UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.
Petitioner

v.

Qualcomm Incorporated
Patent Owner

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

PATENT OWNER'S OPENING BRIEF ON REMAND

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I. INTRODUCTION

This remand presents a narrow and specific question: "The Federal Circuit remanded for [the Board] to determine whether Majcherczak forms the basis of Apple's challenge, or whether the validity challenge impermissibly violated the statutory limit in section 311." Paper 28 at 2; *see Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1377 (Fed. Cir. 2022). By any measure, the answer is clear: Majcherczak (itself or with the only other prior-art patent or printed publication asserted in Ground 2) does not form the basis of the ground. Rather, AAPA does. Ground 2 thus unquestionably violates the statutory limit in 35 U.S.C. § 311(b).

First, Apple's own statements answer the question on remand. Apple has consistently styled and substantively argued Ground 2 by starting with AAPA and using it as the fundamental and predominant source for the challenge, which makes clear that Majcherczak is not "the basis":

- Apple's petition styles its "*Basis for Rejection*" of Ground 2 as "Applicants Admitted Prior Art (AAPA) in view of Majcherczak." Paper 2 at 2.[1]
- Apple told the Federal Circuit that Ground 2 "is *based on* AAPA in view of the Majcherczak reference." Appeal No. 20-1558, Dkt. No. 54 at 8.
- Apple itself called Ground 2 its "*AAPA* grounds." *Id.* at 48, 49.
- Apple's petition relied on the alleged AAPA, not Majcherczak, for almost

[1] All emphasis in this brief is added unless otherwise noted.

every claim element. *E.g.*, Paper 2 at 46-56 (claim 1).

- Apple's arguments on § 311(b) consistently advocated AAPA as the basis of Ground 2. *See* Paper 16 at 1-2; Appeal No. 20-1558, Dkt. No. 54.

As "the master of its own petition," *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1041 (Fed. Cir. 2022), Apple cannot now distance itself from the way it framed and argued Ground 2. The Board can rest on Apple's acknowledgments alone to answer the Federal Circuit's directive and to hold that Majcherczak does not form the basis, thus rendering Ground 2 impermissible under § 311(b).

Second, § 311(b) compels precisely what Apple has long acknowledged. Applying the plain meaning of "basis," it is clear that Apple used AAPA, not Majcherczak, as the basis of Ground 2. That obviousness theory started with AAPA, it used AAPA as the foundation and premise, and it relied on AAPA for the vast majority of claim elements. By contrast, it used Majcherczak merely as a secondary reference to supplement the AAPA, and for only a limited aspect of the claims.

Third, this conclusion comports with the Federal Circuit's decision in this case. While the Court did not resolve the specific question pending before the Board, its holding and guidance on the proper and improper uses of AAPA in an IPR make clear that, on this record, Majcherczak is not the basis of Ground 2.

Finally, the Director's Updated Guidance on the treatment of AAPA in IPRs does not address the question the Federal Circuit directed for remand—whether a

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