



**ORAL ARGUMENT FOR
IPR2024-00537/00538
(U.S. PATENT NOS. 8,737,933 & 9,173,054)**

Before Administrative Patent Judges

- Jameson Lee
- Miriam L. Quinn
- Lisa A. Murray

McKool Smith



Forutanpour is Not Prior Art So All Grounds Fail

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 '933 patent's filing date of June 28, 2013. "Claims in a patent or patent application are

Petition at 27

See *generally* POR; Sur Reply

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THE '948 APPLICATION PROVIDES SUFFICIENT WRITTEN DESCRIPTION SUPPORT

- The '948 Application's disclosure sufficiently shows Patent Owner was in possession of the Challenged Claims.
- This is a predictable technology requiring “a lower level of detail” to satisfy the written description requirement.
- The named inventor's testimony is helpful to show written description support.
- Comparing the '948 Application to other references confuses the proper standard for written description support.

GENESIS OF THE CHALLENGED CLAIMS COMPARED TO AIRDROP IS IRRELAVENT

See generally POR; Sur Reply

The '948 Application Provides Sufficient Written Description Support for the Challenged Claims

The '948 Application's Disclosure Sufficiently Shows Patent Owner Was in Possession of the Challenged Claims

The Challenged Claims Have Sufficient Written Description Support

“The 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.”

35 U.S.C. § 112

The Challenged Claims Have Sufficient Written Description Support

“[W]hether 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))

“[P]ossession 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.

It is Undisputed That the '948 Application Discloses Both Bluetooth and Wi-Fi in the Same Device

Thus, the parent application at best discloses WTRUs with the ability to communicate using Bluetooth and Wi-Fi, among numerous other possible communication technologies. EX1281, [0017], [0024], [0027], [0043]; EX1203,

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claims, a processor and/or circuitry configured to carry out such a method)⁷. At best, the ancestor applications disclose only devices that may support Bluetooth and WiFi, along with a long, open-ended list of other wireless technologies. *E.g.*, EX1281,

Petition at 19

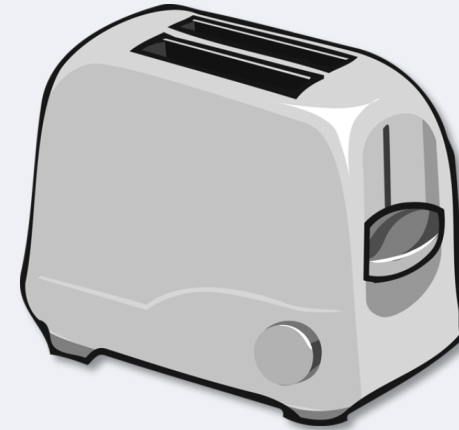
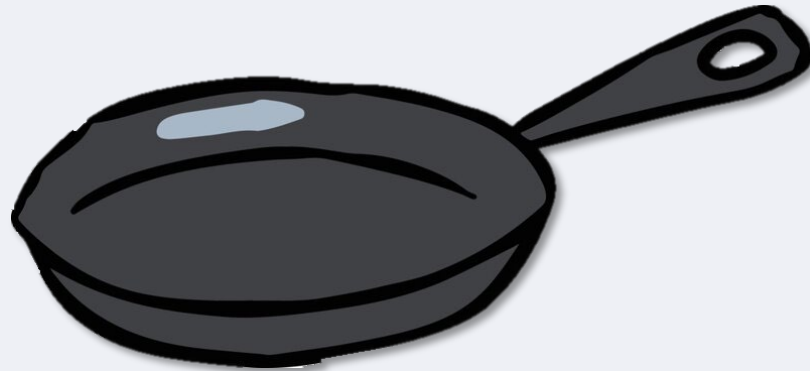
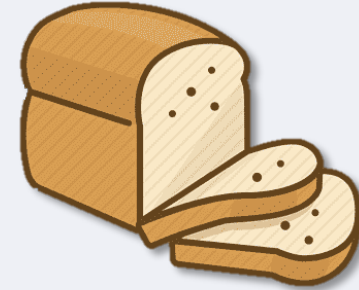
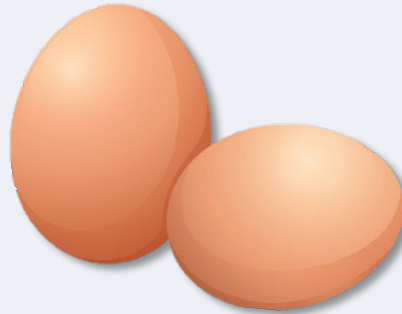
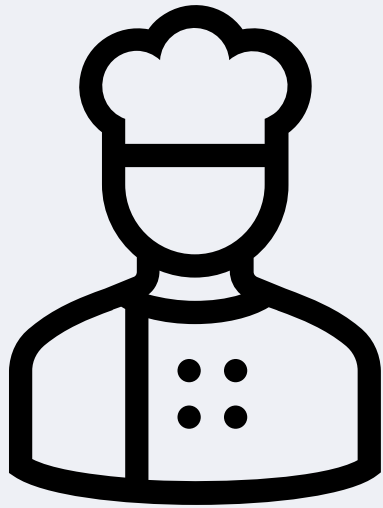
Microsoft Disputes the Disclosure of Bluetooth for Detection and Wi-Fi for Transfer in a Single Device

Thus, the grandparent application at best provides written description support for using a single protocol (e.g., Bluetooth)—and that protocol alone—for both device detection and media content transfer. The grandparent application not only

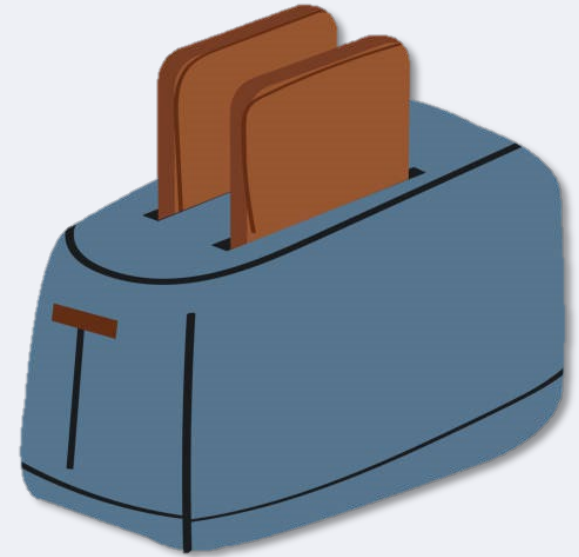
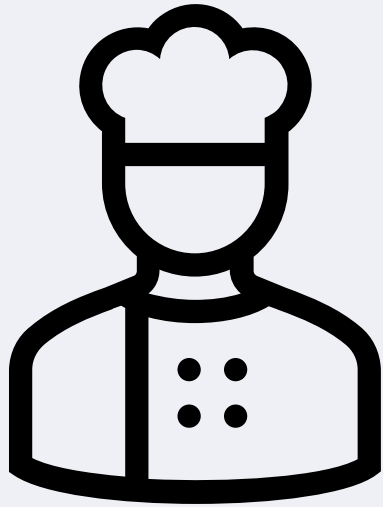
Microsoft's Reply to POR at 5

POR at 8; Sur Reply at 4-5

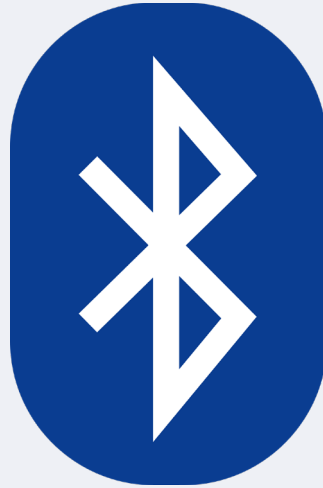
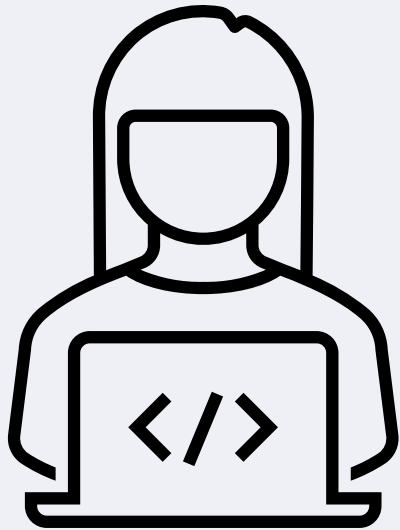
Context Matters



Context Matters



Context Matters

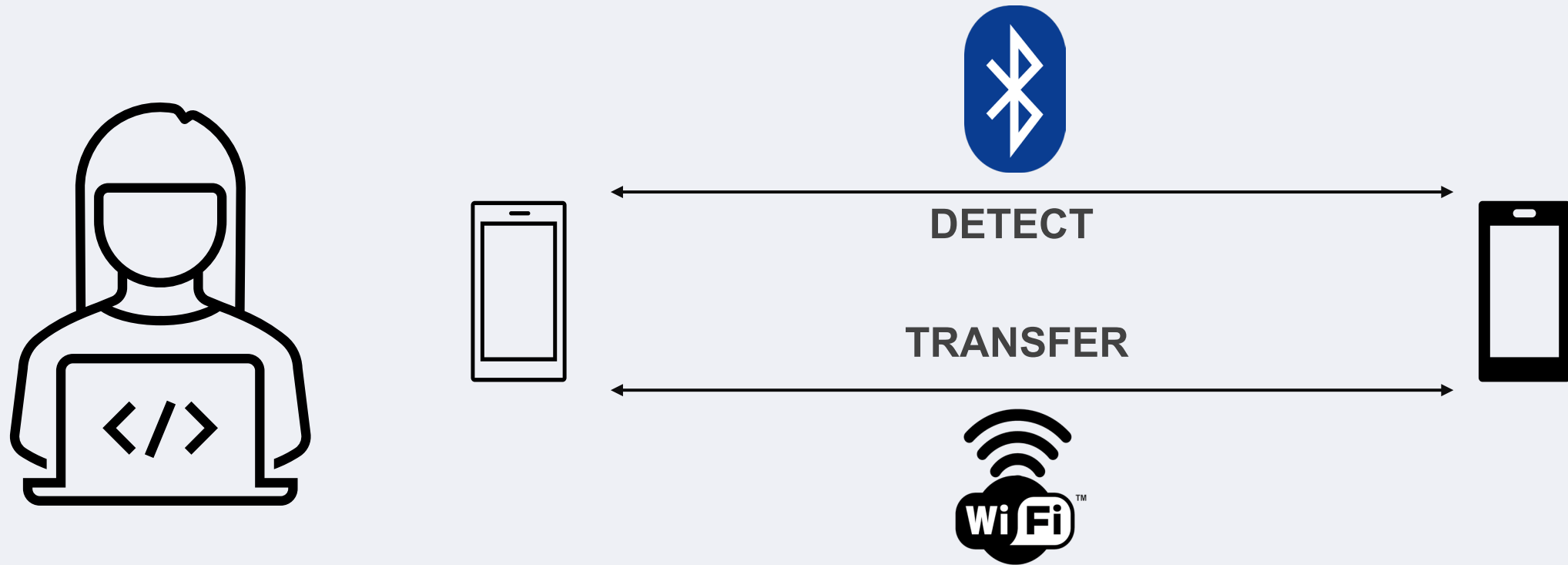


DETECT



TRANSFER

Context Matters



Blaze Marks are Unnecessary Here



POR at 28-29; Sur Reply at 5-6

The '948 Application Explicitly Discloses Bluetooth and Wi-Fi in the Same Device

for example. 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. Other peripherals

Ex-1282, [0024]

The '948 Application Provides Sufficient Written Description Support For the Challenged Claims

This is a Predictable Technology

This is a Predictable Technology Requiring a Lower Level of Detail

“[T]he 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., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (emphasis added)

“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.”

Hologic, Inc. v. Smith & Nephew, Inc., 884 F.3d 1357, 1361 (Fed. Cir. 2018) (emphasis added)

Patent Owner Does Not Rely on Obviousness to Show Written Description Support

**Even If Wi-Fi's Known Benefits Rendered The Claims Obvious,
That Is Not A Substitute For Written Description Support**

Microsoft's Reply to POR at 8

Sur Reply at 8-10

The '948 Application Provides Sufficient Written Description Support For the Challenged Claims

Dr. Reznik's Testimony is Helpful to Show Written
Description Support

Inventors Are Competent Witnesses

“An inventor is a competent witness to explain the invention and what was **intended to be conveyed by the specification** and covered by the claims.”

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)) (emphasis added)

“The testimony of an 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))

Wi-Fi for Data Transfer was Disclosed

14 Q. Let's back that up a little bit then.

15 What were the known ways to
16 transfer data that he refers to?

17 A. So any kind of wireless transfer
18 technology. So WiFi for sure. You know,
19 mobile. Because, by that time, mobile phones
20 were data transfer devices, right.

21 So those were the connectivity
22 options. And then somehow they all involved
23 having an application server somewhere, like a
24 Dropbox or something, right, that would
25 facilitate it or something like that. I'm sure

1 there may have been some other ones that we had
2 in mind.

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

5 A. Right. So you're asking me today
6 what were reasonable technologies back then for
7 data transfer.

8 WiFi and cellular definitely
9 come to mind. I think — the wireless transfer

Ex-2015, 58:14-59:9

POR at 22; Sur Reply at 12

Bluetooth Worked Best for Proximity Detection

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

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

Ex-2015, 60:18-61:3

POR at 22-23; Sur Reply at 12-13

The '948 Application was a Solution to Proximity Detection and File Transfer in a Single Device

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

15 A. So as I recall, right, once we kind
16 of realized that, hey, the reason this is hard
17 is because you don't have the technology that
18 can do both proximity and transfer in a natural
19 way, the solution became, you know, we've got
20 one set of technologies that can do the
21 proximity, right, that can figure out the two
22 devices are next to each other. We have
23 another set of technologies that could
24 affectively do data communication.

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

Ex-2015, 61:12-62:4

The '948 Application Disclosed Bluetooth for Detection and Wi-Fi for File Transfer

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

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

2 This paragraph refers to a data
3 transmission technology.

4 I think, for that, we would be
5 leaning towards WiFi and cellular as more
6 typical uses as opposed to Bluetooth.

Ex-2015, 155:18-156:6

The '948 Application Provides Sufficient Written Description Support For the Challenged Claims

Comparing the '948 Application to Other References
Confuses the Proper Standard for Written Description
Support

Other References Cited by Microsoft are Irrelevant to the '948 Application's Written Description

- **Mckillop** discloses: “[T]he portable device includes circuitry for
- **Hoddie** discloses: A device “searches for other devices available for
- **Banerjea** discloses: “First, a Bluetooth connection (BT connection)
- **Kapur** discloses: “[T]he Bluetooth® device 1002 may utilize its
- **Adler** discloses: “[E]stablishing a first connection between a first

Microsoft's Reply to POR at 11-13

Sur Reply at 14-15

The Technology is Not Complex



The Genesis of the Challenged Claims Compared to AirDrop is Irrelevant

Microsoft's Argument That the Challenged Claims
Were Drafted to Cover AirDrop Have no Bearing in
This Proceeding

The Genesis of the Challenged Claims is Irrelevant

“Any 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.’”

BlephEx, LLC v. Myco Indus., Inc., 24 F.4th 1391, 1404 (Fed. Cir. 2022) (quoting *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988)) (emphasis added)

“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.’”

Id.

One Application May Lead to Multiple Patents

'948 Application

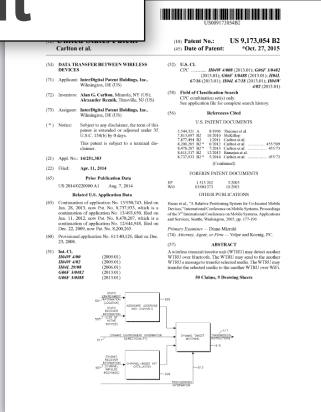
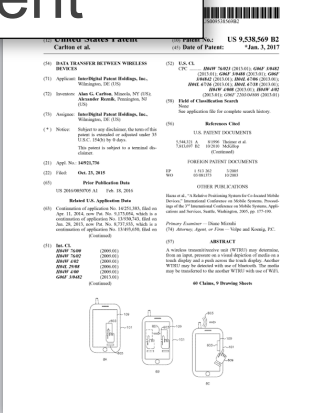
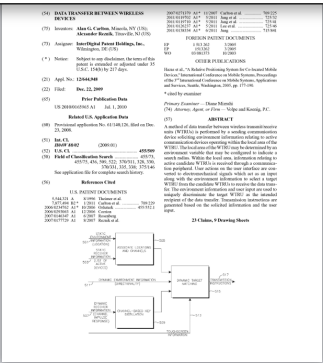
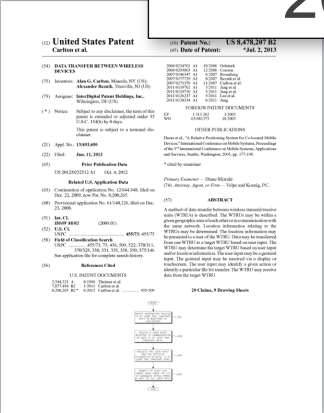
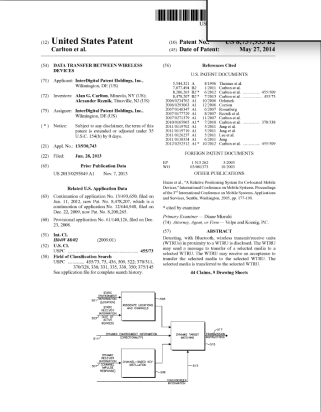
'265 Patent

'933 Patent

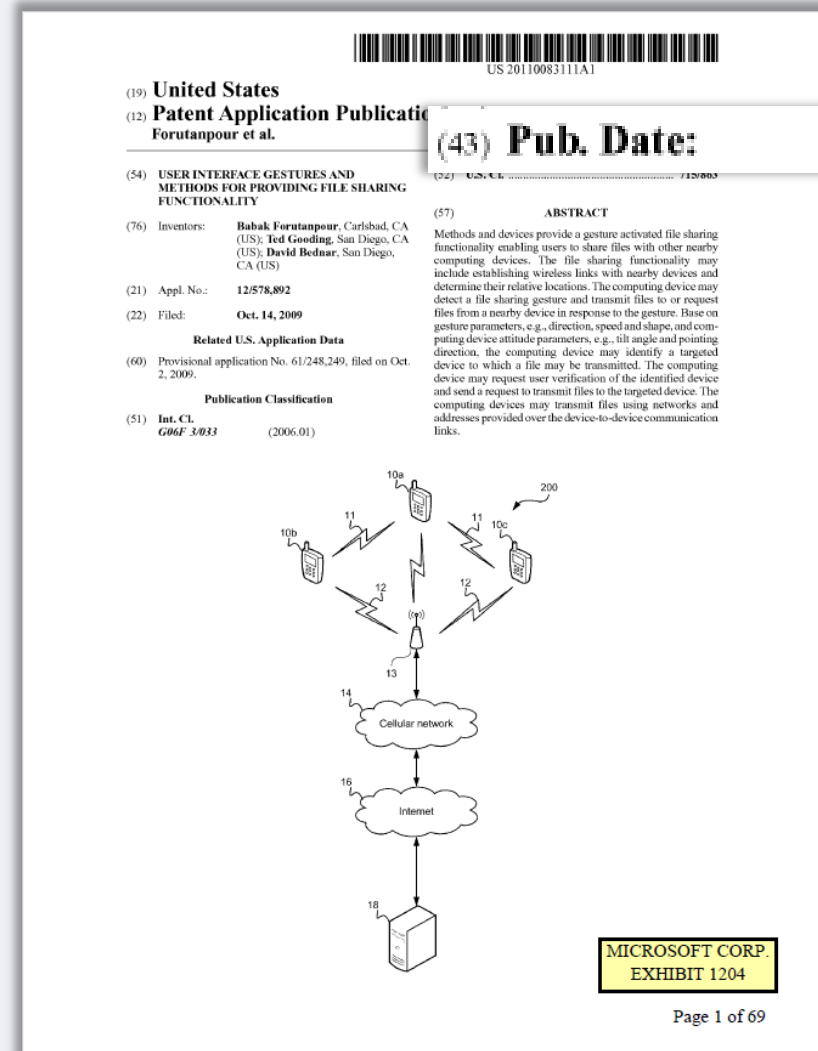
'054 Patent

'207 Patent

'569 Patent



Forutanpour is Not Prior Art



See generally POR; Sur Reply

Forutanpour is Not Prior Art

US008737933B2

(12) **United States Patent**
Carlton et al.

(10) **Patent No.:** US 8,737,933 B2
(45) **Date of Patent:** May 27, 2014

(54) **DATA TRANSFER BETWEEN WIRELESS DEVICES**

(71) Applicant: **InterDigital Patent Holdings, Inc.**,
Wilmington, DE (US)

(72) Inventors: **Alan G. Carlton**, Mineola, NY (US);
Alexander Reznik, Titusville, NJ (US)

(73) Assignee: **InterDigital Patent Holdings, Inc.**,
Wilmington, DE (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **13/930,743**

(22) Filed: **Jun. 28, 2013**

(65) **Prior Publication Data**

(56) **References Cited**
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Related U.S. Application Data

(63) Continuation of application No. 13/493,650, filed on Jun. 11, 2012, now Pat. No. 8,478,207, which is a continuation of application No. 12/644,948, filed on Dec. 22, 2009, now Pat. No. 8,200,265.



US009173054B2

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Carlton et al.

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(45) **Date of Patent:** *Oct. 27, 2015

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This patent is subject to a terminal disclaimer.

(21) Appl. No.: **14/251,383**

(52) **U.S. CL.**
CPC **H04W 4/008** (2013.01); **G06F 3/0482** (2013.01); **G06F 3/0488** (2013.01); **H04L 67/16** (2013.01); **H04L 67/18** (2013.01); **H04W 4/02** (2013.01)

(58) **Field of Classification Search**
CPC combination set(s) only.
See application file for complete search history.

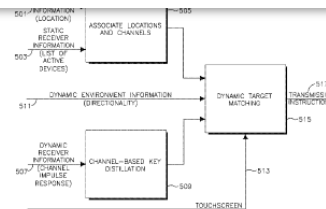
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(Continued)

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See generally POR; Sur Reply

CONCLUSION

THE '948 APPLICATION PROVIDES SUFFICIENT WRITTEN DESCRIPTION SUPPORT

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GENESIS OF THE CHALLENGED CLAIMS COMPARED TO AIRDROP IS IRRELAVENT

**The Challenged Claims are entitled to a priority date of at least
December 22, 2009**

See generally POR; Sur Reply