UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple, Inc.,
Petitioner,

v.

Qualcomm Incorporated,
Patent Owner

Case IPR2018-01249
U.S. Patent No. 7,693,002

PATENT OWNER SUR-REPLY

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I. Introduction

Petitioner's reply introduces unpersuasive and belated arguments and evidence that cannot salvage the petition. Sato does not meet the "clock signal" limitation of the claims, as properly construed, and Petitioner failed to present an adequate motivation to combine Asano and Itoh. The Board should confirm the patentability of claims 1-28 and 31-37.

II. Claim Construction – "Clock Signal"

A. Petitioner's Criticism Of Dr. Pedram's Testimony Is Misplaced

In his expert declaration supporting Qualcomm's response, Dr. Pedram provided extensive testimony showing that the term "clock signal" should be interpreted as "a periodic signal used for synchronization." Ex. 2001 at 53-70. The reply argues that "Dr. Pedram's opinion on the BRI of the term 'clock signal' … should be accorded little weight" because he has not provided testimony on the full scope of the claims. Paper 15 at 2-3.

Petitioner's criticism is misplaced. The reply cites no legal authority for the proposition that an expert must consider and testify as to the full scope of claims in order to opine on the meaning of certain claim terms. In preparing his expert declaration, Dr. Pedram considered and testified as to a number of discrete issues: (i) the meaning of the term "clock signal," and (ii) whether Petitioner's unpatentability grounds render obvious the challenged claims. *See generally*

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Ex. 2001. None of these issues required consideration of the "exact scope of the claims."[1]

B. Qualcomm's Construction Is Not Inconsistent With The Conditional Clock Outputs Of The '002 Patent

The reply argues that because the challenged claims require a first logic and/or conditional clock generator that applies a clock signal to a selected one of multiple clock outputs, Qualcomm's "interpretation of the term 'clock signal' is too narrow to even encompass the clock signals carried by 'clock outputs' of the '002 patent claims." Paper 15 at 3-4.

Petitioner's argument is based on the unfounded assumption that in the '002 patent, *all of the clock outputs* of the conditional clock generator *are always carrying a clock signal*. But they are not. In fact, the specification repeatedly makes clear that "[t]he conditional clock generator 110 receives a clock signal via the clock input 118 and selectively applies the clock signal to a *selected one* of the clock outputs 124, 126, 128 and 130" (Ex. 1001 at 3:28-31), and that

[1] The reply also criticizes Dr. Pedram as lacking understanding of the law of obviousness, citing a statement in his declaration that is allegedly contrary to the Supreme Court's decision in *KSR*. Paper 15 at 27-28. Qualcomm disputes this criticism. As Dr. Pedram made clear at deposition, his understanding of obviousness is not limited to the legal standards recited in his declaration. *See* Ex. 1019 at 36:6-15. Thus, even assuming that the declaration contains a misstatement regarding the law of obviousness, this does not show that Dr. Pedram lacks a sufficient understanding of the law.

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