

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

INTERDIGITAL PATENT HOLDINGS, INC.,
Patent Owner.

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

Record of Oral Hearing
Held: April 15, 2025

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

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

APPEARANCES:

ON BEHALF OF THE PETITIONER:

ANDREW M. MASON, ESQ.
SAMUEL B. THACKER, ESQ.
Klarquist Sparkman, LLP
One World Trade Center
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204
503-473-0804 (Mason)
andy.mason@klarquist.com

ON BEHALF OF THE PATENT OWNER:

SCOTT W. HEJNY, ESQ.
RICHARD A. KAMPRATH, ESQ.
GARRETT GRIGGS, ESQ.
McKool Smith, P.C.
300 Crescent Court
Suite 1200
Dallas, Texas 75201
214-978-4241 (Hejny)
shejny@mckoolsmith.com

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

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

(11:50 a.m.)

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

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

We are going to take appearances now for patent Petitioner.

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

JUDGE QUINN: And for Patent Owner.

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

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

MR. THACKER: No objection.

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

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

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

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

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

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

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

14 JUDGE QUINN: So you said 40 and 20?

15 MR. HEJNY: Yes, Your Honor.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

18 MR. THACKER: Just give me one sec here. I believe that the extent
19 of our expert testimony in the reply declaration, which is Exhibit 1286 in the
20 537, and 1288 in the 538 IPR, describes how this paragraph about the
21 transmission instructions gives no indication that there's a switch.

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

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

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

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

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

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

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

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

3 JUDGE QUINN: Thank you.

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

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

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

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

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

1 MR. THACKER: That's correct.

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

5 MR. THACKER: That is correct, Your Honor.

6 JUDGE LEE: Okay. Thank you.

7 MR. THACKER: Yes. And just to provide a little explanation for
8 that, that this -- the specification, specifically Paragraph 24, also mentions
9 3G and other technologies, but it never once discloses using Wi-Fi or 3G, for
10 example, to transfer a media element to another device.

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

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

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

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

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

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

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

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

12 MR. THACKER: Yes.

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

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

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

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

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

23 JUDGE LEE: Okay. Thank you.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

23 JUDGE QUINN: Thank you.

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

1 So if those transmission instructions indicated a switch from
2 Bluetooth to Wi-Fi, a POSITA would expect that those transmission
3 instructions which are delivered to you in a physical device, the
4 communication peripheral, that those transmission instructions impact layer
5 1.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

1 JUDGE QUINN: Okay. I also have a question for you on Paragraph
2 7 of the application. It's on the background of the disclosure.

3 MR. THACKER: Yes. I see that.

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

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

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

12 MR. THACKER: Okay.

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

15 MR. THACKER: Correct.

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

18 MR. THACKER: That's correct.

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

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

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

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

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

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

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

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

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

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

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

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

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

18 JUDGE QUINN: What exhibit number is that?

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

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

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

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

12 MR. THACKER: Okay.

13 JUDGE QUINN: -- something else?

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

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

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

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

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

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

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

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

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

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

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

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

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

24 MR. THACKER: Yes. I agree with that.

25 JUDGE LEE: Okay. Thank you.

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

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

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

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

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

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

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

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

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

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

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

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

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

10 JUDGE LEE: Okay.

11 JUDGE QUINN: This is your total time remaining.

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

14 MR. MASON: Okay. Judge Quinn --

15 JUDGE QUINN: Yes.

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

17 JUDGE QUINN: Sure. Absolutely.

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

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

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

5 And so it does not say how you might use Wi-Fi, or indeed, that you
6 use Wi-Fi at all in these claimed methods. And I think if we look to Slide
7 12, and this is Dr. Edwards, Patent Owner's expert, I mean, he actually, to a
8 smaller degree, rewrites this paragraph. I mean, he rewrites it to say in the
9 middle there, it says, his characterization of that paragraph, it says including
10 a 3G PP modem, Bluetooth, or Wi-Fi can be used in a single component
11 design. So he starts going from "implemented with" to "used" in this design,
12 right? So he's already, with his expert testimony, rewriting that disclosure a
13 little bit.

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

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

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

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

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

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

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

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

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

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

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

1 JUDGE QUINN: Thank you.

2 MR. MASON: Thank you.

3 JUDGE QUINN: Yes, no problem.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

21 MR. HEJNY: Yes.

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

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

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

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

16 JUDGE LEE: Okay. Thank you.

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

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

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

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

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

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

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

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

5 JUDGE QUINN: Yes.

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

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

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

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

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

23 JUDGE QUINN: Okay. Thank you.

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

1 JUDGE QUINN: Okay.

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

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

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

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

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

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

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

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

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

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

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

10 MR. HEJNY: Yes, Your Honor.

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

13 MR. HEJNY: Yes.

14 JUDGE MURRAY: I think, in the present tense?

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

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

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

26 JUDGE MURRAY: Yes.

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

7 JUDGE MURRAY: Yes, that's right.

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

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

20 JUDGE MURRAY: Question --

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

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

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

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

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

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

21 JUDGE MURRAY: Thank you.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

3 There's simply not a word in the -- there's not an explicit word in the
4 '948 application that says switch, as Microsoft had suggested might need to
5 be there, and/or did you obviously disagree and believe that the disclosure
6 and the '948 application, Exhibit 1282, adequately supports the 2013
7 amended claims regarding Bluetooth detection and Wi-Fi data transfer.

8 And Dr. Edwards discusses this in detail in Exhibit 2014 at Paragraph
9 80 through 85. And he discusses why a person of ordinary skill in the art
10 would consider Bluetooth for detection because it's a low-power, low-radius
11 technology, but would consider Wi-Fi for data transfer, or cellular for that
12 matter because there's a higher power, faster transfer process that can be
13 implemented in the same device.

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

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

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

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

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

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

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

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

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

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

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

6 JUDGE QUINN: Well, I mean, my question wasn't whether there is a
7 requirement, my question is how does that statement, that same Paragraph
8 39 can be read as Petitioner read it, which is you're really transmitting using
9 the same communication protocol from the detecting step?

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

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

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

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

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

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

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

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

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

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

9 MR. HEJNY: Sure.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

9 And Petitioner submits that a POSITA reading that would understand
10 in the context of Paragraph 41, for example, and in other paragraphs, that
11 really what these instructions are trying to do, is to ensure that only the
12 intended device, the recipient, is getting the message. Because in Paragraph
13 41, they say that the data may be transferred only as far as is necessary to
14 reach a minimal set of users. So what they're saying is, hey, orient the
15 antenna and adjust the power so that only that user receives that message.

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

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

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

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

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

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

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

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

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

26 JUDGE MURRAY: Yes. Thank you.

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

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

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

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

16 JUDGE LEE: Yes. One more question.

17 MR. THACKER: Oh, yes.

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

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

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

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

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

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

6 JUDGE LEE: Thank you.

7 JUDGE QUINN: All right. Thank you very much.

8 MR. HEJNY: So just addressing Counsel's final arguments, the first
9 and the last seem to go together. Microsoft continues to insist that there
10 does have to be verbatim disclosure of switching because that is the essence
11 of both their first and last arguments. And that is contrary to the prevailing
12 case law which I cited to the Board earlier. And so we got a situation where
13 --

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

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

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

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

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

10 JUDGE QUINN: Does Claim 7 also help you?

11 MR. HEJNY: Yes. Thank you. So that's on Page 19 to 20 of Exhibit
12 1282. It's acknowledging to disclose as we discussed it was known in the
13 art to use Wi-Fi for data transfer. There is no requirement for in haec verba
14 disclosure of a limitation as long as that limitation is supported by the patent
15 disclosure, and that's supported by both the Novartis case, 21 F.4th 1362,
16 1373, Federal Circuit 2022, as well as the Quake case, which is actually
17 cited by Microsoft, which is 928 F.3d, 1365, 1374, Federal Circuit 2019,
18 which states, however, if this burden is disclosure, it is not necessary to
19 satisfy the written description requirement of Section 112.

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

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

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

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

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

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

14 JUDGE QUINN: And it looks like we are good.

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

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

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

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

PETITIONER:

Andrew M. Mason
Sarah Jelsema
Samuel B. Thacker
Frank Morton-Park
KLARQUIST SPARKMAN,LLP
andrew.mason@klarquist.com
sarah.jelsema@klarquist.com
samuel.thacker@klarquist.com
frank.morton-park@klarquist.com

PATENT OWNER:

Scott W. Hejny
Richard A. Kamprath
George T. Fishback, Jr.
MCKOOL SMITH, P.C.
shejny@mckoolsmith.com
rkamprath@mckoolsmith.com
gfishback@mckoolsmith.com