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'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE EVIDENCE

I. INTRODUCTION

Patent Owner, Qualcomm Incorporated ("Qualcomm"), opposes Petitioner's Motion to Exclude Evidence (Paper 19). Petitioner, Apple, Inc. ("Apple"), has not met its burden of establishing that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c). Apple's motion to exclude Exhibit 2004 should be denied for the reasons that follow.

II. BACKGROUND

Dr. Alpert is not as far removed from this proceeding as Apple implies in its motion. *See* Paper 19 at 1-3. In reality, Dr. Alpert served as Apple's expert in the ITC investigation against Qualcomm for the same patent at issue here, U.S. Patent No. 7,693,002 ("the '002 patent"). *See* ITC-337-TA-1093. Accordingly, Apple has already recognized him as a person of ordinary skill in the art (POSA).

And while Qualcomm agrees that Dr. Alpert's testimony in IPR2015-00148 relates to the construction of the term "clock"—a different (and broader) term than "clock signal" at issue in these proceedings—Apple's argument on the relevancy of such testimony is disingenuous. Apple itself relied on dictionary definitions of "clock" in arguing for its unduly broad construction of "clock signal." *See* Paper 15, at 7-11. Exhibit 2004 merely shows that Apple's ITC expert previously construed the same term, "clock," more narrowly. This inconsistent testimony by a POSA is relevant to Apple's reliance on its definition for "clock," and as such, should not be

excluded.

III. ARGUMENT

A. Exhibit 2004 Is Not Offered As Expert Testimony

Rule 702 on the admissibility of expert testimony is inapplicable here. Qualcomm does not offer Exhibit 2004 as expert testimony—the contents of Exhibit 2004 were prepared for a different proceeding, as Apple notes. Rather, Qualcomm provides this exhibit as extrinsic evidence that Apple's proposed definition for a term is not the broadest reasonable interpretation as understood by a POSA. Because Exhibit 2004 is not being provided as expert testimony, Apple's arguments under Rule 702 are irrelevant.

B. Exhibit 2004 Is Not Offered For The Truth Of The Matter Asserted

Exhibit 2004 is not hearsay because it is being offered for what it describes, not for the truth of its disclosures. As Apple recognizes, Dr. Alpert's testimony relates to the meaning of the claim term "clock" from a different patent than that of this proceeding. Qualcomm does not offer Dr. Alpert's testimony for the truth of the matter asserted, *i.e.*, Dr. Alpert's conclusions about the meaning of "clock" in the '122 patent. Rather, his testimony is evidence that Qualcomm's reliance on the IEEE dictionary definition would not be unreasonable to a POSA, as Dr. Alpert relied on the same definition for a similar term.

Indeed, evidence proffered to show its effect on a POSA or the belief of a

POSA is not hearsay. *Neev v. Abbott Med. Optics, Inc.*, No. 09-146 RBK, 2012 WL 1066797, at *14 (D. Del. Mar. 26, 2012) ("Statements in a reference offered for their effect on one of ordinary skill in the art are not hearsay.") (citing *Abbott Labs v. Diamedix Corp.*, 969 F. Supp. 1064, 1066 n.1 (N.D. Ill. 1997)); *see also EMC Corp. v. PersonalWeb Techs., LLC*, IPR2013-00084, 2014 WL 2090663, at *26 (PTAB May 15, 2014) (finding a "'prior art document submitted as a 'printed publication' under 35 U.S.C. § 102(a) is offered simply as evidence of what it described, not for proving the truth of the matters addressed in the document'") (internal citations omitted). Because Exhibit 2004 is simply being offered as evidence of what a POSA would have understood at the relevant time, and not for the truth of the matter asserted, it should not be excluded as hearsay.

C. Exhibit 2004 Is Relevant

Qualcomm agrees Exhibit 2004 concerns a different claim term and patent than at issue in this proceeding. But that does not mean the exhibit is irrelevant. Dr. Alpert's analysis set forth in Exhibit 2004 is directed to the term "clock"—the very same term Apple defines in its Reply. *See* Paper 15, at 7-11. Yet Apple provides a broader meaning for the term than that described by Dr. Alpert. Thus, Dr. Alpert's testimony is plainly relevant to the meaning of the claim term as understood by a POSA.

The degree to which the '122 patent and Dr. Alpert's testimony relate to the

patent at issue in this proceeding goes to the ***weight*** afforded this evidence—not to its admissibility. And, as the Board has emphasized, "there is a strong public policy for making all information filed in an administrative proceeding available to the public." *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00010, Paper 59 at 40 (PTAB February 24, 2014). Accordingly, Exhibit 2004 should not be excluded.

IV. CONCLUSION

For the reasons discussed above, Qualcomm respectfully requests that the Board deny Petitioner's Motion to Exclude Evidence.

Respectfully submitted,

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