

No. 20-1561

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

APPLE INC.

Appellant,

v.

QUALCOMM INCORPORATED

Appellee.

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE, PATENT
TRIAL AND APPEAL BOARD IN INTER PARTES REVIEW No. IPR2018-01279

APPLE INC.'S CORRECTED PETITION FOR REHEARING *EN BANC*

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May 10, 2021

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CERTIFICATE OF INTEREST

Counsel for Appellant Apple Inc. (“Apple”) certifies the following:

1. Provide the full names of all entities represented by undersigned counsel in this case.

Apple Inc.

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.

Not applicable

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. 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).

Fish & Richardson P.C.: Walter Renner, Thomas Rozylowicz, Timothy Riffe, Thad C. Kodish, Dan Smith

5. 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).

The following appeals involve common issues related to jurisdiction and standing: *Apple Inc. v. Qualcomm Incorporated*, No. 20-1642 (Fed. Cir.); *Apple Inc. v. Qualcomm Incorporated*, No. 20-1683 (Fed. Cir.); *Apple Inc. v. Qualcomm Incorporated*, No. 20-1763, -1764 (Fed. Cir.); and *Apple Inc. v. Qualcomm Incorporated*, No. 20-1827 (Fed. Cir.).

No other case is known to the undersigned counsel to be pending in this or any other court or agency that will directly affect or be

directly affected by this Court’s decision in the pending appeal.

6. 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 10, 2021

/s/ Lauren A. Degnan
Lauren A. Degnan

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States: *MedImmune Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007); *Cardinal Chem. Co. v. Morton Int'l Inc.*, 508 U.S. 83 (1993); and *Altwater v. Freeman*, 319 U.S. 359 (1943).

Dated: May 10, 2021

/s/ Lauren A. Degnan

Lauren A. Degnan

PRELIMINARY STATEMENT

Congress created *inter partes* review proceedings to create “an efficient system for challenging patents that should not have issued.” H.R. Rep. No. 112-98, pt. 1, at 39-40. This system was designed not only to help “resolve concrete patent-related disputes among parties,” but also to help “protect the public’s ‘paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.’” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016) (quoting *Precision Instrument Mfg. Co. v. Auto. Maintenance Machinery Co.*, 324 U.S. 806, 816 (1945)). One of the key improvements Congress implemented over pre-AIA reexamination proceedings was improved access to appellate review. *See* S. Rep. No. 110-259, at 18-19 (2008) (noting that the absence of appellate rights “made reexamination a much less favored avenue to challenge questionable patents than litigation”).

Even before Congress created administrative avenues for private parties to challenge patent validity, the Supreme Court had long emphasized the important role private parties play in protecting this public interest. Thus, in *Lear, Inc. v. Adkins*, the Supreme Court abolished the doctrine of licensee estoppel, holding “that the technical requirements of contract doctrine must give way before the demands of the public interest.” 395 U.S. 653, 670 (1969). The Court in *Lear* recognized that patent licensees “may often be the only individuals with enough

economic incentive to challenge the patentability of an inventor’s discovery,” and “[i]f they are muzzled, the public may continually be required to pay tribute to would-be monopolists without need or justification.” *Id.* The Court reiterated the public value of “authoritative testing of patent validity” in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 344 (1971), holding that a finding of invalidity in one case was binding against the patent-holder in a subsequent suit against another defendant. *Id.* at 349-50.

The Supreme Court invoked the same principle yet again in *Cardinal Chemical Co. v. Morton Int’l, Inc.*, holding not only that the federal courts had Article III jurisdiction over patent invalidity counterclaims following a determination of noninfringement, but also that this Court abused its discretion in routinely vacating invalidity judgments on prudential grounds. 508 U.S. 83, 96-102 (1993). Although *Lear* does not explicitly address Article III standing, the Court reaffirmed that licensees’ interests in patent validity are sufficient to satisfy Article III’s case-or-controversy requirement in *MedImmune, Inc. v. Genentech, Inc.*, rejecting this Court’s restrictive approach to analyzing standing to challenge patent validity. 549 U.S. 118, 126-34 (2007). The Court explained that a licensee was not required to cease royalty payments and “risk treble damages” and injunctive relief before bringing a declaratory judgment claim for patent invalidity. *Id.* at 122, 134.

The panel opinion in this case fails to heed the lessons of *MedImmune* and its predecessors. Despite *MedImmune*'s focus on the licensee's legitimate interest in avoiding the risk of patent infringement remedies such as enhanced damages or injunctions, 549 U.S. at 128-29, 131 & n.10, 134, the panel opinion narrowly interprets "the reasoning of *MedImmune*" to apply only where "the validity of the patents at issue will affect" a party's "contract rights." Op. 6-7. That holding conflicts with *MedImmune*'s explicit statement that the distinction between a contract claim and a "freestanding claim of patent invalidity" "probably makes no difference" to the jurisdictional analysis, 549 U.S. at 123, as well as with *MedImmune*'s reliance on *Altvater v. Freeman*, 319 U.S. 359 (1943), where the parties' contract dispute was fully resolved before the case reached the Supreme Court. When *MedImmune* is correctly interpreted, it leaves no doubt that Apple has standing to appeal the Board's adverse IPR determinations concerning the '037 and '362 patents—two patents Qualcomm sued Apple for allegedly infringing.

The remainder of the panel's reasoning for dismissing Apple's appeals is equally inconsistent with precedent. Without substantive analysis, the Court assumed that the dismissal of Qualcomm's infringement claims with prejudice rendered them no longer relevant to standing. Op. 10. But under *Cardinal Chemical*, resolution of an infringement claim does not jurisdictionally moot a counterclaim for invalidity, and that reasoning applies with equal force to Apple's

administrative challenges to the patents' validity. 508 U.S. at 94, 102-03. Further, the panel evaluated only whether each of Apple's injuries was independently sufficient to create Article III jurisdiction, Op. 6-11, rather than considering the totality of the circumstances, as *MedImmune* commands. 549 U.S. at 127.

The result of these errors is an opinion that retreads the rigid, patent-specific rules rejected in both *Cardinal Chemical* and *MedImmune* to the detriment of litigants and the public alike. This Court should rehear these cases *en banc* to correct the Court's Article III standing jurisprudence and realign it with the flexible and pragmatic approach dictated by the Supreme Court's precedents.

ARGUMENT

I. The Panel's Narrow Interpretation of *MedImmune* Is Incorrect

A. *MedImmune* Does Not Rely upon a Potential Alteration in the Parties' Contractual Rights

The panel's analysis of *MedImmune* focuses on the number of patents under which the license agreement grants rights to Apple, holding that it was "fatal to establishing standing" that Apple "has not alleged that the validity of the" particular "patents at issue will affect its contract rights," such as the amount of on-going payments due under the license agreement. Op. 6-8.

MedImmune's jurisdictional analysis, however, does not rest on whether the licensee's claims would affect the parties' contract rights. Indeed, *MedImmune* explicitly notes that it "probably makes no difference to the ultimate issue of

subject-matter jurisdiction” whether the licensee brings “only a freestanding claim of patent invalidity” or also asserts a contract claim. 549 U.S. at 123. Instead, *MedImmune* describes the licensee’s conundrum as one where the licensee’s “own acts,” *i.e.*, payment of royalties under the license, “eliminate the imminent threat of harm,” *id.* at 128, including the risk of “treble damages and an injunction fatal to his business.” *Id.* at 132 n.11.

Analogizing the circumstances to cases involving challenges to threatened government action, *MedImmune* holds that these circumstances do “not preclude subject-matter jurisdiction because the threat-eliminating behavior [is] effectively coerced.” *Id.* at 129 (discussing, *e.g.*, *Steffel v. Thompson*, 415 U.S. 452 (1974)). The Article III injury upon which *MedImmune* relies is therefore not just the royalty payments themselves, but primarily the consequences of nonpayment. *Id.* at 130 n.9 (“[T]he relevant coercion is not compliance with the claimed contractual obligations, but rather the consequences of failure to do so.”). Hence, standing in *MedImmune* does not rely on any prospective alteration to “the claimed contractual obligations,” *id.*, but instead upon the potential alleviation of the consequences of nonpayment—specifically, the threat of treble damages and injunctive relief, *id.* at 132 n.11.

MedImmune’s reliance upon and description of *Altwater v. Freeman*, 319 U.S. 359 (1943), confirms that the focus of both cases is upon eliminating the risk

of patent infringement remedies upon nonpayment—not on altering the parties’ contract rights. Although *Altvater* began as a contract dispute, *id.* at 360, the contract claims had been finally resolved before the case reached the Supreme Court. The lower courts had held that the license terminated nearly seven years before the Supreme Court’s decision, when the patentee surrendered its original patent in pursuit of two reissue patents. *Id.* at 362-64. The courts below had also finally concluded that the license did not extend to the reissues, although the putative licensee had been paying royalties for them rather than face the risk of an infringement suit. *Id.* at 364-65. In that posture, a decision on the validity of the reissues would not affect either party’s contract rights, but that did not preclude jurisdiction. *Id.* at 365-66. That is because “the central lesson of *Altvater*” is “that payment of royalties under ‘coercive’ circumstances does not eliminate jurisdiction.” *MedImmune*, 549 U.S. at 131 n.10.

B. The Panel’s Description of Apple’s Payments as “Voluntary” Confirms Its Misreading of *MedImmune*

The panel dismissed Apple’s arguments that it faced the same dilemma as the declaratory-judgment plaintiff in *MedImmune* by suggesting that “Apple’s assertions amount to little more than an expression of displeasure with a license provision into which it voluntarily entered.” Op. 8. This reasoning is irreconcilable with the *MedImmune* majority. Indeed, one of the key disagreements between the majority and Justice Thomas in *MedImmune* was

whether the licensee’s payments were “voluntary” or “coerced.” Justice Thomas would have found no jurisdiction because he thought that the licensee made a “voluntary choice to enter” the agreement and that the license payments were thus “voluntarily made.” 549 U.S. at 146 (Thomas, J., dissenting). The majority opinion explicitly repudiates this characterization, explaining that the licensee’s decision to enter the agreement and make payments was coerced by “the threat of treble damages and loss of 80 percent of [its] business.” *Id.* at 134 n.12. In describing Apple’s decision to settle Qualcomm’s infringement claims as “voluntary,” the panel thus echoes *MedImmune*’s dissent and fails to follow the controlling majority opinion.¹

The panel in this case, however, goes even further astray than merely adopting that dissenting rationale. Even Justice Thomas recognized that the Court’s threatened-action precedents would apply “if Genentech had threatened *MedImmune* with a patent infringement suit in the absence of a license agreement.” 549 U.S. at 146 (Thomas, J., dissenting). In this case, Qualcomm did

¹ Although the *MedImmune* majority opinion disputes Justice Thomas’ description of the licensee’s royalty payments as “voluntary,” and his assertion that the decision lacked any limiting principle, it pointedly does not dispute his claim that “the majority has given every patent licensee a cause of action.” 549 U.S. at 146 (Thomas, J., dissenting); *see also id.* at 134 n.12. This further confirms “the broad scope of the Court’s holding.” *See id.* at 141 (Thomas, J., dissenting).

not just *threaten* Apple with a patent infringement suit under the '037 and '362 patents in the absence of a license agreement. It brought one. Appx2904-2908; Appx2920-2923.²

II. This Court Has Article III Jurisdiction Under *MedImmune*

A straightforward application of *MedImmune* establishes Apple's standing to challenge the '037 and '362 patents. For each patent, Apple suffers exactly the same injury-in-fact identified in *MedImmune*—the dilemma between continuing its payments and facing the threat of infringement liability or injunctive relief.

Appx2904-2908; Appx2920-2924; *MedImmune*, 549 U.S. at 128-29. Those injuries are fairly traceable to the '037 and '362 patents, respectively, because any infringement damages would be “carefully tie[d]” to each alleged invention's individual “footprint in the market place,” *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 869 (Fed. Cir. 2010), and any injunction would extend to only the particular functionality allegedly covered by each individual patent, *Versata Software, Inc. v. SAP Am., Inc.*, 717 F.3d 1255, 1268-69 (Fed. Cir. 2013); *see also Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 441 (1984).

Furthermore, because invalidation of the '037 and '362 patents would eliminate

² Consistent with the panel opinion, *see* Op. 3 n.2, all citations to the briefs and the joint appendix herein refer to the submissions in *Apple Inc. v. Qualcomm Inc.*, No. 20-1642.

any cause of action for infringement of those patents if Apple ceased its payments, Apple's injury under each patent would be redressed by a favorable decision.

The correct result would be the same even if the effect of Qualcomm's patent-enforcement efforts were treated as a single unitary injury. Despite Qualcomm's "tens of thousands of patents," Op. 7, that injury would still be fairly traceable to the '037 and '362 patents because those are two of the particular patents under which Qualcomm not only threatened—but actually asserted—an enforcement action. *See Steffel v. Thompson*, 415 U.S. 452, 459 (1974) ("[P]etitioner's challenge is to those specific provisions of state law which have provided the basis for threats of criminal prosecution against him."). Finally, the injury is adequately redressable, for Article III purposes, because reducing Apple's potential liability provides at least partial redress. *Uzuegbunam v. Preczewski*, 141 S. Ct. 792, 801 (2021) ("True, a single dollar often cannot provide full redress, but the ability 'to effectuate a partial remedy' satisfies the redressability requirement." (quoting *Church of Scientology of Cal. v. United States*, 506 U.S. 9, 13 (1992))); *see also Village of Arlington Heights v. Metro. House. Dev. Corp.*, 429 U.S. 252, 261 (1977) (holding that judicial relief will provide constitutionally sufficient redress if it "remove[s]" a "barrier" to a party's objective).

The panel's holding that Apple lacks standing is based on its mistaken understanding that the operative injury in *MedImmune* was the amount of royalties

due under the license. *See* Op. at 6-8. Yet, while Apple agrees that disputes over contractual royalty obligations can also give rise to Article III standing, *MedImmune* instead focuses on the coercive effect of potential patent infringement liability. 549 U.S. at 123, 131-32; *see also* Apple Reply Br. 21-22 (“The constitutionally-sufficient injury in *MedImmune* was the risk of treble damages, attorneys’ fees, and injunctive relief based on a finding of infringement under the relevant patent if the license ceased payment of royalties.”).

The panel’s decision not only jettisons *MedImmune*’s focus on coercion, but permits patent-holders to exploit the very same coercion to shield their patents from scrutiny. After all, under the panel’s holding, a licensee can evade jurisdiction under *MedImmune* simply by bundling its allegedly-infringed patents with many other patents, which may have little or no relevance to the licensee’s business. *See* Op. 6-8. The licensee, of course, has little choice but to acquiesce if, as here, the alternative is to face the threat of treble damages and injunctive relief. *See MedImmune*, 549 U.S. at 129. The facts here illustrate the point. Apple proposed a permanent grant of rights under the ’037 and ’362 patents such that the parties could settle these *inter partes* reviews in addition to the infringement litigation. Appx2931. Using its infringement suit as leverage, Qualcomm rejected that proposal, *see id.*, and the result was the current license agreement involving “tens of thousands of patents,” Op. 7, under which Apple must discharge ongoing

payments obligations to be free from the threat of suit under the invalid '037 and '362 patents. Appx2930. To hold, as the panel opinion does, that Apple needed to eschew any agreement and continue the infringement litigation to preserve its appellate rights in the *inter partes* reviews cannot be squared with the reasoning of *MedImmune*, which explicitly rejects the suggestion that a licensee must undertake those litigation risks to have standing to challenge patent validity. *Id.* at 129, 133.

III. The Dismissal of Qualcomm's Infringement Suit Did Not Deprive This Court of Jurisdiction To Decide the Parties' Validity Disputes

An Article III case or controversy over the validity of the '037 and '362 patents unquestionably arose when Qualcomm sued Apple for infringement of those patents. *Cardinal Chem.*, 508 U.S. at 96 (“If . . . a party has actually been charged with infringement of the patent, there is, *necessarily*, a case or controversy adequate to support jurisdiction.”). The panel discounted the significance of Qualcomm's infringement suit because it was dismissed with prejudice after Apple entered into the license agreement. Op. 3, 10. This dismissal, however, did not negate the coercive threat of infringement liability but for Apple's on-going payments under the license agreement, and thus did not eliminate the case or controversy. *Nike, Inc. v. Already, LLC*, 663 F.3d 89, 96 (2d Cir. 2011) (“As in *MedImmune*, for example, simply holding litigation in abeyance, where a party could forestall litigation indefinitely by paying licensing fees, does not eliminate the case or controversy.”).

Two independent reasons underscore why. First, under Ninth Circuit precedent, “[r]epudiation of a settlement agreement that terminated litigation pending before a court constitutes an extraordinary circumstance, and it justifies vacating the court’s prior dismissal order” under Federal Rule of Civil Procedure 60(b)(6). *Keeling v. Sheet Metal Workers Int’l Ass’n, Local Union 162*, 937 F.2d 408, 410 (9th Cir. 1991). Thus, if Apple ceased its on-going payments, Qualcomm could and likely would seek vacatur of the dismissal order. Second, under this Court’s claim preclusion precedent, Apple’s continued actions making, using, and selling the products Qualcomm accused of infringement gave rise to separate claims that “did not exist at the time of the earlier action” and thus are “not barred by res judicata.” *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1340, 1342-43 (Fed. Cir. 2012). Even if Qualcomm could not revive its claims for damages that accrued before its prior infringement suit, it could pursue at least damages for Apple’s subsequent acts making, using, and selling the same products previously accused.

The preclusive effect of the dismissal of Qualcomm’s infringement claims with prejudice is thus narrower than a final judgment of noninfringement, which further gives rise to issue preclusion. *See Aspex*, 672 F.3d at 1343-44. The dismissal of Qualcomm’s infringement claims, therefore, does not negate Article III jurisdiction over Apple’s validity claims. Even a noninfringement judgment

does not divest the Court of jurisdiction to decide a declaratory judgment counterclaim for invalidity. *Gen. Elec. Co. v. Nintendo Co.*, 179 F.3d 1350, 1356 (Fed. Cir. 1999) (citing *Cardinal Chem.*, 508 U.S. at 94, 102-103). *A fortiori*, the narrower effect of a dismissal with prejudice does not deprive this Court of jurisdiction either.³

IV. The Panel’s Rigid, Piecemeal Analysis of Apple’s Other Injuries Conflicts with *MedImmune*’s “All-the-Circumstances” Test

Finally, the panel opinion compounds its erroneous interpretation of *MedImmune*’s licensee-standing holding by analyzing each of Apple’s alleged injuries in isolation, rather than consider “whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests,” as *MedImmune* commands. 549 U.S. at 127 (quoting *Md. Cas. Co. v. Pac. Coal & Oil Co.*, 312 U.S. 270, 273 (1941)). The panel’s decision thus constitutes an unfortunate regression toward the type of rigid, patent-specific

³ Nor is this a case, as Qualcomm suggested, *see* Qualcomm Br. 1 (citing *Serta Simmons Bedding, LLC v. Casper Sleep, Inc.*, 950 F.3d 849, 852 (Fed. Cir. 2020)), where the controversy became moot based on a settlement agreement. The Apple-Qualcomm license agreement did not settle the *inter partes* reviews or the validity issues addressed therein. Appx2931. Thus, it did not moot the unresolved proceedings and issues. *See Serta*, 950 F.3d at 852 (noting that a settlement eliminates the case or controversy only “with respect to the settled issues”); *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 914 (Fed. Cir. 1992) (settlement of infringement litigation did not moot dispute over validity and priority); *see also, e.g., El Paso Nat’l Gas Co. v. United States*, 750 F.3d 863, 883-84 (D.C. Cir. 2014) (tribe’s release of certain claims against the government did not moot claims outside the scope of the release).

rules the Supreme Court has rejected not only in *MedImmune* itself, 549 U.S. at 126-27, 132 & n.11, but in numerous other contexts. *E.g.*, *eBay, Inc. v. MerExchange, L.L.C.*, 547 U.S. 388, 391, 394 (2006); *Holmes Grp., Inc. v. Vornado Air Circulation Sys.*, 535 U.S. 826, 832-34 (2002); *see also* Michael J. Burstein, *Rethinking Standing in Patent Challenges*, 83 GEO. WASH. L. REV. 498, 500 (2015) (“[T]he Federal Circuit . . . has crafted patent-specific standing rules that are more restrictive than those called for under the Supreme Court’s broader standing precedents.”).

In assessing Apple’s risk of facing an infringement suit after the license agreement expires or is terminated prior to expiration (e.g., due to non-payment), for instance, the panel invoked precedent concerning patent-challengers who not only had never been accused of infringement, but also had not yet even formed an intent to create a product that could be potentially accused of infringement. *See Op. 9; JTEKT Corp. v. GKN Auto. Ltd.*, 898 F.3d 1217, 1221 (Fed. Cir. 2018). Those are markedly different circumstances from those present here because, as the Supreme Court emphasized in *Cardinal Chemical*, “[a] company once charged with infringement must remain concerned about the risk of similar charges if it develops and markets similar products in the future.” 508 U.S. at 99-100; *see also Morton Int’l Inc. v. Cardinal Chem. Co.*, 967 F.2d 1571, 1576 (Fed. Cir. 1992) (Nies, C.J., dissenting from the orders declining suggestions for rehearing in banc)

(“Once the patentee creates a legitimate fear in an adversary that the patent will be asserted against it, nothing short of the patentee’s unconditional guarantee not to do so under any circumstances ordinarily will remove that apprehension and thereby jurisdictionally moot the claim for declaratory relief.”).

Similarly, the panel dispensed with Qualcomm’s refusal to grant Apple permanent rights in the ’037 and ’362 patents by citing *Prasco LLC v. Medicis Pharm. Corp.*, which holds that “[t]he lack of any evidence that the defendants believe or plan to assert that the plaintiff’s product infringes their patents creates a high barrier to proving that the plaintiff faces an imminent risk of injury.” 537 F.3d 1329, 1340 (Fed. Cir. 2008); *see also* Op. 10. Yet *Prasco* explicitly distinguishes the circumstances present here, where the patent-challenger stood actually accused of infringement. *Id.* The panel opinion fails to acknowledge, much less address that critical context.

Finally, the panel addressed the risk that 35 U.S.C. § 315(e) might estop Apple from raising certain invalidity arguments in any future litigation by considering only whether it “provides an *independent* basis for standing.” Op. 11 (emphasis added). Under the Supreme Court’s standing precedent, however, the relevant inquiry is not whether potential estoppel, potential future litigation, or Qualcomm’s refusal to grant permanent rights each constitute an “independent[.]” basis for standing, *id.*, but whether “*all* the circumstances,” collectively, show a

real and substantial controversy between parties with adverse interests. *Md. Cas.*, 312 U.S. at 273.

The circumstances here are that Qualcomm sued Apple for infringement of the '037 and '362 patents; that Qualcomm continues to extract ongoing payments from Apple based on an agreement Apple entered in part to avoid liability for those very claims; that the license agreement not only requires dismissal of Qualcomm's past infringement suit, but expressly provides forward-looking rights equivalent to a "covenant-not-to-sue" under "the patents at issue" conditioned on Apple's discharging its on-going payment obligations, Op. 6; Appx2930; that these rights, by design, expire before the terms of the '037 and '362 patents; that Qualcomm rejected Apple's proposal to settle the IPRs, Appx2931; and that "the parties agreed" the IPRs would instead "continue through final resolution, including appeals," *id.* In short, just as in *Altvater*, the circumstances show that a "controversy" is "raging, even apart from the continued existence of the license agreement," and that the parties' dispute goes beyond the precise claims and devices at issue in the dismissed infringement litigation. 319 U.S. at 364.

The panel's conclusion that, despite all these circumstances, Apple lacks a constitutionally-sufficient interest to challenge the '037 and '362 patents' validity circumscribes this Court's jurisdiction in a dramatic new way, contrary to the Supreme Court's consistent instructions in *MedImmune*, *Altvater*, and *Cardinal*

Chemical. It also undermines the strong public interest, embodied in the AIA's broad *inter partes* review procedures, in resolving disputed questions of patent validity. See *Cardinal Chem.*, 508 U.S. at 100 (citing *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330 (1945)); *Oil States Energy Servs., LLC v. Greene's Energy Grp.*, 138 S. Ct. 1365, 1374 (2018) (citing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016)). *En banc* review is warranted to address these errors and to correct this Court's Article III standing precedent.

CONCLUSION

The Court should grant rehearing *en banc*.

Dated: May 10, 2021

Respectfully submitted,

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ADDENDUM

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

APPLE INC.,
Appellant

v.

QUALCOMM INCORPORATED,
Appellee

2020-1561

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2018-
01279.

APPLE INC.,
Appellant

v.

QUALCOMM INCORPORATED,
Appellee

2020-1642

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2018-01252.

Decided: April 7, 2021

LAUREN ANN DEGNAN, Fish & Richardson P.C., Washington, DC, argued for appellant. Also represented in 2020-1561 by ROBERT COURTNEY, Minneapolis, MN; OLIVER RICHARDS, San Diego, CA. Also represented in 2020-1642 by CHRISTOPHER DRYER, Washington, DC; NITIKA GUPTA FIORELLA, Wilmington, DE.

MICHAEL HAWES, Baker Botts, LLP, Houston, TX, argued for appellee. Also represented in 2020-1561 by BRIAN W. OAKS, PUNEET KOHLI, Austin, TX. Also represented in 2020-1642 by CHAD C. WALTERS, Dallas, TX.

Before MOORE, REYNA, and HUGHES, *Circuit Judges*.

MOORE, *Circuit Judge*.

Apple Inc. appeals an *inter partes* review final written decision of the Patent Trial and Appeal Board holding Apple did not prove claims 1–14 and 16–18 of U.S. Patent No. 7,844,037 would have been obvious. Apple also appeals another final written decision of the Board holding Apple did not prove claims 1–6 and 8–20 of U.S. Patent No. 8,683,362 would have been obvious. Because Apple lacks standing to maintain either appeal, we *dismiss*.

BACKGROUND

Qualcomm Inc. sued Apple in the United States District Court for the Southern District of California for infringing claims of the '037 patent and the '362 patent. Apple sought *inter partes* review of claims 1–14, 16–18, and

19–25 of the '037 patent and claims 1–6 and 8–20 of the '362 patent. The Board issued final written decisions holding Apple did not prove the challenged claims in either patent would have been obvious.¹ Before the filing of these appeals, Apple and Qualcomm settled all litigation between the two companies worldwide. Based on that settlement, the parties jointly moved to dismiss Qualcomm's district court action with prejudice, which the district court granted. J.A. 2928.² Apple, nevertheless, appeals the Board's final written decisions.

DISCUSSION

“Standing to sue is a doctrine rooted in the traditional understanding of a case or controversy” required by Article III. *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1547 (2016). “[T]he irreducible constitutional minimum of standing” consists of “three elements.” *Lujan v. Defs. of Wildlife*, 504 U.S. 555, 560 (1992). An appellant “must have (1) suffered an injury in fact, (2) that is fairly traceable to the challenged conduct of the [appellee], and (3) that is likely to be redressed by a favorable judicial decision.” *Spokeo*, 136 S. Ct. at 1547 (citations omitted). To establish injury in fact, the alleged harm must be “concrete and particularized” and “actual or imminent, not conjectural or hypothetical.” *Id.* at 1548 (quoting *Lujan*, 504 U.S. at 560).

“Article III standing is not necessarily a requirement to appear before an administrative agency.” *Consumer Watchdog v. Wis. Alumni Research Found.*, 753 F.3d 1258, 1261 (Fed. Cir. 2014) (citing *Sierra Club v. E.P.A.*, 292 F.3d

¹ The Board did not institute on claims 19–25 of the '037 patent because Qualcomm statutorily disclaimed them. See 37 C.F.R. § 42.107(e).

² Citations to briefs and the joint appendix refer to submissions in the *Apple Inc. v. Qualcomm Inc.*, 20-1642 appeal.

895, 899 (D.C. Cir. 2002)). And the Patent Act permits any person “who is not the owner of the patent” to file a petition for *inter partes* review. 35 U.S.C. § 311(a). While nearly any person may seek an *inter partes* review, an appellant must “supply the requisite proof of an injury in fact when it seeks review of an agency’s final action in a federal court.” *Phigenix, Inc. v. Immunogen, Inc.*, 845 F.3d 1168, 1171–72 (Fed. Cir. 2017). Indeed, the Supreme Court has recognized that not every party will have Article III standing to appeal a Board final written decision. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143–44 (2016) (Parties that initiate an *inter partes* review “need not have a concrete stake in the outcome; indeed, they may lack constitutional standing.”).

I

As a preliminary matter, Qualcomm argues Apple waived any argument to establish its standing to file this appeal by failing to address, or submit evidence supporting, standing in its opening brief. *See, e.g.*, Appellee Br. at 1–3. In *Phigenix*, we held “an appellant must identify the relevant evidence demonstrating its standing ‘at the first appropriate’ time, whether in response to a motion to dismiss or in the opening brief.” 845 F.3d at 1173 (quoting *Sierra Club*, 292 F.3d at 900). Likewise, “if there is no record evidence to support standing, the appellant must produce such evidence at the appellate level at the earliest possible opportunity.” *Id.* These rules prevent an appellee or respondent from having to “flail at the unknown in an attempt to prove the negative.” *Sierra Club*, 292 F.3d at 901. Given the global settlement between the parties, Apple should have made its standing arguments and proffered its evidence in support of standing in its opening brief.

Our holding in *Phigenix* is not, however, an inflexible rule. *See Am. Library Ass’n v. F.C.C.*, 401 F.3d 489, 493 (D.C. Cir. 2005). We have consistently held that waiver is

a matter of discretion. *See, e.g., Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1251 (Fed. Cir. 2005) (“An appellate court retains case-by-case discretion over whether to apply waiver.”); *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 800 (Fed. Cir. 1990) (waiver is “not governed by a rigid rule but may as a matter of discretion not be adhered to where circumstances indicate that it would result in basically unfair procedure”). “While there is no general rule for when we exercise our discretion to reach waived issues, we have done so where, among other factors, ‘the issue has been fully briefed by the parties.’” *Ericsson Inc. v. TCL Commc’n Tech. Holdings Ltd.*, 955 F.3d 1317, 1322–23 (Fed. Cir. 2020) (quotation and citation omitted) (quoting *Automated Merch. Sys., Inc. v. Lee*, 782 F.3d 1376, 1379–80 (Fed. Cir. 2015)).

We exercise our discretion to reach the issue of standing because: (1) the issue of Apple’s standing is fully briefed; (2) we see no prejudice to Qualcomm; and (3) the question of standing impacts these and other appeals. In both appeals, Qualcomm sought leave to file a sur-reply addressing Apple’s evidence and arguments on standing. Qualcomm agreed that, if we grant its motions, it will not suffer any prejudice and that evaluating the evidence may resolve standing in other pending cases. *Apple Inc. v. Qualcomm Inc.*, Nos. 20-1561, 20-1642, Oral Arg. at 22:19–22:42, available at http://oralarguments.cafc.uscourts.gov/default.aspx?fl=20-1561_03032021.mp3. Accordingly, we grant Qualcomm’s motions for leave to file a sur-reply and exercise our discretion to review Apple’s arguments and evidence to establish standing. *See Ericsson*, 955 F.3d at 1323 (exercising discretion to reach waived issue that was fully briefed); *cf. Cmty. Against Runway Expansion, Inc. v. F.A.A.*, 355 F.3d 678, 685 (D.C. Cir. 2004) (excusing belated submission of standing evidence and arguments because appellee would not be prejudiced).

II

As part of the global settlement between Apple and Qualcomm, the parties executed a six-year license agreement, which included a license to the patents at issue. Apple has characterized that license agreement as a “covenant-not-to-sue,” at least with respect to the patents at issue. *See, e.g.*, Appellant’s Reply Br. at 23. And in addition to the six-year license term, there is a possibility of a two-year extension. J.A. 2930. Because the parties executed the agreement in 2019, it will expire in either 2025 or 2027.

Apple argues it has standing to appeal the final written decisions of the Board based on three distinct circumstances: (1) its ongoing payment obligations that are a condition for certain rights in the license agreement;³ (2) the threat that Apple will be sued for infringing the ’037 patent and ’362 patent after the expiration of the license agreement; and (3) the estoppel effects of 35 U.S.C. § 315 on future challenges to the validity of the ’037 patent and ’362 patent. We do not agree.

A

Relying upon *MedImmune, Inc. v. Genentech, Inc.*, 529 U.S. 118, 120 (2007), Apple argues it has standing based on its payment obligations under the license agreement. *See, e.g.*, Appellant Reply Br. at 20–22. According to Apple, *MedImmune* holds that its ongoing payment obligations as a condition for certain rights provides standing, irrespective of the other patents in the license agreement. Appellant’s Reply Br. at 21. In Apple’s view, a licensee’s obligations to pay royalties for a license to 100,000 patents would provide standing to challenge the validity of any single licensed patent, even if the validity of any one patent

³ Apple describes these rights in paragraph 4 of a declaration it submitted with its replies. *See* J.A. 2930.

would not affect the licensee's payment obligations. Oral Arg. at 4:30–5:53. We do not read *MedImmune* so broadly.

MedImmune does not require us to find standing here. In *MedImmune*, Genentech asserted that the Cabilly II patent it licensed to Medimmune covered MedImmune's new product and demanded royalty payments under the license agreement. *Id.* at 121. Although MedImmune disagreed it owed royalties because the patent was invalid and did not cover its product, it paid under protest to avoid termination of the agreement and a patent infringement action. *Id.* at 121–22. MedImmune then sought a declaratory judgment that it did not owe any royalties because the sale of its product did not infringe any valid claim of the Cabilly II patent. *Id.* at 122–23. The Supreme Court observed there was no dispute that the standing requirements “would have been satisfied if petitioner had taken the final step of refusing to make royalty payments under the [] license agreement.” *Id.* at 128. The Court held that MedImmune was not required to break or terminate the license agreement before seeking a declaratory judgment of noninfringement and invalidity. *Id.* at 137. Put simply, Medimmune was not required to cease its contract payments (opening itself to a patent suit, treble damages, attorneys' fees, and an injunction) in order to resolve its disputed contract rights (limiting the royalties to products that cover a valid patent).

Here, in contrast, Apple has not alleged that the validity of the patents at issue will affect its contract rights (i.e., its ongoing royalty obligations). This failure is fatal to establishing standing under the reasoning of *MedImmune*, whether we analyze Apple's evidence for injury in fact or redressability. Qualcomm asserts, and Apple does not contest, that the license agreement involves tens of thousands of patents. *See Appellee's Sur-Reply Br.* at 5. Apple nowhere argues or provides evidence that the validity of any single patent, including the '037 patent or '362 patent, would affect its ongoing payment obligations. Nor does

Apple identify any contractual dispute involving its ongoing royalty obligations (e.g., a disagreement over whether certain Apple product sales trigger additional royalty payments) that relates to, or could be resolved through a validity determination of, the patents at issue. Because the validity of the challenged patents would not impact Apple's ongoing payment obligations, the reasoning of *MedImmune* does not apply. Ultimately, Apple's assertions amount to little more than an expression of its displeasure with a license provision into which it voluntarily entered. Such allegations do not establish Article III standing. *Cf. In re Johnson & Johnson Talcum Powder Prod. Mktg., Sales Practices & Liab. Litig.*, 903 F.3d 278, 281 (3d Cir. 2018) (“[B]uyer’s remorse, without more, is not a cognizable injury under Article III of the United States Constitution.”). Thus, Apple has failed to establish standing based on its ongoing payment obligations.⁴

B

Apple next argues it has standing based on the possibility that Qualcomm may sue Apple for infringing the '037 patent or '362 patent after the license expires. *See e.g.*, Appellant Reply Br. at 25–26. But this possibility of suit is too speculative to confer standing. Apple provides no evidence that it intends to engage in any activity that may give rise to an infringement suit of the '037 patent or '362 patent when the license expires. Neither of the

⁴ Relatedly, Apple argues the cancellation of the '362 patent would redress its ongoing payment obligations because it would remove a significant barrier. Appellant's Reply Br. at 22. However, Apple fails to explain why the '362 patent creates a significant barrier, and we see no evidence that the cancellation of the '362 patent is *likely* to affect Apple's ongoing payment obligations. *Lujan*, 504 U.S. at 561.

declarations⁵ Apple submitted as evidence of standing even mention the patents at issue. *See* J.A. 2930–31. Nor do they set forth any plans to engage in conduct after the expiration of the license agreement that might lead to an infringement suit. For example, Apple has not provided any evidence that it has plans to make, use, offer to sell, or sell any of the products, or features thereof, accused of infringement in the district court, such as the iPhone 4, 5, 6, and 7. *See, e.g.*, J.A. 2904, 2920. In fact, Apple offers the sparsest of declarations in support of standing, which are devoid of any of the specificity necessary to establish an injury in fact. Without more, we are left to speculate about what activity Apple may engage in after the expiration of the license agreement that would give rise to a potential suit from Qualcomm. This is insufficient to show injury in fact. *Lujan*, 504 U.S. at 560 (harm must be “actual or imminent, not conjectural or hypothetical” (citation omitted)); *see also JTEKT Corp. v. GKN Auto. Ltd.*, 898 F.3d 1217, 1221 (Fed. Cir. 2018) (holding appellant lacked standing because it had not established that it had “concrete plans for future activity that creates a substantial risk of future infringement”).

To cure the deficiencies in its evidence, Apple suggested we could take judicial notice that Apple sells and will continue to sell its smart phone products. Oral Arg. at 33:45–34:19. A court may take judicial notice of a fact only when it is either “generally known” or “accurately and readily [discernible] from sources whose accuracy cannot reasonably be questioned.” FED. R. EVID. 201(b); *see B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 728 (Fed. Cir. 1988) (“Courts may take judicial notice of facts of universal notoriety, which need not be proved, and of whatever is generally known within their jurisdictions.”)

⁵ Apple submitted identical declarations as evidence of standing in both appeals.

What products and product features Apple may be selling at the expiration of the license agreement years from now are not the kind of undisputed facts we may take judicial notice of because they may be reasonably questioned. *See, e.g., In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (declining to take judicial notice of a “long-felt but unresolved need for a device that will help the blind read”). We are not fortune-tellers. Accordingly, we must decline Apple’s invitation to take judicial notice.

Apple also argues Qualcomm’s previous suit for infringement of the ’037 patent and ’362 patent provides standing, citing *Grit Energy Sols., LLC v. Oren Techs., LLC*, 957 F.3d 1309, 1320 (Fed. Cir. 2020). *See, e.g.,* Appellant Reply Br. at 23. But *Grit Energy* involved a dismissal *without* prejudice, unlike the dismissal with prejudice here. *See* J.A. 2928.

Lastly, Apple argues Qualcomm’s refusal to grant Apple an irrevocable license or other permanent rights in the ’037 patent or ’362 patent and Qualcomm’s history of asserting patents against Apple after certain royalty agreements expired provide standing. *See, e.g.,* Appellant Reply Br. at 24. Apple relies on these facts to speculate a future infringement suit might occur. But that is not enough. “The lack of any evidence that the defendants believe or plan to assert that the plaintiff’s product infringes their patents creates a high barrier to proving that the plaintiff faces an imminent risk of injury.” *Prasco LLC v. Medicis Pharm. Corp.* 537 F.3d 1329, 1340 (Fed. Cir. 2008); *see also Lujan*, 504 U.S. at 561. At best, Apple’s allegations are speculation and conjecture about Qualcomm’s proclivity to assert its patent rights generally. But they are devoid of the specificity necessary to show that Qualcomm is likely to assert these particular patents against any particular products which would be sold after the license agreement expires in 2025 or 2027. As such, Apple has failed to show an injury in fact based on potential future allegations that its products infringe the ’037 patent or the ’362 patent.

C

Finally, Apple argues that its injury is compounded by the likelihood that 35 U.S.C. § 315(e) would estop it from arguing that the '037 patent and '362 patent would have been obvious in future disputes. *See, e.g.*, Appellant Reply Br. at 24–25. To the extent Apple argues this provides an independent basis for standing, we do not agree. “We have already rejected invocation of the estoppel provision as a sufficient basis for standing.” *AVX Corp. v. Presidio Components, Inc.*, 923 F.3d 1357, 1362–63 (Fed. Cir. 2019) (citing *Phigenix*, 845 F.3d at 1175–76). Apple’s harm is particularly suspect because it has failed to show it will likely be engaging in activities that could give rise to a potential suit based on the '037 and '362 patents after the expiration of the license agreement. *See Gen. Elec. Co. v. United Techs. Corp.*, 928 F.3d 1349, 1355 (Fed. Cir. 2019) (“Where, as here, the appellant does not currently practice the patent claims and the injury is speculative, we have held that the estoppel provision does not amount to an injury in fact.”). Thus, the harm Apple may face from estoppel is insufficient to provide standing.

CONCLUSION

Because we hold Apple has failed to establish standing, we *dismiss*.

DISMISSED

COSTS

Costs to Qualcomm.

CERTIFICATE OF SERVICE AND FILING

I certify that on May 10, 2021, I electronically filed the foregoing **APPLE’S CORRECTED PETITION FOR REHEARING *EN BANC*** of Appellant Apple Inc. using the Court’s CM/ECF filing system. Counsel for appellant and appellee were electronically served by and through the Court’s CM/ECF filing system per Fed. R. App. P. 25 and Fed. Cir. R. 25(e).

/s/ Lauren A. Degnan

Lauren A. Degnan

CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2)(A). The brief contains 3890 words. This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman, 14 Point.

Dated: May 10, 2021

/s/ Lauren A. Degnan

Lauren A. Degnan