

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

QUALCOMM INCORPORATED,
Patent Owner.

IPR2018-01334¹
Patent 8,838,949 B2

Before TREVOR M. JEFFERSON, DANIEL J. GALLIGAN, and
AARON W. MOORE, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

SCHEDULING ORDER ON REMAND

¹ IPR2018-01335 and IPR2018-01336 have been consolidated with the instant proceeding.

A. INTRODUCTION AND GENERAL INSTRUCTIONS

1. Introduction

This proceeding is before the Board on remand from the Court of Appeals for the Federal Circuit.

Petitioner challenged claims 1–23 of U.S. Patent No. 8,838,949 B2 (“the ’949 patent,” Ex. 1001). On March 16, 2020, we determined that Petitioner had proven unpatentability of claims 10, 11, 13–15, and 18–23, but not claims 1–9, 12, 16, and 17. Paper 30 (“Final Dec.”), 2, 63. On appeal, the Federal Circuit vacated our determination that Petitioner had not proven unpatentability of claims 1–9, 12, 16, and 17 and remanded the case to us. *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 814 (Fed. Cir. 2021). In particular, the Federal Circuit vacated our construction of the term “hardware buffer” and our determination regarding claims 1–9 and 12 based on that construction and also vacated as to claims 16 and 17 based on our determination that Petitioner had not shown sufficient corresponding structure for certain means-plus-function limitations. *Id.* Our determination regarding claims 10, 11, 13–15, and 18–23, however, stands because Patent Owner dropped its appeal of those claims. *Id.* at 806.

On February 17, 2022, a conference call was held with counsel for the parties to discuss a schedule on remand. Before the call, the parties met and conferred and agreed to a proposal for the scope and schedule of briefing. Ex. 3001.

The Parties propose that the scope of the briefing on remand be limited to (1) the broadest reasonable interpretation of the claim term “hardware buffer,” (2) the applicability of the broadest reasonable interpretation of “hardware buffer” to the asserted prior art disclosures, and (3) whether the Board can resolve the prior art challenge to the patentability of claims 16

and 17 despite the potential indefiniteness of the means-plus-function terms, along with whether these means-plus-function terms of claims 16 and 17 are indefinite.

Ex. 3001. During the call, we raised two additional issues. First, we asked that the parties address the meaning of the term “system memory” as it relates to the “hardware buffer.” *See Intel*, 21 F.4th at 810 (“[B]ecause claim 1 requires both a ‘system memory’ and a ‘hardware buffer,’ there must be some distinction between those two concepts.”). Second, we asked the parties to consider whether the prior art challenges to claims 16 and 17 can be resolved based on the means-plus-function constructions proposed in the Petition. *See IPR2018-01335*, Paper 3, 17–22.

The parties further state,

Given the Federal Circuit’s opinion on the construction of “hardware buffer” and its applicability to the prior art, the Parties propose that (1) Petitioner may submit additional documentary and expert declaration evidence along its opening and reply briefs, (2) Patent Owner may submit additional documentary and expert declaration evidence along with its response brief, but not with its sur-reply brief, and (3) each party may depose any declarant who submits a declaration on behalf of the other party and must file the transcript as an exhibit with its next paper.

Ex. 3001.

The parties also agreed on the following schedule and page limits for the briefing: Petitioner’s opening brief (20 pages, due 6 weeks after authorization); Patent Owner’s response brief (20 pages, due 6 weeks after opening brief); Petitioner’s reply (8 pages, due 4 weeks after response); Patent Owner’s sur-reply (8 pages, due 4 weeks after reply). Ex. 3001.

We accept the parties’ agreed schedule and page limits, and we thank the parties for meeting and conferring before the call with the Board.

On the call, the parties also indicated that they anticipated requesting oral argument. We advised the parties that the total time period for briefing (20 weeks) and an oral argument would mean that we would not issue a decision on remand within six months of the Federal Circuit’s February 3, 2022, mandate, which is the goal set in the Board’s Standard Operating Procedure 9 (“SOP 9”).² The parties acknowledged this and agreed to exceed the six-month goal. *See* SOP 9, 2 (“Notably, certain scenarios may necessitate an extension of the six-month goal for issuing a remand decision.”).

The parties may request conference calls as needed during the proceeding. Any email requesting a conference call with the Board should: (a) copy all parties, (b) indicate generally the relief being requested or the subject matter of the conference call, (c) include multiple times when all parties are available, (d) state whether the opposing party opposes any relief requested, and (e) if opposed, either certify that the parties have met and conferred telephonically or in person to attempt to reach agreement, or explain why such meet and confer did not occur. The email may not contain substantive argument and, unless otherwise authorized, may not include attachments. *See* Consolidated Trial Practice Guide (“Consolidated Practice Guide”)³ at 9–10.

² Available at https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_f_or_decisions_remanded_from_the_federal_circuit.pdf.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

2. Protective Order

No protective order shall apply to this proceeding until the Board enters one. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order shall be filed as an exhibit with the motion. It is the responsibility of the party whose confidential information is at issue, not necessarily the proffering party, to file the motion to seal.⁴ The Board encourages the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See Consolidated Practice Guide at 107–122 (App. B, Protective Order Guidelines and Default Protective Order)*. If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.

The Board has a strong interest in the public availability of trial proceedings. Redactions to documents filed in this proceeding should be limited to the minimum amount necessary to protect confidential information, and the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order may become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See Consolidated Practice Guide at 21–22*.

⁴ If the entity whose confidential information is at issue is not a party to the proceeding, please contact the Board.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.