## 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 No. 7,844,037

PATENT OWNER'S PRELIMINARY RESPONSE



# TABLE OF CONTENTS

## Page

I.	INT	ODUCTION1
II.	OVE	RVIEW OF THE '037 PATENT
III.		RVIEW OF THE PROSECUTION HISTORY OF THE '037 PATENT
IV.		M CONSTRUCTION11
	А.	"prompting"12
V.		TIONER FUNDAMENTALLY MISCONSTRUES ITS PRIMARY CRENCE ( <i>BROWN</i> )17
VI.	LIK	TIONER FAILS TO DEMONSTRATE A REASONABLE LIHOOD THAT ANY OF THE CHALLENGED CLAIMS ARE ATENTABLE
	A.	Petitioner Fails to Demonstrate that the Combination of <i>Brown</i> and <i>Moran</i> Discloses Every Limitation of Independent Claim 1 (Grounds 2A and 2B: Claims 1–16 and 18)
		1. The combination of <i>Brown</i> and <i>Moran</i> does not disclose "in response to receiving the incoming call, <u>prompting</u> 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."
		a) "prompting"25
		2. The combination of <i>Brown</i> and <i>Moran</i> does not disclose "responsive to receiving the incoming call and the user entering the user input, <u>automatically addressing</u> the message to the second computing device using the message identifier determined from the incoming call."27
	B.	Petitioner Fails to Establish a Motivation to Combine or Reasonable Expectation of Success

VII.	II. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER U.S.C. § 325(D) TO DENY REVIEW			
	А.	Similarity of the asserted art and the prior art involved during examination: <i>Brown</i> was substantially considered during prosecution		
	B.	The extent to which the asserted art was considered during examination: <i>Brown</i> was the basis for a rejection during prosecution and it was substantively considered		
	C.	The cumulative nature of the asserted art and the prior art considered during examination: <i>Moran</i> is cumulative to other references cited during prosecution		
	D.	Whether Examiner erred in its consideration of the asserted prior art: Petitioner fails to show how Examiner erred in its consideration of <i>Brown</i>		
	E.	Extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner's arguments during examination: Petitioner relies on <i>Brown</i> in substantially the same manner as the Examiner		
	F.	The extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art: Petitioner's "additional evidence" does not warrant reconsideration of the art43		
VII.	U.S.C	BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 C. § 315(D) TO DENY REVIEW OF DUPLICATIVE CEEDINGS		
VIII.	CON	CONCLUSION		

Patent Owner's Exhibits		
2001	Disclaimer in Patent Under 37 CFR 1.321(a)	
2002	U.S. Patent No. 6,219,413 to <i>Burg</i>	
2003	U.S. Publication No. 2002/0187794 to Fostick	

# EXHIBIT LIST

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<i>Arendi S.A.R.L. v. Apple Inc.</i> , 832 F.3d 1355 (Fed. Cir. 2016)
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Becton, Dickinson & Co. v. B. Braun Melsungen AG, No. IPR2017-01587, 23 (P.T.A.B. Dec. 15, 2017) (designated informative Mar. 21, 2018)
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<i>In re Bigio</i> , 381 F.3d 1320 (Fed. Cir. 2004)
<i>In re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000)23, 31
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