

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

QUALCOMM INCORPORATED,
Patent Owner

Case IPR2018-01249
Patent 7,693,002

PETITIONER'S MOTION TO EXCLUDE EVIDENCE

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64 and the Federal Rules of Evidence, Petitioner, Apple Inc. (“Apple”), moves to exclude Exhibit 2004 (Declaration of Donald Alpert, Ph.D in IPR2015-00148) submitted by Patent Owner, Qualcomm, Inc. (“Qualcomm”). Exhibit 2004 is a declaration offering testimony identified by an unrelated party as expert testimony in an unrelated IPR not involving petitioner to the instant proceeding.

Exhibit 2004 is inadmissible on several grounds. Exhibit 2004 offers testimony which lacks sufficient factual foundation to the present IPR, is inadmissible hearsay in regard to the present IPR, and irrelevant to the facts at issue in the present IPR. Exhibit 2004 should be excluded under the Federal Rules of Evidence (FRE) 402, 702, and 802.

Patent Owner relied on Exhibit 2004 in its Patent Owner Response (Paper 11), filed on April 15, 2019 and its Patent Owner Sur-Reply (Paper 17), filed on August 15, 2019. Subsequently, Petitioner timely objected to Exhibit 2004 in its Notice of Objections served on April 22, 2019. For reasons detailed below, Exhibit 2004 should be excluded.

II. FACTUAL BACKGROUND

Exhibit 2004 is a declaration submitted by Donald Alpert on behalf of Xilinx, Inc. (not Apple) over four years ago in a different *Inter Partes Review* proceeding

(IPR2015-00148), and in reference to a different patent (U.S. Pat. No. 6,356,122) (“the ’122 patent”) directed to subject matter in a different technology field (e.g., “a PLL-based clock synthesizer with a programmable input-output phase relationship for generating output frequencies based on a reference clock input” as stated in the FIELD OF THE INVENTION section of the ’122 patent). Alpert has not offered testimony in the present IPR. Xilinx is not a party to the present IPR. The ’122 patent is not related to the ’002 patent. Exhibit 2004 provides no indication that Alpert reviewed or otherwise considered the ’002 patent in any way when providing the opinions offered with respect to the ’122 patent for which he offered his testimony; nor does Patent Owner provide evidence to the contrary. *See* Ex. 2004, 2. Instead, the opinions expressed in Exhibit 2004 are specific to U.S. Patent 6,356,122 and the facts at issue in IPR2015-00148. Alpert does not apply any of his analysis to the facts of the present IPR.

To illustrate, Alpert acknowledges in Exhibit 2004 that the construction of the term “clock” is “the broadest reasonable interpretation of the term ‘clock’ **for the ’122 patent** . . .” Ex. 2004, 3 (emphasis added). Yet, Patent Owner relies on portions of Alpert’s testimony regarding the definition of the term “clock” as used in the ’122 patent to support its proposed construction of the term “clock signal” as used in the ’002 patent. Further, the Exhibit 2004 analysis of the ’122 patent’s usage of the term “clock” is simply not relevant to the facts of the present IPR, which

addresses the '002 patent; indeed, the '122 patent has at least ten references to periodic characteristics of its clock (e.g., frequency) whereas the '002 patent uses the term clock signal with no such references to periodicity at all.

III. EXHIBIT 2004 IS INADMISSIBLE UNDER FRE 702 AS LACKING SUFFICIENT FOUNDATION

The admissibility of expert testimony in IPRs is governed by the Federal Rules of Evidence. *See* 37 C.F.R. § 42.62 (“[T]he Federal Rules of Evidence shall apply to [an IPR] proceeding.”). According to Rule 702, an expert witness must be “qualified as an expert by knowledge, skill, experience, training, or education,” and the testimony must “help the trier of fact to understand the evidence or to determine a fact in issue.” In addition, Rule 702 requires that the expert’s testimony be “based on sufficient facts or data” and “the product of reliable principles and methods”; and the expert must “reliably appl[y] the principles and methods to the facts of the case.” *Id.*

In *Daubert*, the Supreme Court held that scientific expert testimony is admissible only if it is ***both relevant and reliable***. *See Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 597 (1993); *see also Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 141 (1999) (stating that in *Daubert* “this Court focused upon the admissibility of scientific expert testimony. It pointed out that such testimony is admissible only if it is both relevant and reliable.”). In *Kumho*, the Supreme Court clarified that *Daubert* applies “not only to testimony based on ‘scientific’

knowledge, but also to testimony based on ‘technical’ and ‘other specialized’ knowledge.” 526 U.S. at 141.

Accordingly, in determining whether an expert’s testimony is admissible, the Board must make the following determinations: (1) the expert is qualified to provide the testimony; (2) the expert’s testimony is relevant; and (3) the expert’s testimony is based on sufficient facts or data and is reliable. If any of these requirements is not met, the expert’s proposed evidence and opinions should be excluded under Rule 702, Rule 402, and the Supreme Court’s holdings in *Daubert* and *Kumho*.

Exhibit 2004 lacks proper factual support in relation to the ’002 patent, and should thus be excluded under FRE 702 for not being based on sufficient facts or data and not applying reliable principles and methods to the facts of the present IPR. Exhibit 2004 does not indicate, nor does the Patent Owner argue, that Alpert reviewed the ’002 patent or considered it in any way as part of his analysis and opinions presented therein. *See* Ex. 2004, 2. Instead, Exhibit 2004 explicitly states that the construction of the term “clock” as discussed therein is “the broadest reasonable interpretation of the term ‘clock’ **for the ’122 patent** . . .” Ex. 2004, 3 (emphasis added). Additionally, the analysis expressed in Exhibit 2004 is applied to the “clock synthesizer” described and claimed in the ’122 patent, and Alpert does not relate this analysis to the dynamic wordline drivers and decoders for memory arrays described and claimed by the ’002 patent. The statements made in Exhibit

2004 are not based on sufficient facts or data of the present case, as they are not relevant to the facts of the present case, and the analysis in Exhibit 2004 has nothing to do with the facts of this IPR. Despite this, Patent Owner relies on portions of Exhibit 2004 to support its own proposed construction of the term “clock signal” as used in the claims of the ’002 patent.

For these reasons, Petitioner respectfully requests that the Board exclude Exhibit 2004, and the limited statements citing thereto in Patent Owner’s Reply (e.g., pages 14-15) and Sur-Reply (e.g., page 10), as lacking sufficient foundation under FRE 702.

IV. EXHIBIT 2004 IS INADMISSIBLE UNDER FRE 802

Exhibit 2004 should be excluded under Rule 802 as hearsay because Exhibit 2004 is a statement made outside of this proceeding and relied upon by Patent Owner to prove the truth of the matter asserted in Exhibit 2004. *See* FRE. 801(c). Patent Owner relies on portions of Exhibit 2004 to support its construction of the term “clock signal.” *See* POR, 14-15 (citing Ex. 2004, 3-4).

Patent Owner acknowledges that Exhibit 2004 is evidence submitted in a different IPR proceeding and directed to a different patent. But Patent Owner nevertheless relies on the exhibit, stating “Dr. Alpert told the Board that the term ‘clock’ should be interpreted as ‘a periodic signal used for synchronization’”, and

“Dr. Alpert stated that the ‘definition [‘a periodic signal used for synchronization’] is consistent with the broadest reasonable interpretation of the term [‘clock’].” *Id.*

The Board has previously excluded expert evidence under similar circumstances. In *US Endodontics, LLC v. Gold Standard Instruments, LLC*, the Board granted the petitioner’s motion to exclude an expert declaration under FRE 802 where the declaration was related to a different patent and submitted during a different proceeding. *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 54, 38-42, (PTAB 2016) (“The declaration in Exhibit 2034 qualifies as hearsay . . . the statements in that declaration were not made while testifying in this proceeding. Instead, the declaration was submitted during ex parte prosecution of another patent application.”). As in *US Endodontics*, Exhibit 2004 constitutes inadmissible hearsay under FRE 802.

Additionally, Exhibit 2004 does not meet the conditions under FRE 801(d) for out of court statements that are not considered hearsay. The statements made in Exhibit 2004 were not made by a representative of Apple, with authorization of from Apple, or by Apple’s agent or employee; nor has Apple adopted any of the statements made in Exhibit 2004. FRE 801(2).

Finally, no exceptions to the rule against hearsay are applicable to any of the statements in Exhibit 2004; and Patent Owner offered no testimony, expert or

otherwise, regarding the same. Patent Owner had a burden to provide this evidence or its equivalent in the Patent Owner Reply, but failed to do so.

For these reasons, Petitioner respectfully requests that the Board exclude Exhibit 2004, and the limited statements citing thereto in Patent Owner’s Reply (e.g., pages 14-15) and Sur-Reply (e.g., page 10), as hearsay.

V. EXHIBIT 2004 IS INADMISSIBLE UNDER FRE 402

Exhibit 2004 should be excluded under Rule 402 as irrelevant. Exhibit 2004 reflects statements of an unrelated witness regarding claim constructions and patentability of an unrelated patent from an unrelated technology field.

Exhibit 2004 explicitly states that the claims constructions discussed therein are “the broadest reasonable interpretation of [claim terms] **for the ’122 patent** . . .”, and, thus, are not related to claim terms of the ’002 patent. Ex. 2004, 3, 12 (emphasis added). Instead, Alpert’s analysis is directed to the question of whether a “clock” – as recited in the ’122 patent’s claims – is limited to digital systems only and not to both digital and analog systems. *See* Ex. 2004, 3-11. The periodicity or non-periodicity of a clock signal is simply inconsequential to Alpert’s analysis. Moreover, the ’122 patent referred to in Exhibit 2004 is directed to a “clock synthesizer with a programmable input-output phase relationship” and is classified in U.S. Cl. 327 (Miscellaneous Active Electrical Nonlinear Devices, Circuits and Systems), whereas the ’002 patent is directed to dynamic wordline

drivers and decoders for memory arrays and is classified in U.S. Cl. 365 (Static Information Storage and Retrieval). Exhibit 2004, 1; *compare* '122 patent, Face and Field of Invention *with* '002 patent, Face and Field of Invention; *see also* Unites States Patent and Trademark Office, *US Classes by Number with Title Menu*, USPTO website (Sept. 10, 2019), <https://www.uspto.gov/web/patents/classification/selectnumwithtitle.htm>. Finally, there is absolutely no indication in Exhibit 2004 that the statements made therein are intended to be applied outside the scope of the '122 patent or are in any way applicable to wordline drivers and decoders for memory arrays. *See* Exhibit 2004. Consequently, the statements made in Exhibit 2004 are not relevant to the issues to be decided in this IPR.

For these reasons, Petitioner respectfully requests that the Board exclude Exhibit 2004, and the limited statements citing thereto in Patent Owner's Reply (e.g., pages 14-15) and Sur-Reply (e.g., page 10), as irrelevant.

VI. CONCLUSION

For the foregoing reasons, Petitioner requests that the evidence discussed above be excluded.

Respectfully submitted,

Date: September 16, 2019

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.8(b), the undersigned certifies that on September 16, 2019, a complete and entire copy of this Petitioner's Motion to Exclude Evidence was provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

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