

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner

v.

QUALCOMM INCORPORATED,  
Patent Owner.

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Case IPR2018-01277  
Case IPR2018-01278  
Patent 8,497,928 B2<sup>1</sup>

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

MOORE, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

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<sup>1</sup> Because this Order addresses an issue that is common to both proceedings, it uses a common header. The parties may not use this style heading.

The panel has identified a potential construction of the term “focal point” in the claims of U.S. Patent 8,497,928 B2 that differs from those advanced by the parties. Specifically, the panel is considering whether “focal point” should be construed to mean “area on which the lens component was focused or is to be focused.” The panel is also considering an alternative approach, in which “first focal point” is construed to mean “area on which the lens component was focused” and “second focal point” is construed to mean “area on which the lens component is to be focused.”

In order that the parties have the opportunity<sup>2</sup> to present argument under these possible theories in addition to the discussion at the hearing,<sup>3</sup> they are invited to submit one additional brief, to be filed in each case, and not to exceed ten (10) pages, on or before December 20, 2019. The briefs shall be limited to (a) the appropriateness of the above constructions, and (b) the effect of such constructions on the theories of invalidity presented in the Petitions. The parties are not authorized to submit new evidence.

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<sup>2</sup> See 5 U.S.C. § 554(b)(3); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (“an agency may not change theories in midstream without giving respondents reasonable notice of the change” and “the opportunity to present argument under the new theory”) (quoting *Rodale Press, Inc. v. FTC*, 407 F.2d 1252, 1256–57 (D.C. Cir. 1968)).

<sup>3</sup> See IPR2018-01277, Paper 42 at 9, 40–41.

ORDER

Accordingly, it is

ORDERED that each party may file one brief, no longer than ten (10) pages, that addresses the above-identified issues. The brief shall be filed in each case no later than December 20, 2019. No new evidence may be submitted.

IPR2018-01277; IPR2018-01278  
Patent 8,497,928 B2

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