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21   UNITED STATES DISTRICT COURT

22   SOUTHERN DISTRICT OF CALIFORNIA

23 QUALCOMM INCORPORATED, | CASE NO. 3:17-cv-02398-DMS-MDD

24   Plaintiff, | **QUALCOMM'S MEMORANDUM
                                    | OF POINTS AND AUTHORITIES
25   vs. | IN SUPPORT OF MOTION TO
                                    | ASSERT ADDITIONAL CLAIMS
26 APPLE INCORPORATED, | IN ITS PRELIMINARY
                                    | INFRINGEMENT CONTENTIONS
27   Defendant. |
                                    | Date:
28 | Time:

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Place: Courtroom 13A

Judge: Dana M. Sabraw

I.   Introduction

Plaintiff Qualcomm Incorporated ("Qualcomm") requests leave to assert infringement of twelve total claims in this case. Qualcomm's proposal affords it two claims more than the ten currently allotted by the Court's Case Management Order. (Doc. No. 98 at 2)

Qualcomm's request is supported by good cause. Two additional claims imposes an insignificant amount of additional work, but could have a significant impact on the case. Without those claims, distinct improvements over the prior art may be left out of the case for Apple to continue willfully infringing. Allowing Qualcomm to assert three claims from each of the '356, '674, '002, and '633 Patents affords Qualcomm the opportunity to assert an independent claim with protecting dependents from each patent that remains at issue in this case. In order to balance the burden on the Court and Apple, Qualcomm has agreed **not** to assert any claims of the '336 Patent. Thus, Qualcomm's proposal is in keeping with the Court's directive to narrow the case.

II.   Factual and Procedural Background

On November 29, 2017, Qualcomm filed its Complaint in this Action asserting infringement of forty-six claims of five patents : U.S. Patent No. 9,154,356 ("the '356 patent"), U.S. Patent No. 9,473,336 ("the '336 patent"), U.S. Patent No. 8,063,674 ("the '674 patent"), U.S. Patent 7,693,002 ("the '002 patent"), and U.S. Patent No. 9,552,633 ("the '633 patent"). The Asserted Patents relate to components of mobile devices (such as the accused iPhones and iPads) that enhance signal processing, improve power management, and enhance photographic images taken on the device. The Complaint provides details of Qualcomm's infringement theories and demonstrates that the claim elements are present in at least the Apple iPhone 7, Apple iPhone 7 Plus, Apple iPhone 8, Apple iPhone 8 Plus, and Apple iPhone X.

On November 30, 2017, Qualcomm filed a Complaint with the International Trade Commission regarding Apple's infringement of the same patents in suit. The

1 Complaint was instituted as Investigation No. 337-TA-1093 on January 3, 2018. That

2 Investigation remains ongoing. Fact discovery closes on May 29, 2018 and expert

3 discovery closes on July 13, 2018. There is no narrowing order in that case and the

4 parties continue to litigate fifty asserted claims.

5   On March 1, 2018, the Court held a case management conference in this matter

6 and, thereafter, issued a Case Management Order. The Case Management Order

7 directs Qualcomm to select no more than two claims per patent or no more than ten

8 claims total for its infringement contentions. In view of the Court's Order, Qualcomm

9 has identified the following claims to be litigated in this Action:[1]

'356 Patent	Claims 1, 8, and 11
'674 Patent	Claims 1, 5, and 12
'002 Patent	Claims 2, 17, and 37
'633 Patent	Claims 3, 22, and 29

17   Qualcomm requests leave to assert three claims from each of the '356 patent,

18 the '674 patent, the '002 patent, and the '633 patent. To balance its request,

19 Qualcomm will not include any asserted claims of the '336 Patent. Thus, in total,

20 Qualcomm is only seeking to assert 12 total claims in this case.[2]

21   As of the date of this filing, Apple has not taken a position on whether it will

22 oppose Qualcomm's request for leave to assert two additional claims. (Clark Decl.

23 Ex. A.)

24 **III.   Argument**

25

26 [1]   In the event that the Court does not grant leave to assert twelve claims,
27 Qualcomm will not asset claim 5 of the '674 patent or claim 8 of the '356 patent.

28 [2]   In another case before this Court, Case No. 17-1375, Apple is asserting twelve

1   Allowing Qualcomm to assert 12 claims across the narrowed set of four patents

2 is fair and reasonable. This reflects almost a 75% reduction (from forty-six to twelve)

3 in the number of claims originally asserted in Qualcomm's Complaint. Qualcomm's

4 request to assert just three claims per patent across four patents reflects a good faith

5 effort at significantly narrowing the issues in this dispute as contemplated by the

6 Court's Case Management Order.

7   Allowing Qualcomm to assert three claims from each of the '356 patent, the

8 '674 patent, the '002 patent, and the '633 patent is a minor increase that will not

9 prejudice Apple, but is important for ensuring that the unique features of Qualcomm's

10 inventions that Apple has infringed and continues to willfully infringe are reflected in

11 this case. For the '356 patent, the '674 patent, and the '633 patent, Qualcomm is only

12 seeking to assert one independent claim and two dependent claims. For the '002

13 patent Qualcomm would assert two independent claims and one dependent. Each

14 asserted claim reflects a unique aspect of Qualcomm's inventions and therefore have

15 unique value to Qualcomm's causes of action. This is particularly true because Apple

16 may introduce new non-infringement theories or evidence that it did not disclose in

17 the ITC Action. Similarly, Qualcomm does not – and cannot – know at this stage how

18 Apple will value or attempt to limit damages and other remedies in this case.

19   Similarly, while Qualcomm has some sense of the prior art that Apple may rely

20 on to challenge the validity of Qualcomm's claims, Apple is no bound by its election

21 of prior art in the parallel ITC Action. Requiring Qualcomm to further reduce the

22 number of asserted claims at this stage prior to Apple's provision of narrowed

23 invalidity contentions would be highly prejudicial to Qualcomm. In addition, based

24 on the alleged prior art identified in the ITC Action, Qualcomm believes that each of

25 the proposed claims offer unique distinctions over the prior art and are supported by

26 specific evidence of willful infringement.

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