

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 INCORPORATED,  
Patent Owner.

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IPR 2018-01279  
Patent 7,844,037 B2

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Record of Oral Hearing  
Held: November 20, 2019

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Before DANIEL N. FISHMAN, MICHELLE N. WORMMEESTER, and  
SCOTT B. HOWARD, *Administrative Patent Judges*.

IPR 2018-01279  
Patent 7,844,037 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

KARL RENNER, ESQUIRE  
DAN SMITH, ESQUIRE  
Fish & Richardson, P.C.  
1000 Maine Avenue, SW Suite 1000  
Washington, D.C. 20024  
renner@fr.com

ON BEHALF OF THE PATENT OWNER:

BRIAN W. OAKS, ESQUIRE  
PUNEET KOHLI, ESQUIR  
Baker Botts, LLP  
1500 San Jacinto Center  
98 San Jacinto Boulevard  
Austin, Texas 78701-4078  
brian.oaks@bakerbotts.com

ALSO APPEARING:

DAVID GREENFIELD  
MIKE TAVEIRA  
Qualcomm Incorporated

The above-entitled matter came on for hearing on Wednesday, November 20, 2019, commencing at 9:28 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

PROCEEDINGS

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1  
2  
3 THE USHER: All rise.

4 JUDGE WORMMEESTER: Good morning. We have our final  
5 hearing in Case IPR2018-01279, Apple, Inc., v. Qualcomm Incorporated,  
6 which concerns U.S. Patent Number 7,844,037.

7 I'm Judge Wormmeester. Judges Howard and Fishman are appearing  
8 remotely. Let's get the parties' appearances, please. Who do we have for  
9 Petitioner?

10 MR. RENNER: Thank you. And good morning, Your Honors. Karl  
11 Renner for Apple; and I'm joined by Dan Smith, who is one of our  
12 principals. In terms of the hearing, if we could reserve 20 minutes.

13 JUDGE WORMMEESTER: Twenty minutes, okay.

14 MR. RENNER: Thank you. Your Honor, may I approach with a  
15 copy of the --?

16 JUDGE WORMMEESTER: Sure. And who will be presenting  
17 today?

18 MR. RENNER: Both Mr. Smith and myself.

19 JUDGE WORMMEESTER: Okay. Thank you.

20 MR. OAKS: Good morning, Your Honors. Brian Oaks for Patent  
21 Owner, Qualcomm, with me also is my colleague from Baker Botts, Puneet  
22 Kohli. And also from the client, Qualcomm, we have David Greenfield and  
23 Mike Taveira. Thank you, Your Honors.

24 JUDGE WORMMEESTER: Thank you. And did you want to  
25 reserve time? Or you can tell me later.

1 MR. OAKS: Yeah. I would like to reserve 10 minutes when I start,  
2 yes.

3 JUDGE WORMMEESTER: Ten minutes?

4 MR. OAKS: Yes.

5 JUDGE WORMMEESTER: Welcome. We set forth today's  
6 procedure in our Trial Order, but just to remind everyone the way this will  
7 work. Each party will have 60 minutes to present arguments. Petitioner has  
8 the burden and will go first, and may reserve time for rebuttal, which I  
9 understand is 20 minutes. Patent Owner will then have the opportunity to  
10 present its response, and may also reserve time for sur-rebuttal, which I  
11 understand is 10 minutes.

12 Please remember that Judges Howard and Fishman will be unable to  
13 hear you unless you speak into the microphone. And when referring to any  
14 demonstratives please state the slide numbers so they can follow along.  
15 Please also remember that the demonstratives you submitted are not part of  
16 the record. The record of the hearing will be the transcript.

17 We will give you a warning when you're reaching the end of your  
18 argument time. Are there any questions before we proceed? Okay. I've set  
19 the clock for 40 minutes, and you'll get a five-minute warning. Pardon?  
20 Okay. When you're ready.

21 MR. RENNER: Your Honors, again, Karl Renner on behalf of Apple.  
22 In this case the dispute is centered on just a few issues. So if you can turn to  
23 slide 2, please?

24 With respect to the original claims we'll address three issues in  
25 particular, the first two issues deal with claim construction, and the first of  
26 those deal with the prompting limitation, the second being a composing

1 limitation. Qualcomm proposes an unjust narrowing of prompting, and they  
2 ask you to inject limitations that are not recited by the claims, but are  
3 undisclosed -- and that aren't disclosed by the specification as it relates to the  
4 embodiments relied upon.

5 The composing limitation is where Qualcomm, they seek a  
6 construction that defies the plain meaning of the term, as well as the  
7 terminology that they chose to include in their dependent claims that depend  
8 upon the claim limitation.

9 And finally, the third limitation on the original claims deals with the  
10 mapping of the limitations. Here, we'll talk about how the challenged claims  
11 are fully satisfied with the Makela and the Moran combinations, as those  
12 were set forth by Apple, and it's important to understand the combination  
13 that Apple put forth. Not the straw man that was put up against by  
14 Qualcomm.

15 Slide 3, please. Now, Mr. Smith will be talking about the original  
16 claims and the issues I just mentioned, and I'll follow him by talking about  
17 the substitute claims today. And in those we'll also have three limitations,  
18 the three issues that we're talking about. One will be the impermissible  
19 broadening of the claimed terms through the substitution, or the amendments  
20 that are offered.

21 The second will be responsiveness, and this will be talked about in  
22 two dimensions, one is the burden that the motion party, the motion party,  
23 Qualcomm, carries and their inability to satisfy that burden, as well as their  
24 lacking attempt to do so in the original motion to amend.

25 Finally, we'll talk about the advanced combination here too, and in  
26 this case we'll talk not only about the combination that was put forth by

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