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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

INTERDIGITAL PATENT HOLDINGS, INC.,
Patent Owner.

IPR2024-00537 (Patent 8,737,933 B2)
IPR2024-00538 (Patent 9,173,054 B2)

Record of Oral Hearing
Held: April 15, 2025

Before JAMESON LEE, MIRIAM L. QUINN, and LISA A. MURRAY, *Administrative Patent Judges*.

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The above-entitled matter came on for hearing Tuesday, April 15, 2025, commencing at 11:50 a.m., at the USPTO Southwest Regional Outreach Office, 207 South Houston Street, Suite 159, Dallas, Texas.

P-R-O-C-E-E-D-I-N-G-S

(11:50 a.m.)

JUDGE QUINN: Welcome back, everybody. We are going to go ahead and get started. This hearing is for the case captioned Microsoft Corporation v. InterDigital Patent Holdings, Inc. The Case No. is IPR2024-537 and IPR2024-538.

I am Judge Miriam Quinn, presiding over the proceeding taking place at the Texas Regional Office in Dallas, Texas, at the USPTO. And with me are my colleagues, Judge Jameson Lee and Judge Lisa Murray coming to you from the USPTO hearing room in our Alexandria, Virginia headquarters.

We are going to take appearances now for patent Petitioner.

MR. THACKER: Sam Thacker on behalf of Petitioner Microsoft Corporation.

JUDGE QUINN: And for Patent Owner.

MR. HEJNY: Your Honor, Scott Hejny, McKool Smith, on behalf of InterDigital. And as of this morning, my colleague, Mr. Garrett Griggs here in-person. And remotely, Richard Kamprath, lead counsel, as well as in-house counsel for InterDigital, Leslie Lee.

JUDGE QUINN: Thank you. Okay. A couple of house-keepings. As we did this morning, I asked the parties to express any objections, if you have any, on the Panel's desire to consider consolidation of the final written decisions in the IPRs 2024-305, -306 and also the 537 and -38

MR. THACKER: No objection.

MR. HEJNY: No objections, Your Honor, outside of the comments made by Judge Murray with respect to the priority date issue. I don't know

that that would cause any issues for the panels, but we would be supportive of whatever the Panel is comfortable with.

JUDGE QUINN: Thank you. Duly noted. The second issue here is we have a LEAP request. And Mr. Thacker has been granted the request to appear here under the LEAP program, so Petitioner will get an additional 15 minutes.

So we are going to start with asking how much time do you want to reserve for rebuttal for each one of you so I can program the timer. Petitioner?

MR. THACKER: Thirty minutes, please, Your Honor.

JUDGE QUINN: Okay. Thank you. Yes, and Patent Owner?

MR. HEJNY: Your Honor, 40 minutes again, for opening, arguing, and reserving 20 minutes for surrebuttal.

JUDGE QUINN: So you said 40 and 20?

MR. HEJNY: Yes, Your Honor.

JUDGE QUINN: Okay. Thank you. All right. Petitioner, you may come up and begin when you are ready.

MR. THACKER: May it please the Board, Sam Thacker on behalf of Petitioner Microsoft Corporation.

Turning to Slide 2, there's only one dispute in these IPRs, and that's whether the claims are entitled to claim priority to the filing date of the '948 application. If they aren't, then the Forutanpour reference is prior art. If Patent Owner does not dispute that Forutanpour renders all challenged claims unpatentable. This priority date dispute turns on whether the '948 application provides Section 112 written description support for the claims.

Now, written description support requires that the specification reasonably convey to a skilled artisan that the inventor possessed what is actually claimed. Now, the Fed Circuit has made clear that this requires unambiguous disclosure of every claim element such that a skilled artisan would immediately discern each limitation from the specification and clearly conclude that the inventor invented what is claimed.

Turning to Slide 3, this written description issue centers around two claim elements which are shown highlighted on Slide 3. These elements are, first, detecting another device using Bluetooth, and then transferring to that detected device, using Wi-Fi, a selected media outlet.

The '948 application does not provide written description support for the use of Wi-Fi to transfer a media element to another device, let alone to a device that was detected using Bluetooth.

At Institution, which applies a different standard, the Board preliminarily found that the '948 application does not provide written description support for this claimed hybrid method of using one technology, Bluetooth, for detection, and then another technology, Wi-Fi, for the transfer.

Nothing the Patent Owner has submitted since the Institution Decisions changes this outcome. All that Patent Owner has submitted is a post-Institution declaration from its expert that is substantively identical to the expert's pre-Institution declaration, and, second, is additional testimony from a named inventor of the challenged patents that does not bear substantively on this written description issue, and, even if it did, does not move the needle in favor of Patent Owner.

Mr. Rysavy, Petitioner's expert, on the other hand, has provided lengthy testimony explaining why the '948 application does not reasonably convey to the skilled artisan that the inventors had possession of this hybrid method using Bluetooth for detection and Wi-Fi for transferring. The record, as a whole, shows that the '948 application does not provide written description support for this hybrid method.

Turning to Slide 4, although Patent Owner has the burden of production to show entitlement to the '948 application's filing date, Patent Owner points to a passage from Paragraph 24 of the '948 application that does not provide written description support for this claimed hybrid method. All this passage describes is that the device can include Bluetooth and Wi-Fi. But this passage does not disclose using Wi-Fi to transfer a selected media element to another device, let alone to a device that was detected using Bluetooth.

Now, Patent Owner also points to Paragraph 39, as this paragraph, as explained by our expert, Mr. Rysavy, is vague as to exactly what's going on, but all Mr. Rysavy says that it indicates to a POSITA is that there's some transmission instructions. But these transmission instructions give no indication to a POSITA to switch from Bluetooth to Wi-Fi for the transfer.

Indeed, as shown on Slide 5, the Institution Decision in the 538 IPR correctly found that these passages from the '948 application do not provide written description support for the claimed hybrid method.

And then, turning to Slide 6, the 537 Institution Decision similarly found that the '948 application does not provide written descriptions according to the claimed hybrid method. It also found that there's no written

description support for using Wi-Fi to transfer a media element to another device, regardless of how that device was detected.

JUDGE QUINN: So, Counsel, I want to ask you, because the Institution Decision's one thing; we're going to look at the case anew for the final written decision. And so we have here now is explanations that your communication peripheral can have many communication elements, including the two, the Bluetooth and the Wi-Fi components, in that communication peripheral at the same time.

And you said that there is configuration information, but you just basically stated that there's nothing there. And I want to ask to go more deeply into the operation of the application that takes transmission instructions, and why disclose that you can have a communication peripheral that supports multiple protocols of communication and yet limit the transmission instructions to be one or another, but not two different communication protocols?

MR. THACKER: Yes. So, I understand your question, and I would point the Board to Slides 7 through 11 which -- or 7 through 10, excuse me, which we can turn to Slide 7 first, but our expert, Mr. Rysavy, explained that this disclosure of a device that includes Bluetooth and Wi-Fi is not enough to convey to a POSITA to switch from one technology to another during this file transfer method. The application describes using Bluetooth for detection and then never describes switching to another technology during that whole file transfer process.

And so let me stop there. Does that speak to your question?

JUDGE QUINN: I think you need to go deeper into that. I mean, you're telling me what your expert said. And I can read that from your slide, but I think you need to explain it.

MR. THACKER: Okay. So, Mr. Rysavy explained, and this is on Slide 8, that the application's specification is silent on which technology is used for the transfer, and so a POSITA would understand that the same technology used for detection is also used for the transfer.

And then if we go to Slide 10, Mr. Rysavy further explained that if the inventors truly had possession of this concept, this hybrid method of using Bluetooth for detection and Wi-Fi for transfer, a POSITA would have expected disclosure of a switch from one technology to another. And he explained that there's just no disclosure of such a switch in the application.

And then in response to Edward's test -- Doctor -- Patent Owner's expert Dr. Edward's testimony --

JUDGE QUINN: But isn't that part of the transmission instructions? If you're sending transmission instructions that tell the application that Wi-Fi is the communication protocol, isn't that essentially switching from the discovery using SDP or the Bluetooth protocol, and then now transferring something using Wi-Fi?

MR. THACKER: Well, there's nothing in the '948 application that says that the transmission instructions indicate using Wi-Fi just -- at all. At most --

JUDGE QUINN: But you will contend that the transmission's instructions may say use Bluetooth?

MR. THACKER: Petitioner never argued in the briefing or -- and Mr. Rysavy never submitted it in his expert declarations, that the transmission instructions necessarily indicate a specific protocol to use.

JUDGE QUINN: So what are you contending the transmission's instructions do in the patent?

MR. THACKER: Well, so let's look at the '948 application really quickly. It seems like it's inside here. So although this was not presented and this specific issue is not presented in the briefing, Petitioner's best understanding of the transmission instructions is that they indicate, for example, which device to send the media elements to, perhaps what the media element is.

And in Paragraph 41, for example, the application states that the data may be transferred only as far as necessary to reach a minimal set of users operating in a local environment. So perhaps the transmission instructions include some indication of the direction or power given to the transmission.

JUDGE QUINN: And your expert did not opine as to what that means?

MR. THACKER: Just give me one sec here. I believe that the extent of our expert testimony in the reply declaration, which is Exhibit 1286 in the 537, and 1288 in the 538 IPR, describes how this paragraph about the transmission instructions gives no indication that there's a switch.

And then if we turn to his original declaration, I do not believe that he specifically addressed the transmission instructions either, but I will confirm that on rebuttal.

JUDGE QUINN: So is it your contention that the disclosure needs to say "switch" in order for the transmission instructions to convey to a person of skill in the art that the transmission could occur with Wi-Fi technology?

MR. THACKER: Well, two things. Whether or not something could do something is not sufficient for the written description requirement, which requires unambiguous disclosure. So whether or not a POSITA may have found it obvious to implement the teachings of this reference to these Wi-Fi, that's not enough for a written description. And secondly --

JUDGE QUINN: The disclosure could say you may use Wi-Fi and you may use Bluetooth, and choosing "may" so that means you could use one or the other. So we're quibbling about words, but do you suggest -- are you suggesting that in order for the transmission instructions to be sufficient, there needs to be some disclosure of switching, per se?

MR. THACKER: Yes. I think on Slide 10, Mr. Rysavy explained that a POSITA would expect disclosure of such a switch given that, in this time period, those that actually had possession of this hybrid method of this switch, they included express disclosure of that switch.

And Mr. Rysavy also explained that even barring express disclosure -- and this is on Slide 14 -- a POSITA, at the very least, would have expected disclosure that necessarily implicates that change in protocol, such as a change in the radio signal transmission and our multiplexing techniques at layer 1.

And he went on to explain that the characteristics of Bluetooth and Wi-Fi are very different in layer 1 and thus, you'd expect at least some indication of these transmission instructions are impacting these layer 1

aspects. And there's just no disclosure of the transmission instructions impacting layer 1. Does that speak to your question?

JUDGE QUINN: Thank you.

JUDGE LEE: Counsel, it's Judge Lee. I want to ask you, does the specification say anything specific about what technology or what protocol is used for detecting, and what protocol is used for data transfer?

MR. THACKER: The specification only mentions Wi-Fi -- or sorry -- only mentions -- strike that -- it only mentions Bluetooth during this file transfer process. And it mentions using Bluetooth for detection specifically. It does not expressly mention any technology for the transfer steps specifically.

JUDGE LEE: Right. So that means, according to your logic, the patentee would not be able to claim anything specific about what protocol is used for data transfer, or instead say, they wouldn't be able to add another claim that says after detection, transfer the data through Wi-Fi then? Just following the logic, there's nothing expressly stated?

MR. THACKER: Well, I respectfully disagree. I think that what Mr. Rysavy explained is that what a POSITA would understand from the application, is that the same technology that is used for both detection and for transfer.

JUDGE LEE: Right. And that'd be because you just told me the only description contained here is that Bluetooth is used for detection. So nothing can be claimed about Wi-Fi then, because Wi-Fi is not described as being used for anything specific; not for detection, not for data transfer, and therefore, following your logic, then it cannot be claimed, drafted without the support that says transfer the data by Wi-Fi.

MR. THACKER: That's correct.

JUDGE LEE: Even though there's a description about any combination of these technologies can be used for communication. Is that right?

MR. THACKER: That is correct, Your Honor.

JUDGE LEE: Okay. Thank you.

MR. THACKER: Yes. And just to provide a little explanation for that, that this -- the specification, specifically Paragraph 24, also mentions 3G and other technologies, but it never once discloses using Wi-Fi or 3G, for example, to transfer a media element to another device.

JUDGE LEE: Okay. I just wanted to understand what you're saying. I think I do, but it seems such a narrow reading that there's no support here based on this text for claiming data transfer by Wi-Fi. So I understand that's your position?

MR. THACKER: Yes. And even if the Board were to find that somehow there is disclosure of using Wi-Fi to transfer a media element to another device, there still isn't written description support for the claimed hybrid method of using Bluetooth for detection of Wi-Fi for transfer. So that switch, that change in technologies, is just not contemplated by the '948 application.

JUDGE LEE: Yes. That sounds like the better argument from my perspective, and I can see that because the disclosure here is any combination of these technologies may be implemented in a single component design.

So that seems to say this unit has the ability to do Bluetooth, or to do Wi-Fi, or to do one or the other things, but it never says how. So there

seems to be a Step 4 to say you send by this and you receive by that; that sounds like more. And to me it's a better argument than to say, oh, because it's not expressly stated, you cannot claim it.

Because what if -- you know, you would even say he cannot claim detection by Wi-Fi and sending data by Wi-Fi. You would say that, right? By your logic?

MR. THACKER: Can you -- sorry, can you repeat that last bit again?

JUDGE LEE: I mean, your own argument is broader in saying the patent has no description for say a uniform application, sending -- detecting by Wi-Fi and sending data by Wi-Fi? You would say they have no description for that?

MR. THACKER: Yes.

JUDGE LEE: Even though it's the same both ways?

MR. THACKER: Yes, but Petitioner's position is that there's two arguments and -- you're correct -- that our first argument is that there's no disclosure of using Wi-Fi to detect and transfer content.

But even if the Board found that there was disclosure for that, there's certainly no adequate written description support for using different technologies to perform the detect and transfer actions.

JUDGE LEE: I understand. So you have two separate arguments, and you only need to win on one of them?

MR. THACKER: That's correct, Your Honor.

JUDGE LEE: Okay. Thank you.

MR. THACKER: So on the second argument that Judge Lee was alluding to about there's no disclosure of this switch from Bluetooth to Wi-Fi, I'd like to return to Slide 10 where Mr. Rysavy explained that references

that actually demonstrated possession of such a switch, like Hoddie, McKillop, Banerjea, Adler, and Kapur; so that's five references, and they all expressly disclose this switch in technologies when going from detection to transfer, and the '948 application provides no such disclosure.

And in the earlier hearing regarding the 305 and 306 IPRs, Counsel for InterDigital seemed to be pushing the importance of this Bluetooth to Wi-Fi switch.

Well, if this Bluetooth to Wi-Fi switch was so important, then why didn't the '948 application at least mention that there's this switch?

JUDGE MURRAY: Counsel, this is Judge Murray. That's -- so given the number of references that you've shown that show such a switch, what is your best evidence that a person of ordinary skill would not have concluded that given this state of the art, the claims must be referring to using Bluetooth for detection and Wi-Fi for transfer?

MR. THACKER: Yes. I will go back to all those slides from Mr. Rysavy, and this is in his testimony as in his original declaration in Paragraph 62 to 78, and his reply declaration in Paragraphs 7 to 12, where he explains that the silence on a such switch indicates to a POSITA that the same technology is used for both detection and transfer, and that, you know, if there really was this switch, a POSITA would have expected express disclosure. Does that speak to your question?

JUDGE MURRAY: Well, why is that? I understand that your expert has said that, but what is the basis for your expert's statement?

MR. THACKER: Well, our expert is opining that one who's skilled in the art reading this application, would not understand that the inventors

possess this switch because they would have expected disclosure or at least some suggestion of such a switch.

And as I explained to Judge Quinn earlier, one, there's just no express disclosure, and there's also no implicit disclosure that indicates to a POSITA that there is such a switch. For example, there's no indication that the transmission instructions impact layer 1.

JUDGE QUINN: Why would it need to impact layer 1?

MR. THACKER: Just disclosure that the transmission instructions impact the radio's signal or multiplexing technologies, for example.

JUDGE QUINN: But the Bluetooth stack starts at layer 2, so if you're communicating at layer 2, layer 3, you're already telling the application that you're using a Bluetooth or a Wi-Fi stack. Why would you need to also communicate at layer 1? Applications don't communicate at layer 1.

MR. THACKER: Well, I think Mr. Rysavy explains that whether or not there's some application level, you know, layer 2, layer 3 communication going on, what he explained is that because the protocols are so much different in layer 1, you would expect that there's some mention of the instructions impacting layer 1 because that Paragraph 39 of the application --

JUDGE QUINN: For the record, when you're saying the application, what exhibit number are you referring to?

MR. THACKER: Sorry. That's Exhibit 1282.

JUDGE QUINN: Thank you.

MR. THACKER: It states that the transmission instructions are delivered to the communication peripheral. So that's a physical device that you would expect that physical device is impacted at layer 1.

So if those transmission instructions indicated a switch from Bluetooth to Wi-Fi, a POSITA would expect that those transmission instructions which are delivered to you in a physical device, the communication peripheral, that those transmission instructions impact layer 1.

JUDGE QUINN: So does the other prior art that you have selected for this case, do they have also disclosures of communications at that level?

MR. THACKER: Not that I'm aware of, Your Honor, but I can check that. But that --

JUDGE QUINN: I mean I'm looking for parity here. You're saying that this disclosure is insufficient because it doesn't have that level of detail, but that level of detail is also not present in other patents that disclose the same switching?

MR. THACKER: Well, I respectfully disagree because those other references expressly disclose the switch.

JUDGE QUINN: So once you have the word switch, then everything else a person of skill in the art would know how to implement that? And without the word switch, you don't know how to implement that?

MR. THACKER: Well, one, I'm going to say yes. Where there's no dispute that if there had been disclosure of such a switch, that a POSITA would know, but that's also not the standard for a written description. The written description standard is what the application conveys to a POSITA about what the inventors actually possess, not whether a POSITA would have been able to, you know, make and use the invention.

And there's case law on this distinction between the written description requirement and the enablement requirement, which I can go into, but I'll stop there and just ask if that speaks to your question?

JUDGE QUINN: Well, I want to know also when the disclosure says that you transmit a radio signal to the sending WTRU, for example, an acknowledgement signal, this is after you've done some initiating the user input, I mean, is generally referring to a signal.

And we know from the disclosure earlier, that you can have three types of communications: 3G, Wi-Fi, or Bluetooth. It doesn't say only Bluetooth signal, or only 3G signal, or only Wi-Fi signal. It just says a radio signal.

I mean you said not sufficient to say as long as one of these wireless technologies is used, you have a transmission that meets the claim?

MR. THACKER: No. We submit it is not because the application itself does not specifically say to use Wi-Fi. It only says to use Bluetooth expressly. And as Mr. Rysavy explained, there's just no disclosure of a switch.

And so whether or not there's disclosure of broader radio signals, there's still no disclosure of switching from one technology to another. So a POSITA would not understand that the inventors possessed this concept of switching between technologies.

And Mr. Rysavy went on to explain, and this is on Slide 10, he said all it would have taken is just a sentence or two for the '948 application to have conveyed possession of this switching concept.

So it was a very easy thing to do, and there's just simply no disclosure of that.

JUDGE QUINN: Okay. I also have a question for you on Paragraph 7 of the application. It's on the background of the disclosure.

MR. THACKER: Yes. I see that.

JUDGE QUINN: And it says that it's known that data is being transmitted from one device to another using suitable technologies, for example, wireless LAN. Why isn't that disclosure that it is known that you can transmit data using wireless LAN; specifically, data transfer between devices?

MR. THACKER: Well, I mean, that's not disclosure of switching between different technologies. All that's saying is that you could transfer --

JUDGE QUINN: I didn't say it was disclosure of switching.

MR. THACKER: Okay.

JUDGE QUINN: It plainly discloses that it is known that data can be transmitted between two devices using wireless LAN --

MR. THACKER: Correct.

JUDGE QUINN: -- and it discloses the problem of using this particular background of file transfers using that technology.

MR. THACKER: That's correct.

JUDGE QUINN: But if it's known, why do you have to repeat it?

MR. THACKER: So are you asking as far as to express disclosure of using Wi-Fi for transfer, or are you asking in the context of this switch between protocols?

JUDGE QUINN: Well, if it's known that data transfers occur traditionally or currently in the technology using wireless LANs, which is also a Wi-Fi technology, why do you need to then later specify and stress again that what you really mean is for transfer data using wireless LAN

when the disclosure applies to the newness of the combination of using a discovery protocol with the current data transfer. Why isn't that not possible?

MR. THACKER: Well, again, I think that the disclosure of a single technology to transfer data is not sufficient to disclose this concept of switching between different protocols during the file transfer process.

And also this background paragraph is talking about how the, you know, it was known to, for example, use a WLAN, but what it does not say is that it was known to use that in combination with another technology during the same file transfer process.

JUDGE QUINN: Well, I don't think the claims are saying that during the same file transfer process you're using different technologies. The file transfer occurs using Wi-Fi.

MR. THACKER: Correct. But it disclose -- so let's go back to the claim, and this is shown on Slide 3. So the method comprises detecting another device using Bluetooth, right? And then transferring to that device, to that detected device that you detected using Bluetooth, using Wi-Fi to transfer a selective media element.

So as part of that method or process, there's two different technologies that are being used: one to detect the device, and one to transfer content to that detected device. Does that speak to your question?

JUDGE QUINN: No. I mean, I can read the claim. What we're talking about is the background provides the starting point of where the technology is at the time, and that background's already telling you that it is known to send or transfer data between devices using a wireless LAN.

If you start from that standpoint, and then you add the further discoveries of these inventors to add the protocol for discovery using Bluetooth, why is that not a jump to what you have in the claims, which is you already know how to transfer data using your wireless LAN and you're adding a discovery protocol using Bluetooth?

MR. THACKER: Because so first, there's no -- I understand the question. I understand that what you're saying is, okay, well Wi-Fi was known to use Wi-Fi for transfer and Petitioner does not dispute that. And it was known to use Bluetooth for detection. Petitioner also does not dispute that. But what the reference is, like, Hoddie and McKillop disclosed, is that they were leveraging those known technologies to perform a specific transfer process that was more energy efficient because if you use for Bluetooth for detection and was faster because it used Wi-Fi for the transfer.

So those references that actually demonstrated possession of this concept of switching from one to another, they actually expressly disclosed that. And if we look at McKillop for example, and this is cited in Mr. Rysavy's original declaration at Paragraph 35.

JUDGE QUINN: What exhibit number is that?

MR. THACKER: That is Exhibit 1203. So in Paragraph 35, he explains that there were many prior devices that had Bluetooth and Wi-Fi capabilities, right? So he says by as early as May 2007, for example, laptop computers such as a MacBook Pro, was configured to communicate wirelessly and in accordance with both the Wi-Fi and Bluetooth standards. Similarly, by at least August 2007, iPhone had more antennas than an ant colony; one for cellular, one for Wi-Fi, a third for Bluetooth.

And then he also cites to Exhibit 1267, Paragraph 6, saying that by July 2006, many devices that included Bluetooth also supported other wireless technologies including 802.11 which is Wi-Fi.

And so -- but what is not -- these devices however, that including the iPhone and the Mac, that had these Bluetooth and Wi-Fi capabilities, didn't use this hybrid method of one for detection and another for transfer. So just that ability or just the fact that a device has Bluetooth and Wi-Fi, doesn't necessarily indicate to a POSITA to use one for detection and another one for the transfer.

JUDGE QUINN: Okay. You're five minutes into your rebuttal time, so you want to jump into --

MR. THACKER: Okay.

JUDGE QUINN: -- something else?

MR. THACKER: Yes. I would like to touch on one other thing which is this eggs and toast analogy that Patent Owner raised for the first time in its sur-reply.

And essentially what Patent Owner argues is that he gave the chef a skillet and a toaster and told him to make scrambled eggs and toast, that the chef would know to cook the eggs in the skillet and toast the toast in the toaster. But this analogy is inapt to the facts here.

In their analogy, the chef would know to cook the eggs in the skillet because you can't cook eggs in a toaster. But here Bluetooth could be used, and is perfectly capable of being used, for both detection and transfer.

If we look at Patent Owner's own expert, Dr. Edwards, he acknowledged, and this is in Paragraph 84 of his declaration which is Exhibit 2014, that quote that Bluetooth can quote easily handle the transfer

of a single file. All the claims require is the transfer of a single media element. Thus, Bluetooth is perfectly capable of handling the transfer, and a POSITA would not necessarily know from the '948 application that Wi-Fi is used for the transfer instead of Bluetooth.

JUDGE LEE: Can I ask you a question? It's Judge Lee. I think what's critical is this one single sentence in the description in this stack. It says any combination or all of these communication technologies may be implemented in a single component design.

So that sentence is critical and I just want to add something. What about a switch -- the last two words a little bit, instead of saying may be implemented in a single component design, instead of saying that, what if it were to say may be implemented in a single communication between two WTRUs. Would that make a difference? I know it doesn't say that, but what if the description is that? Instead of saying in a single component, it says in a single communication between two WTRUs? Would that make a difference? So it wouldn't be supported?

MR. THACKER: Yes. That would definitely make a difference. I think that if it had said any combination of the technologies may be implemented in transfer of, you know, media content between devices, then we would have perhaps a different outcome, but it doesn't say that. It says just --

JUDGE LEE: The way it says is -- all it indicates seems to be this hardware as that, but it doesn't tell you how to use it which is your point. If you want to claim a specific way of using it in combination, that's beyond the description.

MR. THACKER: That's correct, Your Honor. And I mean, the facts that the device includes Bluetooth and Wi-Fi, and that doesn't necessarily mean to use them as part of this method of sending a media element to another device. I mean, the Wi-Fi could be used for browsing the Internet through your router.

So there's just no unambiguous disclosure of using these technologies in combination with each other to perform the specific detection and transfer actions as in this hybrid-claimed method.

JUDGE LEE: I think I understand of the point in fact that something just occurred to me, I think this reflects it. But if I were on the gym, and I can put taped lines for whatever sport I want, for badminton court, for a tennis court, or a pickleball court, you know, it's a big space. I can have, like, five or six courts and I can lay down the tapes on the floor that are used for all sports, right? And it would be, like, I can put out promotional materials saying I have facilities for all three -- any combination of these sports.

But what I mean is, you know, in court 1 you can have badminton, court 2 you can play tennis, court 3 you'd have pickleball in it. What you're saying is that that doesn't mean I'm saying for this one court, one guy over here is playing by pickleball lines with a pickleball pattern for them. The other half of the same court, the other guys are using a tennis racquet with tennis lines. I think that's kind of the same thing as what you're saying about this one-line description.

MR. THACKER: Yes. I agree with that.

JUDGE LEE: Okay. Thank you.

JUDGE QUINN: So would you say that we have here in this case, and we're dealing basically with, a battle of the experts on what a person skilled in the art would have understood by the disclosure?

MR. THACKER: Really this comes down to, and I mean, it may -- Yes, it is in the terms of that there's two experts and they have provided some testimony.

But ultimately, Dr. Edwards, and now I want to turn to Slide 12, for example. He just provides this conclusion that's unsupported and Mr. Rysavy explained that this is unsupported that the transmission instructions can indicate that Wi-Fi should be used for the transfer. And that's just -- he doesn't provide any explanation to support that. And Mr. Rysavy explained why that's not the case. And because, you know, there's no indication that there's any impact on layer 1.

And then similarly, if we turn to Slide 11, Dr. Edwards sort of just concludes that a POSITA would understand that Wi-Fi's used for the transfer because it offers better transmission speed. But what Dr. Edwards appears to be doing here is sort of filling in this complete lack of disclosure in the '948 application with the knowledge of a POSITA. And while the knowledge of a POSITA is certainly relevant, that knowledge alone is insufficient to fill the total gap in the disclosure in the '948 application.

And although Dr. Edwards doesn't use the word obvious here, his argument essentially boils down to what seems like an obvious to try rationale. At, like, oh, because a POSITA knew that Wi-Fi offered better transmission speeds, they would have found it obvious to use Wi-Fi for the transfer. But again, the expert has explained that throughout his briefing that

obviousness alone is not enough to satisfy the written description requirement.

So while there is expert testimony on both sides, Mr. Rysavy has provided lengthy explanations as to why the '948 application does not convey possession. Whereas Edwards -- Dr. Edwards, Patent Owner's expert, has provided only conclusory assertions about one, what the transmission instructions could indicate, which is not unambiguous disclosure; and second, what a POSITA would have found obvious based on their knowledge, which, again, is not sufficient to satisfy the written description requirement. Does that speak to your question?

JUDGE LEE: It's Judge Lee again. Do you have to prove they should not get the vested date, or do they have to prove they are entitled to the vested date?

MR. THACKER: Yes. That's a good question. So there's the burden of production to conform with evidence showing entitlement is on Patent Owner, but ultimately, it's Petitioner's burden of persuasion.

JUDGE LEE: What does that really mean? Because we all talk about, okay, so the burden of production is on Patent Owner to come forward with something, right? But how much is enough? You know, what if they just have a one liner and I'm entitled to the benefit made in that? Nothing else, but they could say, well, there, I came forward with something. And then now the burden's back to you to show that I'm not entitled to it. Is that -- it's kind of a little confusing. I think Dynamic Drinkware does not say enough about how much it takes to meet the burden of production. Does it have to be enough to make it a prima facie case, or it doesn't. All it takes is some utterance by the Patent Owner, hey, I want that

patent today. And my expert says I'm entitled to it period. Is that's enough to meet the burden of production?

MR. THACKER: I think that it's, again, like you were saying unclear in the law whether Patent Owner hasn't met that burden here. But I think that it doesn't matter because even if they have met that burden, Petitioner has shown by preponderance of the evidence that they are not, in fact, entitled to that earlier date.

So I think that that discussion about whether or not they've met that burden is sort of moot.

JUDGE LEE: Okay.

JUDGE QUINN: This is your total time remaining.

MR. THACKER: Okay. I see that. I think that I will reserve the remainder of my time for rebuttal.

MR. MASON: Okay. Judge Quinn --

JUDGE QUINN: Yes.

MR. MASON: -- under me, can I make just a couple clarifying --

JUDGE QUINN: Sure. Absolutely.

MR. MASON: -- points. Okay. May it please the Board, Andy Mason on behalf of Petitioner briefly under LEAP, just making a couple clarifying points.

So I think going back to Slide 4, and this shows Paragraphs 24 and 39 of Exhibit 1282, the grant for an application, and I just want to make clear, so I think this was conveyed through Judge Lee's questioning, but Paragraph 24 and 39 relates to, what it describes is just a device having certain capability. It just says it's implemented. All of these communication technologies may be implemented in a single component design. It doesn't

say they are used by that design. It doesn't say how they're used. It doesn't say, you know, to Judge Lee's hypothetical, you know, these technologies may all be used in any of the following methods described in this application. There's none of that language.

And so it does not say how you might use Wi-Fi, or indeed, that you use Wi-Fi at all in these claimed methods. And I think if we look to Slide 12, and this is Dr. Edwards, Patent Owner's expert, I mean, he actually, to a smaller degree, rewrites this paragraph. I mean, he rewrites it to say in the middle there, it says, his characterization of that paragraph, it says including a 3G PP modem, Bluetooth, or Wi-Fi can be used in a single component design. So he starts going from "implemented with" to "used" in this design, right? So he's already, with his expert testimony, rewriting that disclosure a little bit.

And as Judge Lee noted, this is a critical disclosure. This is one of the two pieces that Patent Owner, in trying to meet his burden of production, has cited to. So they cited to Paragraph 29. All that gives you is a device with its possible capabilities. It doesn't say how to use it.

And then later describing the method, what it does is it walks through these different method steps at the beginning of evidence says he used Bluetooth for detection, and then it walks you through some other things, and then okay, and then you transfer the data.

Mr. Rysavy, with the Petitioner, explained why, you know, that silence as to what happens with the transmission would leave a skilled artisan to understand that description as using the same protocol Bluetooth that was used for detection throughout the whole method. And so you would use Bluetooth for transfer.

In response, Patent Owner pointed to Paragraph 39, and this is, again, on Page 4, Slide 4, Paragraph 39 of Exhibit 1282, and the transmission instructions. And I just want to make clear on that, but in, one, the transmission instruction's reference is vague and it was Dr. Edwards' testimony on that was -- lacked a lot of explanation. And also, he didn't say someone would understand that this disclosure in Paragraph 39 to mean that there's a switch described here. He'd say, oh well, you could use these transmission instructions to indicate a switch, but that falls short of what a skilled artisan would understand that disclosure to describe, or to mean.

And it's not that, again, the test is not what someone might envision as possible, or there's an alternative in rating the application, it's what does the application, you know, if you imagine a teacher-student analogy? The student has to show their work in answering a test. You know, if they don't show their work and explain to the teacher every part of the answer, then it's not just oh, can a teacher in front of me answer from what the student has said. It's the student actually walk through, show their work, and provide an answer.

Here, in the application, they did not provide that. And I think specifically with respect to the transmission instructions in Paragraph 39, this might have been covered but I want to make sure it did is it -- Dr. Rysavy, or Mr. Rysavy explained, if those did indicate some switch or even could indicate some switch, you would expect there'd be some mention of layer 1 because layer 1 is where that kind of switch between different protocols would be reflected. And he provided nearly a page of background references explaining why that's the case in these situations.

And then he went on to say, there's no mention of a layer 1 change. There's no mention of layer 1 with respect to these transmission instructions which would lead a skilled artisan to understand this as not indicating a switch. You know, this has nothing to do with the switch. So again, ultimately, in reading this, these different -- what Patent Owner is pointing to is a skilled artisan would still understand that there's no switch between your detection protocol and the other protocol.

And one last point, I think Judge Quinn, you had a question on Paragraph 7 of 1282, and, you know, asking well, you know, wasn't Wi-Fi known? I think there's no dispute that Wi-Fi was known as a way to transmit data.

And I think what actually Paragraph 7 and 8 and others in that -- the beginning of the application shows, they show that the actual disconnect between the original 2009 application and these claims which were not filed until 2013. And because if you look at that application, it talks about Wi-Fi. It talks about different ways transfers can be done.

And then it goes on, it focuses on sort of how cumbersome this is for users. It doesn't say users are worried about speed or, you know, and so we want to solve this detecting, we're concerned about speed and energy. What it says is users think this is too cumbersome and then it goes on to explain different gesture-based techniques for making it less cumbersome to the user.

So I think, if anything, that exposes the disconnect kind of between the original application and the claims. And because of that disconnect in this instance, that they just -- there is no written description support for these later filed claims, and for a prior art it renders all challenged claims on that.

JUDGE QUINN: Thank you.

MR. MASON: Thank you.

JUDGE QUINN: Yes, no problem.

MR. HEJNY: May it please the Board, Scott Hejny, McKool Smith, on behalf of Patent Owner InterDigital.

So the question here, obviously, revolves around a written description, and what is involved in a written description analysis? And Section 112 makes it clear that the specifications shall contain a written description in a manner of making and using the invention to enable a person of ordinary skill in the art to make and use the same.

And then a question has been addressed by the Federal Circuit in many cases, and the question is whether the disclosure the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. The question of possession is an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.

Now we've heard argument about the experts and what the experts say. And we have heard about Paragraph 24, which Patent Owner believes in and of itself, is sufficient disclosure to support the use of Bluetooth and Wi-Fi in a single-component design which would be -- a single-component being a single WTRU -- and there's a reason for that. And it's true. There is no straight disclosure in the specification that says use Wi-Fi for data transfer. But what's important is what would be understood by a person of ordinary skill in the art.

And it's also important to remember that the Federal Circuit has stated in several instances that there is no requirement that a claim limitation be

disclosed in haec verba. So in those words. There is no requirement that the patent specification disclose a claim limitation in those very words.

So there is no requirement that the transfer or the switch that Microsoft references be disclosed in the patent specification. What is important is whether a person of ordinary skill in the art read Exhibit 1282, which is the '948 application, would understand that a single-component design, a single WTRU could include these four disclosed functionalities; the 2G, the 3G modem, Wi-Fi, and Bluetooth, and how those would be used.

JUDGE QUINN: Do you think that your inventors had an obligation to describe the particular use of transmitting data through Wi-Fi in addition to the disclosure of the discovery protocol?

MR. HEJNY: I think they believed that they had sufficiently disclosed the invention such that a person of ordinary skill in the art such as the inventor, would understand that you could use different detection and transfer techniques. And I believe that's evident from Mr. Reznik's testimony which we'll take a look at later, is that that's what he believed had been disclosed in the Patent application. By disclosing --

JUDGE QUINN: Well, there's a difference between what they believed and what they thought they had invented, and what actually made it into the application. And so my question is do you think they have an obligation or they had at the point in which they submitted their application to the Patent Office to describe that which they thought that they already had invented which, according to you, is the data transfer using Wi-Fi?

MR. HEJNY: Well, that's a quick quid pro quo for patent protection as you disclose to the Patent Office and to the public your invention, and

then therefore you're guaranteed protection of those inventions for a set period of time.

And I believe that the inventors felt that this disclosure sufficiently disclosed multiple ways to detect and transfer data. So I do believe that that is a requirement in a patent disclosure, but I believe that the inventors felt that they had sufficiently disclosed to one of ordinary skill in the art, how to use different technologies, different layer 2, layer 3, baseband technologies to detect and then transfer data.

JUDGE QUINN: Then why wait to claim it until 2013?

MR. HEJNY: Well, Your Honor, that was obviously the launch date for Apple AirDrop, and the inventors may have felt the need to specifically spell out Bluetooth detection and Wi-Fi data transfer, but the fact of the matter is, is the Examiner felt that there was sufficient disclosure in the patent specification to support this claim amendments because the claims actually issued.

And even more so, Your Honors, there is no preclusion from writing the claims that read on a competitor's product. That's the essence of the Trebro Manufacturing cases, 748 F.3d 1159 at 1172, it's a 2014 Federal Circuit Decision, as well as the BlephEx v. Myco case, 24 F.4th 1391, 1404, which is the Federal Circuit 2022 case, in which the Federal Circuit stated, after all, there's nothing improper, illegal, or inequitable in filing a patent application for the purposes of obtaining a right to exclude a known competitor's product from the market.

So, you know, it may have been individual inventors belief that when Apple launches their AirDrop product, they should amend the claim or submit amended claims that were also supported by the patent specification

making it clear, that, you know, you could have Bluetooth detection and Wi-Fi transfer despite the fact that that was clearly disclosed in Exhibit 1282 which is the '948 application.

Because if it wasn't disclosed the Examiner wouldn't have allowed those claims to issue, and there would have been no support for those claim amendments.

JUDGE LEE: And can I interrupt? It's Judge Lee. I think Judge Quinn's question to you was do you believe there's a requirement for the inventor to describe the use? And your answer I don't think was on point. You know, your answer was, well we already know that inventors have to describe something to enable one with an ordinary skill in the art to make and use. So it's two different things.

You know, there's no question about enablement here, but there's a question about whether the actual use is described. And that's, you know, the critical sentence that seem to be pertaining to use. It seems to be saying this device has dual-ranking abilities as well as Wi-Fi capabilities. It doesn't say use some of it sometimes and the other one in the same communication.

So can you answer Judge Quinn's question? Is there an obligation or requirement for the inventor to disclose in the specification the use -- a use for it, or is it simply enough to enable a POSITA to make a use?

MR. HEJNY: Well, the requirement is whether or not the disclosure relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed invention.

In Paragraph 24 of Exhibit 1282, it clearly shows that the inventors of vision communication peripheral, that could include multiple technologies including Bluetooth and Wi-Fi. And that any combination, or all of these

communication technologies, could be implemented in a single-component design.

So I believe that the inventors had an obligation to disclose these different technologies and did, indeed, disclose these different technologies. And then when explaining the operation of the system, in, for example, Paragraph 39, explained how configuration, information, and communication the transmissions instructions could be used to define which layer 2 or layer 3 baseband component would be used in a given implementation. Taking into account, for example, power settings, antenna orientation, and the and/or the analog and radio frequency components. You know, obviously, the analog radio -- and/or the analog and radio frequency components, those include Bluetooth and Wi-Fi.

So I believe that the inventors did feel the requirement to disclose the claimed invention and did so, and they felt like they had disclosed it in such a way that a person of ordinary skill in the art would understand the disclosure, and the fact that you could have multiple technologies in use in a single component, and that you could have this switching that Microsoft is suggesting is not disclosed and should have been explicitly disclosed in the patent specification. Am I answering your question, Judge Lee?

JUDGE LEE: Not really, but it's okay. You know, my other analogy -- I have a facility for badminton, tennis, and pickleball. That's like what this spec is saying. I'm not saying I have one person playing tennis on one side and pickleball on the other. This was following different tapes on the court. You know, you're saying if I say I have to sell to you -- for you to play any combination of these three sports, that's enough description to say I

have one guy playing pickleball on one side, and the other guy following the boundaries and lines. You know, that doesn't make sense to me.

You're saying that in combination means strange combinations as well. I meant on one court you play tennis, on the second court you play badminton, on the third court you play pickleball and want players -- all the players on one court playing the same thing. Your meaning of this specification is, oh, any combination. I'm a tennis guy, I want -- and I have a pickleball guy and the other going by different lines. That's the way I'm seeing it now so you if you could help me, dissuade me from thinking that, please go ahead.

MR. HEJNY: Without question, you could play pickleball on one side of the court with someone with a tennis racquet on the other. It may not be the most efficient way to play pickleball or tennis, but it could certainly be done.

And to be honest, it kind of leads into this discussion of Bluetooth for detection and Wi-Fi for transfer because in some instances, Bluetooth is better for detection because it's low power, and it has a shorter reach for detecting nearby devices, but Wi-Fi is obviously a more power consuming and powerful vehicle for transferring data. So --

JUDGE LEE: I agree. It won't be as fun, but it's playable?

MR. HEJNY: Yes.

JUDGE LEE: So lines are all on the same court. You know, the big ball lines on one side, one guy follows the tennis lines, and on the other, yes, it won't be a great game, but it certainly it can be done. And there would be description for it if you take the literal meaning of any combination.

MR. HEJNY: Any combination can be used in a single-component design. Are you identifying a single court as a single component?

JUDGE LEE: Facility. Like, you know, my gym facility. Any combination of those can be used in my gym facility. That doesn't mean -- or by court by court -- doesn't mean you can mix different protocols in one communication.

MR. HEJNY: Well, it could be that you have a tennis court right next to a pickleball court, just as you would have a Bluetooth antenna right next to a Wi-Fi antenna, such that you -- you know, some people were playing Bluetooth, doing the detecting, and on an adjacent court you have people playing tennis who are actually doing the Wi-Fi, it's a faster-paced course, on a bigger, more expansive court. And that would still fit within the definition that you're identifying as within, you know, a component being a single facility. You could have players, you know, playing Bluetooth on a court next to players playing Wi-Fi on a court.

JUDGE LEE: Okay. Thank you.

JUDGE MURRAY: This is Judge Murray. One of your arguments is that the level of descriptive detail needed is lower because this is a predictable technology. Could you identify what "this" is referring to, and "this is a predictable technology," and could you explain why it's predictable?

MR. HEJNY: Yes, Your Honor. So a lot of the -- the cases that relate to blaze marks and the like, that have been cited by Microsoft, relate to pharmaceutical cases where you can have a laundry list of compounds, or amino acids, or chemicals, or genes that have to be combined in order to form a specific species.

And if you want to claim that specific species, you need to include guidance for the person of ordinary skill in the art. But here -- this is predictable art because you're disclosing a limited number of transmission technologies; there are four, the 2G and 3G modems, Wi-Fi, and Bluetooth. And because that is a limited realm of disclosure to a person of ordinary skill in the art when it comes to detecting and transferring, there necessarily can be a lower level of detail because a person of ordinary skill in the art will see those technologies, and they will understand that some of them are more efficient for detection, like Bluetooth, and some are more efficient for transmission, like Wi-Fi.

And that's what I mean, when I say this is a field that requires less description, and which a lower level of detail is required, and that's included on Slide 16 of InterDigital's presentation that relates to the Ariad case and the Hologic case where the Federal Circuit held just that.

So a lot of these cases that relate to blaze marks relate to pharmaceuticals, as evident from both of the cases cited on Slide 16. But there's a predictable area where you have communication technologies -- layer 2 and layer 3 -- especially as you have here where you have it limited to four different communication technologies, the Federal Circuit has held that you have to have a lesser level of detail in the disclosure than a person of ordinary skill in the art would understand how to implement those different elements in view of the recited claims.

JUDGE QUINN: What is your response to Petitioner's argument that their expert testified in detail as to the importance of the layer 1 communication with the transmission information not having any impact on layer 1; therefore, that that means the transmission information is really not

affecting the radio layer which you would need to switch between the Bluetooth radio to the Wi-Fi radio?

MR. HEJNY: Well, the Bluetooth radio and Wi-Fi radio are both in layer 2 and 3, if I understand correctly.

JUDGE QUINN: Yes.

MR. HEJNY: And the system is configured such that you can operate this system, and you could do the detecting and the transferring without intervention by the users.

So the user's going to have a WTRU, and they're going to be seeking to detect a nearby device, and send the request to transfer, receive an acknowledgement and acceptance, and then transfer that media. But the detection of the transfer technology's going to be transparent to the user of the WTRU who's looking at a graphical user interface, and just selecting which media they want to transfer.

So I don't know how layer 1 would come into play because everything's operating behind the scenes at a lower level -- layer 2 and 3 for Bluetooth and Wi-Fi, so I don't know that that is an accurate analogy or an accurate argument.

JUDGE QUINN: Did your expert have any rebuttal explanation of that?

MR. HEJNY: He did not respond to the layer 1 arguments, Your Honor.

JUDGE QUINN: Okay. Thank you.

MR. HEJNY: I will note that Microsoft did depose Dr. Edwards after submission of that declaration but did not ask him any questions about that either.

JUDGE QUINN: Okay.

MR. HEJNY: So Slide 17 is important. I mean, we heard Counsel for Microsoft say that InterDigital didn't use the word obvious anywhere in its briefing, and that's true. Because we are not arguing that it would be obvious to use Bluetooth for detection and Wi-Fi for transfer. We are arguing that a person of ordinary skill in the art would understood, having read the specification, that that was an option in view of the disclosed technologies.

Now the inventor -- one of the inventors -- of the '948 application, which is Exhibit 1282, was deposed in a parallel case; a parallel proceeding before the FTC, and Mr. Reznik was deposed on these very same issues related to the validity of the '933 and '054 patents. He was not questioned by counsel for Microsoft. He was represented by counsel for Lenovo, Microsoft's real party in interest -- Microsoft's admitted real party in interest in this proceeding. And the law is clear that an inventor is a competent witness to explain the invention and what was intended to be conveyed by the specification and covered by the claims.

The testimony of an inventor may also provide background information including an explanation of the problems that existed at the time the invention was made, and the inventor's solution to these problems.

So those two cases which were cited on Slide 19 of individual's protected of presentation are Bradium Techs., 923 F.3d 1032 at 1044, a 2019 Federal Circuit case. And then Voice Techs., 164 F.3d at 615, which is another Federal Circuit case that was cited and briefed in the Patent Owner's response on Page 21.

So Mr. Reznik was deposed and he was asked questions. And he was asked questions about, you know, what were the known ways the data transfer were you referring to in the patent application, and he said so Wi-Fi for sure. And he said, well they asked the question. So those were Wi-Fi and cellular data transfers. Is that right? For the record, I'm reading from Slide 20, the individual's presentation in citing to Exhibit 2015. And his answer was Wi-Fi and cellular definitely come to mind for data transfer.

And again, Counsel for Lenovo's probing on, you know, what sort of technologies did Mr. Reznik, who was being deposed, and Mr. Carlton, who is the other inventor, have in mind for determining whether devices were nearby? So, technologies like Bluetooth was his answer. And again, quote they tend to be pretty good figuring out what devices are nearby, right? And that's why we use Bluetooth for wireless phones and stuff like that.

And turning to Slide 22 of the individual's presentation, more testimony from Exhibit 2015. The explanation that Mr. Reznik gave is important in view of the wording of the 1282 patent specification.

The reason this is hard is because you don't have the technology that can do both proximity and transfer in a natural way. We've got one set of technologies that can do the proximity, right? We have another set of technologies that could effectively do data transmission. Let's figure out how we take advantage of both to actually achieve this result we wanted to achieve.

So when they prepared and filed the Patent application, it's confirmed by Mr. Reznik's testimony about the state of the art, what they had in mind when they filed that application that is Exhibit 1282, and what they were attempting to achieve. And they ultimately came to an ultimate question,

and I'm referring to Slide 23 of InterDigital's presentation, and the question was asked, okay. Would Bluetooth also be a technology you had in mind when referring to these layer 2, layer 3 baseband? And Mr. Reznik testified, the way I'm looking at the problem we're trying to solve here, Bluetooth is usually more of a proximity technology. This paragraph refers to data transmission technology. I think that for that, we would be leaning towards Wi-Fi and cellular as more typical uses as opposed to Bluetooth. So --

JUDGE MURRAY: Counsel, this is Judge Murray. Let me pause you there for a moment.

MR. HEJNY: Yes, Your Honor.

JUDGE MURRAY: The passage that you just read is talking about the inventor's thoughts at the time of the deposition, isn't it?

MR. HEJNY: Yes.

JUDGE MURRAY: I think, in the present tense?

MR. HEJNY: That's correct, Your Honor. He's reflecting on what he had in mind; what he and the other inventor had in mind when they filed the application because that was the nature of the questioning.

JUDGE MURRAY: And on Page 24 of your response brief, you have another quote from him it says, whether we stop at that point, and we said, hey, this is the best one in this family, or this is the best one in that family, I don't remember, right? We kind of said there's options on both sides, and is that testimony about what the inventors were intending at the time of the invention?

MR. HEJNY: Yes, Your Honor. This is also testimony from -- I'm referring to Page 24 of the Patent Owner response?

JUDGE MURRAY: Yes.

MR. HEJNY: And this is also testimony from Mr. Reznik where he mentions both cellular and Wi-Fi are two good families for data transfer, and your question related to the last paragraph, correct? Whether we stopped at that point and we said, hey, this is the best one in this family, or this is the best one in that family, I don't remember, right? We said -- we kind of said there's options on both sides. Is that what you're referring to?

JUDGE MURRAY: Yes, that's right.

MR. HEJNY: So again, this is Mr. Reznik's testimony, so I'm speculating as to the meaning of those words. But there were four transmission technologies and a detection technology, and we have heard testimony on these other slides and InterDigital's presentation, and we submitted additional testimony from Mr. Reznik in an exhibit, Your Honors, in connection with the sur-reply because I know that the -- I'm sorry, yes. In the sur-reply, because I know that the Board were questioning in the Institution Decision where they had seen enough testimony to have context.

But the inventors wanted to lay out the options knowing that a person of ordinary skill in the art would understand which of these options were best for detection, and which were options were best for transmission. Because I think it's without --

JUDGE MURRAY: Question --

MR. HEJNY: I'm sorry, Your Honor.

JUDGE MURRAY: I'm sorry. What these two passages are telling me is that we now know what one of ordinary skill would think now, but that we don't know what they would have thought at the time because the inventor couldn't remember. Is that a fair characterization?

MR. HEJNY: So he was asked a question, if you're reading at the top of the page, when pressed as to whether the invention disclosed a communication peripheral, it must be limited to a Bluetooth device or a Wi-Fi device but not both, then he provided the testimony that I just mentioned.

And you're right. I mean, he is -- he may not have a perfect recollection of exactly what happened in 2008 when the provisional application was filed or in 2009, when the -- when Exhibit 1282 to the application -- the '948 application -- was filed, that he's testifying as to the best of his recollection in the context of addressing the written description of the '948 application as to what he remembered about what they did, and why they did what they did.

And to me this reads out that they laid out the possibilities knowing that a person of ordinary skill in the art would understand that because of the statement in the patent specification or the '948 application, pardon me, Exhibit 1282, that you have four communication protocols and any combination could be included in a single device, that a person of ordinary skill in the art would understand the benefits of using one over the other, or in combination.

But you're right, Your Honor. To answer your question, he may not have a perfect recollection as to what happened in 2009. I know I don't.

JUDGE MURRAY: Thank you.

MR. HEJNY: And again, the reason for offering this testimony is just to describe as cited in Bradium Techs., what the witness -- the inventor, who is undoubtedly a person of ordinary skill in the art, intended to be conveyed by the specification. And then for that same person of ordinary skill in the art as in Voice Techs., to provide background information about the

problems that existed at the time, and the inventor's solution to those problems.

So I believe that this testimony is squarely on point, and I urge the Board to consider it as they make their determination as to priority.

JUDGE QUINN: How much weight shall we give to inventor testimony that is not corroborated with anything in any other documentation, or notebooks, or contemporaneous documents?

MR. HEJNY: I mean, the case law that I cited doesn't speak to the need to corroborate that inventor testimony. Now obviously, if you're in a patent infringement lawsuit, and your inventor is testifying as to claim construction or something to that effect, typically you would have corroboration by an inventor notebook.

But the cases that I cited as to what the inventors had in mind at the time they filed the application, I don't believe there's an independent requirement of corroboration in correlation with those Federal Circuit cases, Your Honor.

JUDGE QUINN: Yes. I mean, the case law's typically on antedating or on a priority dispute, but I mean, this is ,sort of has, the same flavor to a priority dispute, which is, you know, can you claim priority to the provisional if you don't have sufficient disclosure. And so my question is, is there room here to require corroboration or not?

MR. HEJNY: Your Honor, there's no requirement for corroboration in connection with those cases. So the Federal Circuit has clearly felt that it's proper to allow an inventor to testify as to what he had in mind with his invention at the time the application was filed.

But I agree with you. If we were trying to do something different when it comes to arguing an earlier conception date where the inventor is testifying, potentially, I don't have on behalf of the patentee in an infringement case, you would need proof that the inventor notebook or something of that nature to corroborate. But this is a little different.

We heard argument from Counsel for Microsoft about the written description and different prior references like McKillop and Hoddie, and the argument that some of those references disclose an explicit switching from Bluetooth to Wi-Fi.

But what's disclosed in prior art, patents or publications is wholly irrelevant to this analysis. The analysis is squarely focused on Exhibit 1282 which is the '948 application, and what was done in a different patent application, you know, depending on what law firm drafted it, who the inventors were, it has no bearing on this current dispute.

So regardless of what was said in any of these other prior references is simply irrelevant. It has nothing to do with the dispute that we're here to discuss today.

JUDGE QUINN: So we cannot consider that information, but we can consider what the inventor said and what your experts say?

MR. HEJNY: Well, that's because our inventors and our experts are tethered to this dispute; Exhibit 1282, and the dispute over priority. Other inventors were tethered to their patent applications and their own inventions.

JUDGE QUINN: But the state of the art, isn't there evidence of state of the art when you look at the prior art that is in this case?

MR. HEJNY: I think there is. The state of the art obviously can be relevant, Your Honor. And I think that the statement, the art, at the time that

the '948 application was filed, shows that persons of ordinary skill in the art understood that you could use Bluetooth for detection and Wi-Fi for transfer.

There's simply not a word in the -- there's not an explicit word in the '948 application that says switch, as Microsoft had suggested might need to be there, and/or did you obviously disagrees and believes that the disclosure and the '948 application, Exhibit 1282, adequately supports the 2013 amended claims regarding Bluetooth detection and Wi-Fi data transfer.

And Dr. Edwards discusses this in detail in Exhibit 2014 at Paragraph 80 through 85. And he discusses why a person or ordinary skill in the art would consider Bluetooth for detection because it's a low-power, low-radius technology, but would consider Wi-Fi for data transfer, or cellular for that matter because there's a higher power, faster transfer process that can be implemented in the same device.

JUDGE QUINN: Can you walk me through, and I'm giving you the same option I gave Petitioner's Counsel, to address the transmission instructions and how they relate to being able to disclose that -- the Wi-Fi technology would be used for transmission of data?

MR. HEJNY: Sure. So first, we have the disclosure of the different communication technologies in Paragraph 24. And we discussed those at length.

And then when you look at Paragraph 39, there's configuration information related to issues like power level, antenna orientation, security parameters, and then there are transmission instructions that include instructions for implementing the transfer through specific components in the communication peripheral. The low-specific components in the

communication peripheral could do a Bluetooth antenna, or a Wi-Fi antenna, or a cellular antenna.

As Counsel indicated at the end of the argument of Microsoft, you know, these communication devices in this time period have multiple antennas and could perform multiple functionalities. And the configuration information and transmission instructions would direct which of the layer 2, layer 3 baseband components perform the different elements of the communications as we discussed before. It would be a background implementation whereas the system knew to use Bluetooth for detection and then to use Wi-Fi for data transfer.

So the transmission instructions are absolutely important because they implement the transfer through specific components in the communication peripheral. And those specific components are identified in Paragraph 24, the communication peripherals include these technologies and they can be any or all, any combination or all of these technologies can be implemented in a single-component design.

So when this, where I'm looking at, Paragraph 39 at the bottom of the page on Exhibit 1282, and it states, as well as instructions for implementing the transfer through a specific components in the communication peripheral, the components that are being spoken about are the antennas that are used, or the transmit, receive instructions that the Bluetooth layer, the Wi-Fi layer, all of these layer, two layer, three baseband components that are discussed on the top of Page 11, still in Paragraph 39.

Moving on, did that answer your question, Judge Quinn?

JUDGE QUINN: Yes. I'm just wondering, my follow up, which is why isn't that support for what Petitioner is advocating, which is the

transmission will, that is the transmission that is referred to there, the peripheral device will be the same communication protocol that was used for the detection?

MR. HEJNY: Well, there's simply no requirement that that same protocol be used for both detection and transfer.

JUDGE QUINN: Well, I mean, my question wasn't whether there is a requirement, my question is how does that statement, that same Paragraph 39 can be read as Petitioner read it, which is you're really transmitting using the same communication protocol from the detecting step?

MR. HEJNY: Well, then, my answer would be this. If you look at Paragraph 34, it talks about, first of all, so there's no abstracting this one. But Paragraph 34 at the top of Page 9, Exhibit 1282, states that for example, a Bluetooth connection may be used to implement an SDP, which is a service discovery protocol, for this purpose, which is discovery. And again, at the very beginning of Paragraph 34, the environment information may be gathered via a service discovery protocol such as currently available in protocols such as Bluetooth, for example.

So you're capturing environment information. So you know there's a disclosure of Bluetooth detection in the patent specification, in the -- sorry, the '948 application, Exhibit 1282, and then there's configuration information that's configuring transmission instructions that may impact the configuration of the layer 2, 3, baseband components.

Why would you have transmission instructions to configure the different layer 2, layer 3, baseband components if you're wanting to do transmission via a single technology? To me this reads that yes, you can do Bluetooth for detection, but you may want to do something else for

transmission, and these transmission instructions can be used to configure the system including the layer 2, 3, baseband components which include Bluetooth and Wi-Fi to transfer data so you could be in over a different service.

So my answer in summary, is that the patent, the 1282 application discloses Bluetooth as a service discovery protocol, but then you have this additional disclosure on Page 11, Paragraph 39 of Exhibit 1282, that talks about using configuration information and transmission instructions to impact a configuration of the layer 2, 3, baseband elements. Why would you be needing to further configure those elements if you do that you're wanted to do Bluetooth detection and Bluetooth transfer? It leaves the option open. There are different technologies disclosed. A person of ordinary skill in the art reading this would understand that these different technologies can be controlled using these transmission instructions that are generated once you have detection completed.

JUDGE QUINN: And I'm giving you an option to also describe to me the importance or the lack thereof of Paragraph 7 in the background.

MR. HEJNY: So Paragraph 7 to me explicitly discloses that it was known in the art to do data transfer using Wi-Fi. So it clearly states currently data transfers may be performed using applications through suitable technologies such as GPRS or wireless local area network.

So it was known in the art that you could do data transfer via Wi-Fi. And I think the, reading that, the comment -- obviously, the state of the art plays into the discussion because the state of the art is going to be known by a person of ordinary skill in the art.

And if a person in the ordinary skill in the art knew that you could do data transfer via Wi-Fi, then I think that's indicative of why you have these, this disclosure of using different technologies any of which can be used in a single combination in a component design, you have different technologies that can be used in a single device to detect and then transfer information. And clearly Wi-Fi was a known way to transfer information from one device to the other, whether it be a handset to a handset, or a PC to a PC.

JUDGE QUINN: Now I play devil's advocate and --

MR. HEJNY: Sure.

JUDGE QUINN: -- Petitioner might come back and say, well fine. These were options that you had open there. But an option is not a disclosure, it's just giving you the opportunity to later invent or to later narrow down which option you really were thinking about. And that is in the realm of obviousness rather than written description, what say you?

MR. HEJNY: I think that the fact of the matter is that the inventors were required to disclose the technologies that they had in mind, and they did. And then they wrote a generic claim related to detecting a transfer.

And in 2013, after AirDrop came out, they submitted amended claims, the Patent Office allowed them, and they recited Bluetooth detection and Wi-Fi transfer. And those were both species of the genus that is embodied within the original claim in the '948 application. And I'm very close to the end. I'm going to reserve the rest of my time for surrebuttal, Your Honor.

JUDGE QUINN: Okay. Thank you. You're ready?

MR. THACKER: May it please the Board, Sam Thacker on behalf of Petitioner Microsoft Corporation. I would like to address six points that Patent Owner Counsel just raised.

The first is this argument that verbatim disclosure is not needed. That's not what Petitioner is arguing here. We're not arguing that there have any express disclosure of use Bluetooth for detection then use Wi-Fi for the transfer.

What we're arguing is that there has to be some disclosure that conveys to a person of ordinary skill in the art that there's a change in technologies, or at least, that these two technologies could be used in combination to perform this specific claimed method of using one technology for detection and another technology for transfer.

And Patent Owner relies on this paragraph which just says that there's -- that these two technologies could be implemented in the same component design, but that's not disclosure of using those technologies in combination with one another to perform this specific method that's claimed; this hybrid method.

And Patent Owner also argues, this is the second point, that this is a more predictable art that requires a lower level of detail. Well, whether or not that's true, the written description requirement still requires at least some disclosure.

And I want to get into this, Patent Owner stated that, you know, you need to reasonably convey to a POSITA that the inventors possess what is claimed. But there's several Federal Circuit cases that Petitioner cited, including Lockwood, Perdue Pharma, and the Hyatt v. Boone case. And those cases make it clear that this requirement about reasonably conveyed possession, requires that a POSITA can clearly conclude that the inventor invented what's claimed, that's Lockwood, and Perdue Pharma, and this is

cited in the 537 Institution Decision, a POSITA must be able to immediately discern each limitation from the prior application.

And so whether or not there's a lower level of detail required here, still some detail is required and there's just no disclosure of a switch for Bluetooth to Wi-Fi.

Next, I wanted to address Patent Owner's argument that an applicant's allowed to pursue different aspects of an invention in continuation applications. Well, that's true. But those aspects actually have to be described in the original application if Patent Owner's trying to claim priority to that application.

So the whole purpose of Section 120 and Section 112 is that they prevent the kind of after-the-fact overreaching that Patent Owner has engaged in here.

And then I want to address next, Patent Owner's argument that an inventor is a competent witness to explain what was intended to be conveyed. Again, even if that's true, which, I mean, the case law is clear that that's true, that's irrelevant for written description. What an inventor intended to convey is not what was actually conveyed in the application.

JUDGE QUINN: So what weight should we give the inventor's testimony here?

MR. THACKER: Petitioner submits that no weight should be given to the inventor's testimony about what he had in mind but failed to write down.

JUDGE QUINN: But clearly would be error for us to not consider what they said?

MR. THACKER: Yes. Petitioner is not moving to exclude the inventor testimony, just that Petitioner submits that very little, if any, weight should be given to that inventor testimony.

The fifth point that I'd like to respond to is these transmission instructions that are discussed in Paragraph 39. And the -- what specifically Paragraph 39 says is that there's impact to the layer 2, 3, baseband components, and it says power settings. And then it says and/or analog and radio frequency components, and it says antenna orientation.

And Petitioner submits that a POSITA reading that would understand in the context of Paragraph 41, for example, and in other paragraphs, that really what these instructions are trying to do, is to ensure that only the intended device, the recipient, is getting the message. Because in Paragraph 41, they say that the data may be transferred only as far as is necessary to reach a minimal set of users. So what they're saying is, hey, orient the antenna and adjust the power so that only that user receives that message.

JUDGE QUINN: Well, that is something that is very easily done with Wi-Fi. So why is it not also supporting the idea that you can use Wi-Fi directional, ad hoc networks, to control the radius of communication with other devices?

MR. THACKER: Yes. Again, it doesn't say specifically which protocol is being used, but regardless of whether or not Wi-Fi could be adjusted that way, the POSITA would understand that the same technology's used for both detection and transfer because there's no indication that you're switching from one to the other.

JUDGE QUINN: So if the claims had said detecting using Wi-Fi, you would have still said that that is not disclosed?

MR. THACKER: Petitioner's position is that the only -- yes. Petitioner's position is that Wi-Fi is not specifically mentioned for detection. And, in fact, it's just -- in Paragraph 24, it's mentioned that the device includes Wi-Fi.

But even if the Board found that there was sufficient written description support for using Bluetooth for detection, Petitioner submits there's still no written description support for using different technologies for the detection of the transfer.

And then there's one last point. I'd like to address Patent Owner's argument about the '948 application allegedly discloses a genus, and that they just claimed a species, but here there's no disclosure of a genus because there's no disclosure that any technology can be used for -- or that there's a switching technologies or that somehow different combinations of the technologies can be used to perform the detection and the transfer. So there's just -- there's no disclosure of even a genus.

If there are no further questions, I'd like to cede my remaining time.

JUDGE MURRAY: This is Judge Murray. I just want to make sure I understand your last point. There's no disclosure of a genus because there's no disclosure of any switching technology? Was that what you think it is?

MR. THACKER: Yes. Yes. You know, they've claimed the specific species of using Bluetooth for detection and Wi-Fi for transfer. And they haven't even disclosed a genus of using different technologies for the detection and the transfer much less the specific species claimed here which is Bluetooth for detection and Wi-Fi for transfer. Does that speak to your question?

JUDGE MURRAY: Yes. Thank you.

JUDGE LEE: This is Judge Lee. Doesn't that single sentence disclosure provide a genus? Any combination for all of these communications technologies may be implemented in a single-component design. Isn't that reasonably deemed a genus because it doesn't give any specifics? It says here are all these technologies, go do it. Isn't that a genus?

MR. THACKER: It discloses the genus of the device, the technologies that the device supports, but it does not disclose a genus of performing a method that uses one technology for detection and another technology for transfer.

JUDGE LEE: Okay. So it goes back to the same issue we were talking about before which is the use -- the manner of use; genus is what you're talking about?

MR. THACKER: Yes. The genus is the manner of use. Yes. Exactly. Okay. If there are no further questions --

JUDGE LEE: Yes. One more question.

MR. THACKER: Oh, yes.

JUDGE LEE: Sorry. What really is the difference between Wi-Fi and Bluetooth? Is it just a different protocol? Do you actually need different structures, different antennas, or what? Or completely the same hardware can be used to implement either one?

MR. THACKER: Petitioner's understanding is that you would need different hardware for --

JUDGE LEE: And do you need different antennas? different transmitters? or no? It's just different software, hardware, and protocol?

MR. THACKER: No. Petitioner submits that different hardware would be required, not just different software.

JUDGE LEE: For instance, like, what hardware might be different?

MR. THACKER: For example, the circuitry itself can be different, the antenna could be different. Those are just two examples.

JUDGE LEE: Thank you.

JUDGE QUINN: All right. Thank you very much.

MR. HEJNY: So just addressing Counsel's final arguments, the first and the last seem to go together. Microsoft continues to insist that there does have to be verbatim disclosure of switching because that is the essence of both their first and last arguments. And that is contrary to the prevailing case law which I cited to the Board earlier. And so we got a situation where --

JUDGE QUINN: There is a disconnect here. I heard him say that they don't -- they agree that you don't have to have verbatim disclosure, but there has to be some disclosure supporting the words of the claim, and whether that is verbatim repetition of the claim in the disclosure, or a description of how that limitation works, those are two different issues.

MR. HEJNY: Okay. And InterDigital's position is that the technologies are absolutely disclosed. There's no question about that. And it is InterDigital's position is also that the genus that we're talking about is not only this combination of technologies, you know, that can be used in combination in any single-component design but the fact that the original claims of the '948 application in Exhibit 1282 recite generic detection and generic transfer.

The species is putting a finer point on it as they did in 2013 when they submitted claims related to Bluetooth detection and Wi-Fi data transfer, and it's not after-the-fact overreaching. The Examiner clearly disagreed with that point when he issued the claims.

JUDGE QUINN: Can you point me to the original claims that you are referring to?

MR. HEJNY: Yes, Your Honor. It's Exhibit 1282, Claim 1, where you have generic detecting environment information, and you have a generic transfer between the WTRU and the target WTRU.

JUDGE QUINN: Does Claim 7 also help you?

MR. HEJNY: Yes. Thank you. So that's on Page 19 to 20 of Exhibit 1282. It's acknowledging to disclose as we discussed it was known in the art to use Wi-Fi for data transfer. There is no requirement for in haec verba disclosure of a limitation as long as that limitation is supported by the patent disclosure, and that's supported by both the Novartis case, 21 F.4th 1362, 1373, Federal Circuit 2022, as well as the Quake case, which is actually cited by Microsoft, which is 928 F.3d, 1365, 1374, Federal Circuit 2019, which states, however, if this burden is disclosure, it is not necessary to satisfy the written description requirement of Section 112.

The issue in play which Counsel for Microsoft brought up earlier is different than what we have here because the new claim amendments created a mismatch between the claims and the written description. And that's not we have here.

We have disclosure of different technologies that could be used for different applications within a single device, in your all those technologies for communication can be used in a single device, and that is exactly what

InterDigital did when they submitted their amended claim to 2013. They elected to recite Bluetooth for detection and Wi-Fi for data transfer.

As to a bit of testimony, Counsel said you should give it no weight. And I will tell you that Mr. Reznik is a Dell employee. He is not employed by InterDigital; hasn't been for many years. He's an inventor. He is absolutely a person of ordinary skill in the art. He had no skin in the game between Lenovo and InterDigital when he was deposed as a part of that dispute.

He testified under oath, and giving his testimony no weight would be contrary to Federal Circuit precedent that I cited to you that he's instructed otherwise.

Other than that, Your Honors, I will cede you 15 minutes unless you have questions?

JUDGE QUINN: And it looks like we are good.

MR. HEJNY: Thank you all for your time today. I know I speak for both of us, including a great job by Sam Thacker, as part of the LEAP program.

JUDGE QUINN: Thank you. This has been very useful. We thank you for the very vigorous arguments. Congratulations on your LEAP argument today. You did very well.

We are adjourned and we consider the matter submitted for final written decision.

(Whereupon, the above-entitled matter went off the record at 1:52 p.m.)

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