the selected media element to the selected WTRU and to receive a responsive message from the selected WTRU accepting the transfer. Ex. 1001, 10:62–65. At this stage of the proceeding, Petitioner reasonably demonstrates how

Foruntapour teaches this limitation. Pet. 39–40 (citing Ex. 1204 ¶¶ 79–82, 86, 143, 145, Fig. 42). Patent Owner does not contend otherwise. *See* Prelim. Resp. 14–46. Foruntapour discloses the computing device can “prompt a user to confirm or authorize sharing the selected file with the targeted computing device” and “receive a message from the targeted recipient computing device, indicating whether the device will accept the file.” Ex. 1204 ¶¶ 79, 86, 143.

Finally, claim 1 requires the WTRU to transfer, via WiFi, the selected media element to the selected WTRU. Ex. 1001, 10:66–67. At this stage of the proceeding, Petitioner reasonably demonstrates how Foruntapour teaches this limitation. Pet. 40–41 (citing Ex. 1204 ¶¶ 4, 5, 81–84, 143, 144). Patent Owner does not contend otherwise. *See* Prelim. Resp. 14–46. Foruntapour discloses that, “[a]s part of discovering nearby computing devices . . . or receiving authorization to transmit files” to a discovered device, the computing device may receive “access data that [it] uses to accomplish a file transmission.” Ex. 12004 ¶ 81. The access data can “identify a preferred communication method and communication network to be used for transmitting the file,” including a “WiFi direct communication link.” *Id.* Foruntapour further discloses “the request to transmit the file to the target computing device may be accomplished using the established wireless link [e.g., Bluetooth]” and the determined or preferred “wireless communication link used to transmit the file [can] use[] a wireless technology that is different than the established wireless link technology [e.g., WiFi].” *Id.* ¶ 5. Lastly, Foruntapour discloses that “[o]nce the intended recipient computing device is identified, and transfer of the file is verified and/or authorized,” the computing device can “transmit the selected file to the targeted device using [the] identified access data and communication network.” *Id.* ¶ 82.

Claim 23 is substantially similar to claim 1, reciting a WTRU configured to perform the method recited in claim 1. *Compare* Ex. 1001, 10:54–67, *with id.* at 12:8–21. Petitioner’s analysis of claim 23 refers back to its analysis of claim 1, and cites additional evidence demonstrating that Foruntapour teaches or suggests a computing device configured to perform each of the recited steps of claim 1. *See* Pet. 54–55 (citing Ex. 1204 ¶¶ 9, 63, 70–72, 74, 78–80, 101, 104, 123, 128, 150–156, Figs. 31, 47). We have reviewed the cited passages of Foruntapour and find Petitioner demonstrates a reasonable likelihood of showing claim 23, like claim 1, is unpatentable over Foruntapour.

3. Claims 2–9, 11, 13, 14, 22, 24–31, 33, 35, 36, and 44

We have reviewed Petitioner’s contentions for the unpatentability of these claims, which Patent Owner does not contest. *See* Pet. 41–55; Prelim. Resp. 14–46. We are persuaded, at this stage of the proceeding, based on the evidence and argument presented in the Petition and Preliminary Response, that Petitioner has demonstrated a reasonable likelihood of showing that claims 2–9, 11, 13, 14, 22, 24–31, 33, 35, 36, and 44 are unpatentable as anticipated by or obvious over Forutanpour.

F. Remaining Challenges

As noted above, in addition to challenging certain claims of the ’933 patent as anticipated by or obvious over Forutanpour (Grounds 1 and 2), Petitioner challenges some of these claims as obvious over Forutanpour and Hinckley (Ground 3), Forutanpour and Hoddie (Ground 4), and Forutanpour and Heinonen (Ground 5). Pet. 2. Because Petitioner has demonstrated a reasonable likelihood of showing at least one challenged claim is unpatentable as anticipated by or obvious over Forutanpour, we need not review Petitioner’s remaining challenges to institute review. *See* 35 U.S.C.

§ 314(a) (“The Director may not authorize an inter partes review to be instituted unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”).

III. CONCLUSION

We have reviewed the Petition, Patent Owner Preliminary Response, Petitioner Preliminary Reply, and Patent Owner Preliminary Sur-Reply, and have considered all of the evidence and arguments presented by Petitioner and Patent Owner. We find, at this stage of the proceeding, Petitioner has demonstrated a reasonable likelihood of showing at least one claim of the ’933 patent is unpatentable. Accordingly, we institute *inter partes* review of all claims on all grounds raised in the Petition.

The Board has not yet made a final determination with respect to any claim construction issue, priority issue, or the patentability of any challenged claim.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Patent Owner’s request for discretionary denial is denied;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314, an *inter partes* review is instituted on all challenged claims on all grounds; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

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