Paper No. 6

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

QUALCOMM INCORPORATED'S
PATENT OWNER PRELIMINARY RESPONSE

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37 C.F.R. § 42.107 1

Pursuant to 37 C.F.R. § 42.107, Patent Owner Qualcomm Incorporated ("Qualcomm") submits this Preliminary Response to Apple, Inc.'s Petition for *Inter Partes* Review ("IPR") of U.S. Patent 8,768,865 (the "'865 Patent") (Paper 1).

I. INTRODUCTION

The Petition fails to address all elements of the Challenged Claims. Specifically, Petitioner fails to allege that any cited art discloses "***fix[ing] a subset of varying parameters associated with said first pattern***," which appears in each of the independent Challenged Claims.[1] Petitioner avoids addressing this limitation by removing it from the claims under the guise of claim construction.

Petitioner's proposed construction does not interpret the claim language. Rather, it leaves the plain language unchanged—other than deleting a limitation that Petitioner cannot show is in the prior art—as is apparent from comparing in redline the proposed "construction" to the actual claim language:

> ~~**fixing a subset of varying parameters associated with said first pattern by**~~ associating at least one parameter of **a** ~~**said**~~ subset of varying parameters with said first pattern to represent said at least one detected condition

[1] Petitioner challenges Claims 1-10, 12-30, and 46-53, each of which is or depends from one of Claims 1, 21, or 46.

Petitioner's "construction" is not a reasonable interpretation. It violates the basic claim construction doctrine of giving meaning to all words in a claim. It also ignores the intrinsic record, which emphasizes "fixing" as a key concept, and uses "associating" as a basic computer science operation that could be used in countless contexts. The plain language of the claim requires both that "fixing" is performed and that "associating" be used in performing the "fixing." There is no basis for Petitioner's neglect of the first requirement. Petitioner's construction materially alters the claim by removing the first requirement, such that any association—even one that does not result in "fixing"—would be sufficient. It is not.

Petitioner does not purport to show "fix[ing] a subset of varying parameters associated with said first pattern" in the prior art. Instead, the Petition relies exclusively on the removal of "fixing" via its proposed claim construction: "***As construed above,*** [the fixing] limitation is met by ***associating***. . . ." Petition at 24 (emphases added); *see also id.* at 25 ("Wang discloses the fixing limitation ***because it discloses associating***. . .") (emphasis added). Nothing in the Petition suggests Wang discloses "fix[ing] a subset of varying parameters associated with said first pattern," nor does it. Thus, Petitioner fails to show all claim elements are met by the prior art. Institution should therefore be denied.

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