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Paper 11
Entered: February 1, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

QUALCOMM INCORPORATED,
Patent Owner.

Case IPR2018-01279
Patent 7,844,037 B2

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

HOWARD, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. 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 ("Preliminary Response" or "Prelim. Resp.").

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless "the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

For the reasons set forth below, upon considering the Petition, Preliminary Response, and evidence of record, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims.

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[1] As discussed below in Section II.A, the Petition also seeks *inter partes* review of claims 19–25. However, because those claims have been statutorily disclaimed by the Patent Owner, they are treated as if they were never part of the '037 patent. *See infra* Section II.A.

Accordingly, we institute *inter partes* review on all the challenged claims based on all the grounds identified in the Petition.

Our findings of fact, conclusions of law, and reasoning discussed below are based on the evidentiary record developed thus far, and made for the sole purpose of determining whether the Petition meets the threshold for initiating review. This decision to institute trial is not a final decision as to the patentability of any challenged claim or the construction of any claim limitation. Any final decision will be based on the full record developed during trial.

A. Real Party-In-Interest

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

B. Related Proceedings

The parties identify the following currently pending patent litigation proceeding in which the '037 patent is asserted: *Qualcomm Inc. v. Apple Inc*., Case No. 3:17-cv-02403 (S.D. Cal.). *Id.*; Paper 3, 2. Additionally, Patent Owner identifies a second request for *inter partes* review of the '037 patent: *Apple Inc. v. Qualcomm Inc.*, Case IPR2018–01280. Paper 3, 2

C. The '037 Patent

The '037 patent is titled "Method and Device for Enabling Message Responses to Incoming Phone Calls." Ex. 1001, [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.

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

D. The Challenged Claims

Petitioner challenges claims 1–14 and 16–18 of the '037 patent. Pet. 1. 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. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Reference(s)	Basis[2]	Challenged Claims
Mäkelä[3] in view of Moran[4]	§ 103(a)	1–8, 12–14, and 16–18
Mäkelä in view of Moran and Tsampalis[5]	§ 103(a)	7–11

Pet. 3. In its analysis, Petitioner relies on the declaration testimony of Dr. Narayan B. Mandayam (Ex. 1003).

[2] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. § 100 *et seq.* effective on March 16, 2013. Because the '037 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

[3] U.S. Patent No. 6,301,338 (issued Oct. 9, 2001) (Ex. 1004).

[4] U.S. Patent Appl. 2003/0104827 (published June 5, 2003) (Ex. 1006).

[5] U.S. Patent Appl. 2004/0203956 (published Oct. 14, 2004) (Ex. 1007).

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