

Qualcomm Inc. v. Intel Corp., 6 F.4th 1256 (Fed. Cir. 2021)

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Intel Corp. petitioned for six *inter partes* reviews (IPRs) challenging the validity of U.S. Patent No. 9,608,675, a patent directed to power management in wireless devices. In each proceeding, Intel and patent-owner Qualcomm Inc. agreed the signals described by the term “a plurality of carrier aggregated transmit signals” must increase user bandwidth. The increased bandwidth requirement had already been adopted in a parallel International Trade Commission (ITC) proceeding.

At the oral hearing before the Patent Trial and Appeal Board (Board), one judge asked Intel a single question about the increased bandwidth requirement. Qualcomm received no questions about the increased bandwidth requirement, and it was not otherwise discussed during the oral hearing. After the hearing, the Board *sua sponte* ordered briefing about a different claim term, one that was discussed at great length at the hearing. The Board did not request any additional briefing on the increased bandwidth requirement.

The Board ultimately issued six final written decisions, concluding that all challenged claims were unpatentable as obvious. The Board also construed the term “a plurality of carrier aggregated transmit signals” to mean “signals for transmission on multiple carriers,” omitting the agreed-upon requirement that the signals increase user bandwidth.

Qualcomm appealed. The U.S. Court of Appeals for the Federal Circuit vacated and remanded, finding that Qualcomm’s procedural due process rights and the Administrative Procedure Act (APA) were violated because the Board failed to provide Qualcomm with adequate notice of, and no opportunity to respond to, the Board’s *sua sponte* construction.

The court explained that while the Board may adopt a construction of a disputed claim term that neither party proposes without violating the APA, that is not what happened here. Instead, the Board gave no indi-

Qualcomm further illuminates how the APA limits agency action and protects parties in IPR proceedings.

cation it would depart from the parties’ agreement that the signals were required to increase bandwidth. At the hearing, the Board did not announce a new construction, criticize the agreed-upon requirement, follow up on the single question to Intel about the increased bandwidth requirement, or ask any related questions to Qualcomm. And even though the Board ordered additional briefing on another claim term after the hearing, the Board gave no indication that it would not adopt the parties’ agreed-to increased bandwidth requirement. Qualcomm, thus, had no opportunity to respond to the Board’s new construction.

The court also found that the Board’s new construction prejudiced Qualcomm. Qualcomm had argued throughout the proceedings that the prior art did not disclose the increased bandwidth requirement. So, by removing that requirement, the Board “eliminated an element on which Intel bore the burden of proof.” The court explained that “without notice of the Board’s elimination of the increased bandwidth requirement, Qualcomm had no reason to brief that requirement or establish an evidentiary record supporting it, particularly given the limited word count and breadth of issues in these IPRs.”

RELATED CASE

- *M & K Holdings, Inc. v. Samsung Electronics Co. Ltd.*, 985 F.3d 1376 (Fed. Cir. 2021) (finding APA violation when Board found claim anticipated when only ground presented was obviousness)