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March 30, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC CO.,
Petitioner,

v.

UNIVERSITY OF VIRGINIA PATENT FOUNDATION,
Patent Owner.

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

Held: March 2, 2017

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.

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P R O C E E D I N G S

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JUDGE LEE: Good morning everyone. Welcome to the Board. This is the oral hearing in case number IPR2016-00357, 2016-00358, and 2016-00359 concerning U.S. Patent Number RE44,644. We'll start this morning with appearances by counsel. Counsel for petitioner, if you could step to the podium and make your appearance.

MR. POLLOCK: Good morning, Your Honor. I'm David Pollock with Reed Smith for petitioner, General Electric. With me are my colleagues, Brian Roche and John Detrixhe.

JUDGE LEE: Good morning. Counsel for patent owner?

MR. SPARKS: Good morning, Your Honors. I'm Rodney Sparks, counsel for the University of Virginia Patent Foundation. My colleagues, my backup counsel, who will be speaking are Joe DePumpo and Ari Rafilson.

JUDGE LEE: Good morning. Each side will have 60 minutes to make their presentations. Petitioner, you have the option of reserving time for rebuttal. Would you like to do that?

MR. POLLOCK: Yes, Your Honor, we would like to reserve 15 minutes for rebuttal, please.

JUDGE LEE: Fifteen minutes for rebuttal. That gives you 45 minutes for your main presentation. Are you ready to begin?

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

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

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

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

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

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

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

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

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

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