

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

QUALCOMM INC.,
Patent Owner.

IPR2018-01278
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)

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
A.	Background.....	1
B.	Related Matters.....	2
C.	The '928 Patent.....	2
D.	The Claimed Subject Matter.....	5
E.	Evidence Relied Upon	6
1.	Konicek.....	6
2.	Kitamura.....	7
3.	Suh.....	7
4.	Steinberg.....	7
F.	Grounds of Unpatentability.....	8
II.	ANALYSIS.....	8
A.	Level of Ordinary Skill in the Art.....	8
B.	Claim Construction	9
1.	“focal point”.....	10
a.	Patent Owner’s Position.....	10
b.	Petitioner’s Reply.....	12
c.	Patent Owner’s Sur-Reply.....	12
d.	Our Analysis	13
2.	“focusing the lens component . . . while the image is being displayed”	23
a.	Patent Owner’s Position.....	23
b.	Petitioner’s Reply.....	24
c.	Our Analysis	24
C.	Obviousness of Claims 7, 8, 10, 11, and 13.....	25
1.	Claims 7 and 10.....	25

a.	[a] method for operating a mobile device, the method being performed by one or more processors.....	25
b.	displaying, on a touchscreen display, an image having a first focal point, the image being provided by a lens component.....	26
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	27
d.	focusing the lens component from the first focal point to the second focal point while the image is being displayed	29
e.	selecting a flash level value representing a flash intensity for a flash component based on the second focal point.....	30
f.	capturing the image, based on the flash level value, in response to a second type of user input on the touchscreen display, the second type of user input being different than the first type of user input.....	31
2.	Claims 8 and 11	36
3.	Claim 13.....	37
4.	Conclusion on the Obviousness of Claims 7, 8, 10, 11, and 13	37
D.	Motion to Amend.....	37
1.	Procedural Issues	39
a.	New Matter: “automatically focusing the lens component . . . while the image is being displayed as a substantially real-time preview”.....	39
b.	New Matter: “centered at a set of coordinates of the first type of user input”	42

c.	Responsiveness.....	44
2.	Indefiniteness	45
a.	“Substantially Real-Time Preview of the View Through the Lens Component”	45
b.	Image Cropping	47
3.	Obviousness of the Substitute Claims	48
a.	Claims 17 and 19	48
b.	Claims 18 and 20	51
4.	Conclusion Regarding the Proposed Substitute Claims	53
E.	Motion to Submit Supplemental Information	54
III.	CONCLUSION	55
IV.	ORDER.....	56

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 24, “PO Resp.”), Petitioner filed a Reply (Paper 32, “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 25, “Mot. to Amend”), Petitioner filed an Opposition (Paper 33, “Mot. to Amend Opp.”), Patent Owner filed a Reply (Paper 35, “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 43 (“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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