Trials@uspto.gov
571-272-7822

Paper 45
Date: January 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

QUALCOMM INCORPORATED,
Patent Owner.

IPR2018-01279
Patent 7,844,037 B2

Before DANIEL N. FISHMAN, MICHELLE N. WORMMEESTER, and SCOTT B. HOWARD, *Administrative Patent Judges.*

HOWARD, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
Dismissing as Moot Patent Owner's Motion to Amend
35 U.S.C. § 318(a)

INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition to institute an *inter partes* review of claims 1–14 and 16–18[1] of U.S. Patent No. 7,844,037 B2 (Ex. 1001, "the '037 patent") pursuant to 35 U.S.C. §§ 311–319. Paper 2 ("Petition" or "Pet."). Qualcomm Incorporated ("Patent Owner") filed a Patent Owner Preliminary Response. Paper 10. We instituted an *inter partes* review of claims 1–14 and 16–18 on all grounds of unpatentability alleged in the Petition. Paper 11 ("Institution Decision" or "Inst. Dec.").

After institution of trial, Patent Owner filed a Response (Paper 23, "PO Resp."), Petitioner filed a Reply (Paper 38, "Petitioner's Reply" or "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 39, "PO Sur-reply"). In addition, Patent Owner filed a Contingent Motion to Amend (Paper 24, "Motion to Amend" or "Mot. Amend."), Petitioner filed an Opposition to Patent Owner's Contingent Motion to Amend (Paper 31, "Opp. Amend"), Patent Owner filed a Reply to Petitioner's Opposition (Paper 38, "Reply Amend"), and Petitioner filed a Sur-Reply to Patent Owner's Reply (Paper 41, "Sur-reply Amend").

Petitioner relies on the declaration testimony of Dr. Narayan Mandayam[2] (Exs. 1003, 1018) and Patent Owner relies on the declaration testimony of Dr. Kevin Jeffay (Ex. 2004).

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[1] The Petition also sought *inter partes* review of claims 19–25. *See* Inst. Dec. 6–7. However, because those claims were statutorily disclaimed by the Patent Owner, they are treated as if they were never part of the '037 patent. *Id.*

[2] Due to a family emergency, Dr. Mandayam was unable to appear for a deposition regarding his Second Declaration (Ex. 1018). *See* Order Modifying Scheduling Order, Paper 33; Ex. 3002 (email from Petitioner). Pursuant to the agreement of the parties and our Order, Dr. Cooperstock

An oral hearing was held on November 20, 2019, and the record contains a transcript of this hearing. Paper 44 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–14 and 16–18 are unpatentable. Because we do not find any of the challenged claims unpatentable, we dismiss as moot Patent Owner's Contingent Motion to Amend.

BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies Apple, Inc. as the real party in interest. Pet. 63.

Patent Owner identifies Qualcomm Incorporated as the real party in interest. Patent Owner's Mandatory Notices, Paper 3, 2.

B. *Related Matters*

The parties identify the following dismissed patent litigation proceeding in which the '037 patent was asserted: *Qualcomm Inc. v. Apple Inc.*, Case No. 3:17-cv-02403 (S.D. Cal.). Pet. 63; Patent Owner's Mandatory Notices, Paper 3, 2; Petitioner's Updated Mandatory Notices, Paper 21, 1. Additionally, Patent Owner identifies a second request for *inter partes* review of the '037 patent: *Apple Inc. v. Qualcomm Inc.*, Case IPR2018–01280.[3] Patent Owner's Mandatory Notices, Paper 3, 2.

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adopted Dr. Mandayam's Second Declaration and was made available for deposition. *See* Ex. 2025, 7:8–21, 9:8–17 (Cooperstock Dep.); Order Modifying Scheduling Order, Paper 33.

[3] We exercised our discretion to deny institution under 35 U.S.C. § 325(d). IPR2018-01280 Paper 11 (Decision Denying Institution); IPR2018-1280, Paper 13 (Decision Denying Request for Rehearing).

C. The '037 Patent

The '037 patent is titled "Method and Device for Enabling Message Responses to Incoming Phone Calls." Ex. 1001, code (54). According to the '037 patent, the claimed invention enables "message replies to be made to incoming calls." *Id*. at 1:64–65. "For example, rather than pick up a phone call or forward the phone call to voicemail, the user may simply generate a text (or other form of) message to the caller." *Id*. at 1:67–2:3. Thus, when using the claimed invention,

> [r]ather than answer the call or perform some other action like forwarding the call to voicemail, . . . the recipient computing device 110 issues a message response 122 to the calling device 120. In one embodiment, the message response 122 is an alternative to the user of the recipient device 110 having to decline or not answer the incoming call 112.

Id. at 3:56–63.

> As another alternative, in one implementation, the message creation data 222 is generated in response to a trigger from a user 202. The phone application 210, message response module 230, or some other component may prompt the user to message respond to a caller in response to receipt of call data 202. The prompt may occur shortly after the incoming call 204 is received, such as with or before the first "ring" generated on the computing device 200 for the incoming call. For example, the user may be able to elect message response as one option along with other options of answering or declining the incoming call 204.

Ex. 1001, 5:24–34. Figure 4 of the '037 patent (not reproduced) "illustrates a message for handling incoming calls with message replies, under an embodiment of the invention." *Id*. at 1:53–54.

D. Illustrative Claims

Claim 1 is independent, is illustrative of the subject matter of the challenged claims, and reads as follows:

> 1. A method for operating a first computing device, the method being implemented by one or more processors of the computing device and comprising:
>
> receiving, from a second computing device, an incoming call to initiate a voice-exchange session;
>
> in response to receiving the incoming call, determining a message identifier associated with the second computing device, wherein the message identifier is determined based at least in part on data provided with the incoming call;
>
> in response to receiving the incoming call, prompting a user of the first computing device to enter user input that instructs the first computing device to handle the incoming call by composing, while not answering the incoming call, a message to a user of the second computing device; and
>
> responsive to receiving the incoming call and the user entering the user input, automatically addressing the message to the second computing device using the message identifier determined from the incoming call.

Ex. 1001, 9:63–10:15

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–14 and 16–20 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References
1–8, 12–14, 16–18	103(a)	Mäkelä,[4] Moran[5]
7–11	103(a)	Mäkelä, Moran, Tsampalis[6]

[4] US 6,301,338 B1, issued Oct. 9, 2001 (Ex. 1004).
[5] US 2003/0104827 A1, published June 5, 2003 (Ex. 1006).
[6] US 2004/0203956 A1, published Oct. 14, 2004 (Ex. 1007).

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