

## ***Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801 (Fed. Cir. 2021) (Prost, Taranto, Hughes)**

BY JON E. WRIGHT

Intel filed three IPR petitions against Qualcomm's '949 patent, which is directed to "boot code" in a multi-processor system. Apple, who was not a party to any of the IPRs, uses Intel's baseband processors in certain iPhone models, and Apple had been sued by Qualcomm for infringement of the '949 patent. So Intel had an interest in invalidating the '949 patent.

After instituting, the Board consolidated the three proceedings. Following a trial on the merits, the Board issued a final written decision invalidating some, but not all, of the challenged claims. Intel appealed and Qualcomm cross-appealed. The Federal Circuit vacated the Board's decision as to the claims the Board found to be not unpatentable and remanded for further proceedings.

The court first addressed whether Intel had Article III standing. Intel's IPRs were motivated by a larger patent dispute between Apple and Qualcomm. But Qualcomm and Apple ultimately settled all litigation between them. As part of the settlement, Apple took a license to Qualcomm's patents, including the '949 patent. Apple then went on to acquire "the majority of Intel's smartphone modem business." After Intel noticed its appeal from its three IPRs, Qualcomm moved to dismiss the appeal, arguing that Intel lacked Article III standing because Qualcomm had not sued or threatened to sue Intel for infringement. Apple moved to intervene. The court denied both motions and directed Qualcomm and Intel to address standing in their merits briefs.

The court found that Intel had Article III standing to maintain its appeal, which requires an actual case or controversy. This is because, according to the court, "Intel has engaged in activity that has already given rise to an infringement suit by Qualcomm" in the form of another suit against a third party where Qualcomm identified an Intel product as the claimed "secondary processor" of the '949 patent. Even though Intel did

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not manufacture all of the components required by the claims, the "secondary processor" was central to the claims. The court thus found that Intel's "risks transcend mere conjecture or hypothesis" on the basis of either direct infringement during product testing, or the possibility of indirect infringement based on inducement.

A key takeaway on the Article III standing issue is that the case or controversy requirement is fact intensive. Even though Intel did not make all of the claimed components, the one it did make was central to the invention, and Intel thus faced real infringement risks in the third-party suit.

The court next considered the Board's decision on claims 16 and 17 in the '949 patent, which are written in means-plus-function format. Intel agreed with the Board's suggestion in the institution decision that those claims are indefinite for lack of supporting structure. The Board concluded in the final written decision that Intel's agreement that the claims could not be defined necessarily meant that Intel had not met its burden to demonstrate unpatentability of those terms. On appeal, Intel challenged that merits conclusion.

The court held that the Board's conclusion was error. It explained that "[t]he indefiniteness of a limitation ... precludes a patentability determination only when the indefiniteness renders it logically impossible for the Board to reach such a decision." The court explained that "is not always impossible to adjudicate a prior-art challenge, one way or the other, just because some aspect of a claim renders the claim indefinite." Accordingly, the Board must "decide for itself" on remand "whether the required structure is present in the specification or whether, even if it is not, the absence of such structure precludes resolution of Intel's prior-art challenges."

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