

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. WORMMEESTER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition to institute *inter partes* review of claims 1–16 and 18¹ 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.”). The Board issued a Decision denying institution of *inter partes* review. Paper 11 (“Decision”; “Dec.”). On March 4, 2019, Patent Owner filed a timely Request for Reconsideration of the Decision. Paper 12 (“Request”; “Req.”).

For the reasons that follow, Petitioner’s request for rehearing is denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

¹ The Petition also sought *inter partes* review of claims 19–25. However, because those claims have been statutorily disclaimed, they are treated as if they were never part of the ’037 patent. *See* Dec. (Paper 11), 5–6. For the same reasons, we do not address any arguments in the Request that refer to claims 19–25.

III. ANALYSIS

First, Petitioner argues that the Board overlooked the fact that the Examiner never relied on Brown in addressing the features of dependent claims 2, 5, 6, 12, 13, 14, 15, 16, and 18 of the '037 patents. Req. 3–5. For example, Petitioner points to a rejection of then-pending claim 16, which issued as claim 15, in which the Examiner relied solely on Fostick for the limitation recited in the claim. *Id.* at 4 (citing Ex. 1002, 182–85). Therefore, according to Petitioner, “the Office did not cite or rely on any teachings from Brown in addressing the features of claim 16” and “[t]he Office’s treatment of many other then-pending claims is no different.” *Id.* (citing Ex. 1002, 182–85).

Petitioner further argues that in contrast to the rejections during prosecution, “the Petition specifically applies disclosure from Brown to features of claims 2, 5, 6, 12, 13, 14, 15, 16, [and] 18, . . . each earlier addressed by Fostwick during prosecution.” *Id.* at 4–5 (citing Ex. 1002, 182–85). Petitioner further argues that the correction of this “misapprehension[] or oversight[] shifts the *Becton*^[2] factors to favor institution of the Petition.” *Id.* at 5 (emphasis added); *see also id.* at 11–15 (arguing the *Becton* factors in light of corrected misapprehensions or oversights).

We are not persuaded that we misapprehended or overlooked the Examiner’s use of Brown during the prosecution of the '037 patent. “A claim in dependent form shall be construed to incorporate by reference all

² *Becton, Dickinson & Company v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative).

the limitations of the claim to which it refers.” 35 U.S.C. § 112 ¶ 4.³ A corollary of that rule is that any finding made by the Examiner regarding how a prior art reference teaches a limitation recited in an independent claim similarly applies to the dependent claim. Stated differently, although the Office Action did not explicitly state that the Examiner was relying on Brown for a limitation recited in dependent claim 16, because the rejection encompasses all of the limitations in both dependent claim 16 and independent claim 1 from which it depends, such an incorporation was implicit. Therefore, contrary to Petitioner’s arguments, the Examiner relied on Brown in rejecting all of the dependent claims in the July 24, 2009 Office Action. *See* Ex. 1002, 178–185.

Second, Petitioner argues that we overlooked or misapprehended the Office’s use of Brown in rejecting claims during the prosecution of the ’037 patent. Req. 5–7. Specifically, Petitioner notes that the Office never rejected the claims that eventually issued in the ’037 patent over Brown and thus, never applied Brown to the prompting step which was added in an amendment. *Id.* at 5–6. Instead, Petitioner points out that after the applicant amended the claims to include the prompting step, the Office “presented a new rejection over a different combination (Fostwick and Burg) and made no statement about the propriety of the prior rejection or whether Patent Owner’s arguments regarding Brown were persuasive.” *Id.* at 6 (citing Ex. 1002, 144, 149). Petitioner further argues that the correction of this

³ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 112. Because the ’037 patent issued from an application filed before the effective date of the AIA, we apply the pre-AIA version of section 112.

“misapprehension[] or oversight[] shifts the *Becton* factors to favor institution of the Petition.” *Id.* at 7 (emphasis added); *see also id.* at 11–15 (arguing the *Becton* factors in light of corrected misapprehensions or oversights).

Contrary to Petitioner’s argument, the Board neither overlooked nor misapprehended the prosecution of the ’037 patent. To the contrary, the Decision explicitly discusses what Petitioner says the Board overlooked or misapprehended. For example, the Decision included the following discussion of Patent Owner’s argument relating to the amendment of the claims during prosecution, which states that new prior art was asserted after the amendment of the claim to include the prompting step:

More specifically, Patent Owner argues that following a rejection based on *Fostick* and *Brown*, Applicant amended claim 1 to include the “prompting a user” step. *Id.* at 36–37 (citing Ex. 1002, 165). Patent Owner further argues that Applicant argued, in light of the claim amendment, that *Brown* does not teach the limitation; instead, according to Applicant, *Brown* teaches that “the messages were either (i) sent over the same voicepath as the incoming call, and/or (ii) the messages were sent without requesting user input in response to an incoming call.” *Id.* at 37–38 (citing Ex. 1002, 166–68). *Patent Owner further argues “the Examiner understood that Brown did not disclose [the prompting step] and withdrew the rejection over the combination of Fostick and Brown in the subsequent office action. Id.* at 38 (citing Ex. 1002, 141) (emphasis omitted). However, according to Patent Owner, “Petitioner argues that the very same limitation is disclosed in *Brown.*” *Id.* at 39 (emphasis omitted).

Dec. 8–9 (emphasis added). Similarly, when weighting the *Becton* factors, we explicitly found that although the Examiner originally rejected the claims based on *Brown*, “[f]ollowing an amendment to the claims adding the prompting step along with arguments by the applicant explaining why

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