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March 30, 2017

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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.

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

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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?

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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