Trials@uspto.gov
Tel: 571-272-7822

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 IPR2018-01280
Patent 7,844,037 B2

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

HOWARD, *Administrative Patent Judge*.

DECISION
Denying 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 1–16 and 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 ("Pet."). Qualcomm Incorporated ("Patent Owner") filed a Patent Owner Preliminary Response. Paper 10 ("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).

Upon consideration of the Petition, Patent Owner's Preliminary Response, and the associated evidence, we conclude that the Petition relies on the same prior art and the same or substantially the same argument that was presented previously to the Office. Thus, we exercise our discretion under 35 U.S.C. § 325(d) and deny institution of an *inter partes* review.

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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 Patent Owner, they are treated as if they were never part of the '037 patent. *See infra* Section II.A.

A. Real Party-In-Interest

Petitioner identifies Apple, Inc. as the real party-in-interest. Pet. 50.

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 IPR2018–01279. 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 1–16 and 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:

References	Basis[2]	Challenged Claims
Brown[3] in view of Moran[4]	§ 103(a)	1–6, 12–16, and 18
Brown 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).

II. ANALYSIS

A. Patent Owner's Disclaimer of Claims 19–25

Petitioner seeks, among other things, *inter partes* review of claims 19–25 of the '037 patent. *See* Pet. 3, 30–37, 45–46, 48–49. Subsequent to the filing of the Petition, Patent Owner filed a statutory disclaimer of claims 19–25 of the '037 patent. Ex. 2001; *see also* Prelim. Resp. 1–2 n.1.

Patent Owner argues that the statutory disclaimer renders moot Petitioner's request regarding claims 19–25. Prelim. Resp. 1–2 n.1. Patent Owner also cites our rules that state that "[n]o *inter partes* review will be instituted based on disclaimed claims." *Id*. (quoting 37 C.F.R. § 42.107(e)).

In considering Federal Circuit precedent and our rules, we conclude that we cannot institute a trial on claims that have been disclaimed, and,

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[2] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. § 103 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 Appl. 2004/0203794 (published Oct. 14, 2004) (Ex. 1005).

[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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