UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.
Petitioner

v.

Qualcomm Incorporated
Patent Owner

Case IPR2018-01316
Patent 8,063,674

PATENT OWNER RESPONSE TO PETITION FOR *INTER PARTES* REVIEW PURSUANT TO 37 C.F.R. § 42.220

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Pursuant to the Board's Decision – Institution of *Inter Partes* Review (Paper 7) ("Institution Decision"), entered January 18, 2019 – Patent Owner Qualcomm, Inc. ("Qualcomm" or "Patent Owner") submits this Response in opposition to the Petition for *Inter Partes* Review of U.S. Patent No. 8,063,674 (the "'674 Patent") filed by Apple Inc. ("Apple" or "Petitioner").

I. INTRODUCTION

Petitioner challenged claims 8, 9, 12, 13 and 16-22 of the '674 Patent based on two primary obviousness combinations: (i) Applicant's Admitted Prior Art (AAPA) in view of Majcherczak, and (ii) Steinacker in view of Doyle and Park. In its Institution Decision ("Decision"), the Board instituted trial on all grounds and all claims challenged in the Petition. (Paper 7 at 41.) But despite instituting trial, the Board indicated that it agrees with Qualcomm's Patent Owner Preliminary Response (POPR) arguments (Paper 6 at 16) that the petition fails to sufficiently articulate why the person of ordinary skill in the art (POSA) allegedly would have been motivated to combine Steinacker, Doyle, and Park (Paper 7 at 36-40). For the AAPA/Majcherczak grounds, however, Qualcomm's POPR was limited to procedural arguments (Paper 6 at 27, 34), and the Board found these arguments insufficient to deny institution (Paper 7 at 26-27). As explained in this Response, Petitioner cannot show that any of the challenged claims are unpatentable.

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The AAPA/Majcherczak grounds are improper because the America Invents Act (AIA) only permits *inter partes* review on the basis of *prior art* consisting of patents or printed publications, which literally does not include allegations of admitted prior art. 35 U.S.C. § 311(b). And even if "admitted prior art" were permitted in *inter partes* review, the POSA would not combine the AAPA and Majcherczak as Petitioner proposes because the resulting combination would operate significantly worse than either the AAPA or Majcherczak had they been left unmodified. There is no legitimate reason why the POSA would make such a combination. The AAPA/Majcherzcak grounds therefore fail for these reasons and those explained fully below.

The Steinacker/Doyle/Park ground—for which the Board has already "question[ed] the sufficiency of Petitioner's evidence"—fares no better. In its Decision, the Board recognized that this ground is deficient, and nothing has changed. Petitioner's supposed motivation to combine Steinacker, Doyle, and Park is a textbook example of impermissible hindsight reconstruction, supported only by generic statements that are divorced from the specific references being combined. Petitioner cannot fix the problems of this deficient ground, and the Board should reject any attempts by Petitioner to do so. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (petitioner must

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