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Paper 40
Date: November 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

QUALCOMM INCORPORATED,
Patent Owner.

IPR2018-01315, IPR2018-01316
Patent 8,063,674 B2[1]

Before TREVOR M. JEFFERSON, DANIEL J. GALLIGAN, and SCOTT B. HOWARD, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* SCOTT B. HOWARD.

Opinion Concurring filed by *Administrative Patent Judge* DANIEL J. GALLIGAN.

HOWARD, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision on Remand
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

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[1] The parties may not use this style heading in any subsequent papers without prior authorization.

I. INTRODUCTION

In these *inter partes* reviews, instituted pursuant to 35 U.S.C. § 314, Apple Inc. ("Petitioner" or "Apple") challenges claims 1, 2, 5–9, 12, 13, and 16–22 ("the challenged claims") of U.S. Patent No. 8,063,674 B2 (Ex. 1001, "the '674 patent"), owned by Qualcomm Incorporated ("Patent Owner").

The references applied against the challenged claims are identical in each of the cases. A joint hearing was held for these cases. The parties rely on the same declarants submitting identical declarations in each case for testimonial evidence. The briefing on remand is substantially the same. Under these circumstances, we determine that a combined Final Decision will promote a just, speedy, and inexpensive resolution of these proceedings.

A. IPR2018-01315 Procedural History

Petitioner filed a Petition to institute an *inter partes* review of claims 1, 2, and 5–7 of the '674 patent pursuant to 35 U.S.C. §§ 311–319. Paper 2[2] ("Petition" or "Pet."). Patent Owner filed a Preliminary Response. Paper 6. We instituted an *inter partes* review of claims 1, 2, and 5–7 on all grounds of unpatentability alleged in the Petition. Paper 7 ("Institution Decision" or "Inst. Dec.").

After institution of trial, Patent Owner filed a Response (Paper 12, "PO Resp."), Petitioner filed a Reply (Paper 16, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 19, "PO Sur-reply").

A joint hearing for IPR2018-01315 and IPR2018-01316 was held on October 11, 2019. Paper 25 ("Tr.").

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[2] Unless otherwise noted, all citations are to IPR2018-01315. We note that identical exhibits and substantially identical papers were filed in each of the proceedings.

B. IPR2018-01316 Procedural History

Petitioner filed a Petition to institute an *inter partes* review of claims 8, 9, 12, 13, and 16–22 of the '674 patent pursuant to 35 U.S.C. §§ 311–319. IPR2018-01316, Paper 2 ("1316 Pet."). Patent Owner filed a Preliminary Response. IPR2018-01316, Paper 6. We instituted an *inter partes* review of claims 8, 9, 12, 13, and 16–22 on all grounds of unpatentability alleged in the Petition. IPR2018-01318, Paper 7 ("1316 Inst. Dec.").

After institution of trial, Patent Owner filed a Response (IPR2018-01316, Paper 12, "1316 PO Resp."), Petitioner filed a Reply (IPR2018-01316, Paper 16, "1316 Pet. Reply"), and Patent Owner filed a Sur-reply (IPR2018-01316, Paper 19, "1316 PO Sur-reply").

C. The Final Written Decision, the Federal Circuit Appeal, and the Remand Proceeding

We issued a consolidated Final Written Decision which held all of the challenged claims unpatentable. Paper 26 ("Final Decision," "Final Dec."). In particular, we concluded that, based on the language of 35 U.S.C. § 311(b) and our rules, applicant admitted prior art could form the basis of an *inter partes* review petition. Final Dec. 18–22. Based on the combination of AAPA[3] and Majcherczak, we determined that Petitioner had proven by a preponderance of the evidence that the challenged claims were unpatentable as obvious. *Id.* at 22–54. Additionally, we held that Petitioner failed to prove the challenged claims were unpatentable as obvious in view of Steinacker, Doyle, and Park. *Id.* at 59–81.

[3] AAPA refers to the specific applicant admissions identified by Petitioner in the '674 Patent. *See* footnote 9, *infra*.

Patent Owner filed a Notice of Appeal of the Final Written Decision with the United States Court of Appeals for the Federal Circuit. Paper 27. In that Notice of Appeal, Patent Owner indicated that the issues on appeal may include, *inter alia*, the "determination that alleged Applicant Admitted Prior Art (AAPA) is eligible for use in *inter partes* review proceedings." *Id.* at 1.

On February 1, 2022, the Federal Circuit issued a decision in the appeal vacating our Final Decision and remanding for further proceedings. *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022). Specifically, the Federal Circuit held that we "incorrectly interpreted § 311(b)'s 'prior art consisting of patents or printed publications' to encompass [applicant admitted prior art] contained in the challenged patent." *Id.* at 1376–77. However, because "the use of [applicant admitted prior art] can be permissible in an *inter partes* review," the Federal Circuit remanded with instructions "to determine whether Majcherczak forms the basis of Apple's challenge, or whether the validity challenge impermissibly violated the statutory limit in Section 311." *Id.* at 1377.

With regard to the ground involving Steinacker, Doyle, and Park, the Federal Circuit held that "there was no error in the Board's finding that Apple made an insufficient showing of a motivation to combine Doyle with Steinacker—a prerequisite to its proposed three-way combination of Doyle with Steinacker and with Park." 24 F.4th at 1377.

Following the remand from the Federal Circuit, we held a conference call with the parties. *See* Paper 28, 2 (Order on Conduct of Proceedings on Remand). During the conference, we authorized the parties to submit two rounds of simultaneous briefing. *See id.* Petitioner and Patent Owner,

respectively, submitted Opening Briefs on Remand. Paper 31 ("Pet. Remand Br."); Paper 32 ("PO Remand Br."). The parties also each submitted a Responsive Brief on Remand. Paper 37 ("Pet. Resp. Remand Br."); Paper 39 ("PO Resp. Remand Br.").

Patent Owner requested an oral hearing on remand, which we took under advisement. *See* Paper 28 at 2–3. Given the nature of the issue on remand, no additional oral argument was held. *See* Patent Trial and Appeal Board, Standard Operating Procedure 9[4] at 7 ("In most cases, an additional oral hearing will not be authorized. Normally, the existing record and previous oral argument will be sufficient."), 8 (indicating no additional oral argument when there was an "Erroneous Application of Law").

The Board has jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision on Remand issues pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that the challenged claims are unpatentable.

D. Real Party in Interest

Petitioner identified Apple Inc. as the real party in interest. Pet. 64.

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

E. Related Proceedings

The parties identified the following patent litigation proceedings in which the '674 patent was asserted: *In re Certain Mobile Electronic*

[4] Available at https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_for_decisions_remanded_from_the_federal_circuit.pdf.

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