

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
Patent No. 9,173,054

PATENT OWNER'S SUR REPLY

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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TABLE OF EXHIBITS

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2001	Declaration of George Edwards	X
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	X
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)	X
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)	X
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)	X
2006	Transcript of the March 14, 2024 deposition of Dr. Alexander Reznik in <i>Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, and Components Thereof</i> , Investigation No. 337-TA-1373 (ITC)	X
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-uwb-and-802-11-stack-up-on-power-consumption/ .	X
2008	Jani, Jay and Mahendra Maheta, <i>Wireless Computing with Bluetooth & Wi-Fi</i> , 4 th International Convention	X

Exhibit	Description	Previously Submitted
	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 .	X
2010	Tabona, Andrew, <i>802.11b vs. Bluetooth</i> , Techgenix April 19, 2005, available at https://techgenix.com/80211b-bluetooth/ .	X
2011	Paulus, Wolf, <i>Data Transfer Speeds Compared</i> , July 4, 2006, available at https://web.archive.org/web/20200919150247/https://wolfpaulus.com/dts/ .	X
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/ .	X
2013	June 6, 2024 Email from the Board to Counsel	X
2014	Updated Declaration of George Edwards	X
2015	Updated Transcript of the March 14, 2024 deposition of Dr. Alexander Reznik in <i>Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, and Components Thereof</i> , Investigation No. 337-TA-1373 (ITC)	X

I. INTRODUCTION

Microsoft's ("Petitioner") arguments in their Reply to Patent Owner's Response (Paper 17, "Petitioner's Reply" or "Reply") are unpersuasive and fail to overcome Patent Owner's showing of written description support for the Challenged Claims. Petitioner fails to show that the '948 Application does not sufficiently disclose the Challenged Claims, entitling the claims of the '054 Patent a priority date of at least December 22, 2009. Petitioner's Reply relies on the same arguments made in its Petition while failing to rebut the compelling arguments made by Patent Owner. Petitioner's claim that the disclosure of inclusion of both Bluetooth and Wi-Fi to be used, and switched between, in the same device would not be understood by a POSITA falls short. In an attempt to ignore the clear written description support in the patent specification, Petitioner improperly argues throughout their Reply that Wi-Fi for transmission is not disclosed. Petitioner further argues that the specific method of switching between Bluetooth and Wi-Fi is not disclosed. Both of these arguments fail.

Petitioner further attempts to discredit the Patent Office's findings by arguing that the Challenged Claims were merely an attempt to copy Apple's AirDrop. This is not true because the Challenged Claims had written description support at least as early as December 22, 2009, nearly four years prior to the release of AirDrop. Moreover, the Patent Office Examiner plainly believed that the Challenged Claims

had adequate support in the specification when allowing them to issue. For these reasons, the Board should find the Challenged Claims patentable because the Challenged Claims are entitled to a priority date of at least December 22, 2009, making the lead reference cited by Petitioner in each of its Grounds (Foruntanpour) not prior art.

II. THE ‘948 APPLICATION PROVIDES SUFFICIENT WRITTEN DESCRIPTION SUPPORT FOR THE CHALLENGED CLAIMS

The ‘948 Application provides sufficient written description support for the Challenged Claims. According to 35 U.S.C. § 112, “[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it . . . as to enable any person skilled in the art to . . . make and use the same.” The test for whether the written description is sufficient to enable a person of skill in the art to make and use the same 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.* Courts

have recognized that this factual inquiry “will necessarily vary depending on the context.” *Id.* Importantly, “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)).

It is undisputed that the ‘948 Application discloses the use of both Bluetooth and Wi-Fi in the same device. Petition at 19, 24-25, 27; Reply at 4-8. Petitioner, however, disputes that the ‘948 Application discloses “a method that detects other devices over Bluetooth and then transfers media to one of the detected devices over Wi-Fi.” Reply at 3-4. Petitioner’s argument hinges on the fallacy that the written description must explicitly disclose the use of Wi-Fi to transfer data. This is untrue and an attempt to misdirect the analysis.

A. The ‘948 Application’s disclosure is sufficient to show Patent Owner had possession of the Challenged Claims

Petitioner attempts to apply a more stringent standard to the claims and ignores all context that a person of skill in the art would consider when making an “objective inquiry into the four corners of the specification.” *Ariad Pharms.*, 598 F.3d at 1351. Petitioner argues that the ‘948 Application does not expressly disclose the use of Wi-Fi for data transfer. Reply at 5. While Patent Owner maintains that the ‘948 Application expressly discloses Wi-Fi for data transfer (“The communication

peripherals 107 may include technologies such as . . . WiFi®. Any combination or all of these communication technologies may be implemented in a single component design.” Ex-1282, [0024].), that is not the proper standard when determining whether the ‘948 Application provides written description support to the Challenged Claims. The ‘948 Application must only “reasonably convey[]” to one skilled in the art that the inventor “had possession” of the claimed invention at the time the application was filed. *Ariad Pharms.*, 598 F.3d at 1351.

This leads to Petitioner and their expert, Mr. Rysavy, conveniently ignoring the context of the ‘948 Application that a person of skill in the art would have had at the time it was filed. Reply at 4-5. Petitioner incorrectly argues that the ‘948 Application¹ “nowhere suggests using a different protocol for transfer of media content to a detected WTRU (much less to use Wi-Fi, specifically).” *Id.* at 5; Ex-1203, ¶ 69 (The written description “does not say which protocol to use for the

¹ Petitioner previously argued that the ‘948 Application did not disclose using Bluetooth for detection of other WTRUs. Petition at 19. Petitioner now, however, admits that the ‘948 Application sufficiently discloses the use of Bluetooth for detection. Reply at 5 (“Although the great-grandparent application discloses Bluetooth service discovery protocol (SDP) to gather environment information about nearby WTRUs . . .”).

transfer, gives no indication that the WTRU makes a decision as to which protocol to use for data transmission, and does not provide any indication that the protocol use for data transmission is different than the protocol used for device detection.”). However, claiming that a POSITA would not have “any indication” that the protocol for data transfer is different than the protocol for device detection is not true in this context. For example, if you gave a chef eggs, bread, a skillet, and a toaster with no other instructions other than to make scrambled eggs and toast, the chef would know, due to their knowledge in the art, to use the skillet to scramble the eggs and the toaster to toast the bread. The same process applies here: a POSITA given a WTRU that includes Bluetooth and Wi-Fi with the instructions to detect other nearby WTRUs and then transfer data to those detected WTRUs would know to use Bluetooth for detection and Wi-Fi for data transfer. *See* Ex-2014, ¶ 71 (“[T]o a POSITA, the ’948 Application teaches the usage of Bluetooth detection of proximate WTRUs and WiFi transmission of data between a sending WTRU and a detected WTRU.”).

Petitioner continues to incorrectly assert that the ’948 Application fails to provide “blaze marks.” Reply at 6 (citing *Quake v. Lo*, 928 F.3d 1365, 1374 (Fed. Cir. 2019)). Blaze marks are unnecessary here because the “claimed species is expressly described in the specification.” *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 21 F.4th 1362, 1370 (Fed. Cir. 2022). Further, “blaze marks” are

only required when the specification contains a “laundry-list-type disclosure[],” which is not the case here.² *Id.* Petitioner’s reach is evidenced by its abandonment of its initial reference, *Purdue Pharma L.P. v. Faulding Inc.*, conceding that *Purdue Pharma* is not applicable. 230 F.3d 1320, 1326 (Fed. Cir. 2000). Petitioner, however, switches reliance to *Quake*, but *Quake* actually supports Patent Owner’s arguments. *Quake*, 928 F.3d at 1374 (“However, *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112.” (internal quotations omitted)).

Petitioner concedes that the only dispute is whether the independent claims are sufficiently disclosed by the ‘948 Application. Reply at 6 (“[T]he great-grandparent application simply fails to disclose the independent claims’ limitations of detecting another WTRU over Bluetooth and then transferring data to that WTRU over Wi-Fi.”). Petitioner attempts to further argue that the ‘948 Application doesn’t disclose switching between protocols in the same device, which is incorrect. *Id.* at 6-7. The ‘948 Application explicitly discloses the use of Bluetooth and Wi-Fi in a

² The ‘948 Application disclosure contains only four communication technologies, “third generation partnership (3GPP) second or third generation standards (2G/3G) modem[s], Bluetooth® or WiFi®.” Ex-1282, [0024]. This is far from the type of disclosure that requires “blaze marks.”

single WTRU, which a POSITA would understand that Bluetooth is used for detection and Wi-Fi is used for data transfer. Ex-1282, [0024] (“Any combination or all of these communication technologies [(e.g., Bluetooth and Wi-Fi)] may be implemented in a single component design.”); Ex-2014, ¶ 74 (“[T]he disclosure of the ‘948 Application informs a POSITA that the inventors had possession of the claimed subject matter, including Bluetooth detection of a nearby WTRU and the transfer of data to the detected WTRU using WiFi, at least as early as the filing date of the ‘948 Application, which is December 22, 2009.”). Of course, contrary to what Petitioner asserts, switching from one protocol (Bluetooth) to another (Wi-Fi) would be understood by a POSITA, as indicated above, as being necessarily inherent in this disclosure.

In whole, Petitioner’s arguments against sufficient disclosure are unpersuasive. The ‘948 Application explicitly discloses the use of both Bluetooth and Wi-Fi in the same device and a POSITA would know that Bluetooth is used for detection while Wi-Fi is used for data transfer. The Board should find this satisfies the written description requirement of section 112 such that the lead reference cited in the Petition, Forutanpour, is not prior art, and that the Challenged Claims are patentable.

B. This is a predictable technology requiring “a lower level of detail” to satisfy the written description requirement

In an attempt to circumvent the proper standard for written description relevant to this proceeding, Petitioner tries to make the technology at issue seem more complicated than it is. In doing so, Petitioner ignores the fact that the technology described in the ‘948 Application is neither complex nor unpredictable. As stated above, the Federal Circuit has held that “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.” *Ariad Pharms.*, 598 F.3d at 1351; *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1361 (Fed. Cir. 2018) (“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.”). Petitioner attempts to distinguish *Hologic* by once again improperly arguing that the ‘948 Application has a “complete lack of disclosure.” Reply at 7. But parroting the same argument repeatedly does not make it become true. In both *Hologic* and here, the technologies involved are neither complex nor unpredictable which allows for a “lower level of detail” to be included in the specification. *Hologic*, 884 F.3d at 1361.

Further, Petitioner asserts that Patent Owner has somehow argued that the ‘948 Application renders the Challenged Claims obvious giving the claims written

description support.³ Reply at 8. While Patent Owner acknowledges that obviousness alone is not enough to show written description support, Patent Owner has never relied on obviousness to do so. Petitioner is improperly attempting to draw consequence from Patent Owner relying on the proper written description standard which is lower when the technology is not complex or unpredictable. Nevertheless, the ‘948 Application sufficiently discloses all limitations of the Challenged Claims, specifically that Bluetooth is used to detect WTRUs in the proximity and that Wi-Fi is then used to transfer data to the detected WTRU. *See* Ex-1282, [0039] (“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 [(i.e., Wi-Fi)] in the communication peripheral.”).

Petitioner argues that even if “it was ‘well-known that WiFi offered better transmission speeds as an advantage over Bluetooth’” that this is insufficient to show written description support. Reply at 9 (quoting Patent Owner’s Response at 20).

³ To add to the outlandishness of the claim that Patent Owner’s arguments rely on the fact the ‘948 Application renders the Challenged Claims obvious, the words “obvious” and “obviousness” do not appear even once in Patent Owner’s Response (Paper 14).

However, this is confusing the proper standard. The proper standard, which is laid out above, just requires the written description to “reasonably convey” to a POSITA that the inventor was in possession of the invention at the time of filing. *Ariad Pharms.*, 598 F.3d at 1351. Because Wi-Fi was well-known by POSITAs for its ability to transfer data at high speeds, the disclosure of Wi-Fi to be used in the same WTRU as Bluetooth, and the express disclosure of Bluetooth for detection, the written description “reasonably conveys” to a POSITA that the inventor was in possession of the Challenged Claims at the time of filing, including the use of Wi-Fi for data transfer. Ex-2014, ¶ 87.

In sum, Petitioner’s attempts to confuse Patent Owner’s evidentiary analysis fail. The technology at issue here is neither complex nor unpredictable, requiring a less detailed disclosure than otherwise would be required for a more complex technology. Patent Owner does not claim the improper standard that the ‘948 Application makes the Challenged Claims obvious. This Court should find that a POSITA would have found that the ‘948 Application reasonably conveys that the inventor was in possession of the Challenged Claims at the time of filing. Thus, the Challenged Claims are patentable because Forutanpour is not prior art.

C. The named inventor’s testimony is helpful to show written description support

Petitioner argues that the inventor’s ITC testimony cannot provide written description support for the claims and that the testimony actually supports Petitioner’s position. Reply at 10. Both of these arguments are incorrect. As previously noted, 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)). Furthermore, “[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)). Dr. Reznik’s testimony⁴ is indeed helpful to show the

⁴ Dr. Reznik’s entire deposition transcript has not been provided as it is under confidentiality provisions in the ITC proceedings. Patent Owner has provided the relevant testimony from Dr. Reznik and can explain further context as needed at the hearing.

context surrounding the ‘948 Application and cannot be taken to support Petitioner’s assertions.

While Patent Owner agrees with the Board that written description support is not based on what the inventor “had in mind,” the inventor’s testimony can assist with the context of the written description, which Dr. Reznik’s testimony does. Institution Decision at 22. Unlike Patent Owner, Petitioner does not provide any black letter law that prevents the consideration of the inventor’s testimony. *See* Reply at 10-11. Thus, Dr. Reznik’s testimony should be considered to determine the context surrounding the ‘948 Application’s disclosures.

Furthermore, Petitioner’s assertion that Dr. Reznik’s testimony supports its position is incorrect. While Dr. Reznik did testify that “WiFi is not specifically mentioned” in the specification, he later testified that for data transfer he was “leaning towards WiFi and cellular as more typical uses as opposed to Bluetooth.” Ex-2015, 155:10-156:6. When asked what the known ways were to transfer data at the time of filing, Dr. Reznik responded “So WiFi for sure,” but he never testified that Bluetooth was an option for data transfer in relation to the claimed invention. *Id.* at 58:18.

While Wi-Fi is good at data transfer, it’s not optimal for proximity detection. When asked “[w]hat were the solutions back in 2008 . . . in terms of figuring out devices that are nearby each other?” Dr. Reznik responded “[s]o technologies like

Bluetooth. . .” *Id.* at 60:18-22. Thus, Dr. Reznik’s testimony is helpful to understand the context of the art at the time of the ‘948 Application.⁵ There would be no reason to explicitly disclose Wi-Fi in the communication peripheral, other than for data transfer, especially when Bluetooth is explicitly disclosed for proximity detection. Dr. Reznik’s testimony helps provide the proper context which supports a finding that the ‘948 Application sufficiently discloses the scope and content of the Challenged Claims.

Therefore, Dr. Reznik’s ITC testimony is probative in determining the context of the ‘948 Application and how it supports the Challenged Claims. Further, the additional context omitted by Petitioner shows that Dr. Reznik’s testimony does not support the positions of Petitioner, but rather supports a finding of sufficient written description.

⁵ To the extent Petitioner argues that Dr. Reznik’s testimony is inadmissible, Microsoft has admitted that Lenovo, who along with Patent Owner are parties to the ITC proceeding in which Dr. Reznik’s deposition occurred, is a party in privity with Petitioner for the purposes of this *Inter Partes* Review. Petition at xiii. Microsoft and Lenovo had the opportunity to further examine the witness if they were dissatisfied with his testimony. Likewise, Microsoft and Lenovo have had the opportunity to provide competing evidence but have failed to do so.

D. Comparing the ‘948 Application to other references is improper and attempts to confuse the proper standard for sufficient written description

Petitioner continues to improperly argue that written description support for the Challenged Claims would have required more than what was disclosed in the ‘948 Application. Reply at 11. Further, Petitioner continues to assert that the ‘948 Application should have expressly disclosed switching from Bluetooth for detection to Wi-Fi for data transfer, but this is incorrect based on the analysis above. Petitioner resorts to comparing the ‘948 Application to other publications⁶ in an attempt to show a lack of written description support, but this is improper.

The proper test for written description support is not what other publications disclose, but rather “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.*, 598 F.3d at 1351. Petitioner cites to other references it provided with its petition, but these references are irrelevant to the ‘948 Application’s disclosure. The ‘948 Application reasonably conveys to those skilled in the art that the inventor was in possession of the

⁶ Petitioner has not asserted any grounds including these references based on anticipation of the Challenged Claims. As such, any argument suggesting that these cited references are relevant to the disclosure required of the ‘948 Application fails.

Challenged Claims at least as early as December 22, 2009. Even if *arguendo* these references cited by Petitioner were more “detailed,” it does not equate to the ‘948 Application being insufficient to support written description.

Once again, Petitioner introduces unnecessary expert testimony towards supposed lack of disclosure with the underlying goal to make the technology seem more complex than it actually is. Reply at 14-15. In reality, the technology is not complex and, as explained above, the ‘948 Application sufficiently discloses the use of Bluetooth and Wi-Fi in a single device where Bluetooth is used for detection and Wi-Fi is used for data transfer. Further, Petitioner’s opinions on how the ‘948 Application should have been drafted are irrelevant to the proper standard. In fact, Petitioner’s continuous attorney argument rather than legal analysis of the ‘948 Application’s disclosures evidence the weakness of Petitioner’s arguments.

Petitioner’s attempts to confuse the proper standard with irrelevant references and expert testimony to the inner workings of Bluetooth and Wi-Fi likewise falls short. The parties are simply in dispute over the disclosed use of Wi-Fi to transfer data to other devices that were detected using Bluetooth. Disclosures from other publications, some not even from U.S. patents or applications, are irrelevant to what is required of the ‘948 Application by law. The Board should find these arguments unpersuasive and the Challenged Claims patentable.

III. PETITIONER’S ARGUMENT THAT THE CHALLENGED CLAIMS, WERE DRAFTED TO COVER AIRDROP HAVE NO BEARING IN THIS PROCEEDING

Finally, Petitioner suggests that the Challenged Claims were “added later during prosecution in response to development by others.” Reply at 15 (quoting *Quake*, 928 F.3d at 1373). Petitioner asserts that once “Apple released AirDrop for iPhones that Patent Owner shifted course and drafted new claims attempting to cover AirDrop by reciting the claims’ Bluetooth-to-Wi-Fi methodology.” *Id.* at 16. However, the Patent Office allowed the claims to issue when filed, showing that the Examiner felt the language of the Challenged Claims was fully supported by the patent specification. Further, even if Petitioner’s accusations were correct, it does not preclude patent protection of claims that have support in the written description, as the Challenged Claims here did. *BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1404 (Fed. Cir. 2022) (“After all, ‘there is nothing improper, illegal, or inequitable in filing a patent application for the purpose of obtaining a right to exclude a known competitor’s product from the market.’” (quoting *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988))). In fact, the Federal Circuit has held “[a]ny such application, ‘must comply with all statutes and regulations, of course, but, if it does, *its genesis in the marketplace is simply irrelevant* and cannot of itself evidence deceitful intent.” *Id.* at 1405 (emphasis added); see also *Trebro Mfg., Inc. v. Firefly Equip., LLC*, 748 F.3d 1159, 1172 (Fed.

Cir. 2014) (upholding patent claims added after release of competitor’s product where prior written description support existed).

While Patent Owner did pursue a patent based on the ‘948 Application related to gestural input for the transfer of files between WTRUs, this does not mean that the Challenged Claims are not supported by the ‘948 Application. It is a staple of U.S. patent law that patent applications can lead to many different issued patents through continuations, continuations-in-part, and divisional applications. *See* 35 U.S.C. §§ 120-121. Necessarily, however, the claims resulting from those patents cannot be the same. What claims Patent Owner submitted in other applications are irrelevant. Further, *Quake* is distinguishable. In *Quake*, the patentee changed the claim language after the patent challenger’s own patent application published. *Quake*, 928 F.3d 1373. The main difference is that in *Quake*, the new amendments “creat[ed] a mismatch between the claims and the originally filed specification.” *Id.* Here, the Challenged Claims do not “creat[e] a mismatch between the claims and the originally filed specification” but rather have support in the written description of the ‘948 Application, which predates Apple’s AirDrop for iPhones by nearly four years. *Id.*

The *quid pro quo* element of patent law, the written description, has been met here. Reply at 20; *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 1016 (Fed. Cir. 2022). As evidenced above, Patent Owner has fulfilled its duty to

disclose the invention captured by the Challenged Claims. As such, there is no concern that Patent Owner has somehow evaded its end of the bargain, public disclosure.

Thus, Petitioner's suggestion that the Challenged Claims are merely a copy of Apple's AirDrop is unfounded. The Challenged Claims are supported by the written description of the '948 Application, which was filed nearly four years prior to AirDrop's release. While some patents in the '054 patent's family claim detection and data transfer in relation to a gestural input, this does not bar the '054 patent from claiming an invention that was present in the '948 Application's disclosure. As such, the proper priority date for the Challenged Claims is at least December 22, 2009, making the Challenged Claims patentable.

IV. CONCLUSION

As demonstrated above, the Board should find that the '948 Application sufficiently discloses the Challenged Claims entitling the Challenged Claims to a priority date of at least December 22, 2009. The '948 Application's disclosure is sufficient to show that Patent Owner was in possession of Bluetooth for detection and Wi-Fi for data transfer within the same device at the time of filing. Accordingly, the Challenged Claims predate the publishing date of the Forutanpour reference, defeating each ground asserted by Petitioner.

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 the above-described reasons, Patent Owner respectfully requests that the Board find all the Challenged Claims patentable.

Dated: February 10, 2025

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S SUR REPLY** specified in 37 C.F.R. § 42.24 has 4,165 words, in compliance with the 5,600 word limit set forth in 37 C.F.R. § 42.24(c)(4). This word count was prepared using Microsoft Word 2016.

Date: February 10, 2025

Respectfully submitted,

/s/ Scott W. Hejny
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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S SUR REPLY** 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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