

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

QUALCOMM INCORPORATED,  
Patent Owner.

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Case IPR2018-01315  
Case IPR2018-01316  
Patent 8,063,674 B2<sup>1</sup>

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

HOWARD, *Administrative Patent Judge*.

ORDER  
Conduct of Proceedings on Remand  
*37 C.F.R. § 42.5*

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<sup>1</sup> This Order addresses issues that are identical in each of the above-identified cases. Accordingly, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers without prior authorization.

On January 3, 2020, we issued a Final Written Decision in these proceedings finding, *inter alia*, that Petitioner had shown by a preponderance of the evidence that the challenged claims of United States Patent 8,063,674 B2 were unpatentable over Applicant Admitted Prior Art (“AAPA”) and Majcherczak or AAPA, Majcherczak, and Matthews. Paper 26.<sup>2</sup> Patent Owner appealed to the United States Court of Appeals for the Federal Circuit. Paper 27. On February 1, 2022, the Federal Circuit issued an opinion determining that we incorrectly interpreted § 311(b)’s “prior art consisting of patents or printed publications” to encompass AAPA contained in the challenged patent. *Qualcomm Inc. v. Apple Inc.*, 24 F.4<sup>th</sup> 1367 (Fed. Cir. 2022). The Federal Circuit remanded for us 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 1376–77. On June 24, 2022, the Federal Circuit issued its mandate. Mandate, *Qualcomm Inc. v. Apple Inc.*, No. 20-1558 (Fed. Cir. June 24, 2022) (No. 96). On July 11, 2022, in accordance with Standard Operating Procedure 9, the parties contacted the Board requesting a call with the panel to discuss the remand proceedings.

On July 20, 2022, Judges Jefferson, Galligan, and Howard held a call with the parties. Although the parties agreed to the length of remand briefing, they differed on the schedule and whether an additional oral hearing should be held. Petitioner requested that the parties file two rounds of simultaneous briefs and that no oral hearing was necessary. Patent Owner

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<sup>2</sup> Unless otherwise noted, all citations are to IPR2018-01315.

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requested four rounds of responsive briefing and that we conduct an additional oral hearing.

After a discussion, the panel decided to allow two rounds of simultaneous briefing. The parties are authorized to file opening briefs limited to 10 pages. The opening briefs are to be filed by August 31, 2022. Each party is also authorized to file a responsive brief to respond to the opposing party's opening brief. The responsive briefs are limited to 5 pages and are to be filed by September 28, 2022.

Without seeing the briefing, the Panel is unable to determine at this time whether an additional oral hearing would assist the panel. If a new oral hearing is warranted, the Panel will contact the parties after briefing is completed.

#### ORDER

It is

ORDERED that the parties may submit 10-page opening briefs on remand due no later than August 31, 2022; and

FURTHER ORDERED that the parties may submit 5-page responsive briefs on remand due no later than September 28, 2022.

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PETITIONER:

W. Karl Renner  
Thomas A. Rozylowicz  
Timothy W. Riffe  
David L. Holt  
Whitney A. Reichel  
FISH & RICHARDSON P.C.  
axf-ptab@fr.com  
tar@fr.com  
riffe@fr.com  
holt2@fr.com  
wreichel@fr.com

PATENT OWNER:

Joseph M. Sauer  
Matthew W. Johnson  
David B. Cochran  
Joshua R. Nightingale  
Richard A. Graham  
David M. Maiorana  
JONES DAY  
jmsauer@jonesday.com  
mwjohnson@jonesday.com  
dcochran@jonesday.com  
jrnightingale@jonesday.com  
ragraham@jonesday.com  
dmaiorana@jonesday.com