#### 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

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

PATENT OWNER SUR-REPLY IN SUPPORT OF PATENT OWNER RESPONSE PURSUANT TO 37 C.F.R. § 42.120



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I.	INTR	ODUCTION1	
II.	CLAIM CONSTRUCTION		
	A.	"prompting a user of the first computing device"1	
		1. Petitioner Does Not and Can Not Rebut That The Patentee Disclaimed "Embodiments Where No Reply Option Is Provided"	
		2. Patent Owner's Construction Is Not Only Entirely Consistent With The Specification And The Prosecution History, But It Is Mandated By The Intrinsic Record	
		3. Patent Owner's Construction Is Supported by the extrinsic record	
	B.	"composing" 12	
III.		TIONER FAILS TO DEMONSTRATE THAT ANY OF THE LLENGED CLAIMS ARE UNPATENTABLE15	
	A.	Neither <i>Makela</i> nor <i>Moran</i> , alone or in combination, disclose, teach, or suggest the claimed "prompting a user of the first computing device," as recited in claim 1	
	В.	Neither <i>Makela</i> nor <i>Moran</i> , alone or in combination, disclose, teach, or suggest the claimed "in response to receiving the incoming call, prompting a user of the first computing device to enter user input that instructs the first computing device to handle the incoming call by composing a message," as recited in claim 1	
	C.	Neither <i>Makela</i> nor <i>Moran</i> , alone or in combination, disclose, teach, suggest, or render obvious the "automatically addressing the message to the second computing device," as recited in claim 116	
	D.	Petitioner's arguments regarding the dependent claims 2-14 and 16-18 likewise lack merit	
	E.	Petitioner has failed to show the absence of impermissible hindsight underlying its arguments	
IV.	CON	CLUSION21	



## **TABLE OF AUTHORITIES**

CASES	Page(s)
Arendi S.A.R.L. v. Google LLC, 882 F.3d 1132 (Fed. Cir. 2018)	6, 7, 8, 9
Eon Corp. IP Holdings v. Silver Spring Networks, 815 F.3d 1314 (Fed. Cir. 2016)	7
In re Magnum Oil Tools Int'l, Ltd., 829 F.3d 1364 (Fed. Cir. 2016)	20
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)	20
Microsoft Corp. v. Proxyconn, Inc., 789 F.3d 1292 (Fed. Cir. 2015)	15
NHK Spring Co., Ltd., IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)	1
Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	6
Trs. of Columbia Univ. v. Symantec Corp., 811 F.3d 1359 (Fed. Cir. 2016)	7
WBIP, LLC v. Kohler Co., 829 F.3d 1317 (Fed. Cir. 2016)	19
STATUTES	
26 U.S.C. 8 216(a)	20



## **EXHIBIT LIST**

Patent Owner's Exhibits		
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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