

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 8,063,674

PETITIONER'S RESPONSIVE BRIEF ON REMAND

I. Introduction

Apple's petitions showed that Majcherczak discloses the alleged invention while relying on AAPA to establish a skilled artisan's knowledge. Majcherczak is therefore the basis of the Majcherczak grounds under Federal Circuit precedent, the Guidance, and even under Qualcomm's own statutory interpretation.

Qualcomm's arguments against this straightforward conclusion elevate form over substance, contradicting the Federal Circuit's remand and the Guidance.

II. Qualcomm's Arguments Are Without Merit

A. The Federal Circuit's Decision and the Guidance Refute Qualcomm's Arguments

Qualcomm devotes much of its brief to suggesting that the Majcherczak grounds are not based on Majcherczak because of how Apple "styled" them. *E.g.*, Paper 32, 1, 4, 6. However, Qualcomm cites no precedent holding that how Apple styled its grounds is relevant, and its argument cannot be reconciled with the Guidance, which explicitly states that "Board panels should not exclude the use of admissions based on . . . the order in which the petition presents the obviousness combination (e.g., prior art modified by admission or admission modified by prior art)." Guidance, 5. Moreover, if the §311(b) inquiry turned on how Apple's petitions are "styled," the Federal Circuit would have had no reason to remand.

Similarly, Qualcomm suggests that Apple somehow disavowed its reliance on Majcherczak by referring to its grounds as "AAPA grounds." Paper 32, 1, 3-5.

Again, the Federal Circuit implicitly disagreed, or a remand would have been unnecessary. *See Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1377 (Fed. Cir. 2022). Further, while the Federal Circuit did not adopt Apple’s argument that AAPA constitutes “prior art consisting of patents and printed publications,” *id.* at 1375, Apple has also consistently argued that its use of the AAPA was permissible evidence of “a POSITA’s general knowledge” regardless, Appeal Nos. 20-1558, -1559, Dkt. No. 54 at 49-52, an approach both the Federal Circuit and Guidance explicitly permit. *Qualcomm*, 24 F.4th at 1376; Guidance, 3-5.

Qualcomm also implies that Majcherczak is not the basis for the Majcherczak grounds because “Apple relied on the alleged AAPA system for almost every claim element.” Paper 32, 6. This argument is both factually and legally flawed. Factually, Qualcomm’s argument is significantly overstated. Apple’s petition argues that *both* Majcherczak and the “standard” AAPA system disclose most elements of the challenged claims. Paper 2 (Pet.), 39-64. Further, Apple relies on Majcherczak alone for several limitations. *See id.*, 51-52, 57-59. Legally, Qualcomm’s argument directly contradicts the Guidance, which requires that “Board panels should not exclude the use of admissions based on the number of claim limitations or claim elements the admission supplies.” Guidance, 5.

Qualcomm appears to recognize that the Guidance forecloses its argument, suggesting that a literal interpretation of the Guidance would “contradict the

statute.” Paper 32, 9. However, Qualcomm’s only argument for such an alleged contradiction has been repeatedly rejected by the Federal Circuit. Specifically, Qualcomm argues that “a challenge that rests on AAPA in addition to other references cannot be said to rest ‘*only on the basis*’ of prior art consisting of patents or printed publications.” *Id.* (quoting 35 U.S.C. §311(b)) (original emphasis). The Federal Circuit, however, has specifically *rejected* the argument that the phrase “only on the basis” precludes consideration of other evidence of a skilled artisan’s knowledge. *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337 (Fed. Cir. 2020) (“Although the prior art that can be considered in inter partes reviews is limited to patents and printed publications, it does not follow that we ignore the skilled artisan’s knowledge when determining whether it would have been obvious to modify the prior art.”). Further, the Federal Circuit’s decision in this case reaffirmed that, although “party admissions are not themselves prior art references, they are permissible evidence in an inter partes review for establishing” a skilled artisan’s “background knowledge.” *Qualcomm*, 24 F. 4th at 1376. The Board should therefore decline Qualcomm’s invitation to depart from the Guidance.

B. The Majcherczak Grounds Are Based on Majcherczak Under Even Qualcomm’s Statutory Interpretation

Even if precedent and the Guidance did not foreclose Qualcomm’s argument, Majcherczak is the “basis” of the Majcherczak grounds under even

Qualcomm's own interpretation.

Qualcomm argues that “the ‘basis’ of a thing is something fundamental to it, or on which the thing rests.” Paper 32, 5-7. Apple’s petition relies on (i.e., rests on) Majcherczak for every single challenged claim. Pet., 39-64. Although the petition, for ease of illustration, focuses on Qualcomm’s admissions for many well-known claim elements, it further argues that Majcherczak also discloses many of those elements, Pet. 39-43, and specifically relies on Majcherczak alone as disclosing every allegedly inventive element. Pet., 5-7, 51-52, 57-59.

Apple’s obviousness theory for the Majcherczak grounds is that the alleged improvement over “standard” systems “currently in use” and therefore “known” to those of skill in the art was the addition of one or more feedback networks, and that this addition would have been obvious given Majcherczak’s teachings. Pet., 3-7, 39-64; Ex. 1001, 1:55-3:11. It defies credibility to suggest that this theory does not rest on Majcherczak, or that Majcherczak is not “fundamental” to it.

Aside from its erroneous reliance on the number of claim limitations Apple identified in the AAPA, Qualcomm’s only argument for why the Majcherczak grounds do not meet its own definition of “basis” is that Apple described its combination in terms of a skilled artisan modifying “standard” and “conventional” systems in view of Majcherczak. Paper 32, 7.

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