Trials@uspto.gov
571-272-7822

Paper 44
Date: February 12, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

QUALCOMM INC.,
Patent Owner.

IPR2018-01275
Patent 9,203,940 B2

Before DANIEL N. FISHMAN, MICHELLE N. WORMMEESTER, and AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Denying Patent Owner's Motion to Amend
35 U.S.C. § 318(a)

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a. “[a] method for operating a mobile computing device including a display, a power button, a radio, and one or more processors, the method performed by the one or more processors of the mobile computing device” 17
b. “when a telephone call is being received by the mobile computing device,

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presenting a notification on the display indicating the telephone call; and enabling a user to silence a ring associated with the telephone call by pressing the power button without turning off the mobile computing device" 18

c. "when the telephone call is not being received by the mobile computing device, enabling the user to activate a backlight of the display by pressing the power button" 21

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I. INTRODUCTION

A. Background

Apple Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 1–4, 6–15, and 17–22 of U.S. Patent No. 9,203,940 B2 (Ex. 1001, "the '940 patent"). Paper 2 ("Pet."). Qualcomm Inc. ("Patent Owner") filed a Preliminary Response. Paper 11 ("Prelim. Resp.").

On February 14, 2019, we instituted an *inter partes* review of claims 1–4, 6–15, and 17–22. Paper 12 ("Inst. Dec."), 18. Patent Owner then filed a Patent Owner Response (Paper 21, "PO Resp."), Petitioner filed a Reply (Paper 28, "Pet. Reply"), and Patent Owner filed a Sur-Reply (Paper 34, "PO Sur-Reply").

Patent Owner has also filed a Contingent Motion to Amend (Paper 22, "Mot. to Amend"), Petitioner filed an Opposition (Paper 29, "Mot. to Amend Opp."), Patent Owner filed a Reply (Paper 33, "Mot. to Amend Reply"), and Petitioner filed a Sur-Reply (Paper 38, "Mot. to Amend Sur-Reply").

An oral hearing was held on November 14, 2019, and a transcript of the hearing is included in the record. Paper 43.

The Board has jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–4, 6–15, and 17–22 of the '940 patent are unpatentable, and we deny Patent Owner's Motion to Amend.

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B. Related Matters

The ’940 patent was at issue in *Qualcomm Incorporated v. Apple Incorporated*, Civil Action No. 3:17-cv-02403 (S.D. Cal.). *See* Pet. 45. According to PACER, the litigation was terminated in April of 2019, when a joint motion to dismiss was granted.

Petitioner concurrently filed another petition, in IPR2018-01270, seeking *inter partes* review of claims 1, 3–5, 7, 8, 10–16, 18, 19, 21, and 22 of the ’940 patent based on prior art different than that presented in this Petition. We declined to institute that case. *See* IPR2018-01270, Paper 12.

C. The ’940 Patent

The ’940 patent describes “a system and method for using an integrated device featuring functionality of both a PDA and cellular telephone.” Ex. 1001, 1:57–58. It describes a number of individual features, including “a power button offering control of both the computing and telephony functions of the device,” “a lid that turns the device on and off depending on its state, and can also be used to begin and terminate calls,” “a jog rocker that activates the device and is used to select from a variety of menu options,” and “application buttons that offer direct access to applications stored on the device, and which can be configured to operate in conjunction with secondary keys to offer added functionality.” *Id*. at 1:59–67.

The claims of the patent are directed to a specific subset of the various described features: presenting a notification on the display that a telephone call is being received, enabling the user to silence the ring associated with the call by pressing the power button without turning off the mobile computing device, and enabling the user to activate a backlight of the

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