

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

INTERDIGITAL PATENT HOLDINGS, INC.
Patent Owner

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

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit	Description
2001	Declaration of George Edwards
2002	June 21, 2022 Memorandum from Director Vidal to the Members of the Patent Trial and Appeal Board regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation
2003	Case Management Order, <i>InterDigital, Inc. et al. v. Lenovo Group Limited et al.</i> , Case No. 5:23-CV-493-FL, Dkt. No. 33 (E.D.N.C. Nov. 30, 2023)
2004	Respondents' Invalidity Contentions in <i>Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, and Components Thereof</i> , Investigation No. 337-TA-1373 (ITC Nov. 28, 2023)
2005	Defendants' Preliminary Invalidity Contentions, <i>InterDigital, Inc. et al. v. Lenovo Group Limited et al.</i> , Case No. 5:23-CV-493-FL (E.D.N.C. Jan. 18, 2024)
2006	Transcript of the March 14, 2024 deposition of Mr. Alexander Reznik in <i>Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, and Components Thereof</i> , Investigation No. 337-TA-1373 (ITC)
2007	Shor, Godi, <i>How Bluetooth, UWB, and 802.11 stack up on power consumption</i> , EETimes April 15, 2008, available at https://www.eetimes.com/how-bluetooth-uwband-802-11-stack-up-on-power-consumption/ .
2008	Jani, Jay and Mahendra Maheta, <i>Wireless Computing with Bluetooth & Wi-Fi</i> , 4 th International Convention CALIBER-2006, Gulbarga, February 2-4, 2006, available at https://ir.inflibnet.ac.in/bitstream/1944/1103/1/59.pdf .

2009	Kuo, Cynthia, Jesse Walker, and Adrian Perrig, <i>Low-cost Manufacturing, Usability, and Security: An Analysis of Bluetooth Simple Pairing and Wi-Fi Protected Setup</i> , NetSec 2007, available at https://netsec.ethz.ch/publications/papers/kuo_walker_perrig_simple.pdf .
2010	Tabona, Andrew, <i>802.11b vs. Bluetooth</i> , Techgenix April 19, 2005, available at https://techgenix.com/80211b-bluetooth/ .
2011	Paulus, Wolf, <i>Data Transfer Speeds Compared</i> , July 4, 2006, available at https://web.archive.org/web/20200919150247/https://wolfpaulus.com/dts/ .
2012	Foley, Michael, <i>How Bluetooth and 802.11 will team up to deliver high speed wireless connections</i> , EETimes May 13, 2008, available at https://www.eetimes.com/how-bluetooth-and-802-11-will-team-up-to-deliver-high-speed-wireless-connections/ .

InterDigital Patent Holdings, Inc. (“Patent Owner” or “InterDigital”) submits this preliminary response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *Inter Partes* Review (“Petition”) of claims 1, 3-10, 12, 14-15, 21, 23, 25-32, 34, 36-37, 43, 46-47, and 49-50 of U.S. Patent No. 9,173,054 (“the ’054 Patent”) filed by Microsoft Corporation (“Petitioner” or “Microsoft”). The Board should deny institution for the following reasons.

I. INTRODUCTION

Procedurally, the petition should be denied on *Fintiv* grounds in light of the underlying district court and ITC proceedings. Petitioner has filed four IPR petitions challenging the validity of two patents at issue in the underlying district court case and ITC proceeding.¹ The IPR petitions contain in total 25 grounds. *Id.* Importantly, Petitioner has asserted these same prior art references (and many more) in both the ITC proceeding and in the district court case. Ex-2005, 9-10; Ex-2004, 75-146. By way of this Petition and its three other petitions challenging the claims of the two patents, Petitioner is seeking to circumvent the true purpose of the America Invents Act and, rather than simplify or streamline existing proceedings, Petitioner is seeking to offer its real-party-in-interest (“RPI”), Lenovo, four distinct opportunities to challenge the claims of these patents (once at the ITC, once in district court, and

¹ See, e.g., IPR2024-00305; IPR2024-00306; IPR2024-00537; and IPR2024-00538.

in two separate Petitions before this tribunal). Moreover, the district court case (in which Petitioner's RPI, Lenovo, has not requested a stay) will have completed the claim construction process before the Board makes an institution decision in the aforementioned IPRs. Accordingly, institution of this Petition and the other Petitions goes against the very principles and premise of the AIA, as it would multiply and complicate the proceedings, rather than simplify matters.

Substantively, the Petition fails because the Challenged Claims of the '054 Patent are entitled to a priority date of at least December 22, 2009, and the lead reference cited by Petitioner in each of its Grounds (Forutanpour) is not prior art. Microsoft's Petition rests on the unsupported premise that the specification of the '054 Patent, as well as all parent applications to which the '054 Patent claims priority, lack written description support for two limitations recited in Claims 1 and 23:

- using Bluetooth to detect nearby devices and then
- using WiFi to transfer a media element to one of the detected devices.

Petition, 20. However, as shown in detail below, the claims of the '054 Patent, including Claims 1 and 23, are entitled to a priority date at least as early as December 22, 2009, the filing date of the first utility application (the '948 Application, Ex-1282) in the application history. The '948 Application explicitly teaches that

communication peripherals, which are a part of each WTRU, “may include technologies such as a third generation partnership (3GPP) second or third generation (2G/3G) modem, Bluetooth® or WiFi®.” Ex-1282, [0024]; Ex-1201, 2:60-63. The specification of the ’948 Application discloses that the inventors contemplated using both Bluetooth and WiFi in a single embodiment, where “[a]ny combination of or all of these communication technologies may be implemented in a single component design.” Ex-1282, [0024]; Ex-1201, 2:63-65. As shown below, this is all that is required to satisfy the Federal Circuit’s standard for written description in a patent application. Moreover, as discussed below, there is no requirement that the specification describe every claimed embodiment verbatim so long as the substance of the limitations in the claimed embodiments are disclosed in the specification.

Finally, the embodiment in question, with Bluetooth used for detecting nearby WTRUs and WiFi for transferring media elements from the sending WTRU to a Bluetooth-detected WTRU, was clearly contemplated by the named inventors at the time of the invention. That fact was confirmed through the testimony of inventor Alexander Reznik when he was deposed in the co-pending ITC investigation and questioned regarding the scope of the ’933 and ’054 patents as well as the technologies contemplated by the inventors when filing the ’948 Application.

Thus, the ’054 Patent and its Challenged Claims are entitled to a priority date

of at least as early as December 22, 2009. For this reason, the primary reference on which Microsoft relies for each Ground in the Petition, Forutanpour, is not prior art to the '054 Patent and institution should be denied.

II. BACKGROUND

A. The '054 Patent

The '054 Patent includes two independent claims, Claims 1 and 23, and each of these claims, along with numerous claims that depend from Claims 1 and 23, have been challenged in the Petition. Specifically, Petitioner has challenged the patentability of claims 1, 3-10, 12, 14-15, 21, 23, 25-32, 34, 36-37, 43, 46-47, and 49-50 (collectively, the “Challenged Claims”).

The '054 Patent describes, among other things, a device and method for wirelessly transferring data from a touchscreen device. According to the method of the patent, a user may select a file to transfer from a touchscreen device. The processor of the touchscreen device uses Bluetooth to detect nearby devices, from which the user can select a target device. After sending a message to the target device to transfer the selected file, and receiving an acceptance, the touchscreen device transfers the file to the target device using WiFi. Claim 1 of the '054 Patent is representative and is shown below.

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

processing, by the WTRU from a touch display, an input to select

media in an application;

detecting, by the WTRU over Bluetooth, another WTRU;

processing, by the WTRU, another input from the touch display to select the another WTRU;

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

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

transferring, by the WTRU to the selected another WTRU over WiFi, the selected media.

Ex-1201, 10:53-65. As specifically recited in Claim 1, the wireless transmit/receive unit (“WTRU”) is a touchscreen device capable of receiving touchscreen inputs. *Id.*, Figure 1; 2:42-45 (“In general, WTRU 101, and WTRU 103 are each minimally comprised of an application processor 105, a communication peripheral 107, and a touchscreen/display peripheral 109.”).

The WTRU is capable of processing a touchscreen input from a user indicating that a media element is desired to be transmitted to a second device. *Id.*, 8:6-45. When such an input is detected, the transmitting WTRU relies on a communication technology to detect another WTRU (*e.g.*, a target WTRU) in proximity to the transmitting WTRU. These communications technologies can “include technologies such as a third generation partnership (3GPP) second or third generation standards (2G/3G) modem, Bluetooth© or WiFi©.” Ex-1201, 2:60-63. Furthermore, the specification of the ’054 Patent makes clear that “[a]ny

combination or all of these communication technologies may be implemented in a single component design.” *Id.*, 2:63-65.

In a specific embodiment, the '054 Patent discloses that environment information can be gathered by the transmitting WTRU about target WTRUs, and the information gathering process can be “gathered via a service discovery protocol (SDP) such as currently available protocols such as Bluetooth®” *Id.*, 5:38-40. This same protocol enables the transmitting WTRU to discover other information about target WTRUs. *Id.*, 5:38-6:17. The information collected by the transmitting WTRU enables the transmitting WTRU to understand the capabilities of the target WTRU and generate configuration information and transmission instructions that can be used to prepare “instructions for implementing the transfer process through specific components in the communication peripheral.” Ex-1201, 5:38-6:17; 6:50-7:6; Figure 3.

Once a desired target WTRU has been identified, a user can select that specific target WTRU from among other available WTRUs. Ex-1201, 7:7-22. The transmitting WTRU can then send a message to the target WTRU to determine whether the user of the target WTRU is willing to receive the transfer of information (which may be media element such as a digital photograph, video file, word processing document, or other media element (Ex-1201, 8:28-32). Ex-1201, Abstract; Claim 1; Claim 23. If the user accepts the request to transfer the media

element, the media element can be transferred to the target WTRU. *Id.*, Abstract; 8:60-63; Claim 1; Claim 23. The transfer may be based on the aforementioned configuration information, which accounts for “settings for attributes such as power level, antenna orientation, security parameters, and the like.” *Id.*, 6:50-7:6. Thus, in different embodiments, the transfer of the media element data may be completed using one of the communication technologies disclosed in the ’054 Patent, including Bluetooth and WiFi. Ex-1201, 2:46-49; 2:55-65; 4:53-65; 6:50-7:6; Claim 1; Claim 23; Ex-2001, ¶¶2-3.

B. Claim Construction

For the sake of this Preliminary Response only, Patent Owner adopts Petitioner’s position that no constructions are required.

C. Person of Skill in the Art

For the purposes of this Preliminary Response, Patent Owner does not challenge Petitioner’s definition of a POSITA, but Patent Owner reserves the right to argue for a different definition should the Board institute trial in this proceeding.

III. ARGUMENT

A. Institution should be denied under *Fintiv* because the issues presented by this petition and petitioner’s other petitions will be resolved in the underlying District Court case

Petitioner and its real-party-in-interest, Lenovo, are seeking four bites at the validity apple. The ’054 Patent is being asserted by Patent Owner in an ITC

proceeding and a related district court proceeding in the Eastern District of North Carolina. Petitioner has now filed two IPR petitions (the present case and IPR2024-00306) challenging the claims of the '054 Patent. This is contrary to the purpose of the America Invents Act and contravenes the goal of the PTAB to present an alternative to district court litigation challenging patent validity. Instead Petitioner seeks to complicate the proceedings and take advantage of *four* distinct opportunities to challenge the claims of the '054 Patent (in the aforementioned petitions, the district court, and in the ITC proceeding). This should not be permitted, and the Board should exercise its discretion to deny institution of this Petition.

As Director Vidal has pointed out, “Congress designed the America Invents Act (AIA) post-grant proceedings ‘to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.’” Ex. 2002, 1 (citing H.R. Rep. No. 112- 98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69; *see* S. Rep. No. 110- 259, at 20 (2008)). Instituting Petitioner’s multiple IPR petitions is directly contrary to this goal. This is because “[p]arallel district court and AIA proceedings involving the same parties and invalidity challenges *can increase, rather than limit*, litigation costs.” *Id.* (emphasis added).

Here, instituting the two IPR petitions challenging the claims of the '054 Patent will have the same outcome as the *single* district court case (upholding

validity or invalidating the patents) and will dramatically increase the litigation costs of the parties. Notably, the district court case is considering the exact same references and will also consider more invalidity grounds. It is a fallacy to consider Petitioner's IPR petitions as streamlining the dispute between the parties. And this analysis ignores the parallel ITC investigation, in which the ITC is considering the exact same references (as well as additional invalidity grounds). The Board should thus use its discretion to deny institution.

Under 35 U.S.C § 314(a), the Board has discretion to deny a petition based on the status of a related litigation. The Board considers six factors to determine whether efficiency, fairness, and the merits support denial:

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

Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;

Factor 3: investment in the parallel proceeding by the court and the parties;

Factor 4: overlap between issues raised in the petition and the parallel proceeding;

Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same parties;

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

Apple v. Fintiv, IPR2020-00019, Paper 11 at 5-6 (PTAB March 20, 2020) (precedential). As discussed below, the six *Fintiv* factors support the Board denying

institution in this case. This is particularly true because the merits of the petition are weak since the primary reference on which Microsoft relies for each asserted Ground is not prior art to the '933 Patent.

Factor 1: the district court case has not (and likely cannot) been stayed. This factor weighs in favor of discretionary denial. Petitioner has admitted that Lenovo, the party to the underlying district court case and ITC investigation is a real-party-in-interest. Petition, xiii. Further, Petitioner has admitted, through briefing in the related IPR proceeding, that petitions for IPR have not been filed against all of the patents in suit in the district court case, making it unlikely that the court would stay the case since only two out of the five patents in that case have been challenged at the PTAB. IPR2024-00306, Paper 10, 2.

Factor 2: the ITC and district court case will resolve all of the issues presented in the two petitions (and more). A trial date has not been set by the Court in the Eastern District of North Carolina. The Patent Office has noted that “scheduled trial dates are unreliable and often change” and that “[a] court's scheduled trial date, therefore, is not by itself a good indicator of whether the district court trial will occur before the statutory deadline for a final written decision.”² Here, while the court in the Eastern District of North Carolina has not yet set a trial date, Petitioner has not

² Ex-2002, 8.

provided any evidence or speculation as to when that trial date will fall, and the Board should thus consider this factor to be neutral.

Factor 3: there has and continues to be significant investment by the parties in the district court litigation. The Board has used its discretion to deny institution when, as here, there is significant investment in the parallel district court proceeding. The district court proceeding has been pending since September 1, 2023. The Parties have prepared and exchanged infringement and invalidity contentions, presented initial disclosures, and are in the midst of fact discovery and motion practice. In fact, by the time the Board would even issue an institution decision, claim construction will have been briefed and likely argued. Ex-2003, 15. Specifically, claim construction briefing will be completed on May 23, 2024. *Id.* While the court has not set a date for a claim construction hearing (which is discretionary), it is likely that such a hearing would take place prior to an institution decision in this case, which will issue in August 2024.

While Microsoft has suggested in a related proceeding that no terms from the '933 or '054 Patents will be construed by the court (IPR2024-00305, Paper 10, 2-3), the claim construction process is moving forward, the case cannot be stayed, and the parties will continue to invest time and money in parallel proceedings in which substantially identical invalidity arguments are being presented. Based on the stipulation that Microsoft filed in IPR2024-00306, it is clear that the same references

asserted in the two petitions challenging the claims of the '054 Patent are also being asserted in the district court case. *See* IPR2024-00306, Ex-1081, 3 (“Further, regardless of the PTAB’s institution decisions, Lenovo reserves the right to pursue all other invalidity grounds disclosed in its invalidity contentions.”). Petitioner’s IPR petitions fall far short of “streamlining,” and this factor weighs in favor of discretionary denial.

Factor 4: there is significant overlap between issues raised in the petition and in the parallel proceeding. “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, th[at] fact has favored denial.” *Fintiv*, IPR2020-00019, Paper 11, 12.

Petitioner has filed a *Sand Revolution*-style stipulation in the district court case, suggesting that it will not pursue the same grounds in the district court litigation. *See* IPR2024-00306, Ex-1081. But the Board has held that *Sand Revolution* stipulations do not eliminate the concerns regarding duplicative proceedings and may be insufficient to merit institution. *Samsung Electronics Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01092, Paper 11 at 15-17 (PTAB Jan. 8, 2024) (“Although the new stipulation is somewhat broader than that in *Sand Revolution*, the concerns discussed in *Sand Revolution* remain. Accordingly, for the reason given here and in *Sand Revolution*, this factor weighs only slightly against discretionary denial.”). The same concerns are present here. As in *Samsung*, “the relevant art

appears to include multiple references that disclose the same basic concepts” ... such that “even with Petitioner’s stipulation, Petitioner could raise substantially the same arguments in district court using prior art references that did not ‘form[] the basis of any instituted ground.’” *Samsung*, Paper 11, 17. Thus, as in *Samsung* (which included a broader stipulation than that offered by Petitioner in this case), Petitioner’s stipulation weighs, at best, only slightly against discretionary denial of institution. *Id.*

Factor 5: the petitioner and the defendant in the parallel proceeding are the same party. Factor 5 weighs in favor of denial because both Patent Owner InterDigital and RPI Lenovo are the same parties in the related district court litigation and ITC investigation. *Fintiv*, IPR2020-00019, Paper 11 at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). Accordingly, this factor weighs in favor of discretionary denial.

Factor 6: the merits of the Petition are weak. The final factor weighs in favor of discretionary denial because there is no “compelling challenge” of invalidity on the merits of the Petition. Ex-2002, 4 (“compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel”). As shown in the following sections, Petitioner’s arguments on the merits fail because the primary reference asserted in each Ground is not prior art to the ’054

Patent.

B. Forutanpour is not Prior Art to the '054 Patent

Microsoft argues that a “lack of § 112 support means the challenged claims are not entitled to the filing dates of either the 2012 parent application (EX1281) or the 2009 grandparent application (EX1282) or the 2008 provisional application (EX1266). The earliest possible effective filing date of the challenged claims is thus April 11, 2014.” Petition, 20. Microsoft then concludes that “Forutanpour (EX1204) is prior art under at least AIA Sections 102(a)(1) and 102(b)(1) because it published April 7, 2011, more than one year before the '054 patent’s filing date of April 11, 2014.” *Id.*, 33. Microsoft is incorrect.

The Challenged Claims are entitled to a priority date of at least as early as December 22, 2009. Ex-2001, ¶5, 68. The earliest priority date for Forutanpour is April 7, 2011. Petition, 32. For this reason Forutanpour is not prior art to the '054 Patent, and all of Petitioner’s Grounds—which rely on Forutanpour as the primary reference—fail. *Id.*

The original utility application to which the '054 Patent Claims priority, U.S. Patent Application No. 12/644,948 (“the '948 Application”) (Ex-1282) was filed on December 22, 2009. The '054 Patent is a continuation of the '948 Application, and thus shares a common specification. Ex-1201 (Related U.S. Application Data). As shown in detail below, the '948 Application provides written description support for

the Challenged Claims, and institution should be denied because the specification of the '948 Application provides written description support for each challenged element.

At the outset, it is undisputed that the specification discloses both Bluetooth and WiFi functionality. Petition, 20, 24-25, 27. The dispute is whether the description of Bluetooth and WiFi in the specification supports the language of independent Claims 1 and 23 to the extent those claims recite, for example, “detecting, by the WTRU over bluetooth, another WTRU” and “transferring, by the WTRU to the selected another WTRU over WiFi, the selected media.” Ex-1201, Claim 1; Petition, 25-26. But the specification is clear that “[a]ny combination or all of these communication technologies,” including Bluetooth and WiFi, “may be implemented in a single component design.” Ex-1201, 2:60-65.

The Federal Circuit’s “test for sufficiency” of an application’s written description “is whether the disclosure of 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.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (quoting *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (citing *In re Kalsow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983))). The test for “possession of the claimed subject matter” requires “an objective inquiry into the four corners of the specification from the perspective of a

person of ordinary skill in the art.” *Id.* This is a factual inquiry, and the court has “recognized that determining whether a patent complies with the written description requirement will necessarily vary depending on the context.” *Id.* For example, “the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* (citing *Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005)).

Microsoft suggests that the ’948 Application (and thus the ’054 Patent specification) fail to disclose two specific elements of the Challenged Claims:

Here, the ancestor applications do not show possession of the claimed method that requires **using Bluetooth to detect nearby devices** and then **using WiFi to transfer a media element to one of the detected devices** (or, as in claim 23 and its dependent claims, circuitry configured to carry out such a method)⁶.

Petition, 20 (color added). However, as shown below, a POSITA would recognize that the four corners of the ’948 Application support both Bluetooth detection of proximate WTRUs and WiFi transfer of data between a sending WTRU and a detected WTRU. Ex-2001, ¶¶71, 72-74.

1. The '948 Application discloses the use of both Bluetooth and WiFi in a single WTRU

As described above, the '054 Patent relates to a system and method for sharing media elements (*e.g.*, digital photographs) between two nearby wireless transmit/receive units (WTRUs). Ex-1201, Claims 1, 23; 8:28-32. The '948 Application, whose specification is identical to the specification of the '054 Patent, discloses that “Figure 1 is an illustration of a sending WTRU 101 and a receiving WTRU 103 whereby data is transferred between the WTRUs ... [that] are similarly equipped.” Ex-1282, [0024]. Each of the WTRUs include a “communication peripheral 107, and a touchscreen/display peripheral 109,” and “the communication peripheral 107 may be implemented as a wireless personal area network (WPAN) device, for example Bluetooth®, Wireless Universal Serial Bus (W-USB) or WiFi® in ad-hoc mode.” *Id.* “An application 123 (hereinafter referred to as ‘TapAPP’) may include application software configured to implement a method of data transfer between [the sending] WTRU 101 and [the receiving] WTRU 103.” *Id.*

Each WTRU includes a communication peripheral, and “[t]he 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.” Ex-1282, [0024]; Figure 1. The '948

Application clearly discloses sending and receiving WTRUs that may be equipped with 3GPP functionality, Bluetooth, WiFi, or any combination of those communications technologies “to implement a method of data transfer between [the sending] WTRU 101 and [the receiving] WTRU 103.” *Id.*

Thus, it is without dispute that the '948 Application discloses a system and method for sending data between WTRUs. Moreover, this same disclosure shows that the inventors of the '948 Application, as well as the later issued '054 Patent, clearly contemplated and were in possession of the concept of detecting nearby WTRUs and transferring data between a sending WTRU and a detected WTRU using a 3GPP modem, Bluetooth, and WiFi, and that “[a]ny combination or all of these communication technologies may be implemented in a single component design.” Ex-1282, [0024]; Ex-2001, ¶¶72-74. This disclosure alone satisfies the written description requirement of § 112 and shows that the inventors were in possession of the Challenged Claim elements at least as early as December 22, 2009. Moreover, a POSITA reading within “the four corners of the specification” demonstrates that the inventors were in possession of the claimed subject matter—namely, Bluetooth detection of a nearby WTRU and WiFi transfer of data to that WTRU—because the '948 Application contemplates using a combination of Bluetooth and WiFi in a “single component design.” *Ariad*, 598 F.3d at 1351; *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 21 F.4th 1362, 1368-69 (Fed.

Cir. 2022); *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1361 (Fed. Cir. 2018); Ex-2001, ¶¶72-74. This portion of the specification shows that “the disclosure of the application relied upon [for priority] reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.*; *Crown Packaging Tech., Inc. v. Ball Metal Bev. Container Corp.*, 635 F.3d 1373, 1380 (Fed. Cir. 2011).

2. The '948 Application discloses using Bluetooth for detecting nearby WTRUs using Bluetooth

The '948 Application teaches that the sending “WTRU 101 includes a processor 105 that is configurable to process information from the UI 109 and the communication peripheral 107.” Ex-1282, [0030]. The “[p]rocessor 105 is also configured to receive environment information stored by the communication peripheral 107” that can be used “to identify a target WTRU 101_{c,t}.” *Id.* “The environment information 301 may be gathered via a service discovery protocol (SDP) such as currently available in protocols such as Bluetooth®, for example” and “[t]his protocol allows the WTRU 101 to discover the services (e.g. TapAPP as described herein) that are supported by other WTRUs operating in the local environment,” including target WTRU_{c,t}. Ex-1282, [0034] (“Information received in the radio dialog may be analyzed and filtered (e.g. power level, or quality of a received signal) to determine the individual candidate WTRU_c or set of candidate

WTRUs 101c in a local proximity.”). Thus, the ’948 Application explicitly discloses detecting candidate receiving WTRUs in proximity to a sending (transmitting) WTRU using a Bluetooth SDP. Ex-1282, [0034]-[0036]; Ex-2001, ¶¶77-79.

3. The ’948 Application discloses using WiFi to transfer data between a sending WTRU and a nearby WTRU

The ’948 Application discloses that the sending WTRU can use the detected environment information “to discover the services ... supported by [the] other [detected] WTRUs operating in the local environment,” (Ex-1282, [0034]) and this environment information is used to develop configuration information and transmission instructions “for implementing the transfer of data through specific components in the communication peripheral.” Ex-1282, [0039]. For example, the ’948 Application teaches that “Figure 3 shows inputs that may be used to drive a target discrimination algorithm 313 that uniquely identifies a target WTRU for transfer of data.” Ex-1282, [0032]. The target discrimination algorithm relies on, for example, environment information collected by the sending WTRU as part of the service discovery protocol (Ex-1282, [0034]) to generate configuration information 309 and transmission instructions 311 for use in transmitting information to a target WTRU_{c,t}. *Id.*, Figure 3; [0039]-[0042].

Configuration information 309 may include settings for attributes such as power level, antenna orientation, security parameters and the like. 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***. The configuration information 309 and transmission instructions 311 may be delivered to the communication peripheral 107.

Id., [0039] (emphasis added); [0042] (“Transmission instructions 517 are generated to facilitate the data transfer to the target WTRUs 101_{c,t}.”); Claim 14 (“generating configuration information and target transmission instructions based on the selected media element; and instructing a communication peripheral to transmit the selected media element to the selected target WTRU based on the generated configuration information and transmission instructions.”).

A POSITA would understand that, based on the '948 Application's disclosure that “[a]ny combination or all of these communication technologies,” including a 3GPP (2G/3G) modem, Bluetooth, or WiFi can be used “in a single component design,” (Ex-1282, [0024]) transmission instructions can indicate that WiFi should be used to transfer data to the target WTRU. Ex-2001, ¶¶80-81. The configuration information, described above, specifically includes factors like power level. *Id.* A POSITA would understand that the gathering of environment information towards detection of target WTRUs would benefit from a low-power communication protocol like Bluetooth without requiring high bandwidth, as discussed in Section 7.1.2. As such, a POSITA would consider various factors such as available services and transmission speed of those services. Ex-2001, ¶82. It was well-known that WiFi

offered better transmission speeds as an advantage over Bluetooth, while Bluetooth on the other hand offered low power consumption. Ex-2001, ¶83. Further, a POSITA at the time the '948 Application was filed would have understood the benefits of using WiFi for data transfer when sending media between devices (WTRUs). Ex-2001, ¶¶81-84.

For these reasons, a POSITA would understand that the '948 Application, and the child '054 Patent that ultimately issued from that Application as a continuation, contemplate both Bluetooth detection of proximate WTRUs and WiFi data transfer of media elements from a sending WTRU to the target WTRU. A POSITA would have understood the benefits and tradeoffs between customer and carrier demand and would have understood that the inventors, contemplating these tradeoffs, likewise understood the benefits of using Bluetooth for WTRU detection and WiFi for data transfer. Ex-2001, ¶¶84-85.

4. A named inventor of the '948 Application and '054 Patent clearly contemplated Bluetooth detection and WiFi data transmission between WTRUs

Microsoft RPI Lenovo deposed one of the named inventors, Alexander Reznik, in connection with the underlying ITC investigation on March 14, 2024. Ex-2006. In that deposition, Lenovo questioned Mr. Reznik extensively concerning the disclosure in the patent specification, the claims of the '054 Patent and the related '933 Patent, and the inventions contemplated at the time the '948 Application was

filed. Mr. Reznik’s testimony is helpful because it explains the inventions claimed in the ’054 and ’933 Patents and identifies the manner in which the inventors contemplated solving the problem of detecting nearby WTRUs and transferring data to the detected WTRUs. Ex-2001, ¶¶86-87.

The Federal Circuit held that “[a]n inventor is a competent witness to explain the invention and what was intended to be conveyed by the specification and covered by the claims.” *Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1044 (Fed. Cir. 2019) (citing *Voice Techs. Grp., Inc. v. VMC Sys.*, 164 F.3d 605, 615 (Fed. Cir. 1999)). Moreover, “[t]he testimony of the inventor may also provide background information, including explanation of the problems that existed at the time the invention was made and the inventor's solution to these problems.” *Voice Techs.*, 164 F.3d at 615 (citing *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1580 (Fed. Cir. 1996)). Mr. Reznik explained the scope of the invention at the time the provisional application (Ex-1266) and the ’948 Application (Ex-1282) were filed, and his testimony is compelling in view of Microsoft’s unpersuasive written description arguments.

Mr. Reznik was questioned about the state of the art at the time of the invention, and he responded that “by 2007 we had cell phones with Bluetooth and WiFi capabilities, which would have meant that within a single device there was a – in the language of this particular patent, a peripheral was 3GPP capability. One was

WiFi and one was Bluetooth.” Ex-2006, 146:8-23. When questioned as to whether the patent contemplates WiFi data transfer, Mr. Reznik testified:

Q. Let's back that up a little bit then. *What were the known ways to transfer data that he refers to?*

A. So any kind of wireless transfer technology. *So WiFi for sure.* You know, mobile. Because, by that time, mobile phones were data transfer devices, right. So those were the connectivity options. And then somehow they all involved having an application server somewhere, like a Dropbox or something, right, that would facilitate it or something like that. I'm sure there may have been some other ones that we had in mind.

Q. *So those were WiFi and cellular data transfer; is that right?*

A. Right. So you're asking me today that were reasonable technologies back then for data transfer. *WiFi and cellular definitely come to mind.*

Ex-2006, 58:14-59:9 (emphasis added). When pressed as to whether the invention contemplated a communication peripheral 107 (in a WTRU) need be limited to “a Bluetooth device or a WiFi device but not both,” Mr. Reznik testified:

Q. Did you have any specific technology in mind for those two things that had to be done?

A. So we were looking at families of technologies, right. ***So I mentioned cellular and WiFi as two good families for data transfer.***

I mentioned, you know, 802.15-type stuff -- Bluetooth, Zigbee, for example -- as things that would have been good for proximity detection.

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 kind of said there's options on both sides.

Ex-2006, 64:2-17 (emphasis added). Finally, when questioned as to whether the invention contemplated using Bluetooth for detecting target WTRUs and WiFi for transferring data from the sending WTRU to the target WTRU, Mr. Reznik responded with the following testimony.

Q. Okay. And would Bluetooth also be a technology you had in mind when referring to these layer 2, layer 3, and baseband?

THE WITNESS: Actually, although if -- ***the way I am looking at the problem we're trying to solve here, right, Bluetooth is usually more of a proximity technology.***

This paragraph refers to a data transmission technology. I think, for that, we would be leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth.

Ex-2006, 155:18-156:6 (emphasis added).

Mr. Reznik is without question a POSITA, and his testimony explains how the inventors contemplated using the communication technologies disclosed in the '948 Application, including Bluetooth and WiFi. Ex-2001, ¶¶88-91. Moreover, Mr. Reznik's testimony "explain[s] the invention and what was intended to be conveyed by the specification and covered by the claims." *Bradium Techs.*, 923 F.3d at 1044; *Voice Techs.*, 164 F.3d at 615. As supported by the specification of the '948 Application, and explained by Mr. Reznik in the deposition taken by Lenovo, the inventors of the '948 Application and '054 Patent clearly contemplated Bluetooth detection of nearby WTRUs, WiFi data transfer (of a media element) between a sending WTRU and a receiving (target) WTRU, and the use of both Bluetooth detection and WiFi transfer within a single method or device. Ex-1282, [0024] ("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.***") (emphasis added).

For this reason, Microsoft's priority challenges fails, the '054 Patent is entitled to at least the priority date of the earlier-filed '948 Application (December 22, 2009), and institution should be denied because Forutanpour is not prior art.

5. This is a predictable technology and the cases cited by Microsoft are inapposite

For the reasons identified above, the elements of the '054 Patent Claims challenged by Microsoft, namely Bluetooth detection of nearby devices and WiFi transfer of media elements from a sending WTRU to a nearby, detected device, are supported by the '948 Application and the specification of the '054 Patent (which is identical to that of the '948 Application). Accordingly, the inventors were in possession of these inventive concepts at least as early as the filing date of the '948 Application (December 22, 2009).

a. The technology described in the '948 Application is neither complex nor unpredictable

As stated above, the Federal Circuit has held that the concept of “possession” of the claimed invention is “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad*, 598 F.3d at 1351. Moreover, “the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.*; *Hologic*, 884 F.3d at 1361 (“We agree with the Board’s finding that the field of this invention is a predictable art, such that a lower level of detail is required to satisfy the written description requirement than for unpredictable arts.”).

The technology disclosed in the '948 Application is easily understandable,

and the specific technologies contemplated by the inventors for detection of nearby devices and the transfer of data to the detected devices are clearly delineated within the four corners of the specification. Ex-2001, ¶¶82, 87. For example, the '948 Application clearly identifies detection and/or transmission using 3GPP (2G/3G) cellular, Bluetooth, WiFi, and Wireless USB. Ex-1282, [0024]. This is far from the “long, open-ended list of other technologies” of which Microsoft complains in its Petition. Petition, 19; *Novartis*, 21 F.4th 1362 at 1370 (“The [patent-in-suit] does not contain the laundry-list-type disclosures that we have found require guidance to direct a skilled artisan to the claimed species”); *Hologic*, 884 F.3d at 1361. Moreover, this case is a far cry from cases like *Ariad*, which relates to biotechnology and the “regulation of gene expression” and necessarily requires a more detailed description of a claimed, specific species of a diverse genus. *Ariad*, 598 F.3d at 1340; *Novartis*, 21 F.4th 1362 at 1370.

b. “Blaze marks” are not required when a claimed species is expressly described in the specification

Further, this case is much different from *Purdue Pharma L.P. v. Faulding Inc.*, cited by Microsoft in support of its argument that “blaze marks” are required to direct a skilled artisan to a claimed method when “a forest [is disclosed] in the original application, and then later [an applicant] pick[s] a tree out of the forest and say[s] here is my invention.” *Purdue Pharma*, 230 F.3d 1320, 1326 (Fed. Cir. 2000);

Petition, 26. Here there is no “forest,” only a limited number of detection and transfer technologies that are explicitly disclosed in the specification and confirmed by Mr. Reznik. Ex-2001, ¶¶82-87.

In fact, the Federal Circuit held that “[b]laze marks’ are not necessary where the claimed species is expressly described in the specification” *Novartis*, 21 F.4th 1362 at 1370 (noting that “[b]laze marks’ directing an investigator of ordinary skill in the art to the claimed species from among a forest of disclosed options are not necessary in this case. In cases where the specification describes a broad genus and the claims are directed to a single species or narrow subgenus” blaze marks may be necessary to “lead an ordinarily skilled investigator toward such a species among a slew of competing possibilities.”). That is not the case here because each of the claimed “species” of WTRU detection (Bluetooth) and transmission (WiFi) are expressly described in the ’948 Application, and the field of the invention “is a predictable art, such that a lower level of detail is required to satisfy the written description requirement than for unpredictable arts.” *Novartis*, 21 F.4th 1362 at 1370; *Hologic*, 884 F.3d 1357 at 1361.

c. The disclosure in the ’948 Application explicitly discloses the claimed detection (Bluetooth) and data transfer (WiFi) technologies

LizardTech is equally inapplicable to the present facts. Petition, 27-28; *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1136, 1345-46 (Fed. Cir.

2005). The hypothetical proposed in *LizardTech*, and on which Microsoft relies, is not analogous to the present case. The patent at issue in *LizardTech* unambiguously limited the scope of the invention to a **single method** of creating a discrete wavelet transform (DWT), while the Applicant sought to extend the scope of that disclosure “to cover **all ways** of performing DWT-based compression processes that lead to seamless DWT,” and “there [was] no support for such a broad claim in the specification.” *LizardTech*, 424 F.3d 1336 at 1344 (emphasis added). Here, the Challenged Claims, rather than reciting simply “detecting” and “transmitting,” recite detecting and transmitting using specific technologies disclosed in the specification—including Bluetooth and WiFi. Ex-1201, Claims 1, 23. *See also Crown Packaging*, 635 F.3d at 1382 (distinguishing *LizardTech* and two other cases because “in each of those cases, the specification unambiguously limited the scope of the invention.”).

Flash-Control is likewise inapposite. *Flash-Control, LLC v. Intel Corp.*, No. 2020-2141, 2021 WL 2944592 (Fed. Cir. July 14, 2021) (non-precedential). In *Flash Control* the Federal Circuit upheld a summary judgment finding because Flash-Control could not “identify any disclosure that ‘shows a second buffer that can store a write request, as required by step 3, or ‘the writing of a portion of a page to volatile memory,’ as required by step 2.” *Flash Control*, 2021 WL 2944592 at 4. This case relates to whether certain species of technology for “detecting” and “transferring”—

Bluetooth and WiFi—are disclosed in the specification rather than, for example, whether an entire claim limitation is missing from the disclosure in the specification. For the reasons discussed above, both “detecting” using Bluetooth and “transferring” using WiFi are clearly disclosed in the specification and were contemplated by the named inventors at least as early as December 22, 2009.

Hyatt and *Taylor* fare no better. *Hyatt v. Dudas*, 492 F.3d 1365 (Fed. Cir. 2007); *Taylor v. Iancu*, 809 F. App’x 821 (Fed. Cir. 2020). Microsoft cites these cases to suggest that the ’933 Patent fails to disclose the combination of Bluetooth detection and WiFi transfer, but the foregoing discussion in Sections III.B.1-4 shows that premise is incorrect. Moreover, the facts of *Hyatt* (adjudicating the propriety of the details included in an Examiner’s rejection of pending claims in decades-long prosecution) and *Taylor* (failure to disclose how two different versions of GPS Explorer software would work in combination to enable Internet implementation) are far afield from the present dispute where a limited set of well understood technologies are disclosed and claimed in connection with the detection of nearby WTRUs and transfer of media elements to those detected WTRUs. *Hyatt*, 492 F.3d 1365, 1369 (holding that “we are asked to address *not whether Hyatt’s proposed claims are actually supported by an adequate written description in these applications*, but rather whether the PTO must to more than what MPEP § 2163.04(I)(B) provides to establish a prima facie case of lack of written description

in this and every other such case.”) (emphasis added); *Taylor*, 809 F. App’x 821 at 824 (noting that the inventor’s “experience thus shows that the specification did not demonstrate possession of the claimed invention but was instead a mere wish or plan for obtaining the claimed invention.”) (internal quotations omitted).

d. There is no requirement that the specification disclose a claimed limitation verbatim

Microsoft criticizes Patent Owner because “[t]he parent application does not disclose any method using different protocols to perform different functions, much less the specific claimed method of using Bluetooth to detect nearby devices and WiFi to transfer data to one of the detected devices.” Petition, 29. But this argument likewise falls short because Microsoft “ignores a central tenet of our written description jurisprudence—that the disclosure must be read from the perspective of a person of skill in the art—as well as precedent stating that the disclosure need not describe a limitation *in haec verba*.” *Novartis*, 21 F.4th 1362 at 1373 (citing *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779 (Fed Cir. 2002)) (“[T]he failure of the specification to specifically mention a limitation that later appears in the claims is not fatal when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.”); *LizardTech*, 424 F.3d 1336 at 1345 (“A claim will not be invalidated on section 112 grounds simply because the embodiments of the

specification do not contain examples explicitly covering the full scope of the claim language.”) (citing *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) (“The written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.’”).

A POSITA reading the ’948 Application, which is identical to the specification of the ’054 Patent, would understand that Bluetooth, WiFi, and other identified technologies could be used to detect nearby devices and transfer media elements to those devices. Ex-2001, ¶¶82-84. Thus, just because the specification doesn’t provide, *verbatim*, a specific example of using Bluetooth for detection and WiFi for data transfer, a POSITA would understand that such a method or system was contemplated, particularly in view of the language in the specification noting that “[a]ny combination or all of these communication technologies may be implemented in a single component design.” Ex-1282, [0024]; Ex-2001, ¶¶82-84.

It is important to remember that the principal function of patent claims “is to provide notice of the boundaries of the right to exclude” and that “[c]laims define and circumscribe, the written description discloses and teaches.” *Ariad*, 598 F.3d 1336 at 1347. In this case Claims 1 and 23 recite specific technologies used for detection (Bluetooth) and transfer (WiFi), and both of those technologies are

explicitly disclosed and taught in the written description included in the specification. Ex-2001, ¶87.

C. The Challenged Claims are supported by the disclosure in the '948 Application

Petitioner Microsoft has suggested that two specific limitations recited in Claims 1 and 23 of the '054 Patent are not entitled to a priority date earlier than April 11, 2014:

1. using Bluetooth to detect nearby devices; and then
2. using WiFi to transfer a media element to one of the detected devices (or, as in claim 23 and its dependent claims, a processor and/or circuitry configured to carry out such a method).

Petition, 20. Patent Owner provides the following charts, in addition to the evidence cited above in Section III.B, to show that Claims 1 and 23 are entitled to a priority date of at least as early as December 22, 2009—the filing date of the '948 Application, the first utility application in the priority chain of the '054 Patent. Ex-1201 (Related U.S. Application Data). Moreover, consistent with *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316 (Fed. Cir. 2008), Patent Owner also shows written description support for each element of Claims 1 and 23.

1. Disclosure in the '948 Application supporting each and every limitation in independent Claim 1 of the '054 Patent

The following table shows written description support in the '948 Application for every element of Challenged Claim 1. Ex-2001, ¶¶95-96.

Claim Element	Disclosure of the Claim Element in the '948 Application
1[pre] A method performed by a wireless transmit/receive unit (WTRU), the method comprising:	The '948 Application (Ex-1282), filed on December 22, 2009, discloses a WTRU and a method by which a WTRU, operating in a wireless environment, can communicate with other WTRUs operating in that environment. Ex-1282, [0023]-[0024].
1[a] processing, by the WTRU from a touch display, an input to select media in an application;	The '948 Application discloses a WTRU with a touchscreen display. Ex-1282, [0024]. The touchscreen display may be used to provide a user interface (UI) that can be used to select a media element shown as a visual depiction on the touchscreen. <i>Id.</i> , [0029]. “For example, the visual depiction may identify a selected media element stored in the WTRU 101.” <i>Id.</i> Thus, the user input, via the user interface (UI), can be used to select a media element. The '948 Application discloses that applications like “TapAPP” running on an application processor (105 in Figure 1) can be used to facilitate detection of WTRUs, selection of a target WTRU, and selection of media to transfer to the detected WTRU. Ex-1262, [0024]-[0025]; [0033]-[0045].
1[b] detecting, by the WTRU over Bluetooth, another WTRU;	The '948 Application discloses that a WTRU may use Bluetooth to detect another WTRU in proximity to the WTRU. For example, “[t]he communication peripheral 107 receives and maintains the environment information relating to the WTRUs 101 _c operating within the local areas 211, 213.” Ex-1282, [0027]; Figure 2. “The environment information and the user input are then used as inputs to the processor 105 and are processed to identify a target WTRU 101 _{c,t} .” <i>Id.</i> , [0030]. “The environment information 301 may be gathered via a service discovery protocol (SDP) such as currently available in protocols such as Bluetooth®, for example. This protocol allows the WTRU 101 to discover the services (e.g., TapAPP

	as described herein) that are supported by other WTRUs operating in the local environment.” <i>Id.</i>, [0034]. Accordingly the 2009 Application explicitly discloses that Bluetooth can be used to detect other (e.g., a plurality of other) candidate WTRUs (WTRU_c) in proximity to the WTRU. Furthermore, one of the inventors of the '054 Patent, Mr. Alexander Reznik, was deposed in a co-pending ITC investigation, and he testified as follows: Q. Did you have any specific technology in mind for those two things that had to be done? A. So we were looking at families of technologies, right. So I mentioned cellular and WiFi as two good families for data transfer. I mentioned, you know, 802.15-type stuff -- Bluetooth, Zigbee, for example -- as things that would have been good for proximity detection. 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 kind of said there's options on both sides. Ex-2006, 64:2-17. Q. Okay. And would Bluetooth also be a technology you had in mind when referring to these layer 2, layer 3, and baseband?
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	THE WITNESS: Actually, although if -- the way I am looking at the problem we're trying to solve here, right, Bluetooth is usually more of a proximity technology. This paragraph refers to a data transmission technology. I think, for that, we would be leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth. Ex-2006, 155:18-156:6.
1[c] processing, by the WTRU, another input from the touch display to select the another WTRU;	The '948 Application discloses that the WTRU can process another touchscreen input to select the detected WTRU to, for example, receive a media element from the WTRU. “A user input received from the UI 109, for example a touchscreen/display, may be translated into application signals by the touchscreen/display 109 or processor 105. This touchscreen information 305 is input to the target discrimination algorithm 313 to identify a target WTRU 101_{c,t} from the plurality of other WTRUs.” Ex-1282, [0036]. Moreover, “[d]irectional inputs provided by the user via the touchscreen/display 109 may be synthesized to ... select a target WTRU_{c,t} from the identified [detected] group of candidate WTRUs 101_c to establish a one-to-one communication between the transmitting WTRU 101 and the target WTRU_{c,t}” <i>Id.</i>, [0037].
1[d] sending, by the WTRU to the selected another WTRU, a message to the transfer the selected media;	The '948 Application discloses that the sending/transmitting WTRU can send a message to the selected/receiving WTRU indicating that a media element is ready to be transferred to the receiving WTRU. Ex-1282, [0044]. For example, “[<i>t</i>]he <i>TapAPP 123 provides an indication 603b or a prompt that a data transfer is ready for receiving</i>. To receive a file, the user may touch 710 the touchscreen 109 to

	initiate reception of the data transfer.” <i>Id.</i> ; Figure 7A (emphasis added).
1[e] receiving, by the WTRU, an acceptance to transfer the selected media; and	The ’948 Application discloses that the selected/receiving WTRU can send an acceptance to the sending/transmitting WTRU indicating that the media element has been accepted for transfer. Ex-1282, [0044]. For example, “[t]he TapAPP 123 provides an indication 603b or a prompt that a data transfer is ready for receiving. <i>To receive a file, the user may touch 710 the touchscreen 109 to initiate reception of the data transfer.</i>” <i>Id.</i>; Figure 7A (emphasis added).
1[f] transferring, by the WTRU to the selected another WTRU over WiFi, the selected media.	The ’948 Application discloses that the selected media element can be transferred to the receiving WTRU using WiFi. The specification of the 2009 Application discloses a variety of communication protocols. For example, the specification states that “[t]he communication peripheral 107 may be implemented as a wireless personal area network (WPAN) device, for example Bluetooth®, Wireless Universal Serial Bus (W-USB) or WiFi® in ad-hoc mode.” Ex-1282, [0024]. “The communication peripheral 107 may include technologies such as a third generation partnership (3GPP) second or third generation standards (2G/3G) modem, Bluetooth®, or Wifi®. <i>Any combination or all of these communication technologies may be implemented in a single component design.</i>” <i>Id.</i> (emphasis added) This disclosure is clear. The specification explicitly discloses Bluetooth and WiFi, and likewise explicitly discloses that any combination of these aforementioned communication technologies, including Bluetooth and WiFi, can be used in a single component design. Furthermore, one of the inventors of the ’054 Patent, Mr. Alexander Reznik, was deposed in a co-pending ITC investigation, and he testified as follows:

Q. Let's back that up a little bit then. What were the known ways to transfer data that he refers to?

A. So any kind of wireless transfer technology. So WiFi for sure. You know, mobile. Because, by that time, mobile phones were data transfer devices, right. So those were the connectivity options. And then somehow they all involved having an application server somewhere, like a Dropbox or something, right, that would facilitate it or something like that. I'm sure there may have been some other ones that we had in mind.

Q. So those were WiFi and cellular data transfer; is that right?

A. Right. So you're asking me today that were reasonable technologies back then for data transfer. WiFi and cellular definitely come to mind.

Ex-2006, 58:14-59:9.

Q. Okay. And would Bluetooth also be a technology you had in mind when referring to these layer 2, layer 3, and baseband?

THE WITNESS: Actually, although if -- the way I am looking at the problem we're trying to solve here, right, Bluetooth is usually more of a proximity technology.

	This paragraph refers to a data transmission technology. I think, for that, we would be leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth. Ex-2006, 155:18-156:6.
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2. Disclosure in the '948 Application supporting each and every limitation in independent Claim 23 of the '054 Patent

The following table shows written description support in the '948 Application for each element of Challenged Claim 23. Ex-2001, ¶97.

Claim Element	Disclosure of the Claim Element in the '948 Application
23[pre] A wireless transmit/receive unit (WTRU) comprising:	The '948 Application (Ex-1282), filed on December 22, 2009, discloses a WTRU and a method by which a WTRU, operating in a wireless environment, can communicate with other WTRUs operating in that environment. Ex-1282, [0023]-[0024].
23[a] circuitry configured to process, from a touch display, an input to select media in an application;	The '948 Application discloses a WTRU with a touchscreen display. Ex-1282, [0024]. The “WTRU 101 includes a processor 105 that is configurable to process information from the UI 109 and the communication peripheral 107.” <i>Id.</i> , [0030]. The touchscreen display may be used to provide a user interface (UI) that can be used to select a media element shown as a visual depiction on the touchscreen. <i>Id.</i> , [0029]. “For example, the visual depiction may identify a selected media element stored in the WTRU 101.” <i>Id.</i> Thus, the user input, via the user interface (UI), can be used to select a media element. <i>See also</i> Figure 1; Figure 3; Figure 6.

23[b] circuitry configured to detect, by the WTRU over Bluetooth, another WTRU;	The '948 Application discloses circuitry that enables a WTRU to use Bluetooth to detect another WTRU in proximity to the WTRU. Figure 1; Figure 2; Figure 3. For example, Figures 1 and 2 show system level diagrams that include circuitry for enabling communication peripherals 107 disposed in nearby WTRUs to communicate via the communication environment 115. For example, “[t]he communication peripheral 107 receives and maintains the environment information relating to the WTRUs 101_c operating within the local areas 211, 213.” Ex-1282, [0027]; Figure 2. “The environment information and the user input are then used as inputs to the processor 105 and are processed to identify a target WTRU 101_{c,t}.” <i>Id.</i>, [0030]. “The environment information 301 may be gathered via a service discovery protocol (SDP) such as currently available in protocols such as Bluetooth®, for example. This protocol allows the WTRU 101 to discover the services (e.g., TapAPP as described herein) that are supported by other WTRUs operating in the local environment.” <i>Id.</i>, [0034]. Accordingly the 2009 Application explicitly discloses that Bluetooth can be used to detect other (e.g., a plurality of other) candidate WTRUs (WTRU_c) in proximity to the WTRU. Furthermore, one of the inventors of the '054 Patent, Mr. Alexander Reznik, was deposed in a co-pending ITC investigation, and he testified as follows: Q. Did you have any specific technology in mind for those two things that had to be done? A. So we were looking at families of technologies, right. So I mentioned cellular and WiFi as two good families for data transfer.
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	I mentioned, you know, 802.15-type stuff -- Bluetooth, Zigbee, for example -- as things that would have been good for proximity detection. 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 kind of said there's options on both sides. Ex-2006, 64:2-17. Q. Okay. And would Bluetooth also be a technology you had in mind when referring to these layer 2, layer 3, and baseband? THE WITNESS: Actually, although if -- the way I am looking at the problem we're trying to solve here, right, Bluetooth is usually more of a proximity technology. This paragraph refers to a data transmission technology. I think, for that, we would be leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth. Ex-2006, 155:18-156:6.
23[c] the circuitry further configured to process another input from the touch display to select the another WTRU;	The '948 Application discloses circuitry that enables the processor enables the WTRU to process another touchscreen input to select another WTRU from a set of detected WTRUs to, for example, receive a media element from the WTRU. "A user input received from the UI 109, for example a touchscreen/display, may be translated into application signals by the touchscreen/display 109 or processor 105. This

	touchscreen information 305 is input to the target discrimination algorithm 313 to identify a target WTRU 101_{c,t} from the plurality of other WTRUs.” Ex-1282, [0036]. Moreover, “[d]irectional inputs provided by the user via the touchscreen/display 109 may be synthesized to ... select a target WTRU_{c,t} from the identified [detected] group of candidate WTRUs 101_c to establish a one-to-one communication between the transmitting WTRU 101 and the target WTRU_{c,t}” <i>Id.</i>, [0037].
23[d] circuitry configured to send, by the WTRU to the selected another WTRU, a message to transfer the selected media;	The '948 Application discloses circuitry enabling the sending/transmitting WTRU to send a message to the selected/receiving WTRU indicating that a media element is ready to be transferred to the receiving WTRU. Ex-1282, [0044]. For example, “[<i>t</i>]he <i>TapAPP 123 provides an indication 603b or a prompt that a data transfer is ready for receiving</i>. To receive a file, the user may touch 710 the touchscreen 109 to initiate reception of the data transfer.” <i>Id.</i> (emphasis added); Figure 7A; Figure 1; Figure 3.
23[e] circuitry configured to receive, by the WTRU, an acceptance to transfer the selected media; and	The '948 Application discloses circuitry that enables the selected/receiving WTRU to send an acceptance to the sending/transmitting WTRU indicating that the media element has been accepted for transfer. Ex-1282, [0044]. For example, “[<i>t</i>]he TapAPP 123 provides an indication 603b or a prompt that a data transfer is ready for receiving. To receive a file, the user may touch 710 the touchscreen 109 to initiate reception of the data transfer.” <i>Id.</i> (emphasis added); Figure 7A; Figure 1; Figure 3.
23[f] circuitry configured to transfer, by the WTRU to the	The '948 Application discloses circuitry that enables the selected media element to be transferred to the receiving WTRU using WiFi. Figure 1; Figure 2; Figure 3. For example, Figures 1 and 2 show system level diagrams that include

selected another WTRU over WiFi, the selected media.	circuitry for enabling communication peripherals 107 disposed in nearby WTRUs to communicate via the communication environment 115. The specification of the 2009 Application discloses a variety of communication protocols. For example, the specification states that “[t]he communication peripheral 107 may be implemented as a wireless personal area network (WPAN) device, for example Bluetooth®, Wireless Universal Serial Bus (W-USB) or WiFi® in ad-hoc mode.” Ex-1282, [0024]. “The communication peripheral 107 may include technologies such as a third generation partnership (3GPP) second or third generation standards (2G/3G) modem, Bluetooth®, or Wifi®. <i>Any combination or all of these communication technologies may be implemented in a single component design.</i>” <i>Id.</i> (emphasis added). This disclosure is clear. The specification explicitly discloses Bluetooth and WiFi, and likewise explicitly discloses that any combination of these aforementioned communication technologies, including Bluetooth and WiFi, can be used in a single component design. Furthermore, one of the inventors of the ’054 Patent, Mr. Alexander Reznik, was deposed in a co-pending ITC investigation, and he testified as follows: Q. Let's back that up a little bit then. What were the known ways to transfer data that he refers to? A. So any kind of wireless transfer technology. So WiFi for sure. You know, mobile. Because, by that time, mobile phones were data transfer devices, right. So those were the connectivity options. And then somehow they all involved having an application server somewhere, like a Dropbox or something, right, that would facilitate it or something like that.
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	I'm sure there may have been some other ones that we had in mind. Q. So those were WiFi and cellular data transfer; is that right? A. Right. So you're asking me today that were reasonable technologies back then for data transfer. WiFi and cellular definitely come to mind. Ex-2006, 58:14-59:9. Q. Okay. And would Bluetooth also be a technology you had in mind when referring to these layer 2, layer 3, and baseband? THE WITNESS: Actually, although if -- the way I am looking at the problem we're trying to solve here, right, Bluetooth is usually more of a proximity technology. This paragraph refers to a data transmission technology. I think, for that, we would be leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth. Ex-2006, 155:18-156:6.
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These tables, and the discussion provided above in Sections III.B.1, III.B.2, III.B.3, and III.B.4 provide definitive proof that the inventors were in possession of each and every element of the claims challenged by Microsoft in its priority

challenge (Claims 1 and 23 of the '054 Patent). For this reason, the Challenged Claims are entitled to a priority date of at least as early as the filing date of the '948 Application (December 22, 2009), Forutanpour is not prior art, and institution should be denied as to all Grounds. Ex-2001, ¶¶98-99.

IV. CONCLUSION

For the reasons identified above, the Board should exercise its discretion and deny institution under *Fintiv*. Petitioner and RPI Lenovo ignore the true purpose of the America Invents Act—efficiency, simplification of issues, and cost reduction—and seek multiple challenges to the validity of the Challenged Claims without offering any stipulation concerning the use of identical prior art in the Petitions, the ITC proceeding, and the underlying district court litigation.

Moreover, as demonstrated above, the '054 Patent is entitled to a priority date of at least as early as December 22, 2009, the filing date of the '948 Application, and Forutanpour is not prior art. Specifically, the '948 Application explicitly discloses both Bluetooth and WiFi, describes using Bluetooth as a detection protocol, describes WiFi as a data transfer protocol, and shows that the inventors contemplated using both Bluetooth and WiFi “in a single component design.” Ex-1282, [0024]. Testimony from the inventor, Mr. Reznik, confirms that the inventors were in possession of the substance of the Challenged Claims as of the filing date of the '948 Application and that the specification supports the alleged “missing element” of

Claims 1 and 23 challenged by Microsoft.

For these reasons, Petitioner has failed to show that Challenged Claims 1 and 23 of the '054 Patent are unpatentable. Challenged dependent claims 3-10, 12, 14-15, 21, 25-32, 34, 36-37, 43, 46-47, and 49-50, which depend from Claims 1 and 23, are patentable for the same reasons.

For any or all of the above-described reasons, Patent Owner respectfully requests that the Board deny institution.

Dated: May 28, 2024

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24 have 10,840 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared using Microsoft Word 2010.

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE** is being served on counsel for petitioner via electronic mail on, in its entirety on the following counsel of record for Petitioner:

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