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IPR2016-00357, Paper No. 56

IPR2016-00358, Paper No. 55

IPR2016-00359, Paper No. 57

March 30, 2017

571-272-7822

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GENERAL ELECTRIC CO.,  
Petitioner,

v.

UNIVERSITY OF VIRGINIA PATENT FOUNDATION,  
Patent Owner.

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Case IPR2016-00357

Case IPR2016-00358

Case IPR2016-00359

Patent RE44,644

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Held: March 2, 2017

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BEFORE: KARL D. EASTHOM, J. JOHN LEE, and  
TREVOR M. JEFFERSON, Administrative Patent Judges.

The above-entitled matter came on for hearing on Thursday,  
March 2, 2017, commencing at 9:34 a.m., at the U.S. Patent  
and Trademark Office, 600 Dulany Street, Alexandria,  
Virginia.

Case IPR2016-00357, Case IPR2016-00358  
Case IPR2016-00359, Patent RE44,644

APPEARANCES:

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and

RODNEY L. SPARKS, J.D., Ph.D.  
University of Virginia Innovation



1 MR. POLLOCK: Yes, we are, Your Honor.

2 JUDGE LEE: Before you start, let me first say that we  
3 have reviewed both sides' objections to demonstrative exhibits.  
4 We have elected to reserve judgment on them. We do advise  
5 both parties that to the extent that demonstratives you present  
6 include new arguments not previously presented, those arguments  
7 will be disregarded. And with that, you may proceed.

8 MR. POLLOCK: Thank you, Your Honor. Good  
9 morning, Judges Lee, Easthom and Jefferson. I, David Pollock,  
10 will be presenting the 102(b) and 103 portions of General  
11 Electric's argument and my colleague, Mr. Roche, will be  
12 presenting the 102(a) portion of the argument.

13 Now, in its institution decisions for purposes of  
14 instituting trial, the Board determined that Mugler 2000 is prior  
15 art under both 102(b) and 102(a) and instituted reviews on  
16 multiple grounds for all of the challenged claims. And here is a  
17 summary of the various invalidity grounds for each challenged  
18 claim prepared for the Board's convenience. Most of these  
19 grounds include Mugler 2000, but the last two include reliance on  
20 Mugler '99.

21 Now, although patent owner disputes whether Mugler  
22 2000 is available as prior art, patent owner does not dispute that if  
23 available, all the challenged claims are invalid. Patent owner  
24 disputed invalidity over certain 103 combinations, including  
25 Mugler '99, in its responses but does not do so in its

1 demonstratives. So it's unclear whether any dispute over the 103  
2 obviousness grounds are in dispute.

3           This IPR is unusual. It turns primarily on written  
4 description and authorship issues. Not on the typical prior art  
5 disclosure issues. Regarding the 102(b) issue, the dispute is  
6 whether the provisional '182 application provides adequate  
7 written description support for each of the challenged claims. In  
8 its institution decisions the Board found for many reasons that it  
9 did not. GE believes the Board got it right and patent owner  
10 believes the Board got it wrong. Although there are a few factual  
11 disputes here, the disputes before the Board are primarily disputes  
12 of law. What is adequate written description support and what  
13 can be considered as part of the written description, those are  
14 both legal issues.

15           Now, a disclosure must disclose the invention with all  
16 of its claim limitations. No limitation can be entirely missing. A  
17 disclosure that renders the invention merely obvious is not  
18 sufficient. This is an important point. Although the collection of  
19 limitations need not be present in haec verba, as it says in the  
20 *Lockwood* case, each limitation must be present. Not merely  
21 obvious or just well known.

22           Now, what does the invention with all its limitations  
23 actually mean? The *Novozymes* case tells us each claim must be  
24 disclosed as an integrated whole rather than a collection of  
25 independent limitations. These limitations cannot be spread

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