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14 **UNITED STATES DISTRICT COURT**
15 **SOUTHERN DISTRICT OF CALIFORNIA**

16 QUALCOMM INCORPORATED,
17

18 Plaintiff,

19 vs.

20 APPLE INC.,

21 Defendant.

CASE NO. 3:17-cv-2403-CAB-MDD

**APPLE INC.'S INVALIDITY
CONTENTIONS**

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1 Pursuant to this Court’s Case Management Order (Dkt. No. 102) and Patent
2 L.R. 3.3, 3.4, and 3.6, Defendant Apple Inc. (“Apple”) hereby submits to
3 Qualcomm Incorporated (“Qualcomm”) the following Invalidity Contentions with
4 respect to the patent claims identified by Qualcomm in its Patent L.R. 3.1
5 Disclosure of Asserted Claims and Infringement Contentions served on March 2,
6 2018. According to Qualcomm, the asserted claims are claims 1, 2, 5, 9, 11, 12,
7 and 16 of U.S. Patent No. 8,683,362 (“the ’362 patent”), claims 1, 2, 7, 8, 10, 11,
8 and 13 of U.S. Patent No. 8,497,928 (“the ’928 patent”), claims 1, 2, 3, 4 of U.S.
9 Patent No. 8,665,239 (“the ’239 patent”), claims 1, 7, 10, 12, 13, 14, 16, 18, 21, and
10 22 of U.S. Patent No. 9,203,940 (“the ’940 patent”), and claims 1, 7, 8, 9, 22, 24 and
11 25 of U.S. Patent No. 7,844,037 (“the ’037 patent”) (collectively, “Asserted
12 Claims”).

13 **I. RESERVATION OF RIGHTS**

14 The Patent Local Rules and the Court’s Case Management Order contemplate
15 that these Invalidity Contentions would be prepared and served in response to
16 Qualcomm’s Infringement Contentions. However, Qualcomm’s Infringement
17 Contentions are insufficient because they lack proper and complete disclosure as to
18 how Qualcomm contends that Apple allegedly infringes the Asserted Claims,
19 including but not limited to the deficiencies identified in Apple’s correspondence to
20 Qualcomm on March 23, 2018. Due to Qualcomm’s failure to provide proper and
21 complete disclosure of its Infringement Contentions under Patent L.R. 3.1, Apple
22 reserves the right to seek leave from the Court to modify, amend, and/or supplement
23 these Invalidity Contentions should Qualcomm be allowed by the Court to correct,
24 clarify, amend, and/or supplement its Infringement Contentions, or their inherent
25 claim constructions, or following the Court’s claim construction.

26 Prior art not included in these Invalidity Contentions, whether known or not
27 known to Apple, may become relevant. In particular, Apple is currently unaware of
28 the extent, if any, to which Qualcomm will contend that limitations of the claims of

1 the Asserted Patents are not disclosed in the prior art identified in these Invalidity
2 Contentions. Accordingly, Apple reserves the right to identify other references that
3 would disclose the allegedly missing limitation(s) of the claimed method, device, or
4 system.

5 Such prior art may be discovered during fact and/or expert discovery. In
6 addition to the references listed below and in the accompanying exhibits, Apple may
7 rely upon the patents themselves, references cited in the prosecution histories of the
8 Asserted Patents, any additional references identified by Qualcomm, and the
9 testimony of any named inventors or others involved in the prosecution of the
10 patents-in-suit. Identification of elements or limitations in the contentions and the
11 accompanying exhibits is exemplary, not exhaustive or limiting. Accordingly,
12 Apple contentions set forth below and in the attached exhibits are subject to
13 modification, amendment, withdrawal, and/or supplementation, including by adding
14 prior art, as new information, through discovery or other investigation, becomes
15 available.

16 These contentions are based on Apple's investigations to date that are
17 continuing and ongoing. Apple reserves the right to modify, amend, withdraw,
18 and/or supplement these contentions within a reasonable time after Qualcomm
19 meets its discovery obligations. Apple further reserves the right to modify, amend,
20 withdraw, and/or supplement these contentions in light of any invalidity contentions
21 served by either Apple in this case or the parties in any other lawsuits involving one
22 or more of the Asserted Patents.

23 For purposes of these Invalidity Contentions, Apple identifies prior art
24 references and provides element-by-element claim charts based in part on the
25 apparent constructions of the Asserted Claims advanced by Qualcomm in its
26 Infringement Contentions. For purposes of these Invalidity Contentions, Apple may
27 adopt alternative, and even inconsistent, claim-construction positions. Nothing

28 stated herein shall be treated as an admission or suggestion that Apple agrees with

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