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Paper 46
Entered: January 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

QUALCOMM INC.,
Patent Owner.

IPR2018-01277
Patent 8,497,928 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 device, the method being performed by one or more processors 29

b. displaying, on a touchscreen display, an image having a first focal point, the image being provided by a lens component 29

c. selecting a second focal point for the image in response to receiving a first type of user input on the touchscreen display, the second focal point corresponding to a location on the image displayed on the touchscreen display 30

d. focusing the lens component from the first focal point to the second focal point while the image is being displayed 31

e. selecting a flash level value representing a flash intensity for a flash component based on the second focal point 33

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I. INTRODUCTION

A. Background

Apple Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 7, 8, 10, 11, and 13 of U.S. Patent No. 8,497,928 (Ex. 1001, "the '928 patent"). Paper 2 ("Pet."). Qualcomm Inc. ("Patent Owner") filed a Preliminary Response. Paper 10 ("Prelim. Resp.").

On January 22, 2019, we instituted an *inter partes* review of claims 7, 8, 10, 11, and 13. Paper 11 ("Inst. Dec."), 22. Patent Owner then filed a Patent Owner Response (Paper 23, "PO Resp."), Petitioner filed a Reply (Paper 31, "Pet. Reply"), and Patent Owner filed a Sur-Reply (Paper 33, "PO Sur-Reply").

Patent Owner has also filed a Contingent Motion to Amend (Paper 24, "Mot. to Amend"), Petitioner filed an Opposition (Paper 32, "Mot. to Amend Opp."), Patent Owner filed a Reply (Paper 34, "Mot. to Amend Reply"), and Petitioner filed a Sur-Reply (Paper 38, "Mot. to Amend Sur-Reply").

An oral hearing was held on October 9, 2019, and a transcript of the hearing is included in the record. Paper 42 ("Tr.").

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 7, 8, 10, 11, and 13 of the '928 patent are unpatentable, and we deny Patent Owner's Motion to Amend.

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