

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,

Petitioner

v.

QUALCOMM INCORPORATED,

Patent Owner

Case IPR2018-01281

U.S. Patent No. 8,768,865

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY

TABLE OF CONTENTS

| | Page |
|--------------------------------------------------------------------------------------------------------------------------------------------------|-------------|
| I. INTRODUCTION | 1 |
| II. CLAIM CONSTRUCTION | 3 |
| A. “Pattern” | 3 |
| B. “Fixing ... by Associating ...” | 5 |
| 1. <i>Petitioner Cannot Justify Deleting the “Fixing” Phrase</i> | 5 |
| 2. <i>Qualcomm’s Construction Sets Forth the Meaning of “Fixing” Used by the Specification</i> | 7 |
| 3. <i>Petitioner Identifies No Legitimate Criticism of Qualcomm’s Construction</i> | 8 |
| 4. <i>Subsequent Pattern Recognition Efforts May Indicate that Fixing Did Not Occur</i> | 12 |
| 5. <i>Qualcomm’s Construction Does Not Contradict Its Litigation Positions</i> | 13 |
| III. PETITIONER RELIES UPON ALLEGED EEMSS USE OF TABLE 1 OF WANG NOT DISCLOSED IN WANG..... | 14 |
| A. Wang Does Not Disclose EEMSS Using “Both” the XML State File and Table 1 to Identify States | 14 |
| B. Petitioner’s New Reliance on the EEMSS XML File is Untimely and Fails to Present a Complete Mapping..... | 19 |
| C. Petitioner Therefore Fails to Demonstrate Both “Identifying a First Pattern ...” and “Fixing ... by Associating” Under Any Construction | 20 |
| IV. PETITIONER FAILS TO DEMONSTRATE “FIXING ... BY ASSOCIATING ...” UNDER QUALCOMM’S CONSTRUCTION | 20 |
| V. PETITIONER FAILS TO SHOW CAUSATION BETWEEN ALLEGED FIXING AND REDUCTION OF VARYING PARAMETERS..... | 24 |
| VI. CONCLUSION..... | 28 |

TABLE OF AUTHORITIES

| | Page(s) |
|------------------------------------------------------------------------------------------------------------|----------------|
| Cases | |
| <i>Apple Inc. v. Papst Licensing GMBH & CO. KG</i> , IPR2016-01842, Paper 35, 2018..... | 15 |
| <i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)..... | 16 |
| <i>Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.</i> , 222 F.3d 951 (Fed. Circ. 2000)..... | 10 |
| <i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016) | 19 |
| <i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007) | 10 |

PATENT OWNER'S EXHIBIT LIST

| No. | Description |
|------------|-------------------------------------------------------------------------------------|
| 2001 | U.S. Provisional Application No. 61/434,400 (Incorporated by Reference by Ex. 1001) |
| 2002 | omitted |
| 2003 | Transcript of Deposition of James Allen (April 25, 2019) |
| 2004 | Declaration of John Villasenor |
| 2005 | omitted |
| 2006 | CV of John Villasenor |
| 2007 | omitted |

I. INTRODUCTION

Petitioner's Reply does not—and cannot—dispute the key factual points that demonstrate that: (1) Petitioner's construction of “fixing ... by associating ...” is wrong (and Qualcomm's is correct) and (2) Petitioner's mapping of the Challenged Claims to Wang is based on functionality Wang does not actually disclose. Unable to dispute these key facts, Petitioner resorts to making inaccurate characterizations of Qualcomm's Response and proposing new, untimely, mappings that are, again, grounded in functionality Wang does not actually disclose.

First, Petitioner does not dispute its own expert's testimony that “the specification uses ‘associating’ as a substep of the process of fixing” and that “associating” can be used to “achieve many different goals.” Ex. 2003 at 49:25-50:9; 51:20-23. These facts, not in the record at the time of the Institution Decision, lead to the conclusion the recited “associating ...” need not result in “fixing” As the Institution Decision explained, the plain claim language “limits the claim to fixing the parameters only by the action of associating.” Decision at 17 (emphasis omitted). Petitioner's construction does not “limit[] the claims to fixing” and is, therefore, wrong.

Thus, it is necessary to assign meaning to “fixing”—and Qualcomm is the only party offering any meaning. Petitioner does not—and cannot—identify any portion of the '865 Patent Specification that is inconsistent with Qualcomm's

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