

Microsoft Corporation v. InterDigital Patent Holdings, Inc.

IPR2024-00537 | U.S. Patent No. 8,737,933

IPR2024-00538 | U.S. Patent No. 9,173,054

Demonstratives of Petitioner Microsoft Corporation

April 15, 2025

Klarquist

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Sole Issue

1. Whether the challenged claims are entitled to claim priority to the filing date of the '948 application.

'933 Patent, Claim 1

What is claimed is:

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.

IPR2024-00537: '933 Patent (EX1201), claim 1, 10:54-67 (orange highlighting added).
See also IPR2024-00538: '054 Patent (EX1201), claim 1, 10:53-65.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

'948 Application (EX1282)

[0024] (excerpted)

The communication peripherals 107 may include technologies such as a third generation partnership (3GPP) second or third generation standards (2G/3G) modem, Bluetooth® or WiFi®. Any combination or all of these communication technologies may be implemented in a single component design.

[0039] (excerpted)

Transmission instructions 311 may include information regarding the data to be communicated and the identity of the target WTRU 101_{c,t} as well as instructions for implementing the transfer through specific components in the communication peripheral.

IPR2024-00538: Institution Decision

The passages that Patent Owner cites from the great-grandparent application describe a WTRU that may be capable of both Bluetooth and Wi-Fi communications. Ex. 1282 ¶ 24 ('948 application). They describe detecting another WTRU using Bluetooth. *Id.* ¶ 34. They also describe transferring data to that target WTRU. *Id.* ¶¶ 32, 39, 42. None of the passages cited, however, describe

using Bluetooth for detection and then switching to Wi-Fi for data transfer within the same transaction. This element of claim 1 is neither expressly nor inherently disclosed in the great-grandparent application.⁹

IPR2024-00538: **Institution Decision (Paper 10)** at 16-17 (excerpted)

IPR2024-00537: Institution Decision

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.

IPR2024-00537: Institution Decision (Paper 10) at 22 (excerpted)

Rysavy Testimony

65. At most, the parent application discloses WTRUs that have the capability to communicate using Bluetooth and Wi-Fi, along with a laundry list of other possible communications technologies.

These passing mentions of Bluetooth and WiFi capability give no indication of using the two together as different parts of the same method, much less the particular method of usage later claimed during prosecution of the '933 patent.

IPR2024-00537: **Rysavy Declaration (EX1203)**, ¶65 (excerpted) (cited by Petition (Paper 3), 23-24; Reply (Paper 17), 5).
See also IPR2024-00538: **Rysavy Declaration (EX1203)**, ¶65 (cited by Petition (Paper 3), 25; Reply (Paper 17), 5).

Rysavy Testimony

69. Indeed, the parent application is altogether silent on which communication protocol / technology to use for the transfer, leading a POSITA to understand that the same protocol used for device detection is also used for the transfer. *See, e.g.*, EX1281, [0027-28], [0032], [0036-39]. For example, the parent application does not say which protocol to use for the transfer, gives no indication that the WTRU makes a decision as to which protocol to use for data transmission, and does not provide any indication that the protocol used for data transmission is different than the protocol used for device detection.

IPR2024-00537: **Rysavy Declaration (EX1203)**, ¶69 (excerpted) (cited by Petition (Paper 3), 27; Reply (Paper 17) at 4-5, 7; Sur-Reply (Paper 19), 4-5).
See also IPR2024-00538: **Rysavy Declaration (EX1203)**, ¶69 (cited by Petition (Paper 3), 28; Reply (Paper 17) at 4-5, 8; Sur-Reply (Paper 18), 4).

Rysavy Testimony

The application is silent, however, and a POSITA would reasonably understand that the same communications protocol was used for both detection and data transfer. Thus, the '948 application does not convey with reasonable clarity that the inventors were in possession of the claimed Bluetooth-to-Wi-Fi method.

IPR2024-00537: **Rysavy Reply Declaration (EX1286)**, ¶12 (excerpted) (cited by Reply (Paper 17), 15)

IPR2024-00538: **Rysavy Reply Declaration (EX1288)**, ¶12 (excerpted) (cited by Reply (Paper 17), 15)

Rysavy Testimony

12. In sum, if Patent Owner truly possessed a method for data transfer that involved using Bluetooth for detection and Wi-Fi for data transfer, then the application could easily have said so, even if just with a sentence or two.

IPR2024-00537: Rysavy Reply Declaration (EX1286), ¶12 (excerpted) (cited by Reply (Paper 17), 15)

IPR2024-00538: Rysavy Reply Declaration (EX1288), ¶12 (excerpted) (cited by Reply (Paper 17), 15)

The numerous Bluetooth-to-Wi-Fi background references cited in paragraphs 38-45 of my First Declarations include such descriptions, confirming what a POSITA would have expected from an application that showed possession of a method involving such a switch.

IPR2024-00537: **Rysavy Reply Declaration (EX1286), ¶8** (excerpted) (cited by Reply (Paper 17) at 11-13)

IPR2024-00538: **Rysavy Reply Declaration (EX1288), ¶8** (excerpted) (cited by Reply (Paper 17) at 11-14)

Edwards Testimony

Thus, a POSITA would see that WiFi would offer better transmission speed for data transfer (of the media elements), and that Bluetooth would offer better power consumption for periodic scanning and detection of nearby WTRUs. Therefore, a POSITA would understand that the '948 Application discloses both Bluetooth detection of proximate WTRUs and WiFi data transmission of media elements from a sending WTRU to the target WTRU.

IPR2024-00537: **EX2014, ¶87** (excerpted)

IPR2024-00538: **EX2014, ¶87** (excerpted)

Edwards Testimony

81.To a POSITA, it is clear that the '948 Application discloses that “[a]ny combination or all of these communication technologies,” including a 3GPP (2G/3G) modem, Bluetooth, of WiFi can be used “in a single component design,”⁴⁰ and that transmission instructions can indicate that WiFi should be used to transfer data to the target WTRU.

IPR2024-00537: EX2014, ¶81 (excerpted)

IPR2024-00538: EX2014, ¶81 (excerpted)

Rysavy Testimony

10. My opinion is unchanged by the vaguely described “transmission instructions” discussed by Dr. Edwards. *E.g.*, EX2014, ¶¶80-81 (citing EX1282, [0039] & [0042]); *see also id.*, ¶65. The ’948 application does not suggest that these transmission instructions are used for Wi-Fi communications, much less that they lead to a switch in communications protocols. There is no support for Dr. Edwards’ unexplained assertion that a POSITA would understand the ’948 application to disclose “that transmission instructions can indicate that WiFi should be used to transfer data to the target WTRU” and he cites nothing in making this assertion.

IPR2024-00537: **Rysavy Reply Declaration (EX1286)**, ¶10 (excerpted) (cited by Reply (Paper 17), 14)

IPR2024-00538: **Rysavy Reply Declaration (EX1288)**, ¶10 (excerpted) (cited by Reply (Paper 17), 15)

Rysavy Testimony

11. Moreover, if the transmission instructions related to a switch, then, barring express disclosure of such a switch, one would at least expect disclosure of a change in an attribute that necessarily implicates a change in protocol, such as a change in the radio signal transmission and/or multiplexing techniques at Layer 1 (the physical layer).

The '948 application, however, does not mention any change in the radio signal transmission and/or multiplexing techniques at Layer 1, leading a POSITA to understand that there is no protocol switch, and that instead, the same protocol that was used for detection is also used for data transfer.

IPR2024-00537: **Rysavy Reply Declaration (EX1286)**, ¶11 (excerpted) (cited by Reply (Paper 17), 14)

IPR2024-00538: **Rysavy Reply Declaration (EX1288)**, ¶11 (excerpted) (cited by Reply (Paper 17), 15)

Appendix

Summary

1. Patent Owner's **burden of production**.

E.g., Tech. Licensing 545 F.3d at 1329 (Fed. Cir. 2008)

2. '948 application does **not mention** claimed method using Bluetooth and WiFi.

IPR2024-00537: Petition (Paper 3), 20-29; Reply (Paper 17), 2-15 | IPR2024-00538: Petition (Paper 3), 20-30; Reply (Paper 17), 2-15

3. Mr. Rysavy: application does not convey **possession** of using Bluetooth and WiFi.

IPR2024-00537: EX1203, ¶¶ 62-70; EX1286, ¶¶ 6-12 | IPR2024-00538: EX1203, ¶¶ 62-70; EX1288, ¶¶ 6-12

4. Dr. Edwards focused on POSITA knowledge, not **disclosure** of '948 application.

IPR2024-00537: EX2014 at ¶¶ 83-87 | IPR2024-00538: EX2014 at ¶¶ 83-87

5. **Ambiguities and possibilities** are insufficient to satisfy Section 112.

Hyatt v. Boone, 146 F.3d at 1354 (Fed. Cir. 1998)

Named Inventor Reznik (EX2006)

3 It seems like, at least the
4 portions we have looked at together just now, I
5 am not seeing any specific discussion of using
6 WiFi to transfer data.

7 Is that a fair characterization?

8 ATTORNEY HEJNY: Object to form.

9 THE WITNESS: If you're saying
10 that WiFi is not specifically mentioned,
11 no, it's not specifically mentioned.

EX2006, 155:3-11

(quoted by IPR2024-00537 Reply (Paper 17) at 10, cited at 3-5)

(quoted by IPR2024-00538 Reply (Paper17) at 11, cited at 4-5)

Named Inventor Reznik (EX2015)

Q. *What were the solutions back in 2008, when you're working on this with Mr. Carlton, in terms of figuring out devices that are nearby each other?*

A. *So technologies like Bluetooth, right, so – and I mentioned before the 802.15 family of standards. There's a couple of other ones in there. They tend to be pretty good at figuring out what devices are nearby, right. That's why we use Bluetooth for wireless phones and stuff like that.*

EX2015, 60:18-61:3 (as quoted and emphasized by POR (Paper 14) at 23-24)

Named Inventor Reznik (EX2015)

Q. What was the *solution you had in mind* when you were having this discussion with Mr. Carlton?

A. So as I recall, right, once we kind of realized that, hey, *the reason this is hard is because you don't have the technology that can do both proximity and transfer in a natural way*, the solution became, you know, *we've got one set of technologies that can do the proximity*, right, that can figure out the two devices are next to each other. *We have another set of technologies that could effectively [sic] do data communication.*

Let's figure out how we take advantage of both to actually achieve this result that we wanted to achieve, which is digital equivalent of handing a piece of paper over to something that's right next to you.

EX2015, 61:12-62:4 (as quoted and emphasized by POR (Paper 14) at 23)
(orange highlighting added)

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

The undersigned certifies that on April 11, 2025, a complete copy of
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