UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED,
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

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IPR2021-00375
Patent 8,265,096 B2

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Before KARL D. EASTHOM, TREVOR M. JEFFERSON, and J. JOHN LEE, *Administrative Patent Judges*.

# PETITIONER'S ORAL ARGUMENT DEMONSTRATIVES

## May 12, 2022

Jonathan I. Detrixhe, Michael J. Forbes, Peter J. Chassman
**REED SMITH LLP**

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# Talukdar is Prior Art – Decision on Institution

## Grounds for Institution:

That the '096 patent claims are **NOT** entitled to the priority date of the '798 Application because it does not provide § 112(a) support for any independent claim.

> Based on this record, we preliminarily agree that the '798 Provisional Application, filed on July 12, 2007, does not provide written description support for "wherein each symbol in the second communication system has a shorter symbol period than that in the first communications system," recited in challenged claim 1, and "wherein the second communication system has pilot symbols that are denser than those in the first communications system," recited in challenged claim 8. For example,

(Paper 14 at 26.)

# Law - what is adequate § 112 written description?

**Possession** of the **full scope of the invention** must be shown in the **four corners** of the specification; **obviousness is not enough**.

> The term "possession," however, has never been very enlightening. It implies that as long as one can produce records documenting a written description of a claimed invention, one can show possession. But the hallmark of written description is disclosure. Thus, "possession as shown in the disclosure" is a more complete formulation. Yet whatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.

*Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)(*en banc*). (Paper 40 at 6.)

> cation is not enough. Rather, as stated above, it is the specification itself that must demonstrate possession. And while the description requirement does not demand any particular form of disclosure, *Carnegie Mellon Univ. v. Hoffmann–La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir. 2008), or that the specification recite the claimed invention *in haec verba*, a description that merely renders the invention obvious does not satisfy the requirement, *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571–72 (Fed.Cir.1997).

*Id.* at 1351.

(Paper 40 at 2.)

# Talukdar is Prior Art – Claim 1 not disclosed by Provisional

A POSITA would have known all elements of the '096 inventions of claims 1-8 from the provisional disclosure. I understand that the priority of the '096 should thus be

(Ex. 2001 at ¶ 53.)

A POSITA would have known at the time of the provisional application that by use of the following formulas a "shorter symbol period" can be shown for the second system.

N = number of subcarriers
K = number of samples in the cyclic prefix

$$T_s = \frac{N + K}{3B}$$

$$T_{sL} = \frac{N_L + K_L}{B}$$

(Paper 28 at 19, reproducing Ex. 2001 at ¶ 52.)

10 Q. Those equations do not appear in the '096
11 provisional, correct?
12 A. That's probably correct. I'm not sure,
13 but I think it's correct. These are standard
14 formula how symbol duration is related to the
15 bandwidth. That's probably (inaudible) --
16 THE REPORTER: I cannot hear you.
17 THE WITNESS: That's probably the reason
18 why I added them for clarity.

(Ex. 1038 at 24:10-18.)

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