

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Apple Inc.,  
Petitioner

v.

Qualcomm Inc.,  
Patent Owner

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*Inter Partes* Review No. IPR2018-01279  
U.S. Patent 7,844,037

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**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO  
MOTION TO AMEND UNDER 37 C.F.R. § 42.121**

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**TABLE OF AUTHORITIES**

<b>Cases</b>	<b>Page(s)</b>
<i>Apple Inc., et al. v. Valencell, Inc.</i> , IPR2017-00321, Paper 44 (PTAB June 5, 2018) .....	9
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i> , IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019).....	9

**EXHIBIT LIST**

<b>Patent Owner's Exhibits</b>	
2001	Disclaimer in Patent Under 37 CFR 1.321(a)
2002	U.S. Patent No. 6,219,413 to <i>Burg</i>
2003	Declaration of Puneet Kohli
2004	Declaration of Dr. Kevin Jeffay
2005	CV of Dr. Kevin Jeffay
2006	Transcript of Dr. Narayan Mandayam's Deposition
2007	U.S. Patent No. 8,737,578
2008	Prosecution History for '578 Patent
2009	Apple's Invalidity Contentions
2010	Exhibit E to Apple's Invalidity Contentions
2011	U.S. Pub. No. 2004/0127263 to Vegh
2012	U.S. Patent No. 6,484,027 to Mauney
2013	U.S. Patent No. 6,253,075 to Beghtol
2014	U.S. Pub. No. 2002/0132608 to Shinohara
2015	U.S. Pub. No. 2004/0185885 to Kock
2016	U.S. Pub. No. 2002/0084549 to Yang
2017	EP 1263201 A2 to Hoersten
2018	Sascha Segan, "Coming Attractions-Nokia's Latest Camera Phone," PCMag at 22
2019	Nokia 6682 User Guide (May 4, 2005) ("Nokia 6682 User Guide")

...

2020	Sascha Segan, “Nokia 6682,” PCMag (June 27, 2005)
2022	“IEEE 100: The Authoritative Dictionary of IEEE Standards Terms” (7th ed. 2000)
2023	Merriam-Webster’s Collegiate Dictionary (10th ed. 1997)
2024	Newton’s Telecom Dictionary, 16 <sup>th</sup> Updated, Expanded and Much Improved Edition
2025	Oral Deposition of Jeremy R. Cooperstock, Ph.D. dated October 22, 2019, Apple Inc. vs. Qualcomm Incorporated

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