

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

MONTEREY RESEARCH, LLC,

Plaintiff,

v.

**QUALCOMM INCORPORATED,
QUALCOMM TECHNOLOGIES, INC.,
AND QUALCOMM CDMA
TECHNOLOGIES ASIA-PACIFIC PTE
LTD,**

Defendants.

Civil Action No. 19-2083-NIQA-LAS

Jury Trial Requested

QUALCOMM'S INVALIDITY CONTENTIONS

IPR2021-00167

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EXHIBITS AND APPENDICES

Appendix A (A1-A15)	Invalidity claim charts for U.S. Patent No. 6,459,625
Appendix B (B1-B5)	Invalidity claim charts for U.S. Patent No. 6,534,805
Appendix C (C1-C7)	Invalidity claim charts for U.S. Patent No. 6,642,573
Appendix D (D1-D18)	Invalidity claim charts for U.S. Patent No. 6,651,134
Appendices E (E1-E7)	Invalidity claim charts for U.S. Patent No. 6,680,516
Appendix F (F1-F10)	Invalidity claim charts for U.S. Patent No. 6,765,407
Appendix G (G1-G9)	Invalidity claim charts for U.S. Patent No. 7,572,727
Appendix H (H1-H9)	Invalidity claim charts for U.S. Patent No. 7,977,797
Appendix OA	Obviousness references for U.S. Patent No. 6,459,625
Appendix OB	Obviousness references for U.S. Patent No. 6,534,805
Appendix OC	Obviousness references for U.S. Patent No. 6,642,573
Appendix OD	Obviousness references for U.S. Patent No. 6,651,134
Appendix OE	Obviousness references for U.S. Patent No. 6,680,516
Appendix OF	Obviousness references for U.S. Patent No. 6,765,407
Appendix OG	Obviousness references for U.S. Patent No. 7,572,727
Appendix OH	Obviousness references for U.S. Patent No. 7,977,797
Appendix AA	Applicant Admitted Prior Art for U.S. Patent No. 6,459,625
Appendix AB	Applicant Admitted Prior Art for U.S. Patent No. 6,534,805
Appendix AC	Applicant Admitted Prior Art for U.S. Patent No. 6,642,573
Appendix AD	Applicant Admitted Prior Art for U.S. Patent No. 6,651,134
Appendix AE	Applicant Admitted Prior Art for U.S. Patent No. 6,680,516
Appendix AG	Applicant Admitted Prior Art for U.S. Patent No. 7,572,727
Appendix AH	Applicant Admitted Prior Art for U.S. Patent No. 7,977,797

I. INTRODUCTION

Pursuant to the Court’s Scheduling Order (D.I. 44) Qualcomm Technologies, Inc., and Qualcomm CDMA Technologies Asia-Pacific PTE LTD (“Qualcomm”) (collectively “Defendant” or “Qualcomm”) serves these Initial Invalidity Contentions on Plaintiff Monterey Research, LLC (“Plaintiff” or “Monterey”) for U.S. Patent Nos. 6,459,625 (the “625 Patent”), 6,534,805 (the “805 Patent”), 6,642,573 (the “573 Patent”), 6,651,134 (the “134 Patent”), 6,680,516 (the “516 Patent”), 6,765,407 (the “407 Patent”), 7,572,727, and 7,977,797 (collectively the “Asserted Patents”). These Invalidity Contentions are based on Defendant’s current knowledge of the Asserted Patents and prior art, along with its understanding of Plaintiff’s infringement allegations set forth in its November 20, 2020 Preliminary Disclosure of Asserted Claims and Infringement Contentions (“Infringement Contentions”). Defendant’s investigation of the prior art is ongoing, and Defendant expressly reserves the right to supplement these Invalidity Contentions as the case proceeds.

Nothing in these Invalidity Contentions is intended, nor should be construed, as a waiver of any claim construction argument or non-infringement position. Defendant’s statements herein (including the accompanying claim charts) reflect Defendant’s present understanding of the purported potential scope of the claims that Monterey appears to be advocating by way of its Infringement Contentions. They are not to be seen as any acquiescence to Plaintiff’s interpretation of any claims. Defendant disagrees that any such claim scope is proper. Defendant reserves the right to supplement these contentions to address any supplemental infringement contentions. For purposes of these Invalidity Contentions, Defendant identifies prior art references and provides element-by-element claim charts based on the apparent constructions of the Asserted Claims advanced by Monterey in its Infringement Contentions (which, for at least some limitations, contradict the plain language of the claim).

Nothing herein shall be interpreted as an admission that: (1) the Asserted Claims are infringed by any of Defendant's instrumentalities, (2) any particular feature or aspect of any of the accused instrumentalities practices any limitation of the Asserted Claims, (3) there is 35 U.S.C. § 112 support for any limitation of the Asserted Claims, or (4) any of Monterey's proposed or implied constructions are supportable or proper.

Consistent with the Court's Scheduling Order and the Federal Rules of Civil Procedure, Defendant reserves the right to amend these Invalidity Contentions. The information and documents that Defendant produces are provisional and subject to further revision as follows. Defendant expressly reserves the right to amend its disclosures and document production referenced herein should Monterey provide any information that it failed to provide in its Infringement Contention disclosures or should Monterey amend its disclosures in any way, whether explicitly or implicitly. Further, because discovery has only recently begun and because Qualcomm has not yet completed its search for and analysis of relevant prior art, Defendant reserves the right to amend the information provided herein. Such amendments include, for example, identifying and relying on additional references, should Defendant's further search and analysis yield additional information or references. Defendant reserves the right to supplement these contentions in light of any additional prior art of which Plaintiff is aware, and did not disclose to Defendant in discovery. Also, Defendant anticipates issuing subpoenas to third parties believed to have knowledge, documentation and/or corroborating evidence concerning some of the prior art listed herein and/or additional prior art. These third parties include, but are not limited to, the authors, employers of authors, inventors, assignees, or former or current employee of assignees, of the references identified or the Asserted Patents. Defendant reserves the right to supplement

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