UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.,
Petitioner,

v.

Qualcomm Incorporated,
Patent Owner

Case IPR2018-01315
U.S. Patent No. 8,063,674

PATENT OWNER SUR-REPLY

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I. Introduction

Petitioner's reply introduces unpersuasive and belated arguments and evidence that cannot salvage the petition. The Board should confirm the patentability of claims 1, 2, and 5-7.

II. Petitioner Does Not Disagree That AAPA Is Not Proper Prior Art In *Inter Partes* Review Proceedings

Qualcomm's response showed that Grounds 2(a) and 2(b) are improper because the America Invents Act (AIA) does not permit IPR based on so-called applicants admitted prior art (AAPA). Paper 12 at 17-20.

The reply does not disagree that AAPA is not proper prior art for IPR proceedings. Paper 16 at 1-2. In fact, the reply never makes the affirmative statement that AAPA should be considered prior art in IPRs. *See id.* Instead, Petitioner merely points out that the Institution Decision followed the logic articulated in a previous IPR where a different panel found AAPA to be prior art.[1] *Id.* But Petitioner carefully avoids endorsing the previous panel's approach or ever stating affirmatively that AAPA is proper prior art. The reason for this is clear:

[1] The previous panel decision cited by Petitioner is distinguishable from the present case. In the cited case, AAPA was relied on as a secondary reference in an obviousness ground. *One World Techs., Inc. v. Chamberlain Group, Inc.*, IPR2017-00126, Paper 56 at 6 (PTAB Oct. 24, 2018). By contrast, in the present case, Petitioner attempts to rely on AAPA as a primary reference.

Counsel for Petitioner is currently taking the position before the Board and the Federal Circuit that AAPA is "not 'prior art consisting of patents or printed publications' and, thus is ineligible for *inter partes* review." Ex. 2004 at 3.

Qualcomm agrees with the position taken by Petitioner's counsel in these other proceedings.[2] Petitioner's reliance on AAPA is improper, and the challenged claims should be held patentable over Grounds 2(a) and 2(b).

III. Neither The Reply Nor Dr. Horst's New Simulation Results Rebut Qualcomm's Showing That The POSA Would Not Combine The Alleged AAPA And Majcherczak

A. Petitioner's Argument About The Alleged "Explicit" Motivation To Combine Is Erroneous

The reply argues that a POSITA would have been motivated to integrate the feedback transistor M6 of Majcherczak's voltage detector into the alleged AAPA to enable stabilizing of the detection device through hysteresis, as described in Majcherczak. Paper 16 at 2-6. But Petitioner is wrong because a POSA faced with

[2] Permitting petitioners to rely on AAPA in IPR proceedings is improper because, among other reasons, it dissuades patent applicants from including a background section in their patent applications. Further, Petitioner's reliance on the alleged AAPA here is especially improper because it is being applied as a primary reference. Obviousness is judged by putting oneself in the mind of the POSA—and then asking whether that person, the POSA, would be motivated to combine the prior art to reach the claimed invention. Here, Petitioner puts itself not in the mind of the POSA, but rather in the mind of the inventor as a starting point. Applying the alleged AAPA as the primary reference inherently leads to hindsight bias because it starts the obviousness inquiry from the wrong context: the inventor's mind, not the POSA's.

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