

No. 2020-1558, -1559

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**United States Court of Appeals  
for the Federal Circuit**

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QUALCOMM INCORPORATED,

*Appellant,*

v.

APPLE INC.,

*Appellee,*

KATHERINE K. VIDAL, Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office,

*Intervenor.*

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Appeals from the United States Patent and Trademark Office,  
Patent Trial and Appeal Board in Nos. IPR2018-01315, IPR2018-01316

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**QUALCOMM INCORPORATED'S RESPONSE  
TO APPLE INC.'S PETITION FOR REHEARING *EN BANC***

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**CERTIFICATE OF INTEREST**

Case No. 2020-1558, -1559

*Qualcomm Incorporated v. Apple Inc.*

Filing Party/Entity: Qualcomm Incorporated

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: May 3, 2022

Signature: /s/ Jennifer L. Swize

Name: Jennifer L. Swize

**1. Represented Entities** (Fed. Cir. R. 47.4(a)(1)) – Provide the full names of all entities represented by undersigned counsel in this case.

Qualcomm Incorporated.

**2. Real Party in Interest** (Fed. Cir. R. 47.4(a)(2)) – Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

None.

**3. Parent Corporations and Stockholders** (Fed. Cir. R. 47.4(a)(3)) – Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

None.

**4. Legal Representatives** – List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None.

**5. Related Cases** – Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court’s decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). *See also* Fed. Cir. R. 47.5(b).

None.

**6. Organizational Victims and Bankruptcy Crimes** – Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

Not Applicable.

Dated: May 3, 2022

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## INTRODUCTION

Apple’s petition is precisely what this Court’s *en banc* rules intend to prevent. Federal Rule of Appellate Procedure 35 requires either that the panel decision conflicts with Supreme Court or Federal Circuit precedent, or that the case involves an issue of exceptional importance. Apple’s petition does not raise any decisional conflict; instead, it purports to present a “precedent-setting question[] of exceptional importance.” Pet. 1. Yet Apple does not present any reason for the full Court to rehear this case *en banc*—Apple does not raise any factual or legal issue that was not considered by the panel, nor does it raise any intervening or subsequent law since the briefing and oral argument. In fact, Apple’s petition, though styled as seeking a “rehearing,” acts as though Apple has never been heard at all. Significant portions of Apple’s petition are copied verbatim from its merits brief regarding its interpretation of 35 U.S.C. § 311(b). This Court’s panel decision already considered those arguments, and notably absent from Apple’s petition is identification of any error in the panel’s analysis.

Simply put, Apple has been heard, as the panel’s decision makes clear. In a detailed, 18-page decision, the panel considered and unanimously rejected Apple’s arguments. The panel considered and unanimously rejected the *very same* arguments Apple raises in its petition. As the panel explained at length, Apple’s interpretation was not the “natural reading of § 311(b).” The plain language of

Section 311(b) says what it means: IPR grounds can be “only on the basis of prior art consisting of patents or printed publications.” That plain language precludes Apple’s reading that would include the challenged patent itself as “prior art consisting of patents.” As the panel explained, the challenged patent cannot be prior art to itself, and thus is excluded as a basis for IPR under Section 311(b). The panel also noted that Apple’s interpretation was inconsistent with prior judicial decisions, including this Court’s multiple decisions addressing a similar statute using exactly the same language. Apple, by contrast, had no company for its interpretation.

Despite seeking a rehearing *en banc*, Apple fails to contend with the underlying panel decision. Apple extensively copies verbatim from its merits brief that was filed over 16 months ago, merely reshuffling those paragraphs and sentences. A rehearing petition is not a vehicle for a dissatisfied party to cut and paste arguments that were considered and rejected. That alone is reason to deny Apple’s *en banc* petition, not to mention that the panel decision reached the only conclusion it could: “prior art consisting of patents or printed publications” does not include the challenged patent itself.

Apple had its bite; nothing warrants a second. Apple’s petition offers no new arguments, much less compelling ones, for the panel or the Court to consider. The Court should deny review.

## **BACKGROUND**

The panel decision sets forth the relevant background. *See Op.* 3-8.

Qualcomm owns U.S. Patent No. 8,063,674, and Apple filed two petitions for IPR against various of the patent’s claims, raising two grounds. “In ground 1, Apple challenged the claims as unpatentable under § 103 in view of Steinacker, Doyle, and Park,” two prior-art patents and a prior-art printed publication. *Id.* at 6. The Board found Apple had not proven this ground. *See id.*

In ground 2, Apple “relied on AAPA—Figure 1 and its accompanying description in the ’674 patent—in view of Majcherczak,” a published patent application. *Id.* Qualcomm disputed Apple’s use of “AAPA”—shorthand for so-called “applicant admitted prior art”—explaining that statements in the challenged patent itself “cannot be used to challenge the validity of a patent in *inter partes* review” for purposes of Section 311(b). *Id.* at 7. Section 311(b) limits IPR petitioners to challenging a patent “only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). As Qualcomm explained, “AAPA”—statements in the challenged patent itself—do not meet that limitation. *See Op.* 7-8. The Board disagreed with Qualcomm’s interpretation and, based on this ground, found the challenged claims unpatentable as obvious. *See id.* at 8.



Qualcomm appealed, and merits briefing ensued, with the PTO intervening in the appeal. *See* PTO Br. (ECF 41). The PTO “agrees with Qualcomm that AAPA does not fall within ‘prior art consisting of patents or printed publications’ under § 311(b).” Op. 9. While the appeal was pending, the PTO Director had issued guidance taking that position. *See* Op. 9 & n.9; Appx4530, Appx4532-4533 (The Director’s Guidance on the “Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews Under § 311,” stating: “A patent cannot be prior art to itself, and thus the patent challenged in the IPR cannot be said to be among the ‘patents’ of which the ‘prior art’ ‘consist[s].’”). Apple had full opportunity to make its arguments and respond to both Qualcomm’s and the PTO’s arguments. *See* Apple Br. (ECF 54) (responding to Qualcomm’s opening brief, the PTO’s brief, and the Director’s guidance). On May 4, 2021, the panel generously heard oral argument for nearly an hour. The argument focused almost exclusively on whether Apple and the Board permissibly relied on “AAPA” in invalidating Qualcomm’s claims in the IPR. *See* No. 20-1558, Oral Argument Recording.

On February 1, 2022, the panel issued its unanimous decision. On the issue of the statutory interpretation of the phrase “prior art consisting of patents or printed publications” as used in Section 311(b), the panel adopted Qualcomm’s interpretation and rejected Apple’s. *See* Op. 8-13.

The bulk of the 18-page decision addressed that issue. In the remainder, the panel addressed the extent to which “AAPA,” even though not usable for purposes of Section 311(b), can be considered in an IPR, which led the panel to remand this case to the Board for further proceedings related to that issue. *See id.* at 13-16. The panel also addressed and rejected Apple’s alternate ground for affirmance (ground 1, which the Board had rejected). *See id.* at 17-18. Apple does not challenge these aspects of the panel’s decision.

Apple has petitioned for rehearing *en banc* on the panel’s interpretation of Section 311(b), arguing that the phrase “prior art consisting of patents or printed publications” in the statute “encompasses applicant admitted prior art (‘AAPA’) found within a challenged patent.” Pet. 2. Apple’s petition copies whole passages from its merits brief. Apple includes a new introduction that mentions the panel decision (*id.* at 2-3, 5) and includes other minimal references to the decision (*e.g.*, *id.* at 9-11). But the vast majority of Apple’s petition is drafted as if there is no panel decision at all.

The Court has invited responses from Qualcomm and the PTO. Qualcomm hereby responds, and requests that the Court deny the petition.

## ARGUMENT

### I. THE PANEL CORRECTLY HELD THAT “AAPA” CANNOT BE A “BASIS” FOR UNPATENTABILITY IN AN IPR

The panel correctly interpreted Section 311(b). Qualcomm’s appeal presented the question “whether AAPA constitutes ‘prior art consisting of patents or printed publications’ under § 311(b) such that it may form ‘the basis’ of a ground in *inter partes* review.” Op. 10. The panel’s answer: “We hold that it does not.” *Id.* The panel “agree[d] with Qualcomm and the PTO that the ‘patents or printed publications’ that form the ‘basis’ of a ground for *inter partes* review must themselves be prior art to the challenged patent,” which “excludes any descriptions of the prior art contained in the challenged patent.” *Id.*; *id.* at 3 (“agree[ing] with Qualcomm that the Board erred in concluding that AAPA constitutes ‘prior art consisting of patents or printed publications’ under § 311(b)”).

The panel rooted its analysis in the statutory text. *See id.* at 10-11. Section 311(b) states in full:

**(b) Scope.**—A petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

This plain text makes clear that the basis of an IPR cannot be the challenged patent itself. Instead, the text limits the basis of an IPR challenge to “prior art consisting

of patents or printed publications”—*i.e.*, prior-art documents, which cannot include the challenged patent itself.

As the panel explained, “Section 311 provides a limit on what prior art can be the basis for an *inter partes* review challenge and both the courts and the PTO must adhere to that limit.” Op. 16. Specifically, “the patents and printed publications referenced in § 311(b) must themselves be prior art to the challenged patent.” *Id.* at 13. Statements in the challenged patent itself do not meet that statutory limitation, because such statements are “not contained in a document that is a prior art patent or prior art printed publication.” *Id.*

The panel also reasoned that this Court’s prior decisions reinforce this interpretation. As the panel explained, its interpretation “is consistent with prior judicial interpretations of the statute.” *Id.* at 10-11. “Both the Supreme Court and this court have previously understood the ‘patents and printed publications’ referenced in § 311(b) to themselves be prior art.” *Id.* at 11 (citing cases).

The panel’s analysis identified multiple decisions that described “identical language—‘prior art consisting of patents or printed publications’—in a similar statute.” *Id.* at 11-12 (citing cases involving 35 U.S.C. § 301(a), governing the scope of reexamination). As the panel reasoned, in those decisions, this Court consistently understood the phrase “as referring to prior art documents” and “excluding patents which themselves are not prior art.” *Id.*; *see, e.g., Mikkelsen*

*Graphic Eng'g, Inc. v. Zund Am., Inc.*, 541 F. App'x 964, 973-74 (Fed. Cir. 2013) (observing that Section 301(a) “limited *inter partes* reexamination requests to arguments based on prior art patents or printed publications”); *In re NTP, Inc.*, 654 F.3d 1268, 1271, 1276 (Fed. Cir. 2011) (“During reexamination, the examiner reviews the claims in view of various prior art patents and printed publications.”); *In re Swanson*, 540 F.3d 1368, 1375 (Fed. Cir. 2008) (“Any person may file a request for an *ex parte* reexamination of an issued patent based on prior art patents or printed publications....”); *In re Lonardo*, 119 F.3d 960, 966 (Fed. Cir. 1997) (noting that Section 301’s “consisting of patents or printed publications” limited reexamination to “prior art submitted by a third party”); *In re Freeman*, 30 F.3d 1459, 1468 (Fed. Cir. 1994) (“The reexamination statute provides that anyone at any time may request reexamination ... based upon prior art patents and printed publications.”). Thus, as the panel explained, when Congress used the same phrase in Section 311(b) of the AIA, “the logical extension is that the patents and printed publications referenced in § 311(b) must themselves be prior art to the challenged patent.” Op. 13.

These traditional tools for statutory interpretation uniformly rest on one side of the scale: The text itself, as confirmed by the consistent understanding of the statutory text in judicial decisions including decisions available when Congress used the same language in the AIA, establish that Section 311(b) “does not permit

AAPA” to be the basis of a ground in an IPR. *Id.* The panel so held. The panel was correct.

## **II. APPLE’S MINIMAL COGNIZANCE OF THE PANEL DECISION PROVIDES NO BASIS FOR REHEARING**

In reaching its conclusion, the panel vetted and rejected Apple’s view of how Section 311(b) should be interpreted. Apple’s petition offers nothing new. Instead, Apple reverts to its merits brief—the state of affairs before Qualcomm submitted its reply brief, before the panel heard oral argument, and, most critically, before the panel issued its unanimous decision. Nearly every argument in Apple’s petition—across Sections I, II, and III of its petition—was already presented to the panel in Apple’s merits brief and reiterated at oral argument. In short, after all of the judicial process, Apple’s petition appears as though it has not been heard.

Apple was heard. The panel, by unanimous decision, rejected Apple’s arguments. Apple fails to join issue with the panel decision or present any error in the panel’s analysis. Apple’s nearly verbatim repetition of arguments considered and rejected underscore that there is no basis for rehearing.

### **A. The Panel Considered And Correctly Rejected Apple’s Statutory Interpretation Arguments**

Apple’s statutory interpretation argument is déjà vu. In passages it already presented to the panel in its merits brief, Apple posits that “AAPA is ‘prior art consisting of . . . patents.’” Pet. 8 (capitalization altered). It bases this view on an

unnatural reading of the statute. It emphasizes such points as the statute’s use of “prior art” as a “noun phrase” rather than as an “adjective,” and the “consisting of” clause “function[ing] as an adjective modifying the noun ‘prior art.’” *Id.* at 6-7.

When Apple then puts together its discrete elements, it obtains a meaning that has no relationship to the statutory text: an interpretation that “prior art consisting of patents or printed publications” includes prior art “in the form of a patent or a printed publication,” to arrive at Apple’s conclusion that “AAPA from the challenged patent’s specification meets” this. *Id.* at 8; *see generally id.* at 6-11.

Apple made exactly these same, unmeritorious arguments to the panel. Essentially all of Section I.A in Apple’s petition (at pp. 6-8) was argued verbatim in its merits brief, with only a handful of minor deviations therefrom. *See* Apple Br. 22-24. Likewise for Section I.B in Apple’s petition (at pp. 8-9). *See* Apple Br. 24-25. And much of Sections II.A and II.B in Apple’s petition was argued verbatim in its merits brief. *See* Apple Br. 25-27 (arguing, *e.g.*, that “to ‘deny operative effect to each word in the [statute]’ would be ‘contrary to basic principles of construction,’” that interpreting Section 311(b) to mean prior-art patents “rewrites the statute,” and that the statute uses “the phrase ‘prior art’” as “a noun, not an adjective”—all of which Apple’s petition repeats at pp. 10-11).

The panel already fully considered all of this. In fact, the panel decision expressly notes that “Apple read § 311(b) to permit the use of any ‘prior art’

‘consisting of patents or printed publications,’” and the panel cited specific passages from Apple’s brief. Op. 9 (citing Apple Br. 24-25, 27). As noted above, the panel concluded that Apple did not offer the “more natural reading of § 311(b).” Op. 11. Rather, the statutory text “excludes any descriptions of the prior art contained in the challenged patent.” *Id.* at 10.

Apple has no response to the sound statutory interpretation by the panel and its rejection of Apple’s arguments. While Apple says the panel “neglect[ed] to analyze” the phrase “prior art consisting of,” “never engage[d] with the key statutory text,” and instead “focuse[d] on the term ‘basis,’” Pet. 9-10, that is demonstrably incorrect. The panel repeatedly addressed, and resolved, the meaning of the phrase “prior art consisting of patents or printed publications.” Op. 10-13.

**B. The Panel Considered And Correctly Rejected Apple’s Attempts To Distinguish Informative Cases**

Apple’s arguments regarding the case law also repeat its merits brief, without taking into account the panel’s reasoning. *See* Pet. 11-15 (Section II.C). Just as in its merits brief, Apple attempts to limit the cases to their facts. For instance, Apple argues that *In re Lonardo*, 119 F.3d 960 (Fed. Cir. 1997), “did not engage in statutory construction,” “does not concern AAPA,” and does not support the panel’s interpretation of Section 311(b). Pet. 14. For other judicial opinions, Apple likewise argues that “none of these cases purports to construe the meaning



of the relevant statutory text, nor was it at issue in them.” *Id.* at 13. Apple made these same arguments in its merits brief. *See* Apple Br. 35, 37-38.

The panel considered Apple’s arguments and soundly rejected them. The panel acknowledged that “*Lonardo* did not directly address AAPA,” but found the decision informative. Op. 11. As the panel explained: “While *Lonardo* did not directly address AAPA, it distinguished § 303(a) from § 301(a) by noting that the former ‘is not specifically limited to prior art patents or printed publications,’ and referred to the latter as describing “*prior art* submitted by a third party.” Op. 11 (emphasis in the panel decision). This description understands “prior art consisting of patents or printed publications,” as used in both Section 301(a) and Section 311(b), to “refer[] to prior art documents,” and thus supports that Section 311(b) does not permit an IPR on the basis of “AAPA.” *Id.* at 12. And with *Lonardo* and other judicial decisions embracing the same understanding of the phrase “prior art consisting of patents or printed publications” and existing in the public record “at the time the AIA was enacted,” the panel rightly observed that this demonstrated Congress embraced that same meaning itself when it used the same phrase in the AIA. *Id.* at 12-13. As the panel recognized, even Apple itself agreed that “[w]hen Congress enacted the ‘prior art consisting of patents or printed publications’ proviso for IPRs in section 311(b), it is presumed to have done so with reference to the same specialized provision in the reexamination statute.” *Id.* at 12 (quoting

Apple Br. 38). The panel thus reasoned that “Congress is also presumed to be aware of judicial decisions interpreting statutory language.” Op. 12.

In its petition, Apple again misses the salience of this uniform judicial understanding of the phrase “prior art consisting of patents or printed publications.” Apple continues to emphasize that these decisions were not directly interpreting the statute. *See* Pet. 13-14. But that posture makes the repeated judicial understanding all the more relevant—each time (and without being bound by prior decisions), the Court understood the statute’s straightforward, clear language in the same way. And then, when enacting Section 311(b) against that backdrop of a clear, consistent understanding, Congress is presumed to have adopted that same understanding. In short, as the panel found, prior judicial decisions addressing the same statutory language confirm that Apple’s interpretation is incorrect.

For two other decisions cited by the panel—*Return Mail, Inc. v. U.S. Postal Service*, 139 S. Ct. 1853 (2019), and *Regents of the University of Minnesota v. LSI Corp.*, 926 F.3d 1327 (Fed. Cir. 2019)—Apple vastly overstates the extent to which the panel relied on them. *See* Pet. 12-13 (claiming that the panel “emphasize[d]” the *Return Mail* decision and “relie[d]” on *Regents*). In fact, the panel noted these cases in a single, unassailable sentence: “Both the Supreme

Court and this court have previously understood the ‘patents and printed publications’ referenced in § 311(b) to themselves be prior art.” Op. 11.

Apple’s outsized response does not call into question the panel’s reasoning. Apple tries to discount those decisions as having used “a linguistic convenience” to describe Section 311(b). Pet. 13. But that is the point. Much like claim construction “elaborat[es] the normally terse claim language[] in order to understand and explain, but not to change, the scope of the claims,” courts paraphrase statutes without changing their meaning. *Embrex, Inc. v. Serv. Eng’g Corp.*, 216 F.3d 1343, 1347 (Fed. Cir. 2000) (citation omitted); *see also, e.g., Gonzales v. Oregon*, 546 U.S. 243, 257 (2006) (recognizing the equivalence in “paraphras[ing]” and “parroting” statutory text); *see* Qualcomm Reply Br. (ECF 56) at 7-9. As the panel observed, *Return Mail* and *Regents* did just that in understanding Section 311(b) to refer to patents and printed publications that are themselves prior art to the challenged patent, *i.e.*, “*prior art patents or printed publications.*” Op. 11 (quoting *Regents*, 926 F.3d at 1335 (emphasis in the panel decision)); *see also* Op. 11 (quoting *Return Mail*, 139 S. Ct. at 1860, as understanding that Section 311(b) refers to “patents or printed publications’ existing at the time of the patent application” (emphasis in the panel decision)).

*Return Mail* does not, as Apple contends, support its interpretation. *See* Pet. 12-13. *Return Mail*’s reference to “patents or printed publications’ existing at the

time of the patent application,” 139 S. Ct. at 1860, cannot be read as understanding that the challenged patent is included; the challenged patent does not exist at the time of the patent application.

Finally, Apple wrongly suggests error in the panel relying “largely on case law to reach its holding.” Pet. 11. Ordinary tools of statutory interpretation recommend consideration of consistent judicial decisions addressing the same or similar language. “When ‘all (or nearly all) of the’ relevant judicial decisions have given a term or concept a consistent judicial gloss, we presume Congress intended the term or concept to have that meaning when it incorporated it into a later-enacted statute.” *Bruesewitz v. Wyeth LLC*, 562 U.S. 223, 243 (2011) (citation omitted). In any event, the panel began with the statutory text, interpreted it, and determined its meaning, all before concluding that the case law “aligns with” the panel’s statutory interpretation. Op. 11-12; *see also id.* at 10 (“Our analysis begins with Section 311(b) of the Patent Act.”).

**C. The Panel Considered And Correctly Rejected Apple’s Legislative History Arguments**

Apple’s final argument for rehearing is that use of “AAPA” in an IPR advances “the policy goals of the IPR regime enacted by the AIA.” Pet. 17; *see id.* at 15-18 (Section III). Again, this repeats arguments from Apple’s merits briefing, with wholesale copying of passages. *Compare id.* at 15-18 with Apple Br. 29, 31-32, 39-40.

The panel already considered and declined Apple’s invitation to rest on policy concerns purportedly discerned from legislative history. As Qualcomm explained in its merits briefing, legislative history is irrelevant where, as here, the statutory text is clear. *See United States v. Gonzales*, 520 U.S. 1, 6 (1997) (“Given the straightforward statutory command, there is no reason to resort to legislative history.”); *see* Qualcomm Reply Br. 17-18. Qualcomm further showed that the legislative history that Apple cited—general discussions about efficiency concerns—could not trump the clear statutory language specifically limiting the basis of an IPR. *See* Qualcomm Reply Br. 17-19. Given the clear statutory text, Apple’s legislative history arguments have no force, and the panel properly paid them no heed.

### **CONCLUSION**

Apple presents no basis for rehearing this case and reviewing the unanimous panel decision regarding the interpretation of Section 311(b). Apple’s petition for *en banc* rehearing should be denied.

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE**

The foregoing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because the filing has been prepared using a proportionally-spaced typeface and includes 3,702 words.

Dated: May 3, 2022

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