

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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Case IPR2018-01249  
Patent 7,693,002

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**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO  
PETITIONER'S MOTION TO EXCLUDE EVIDENCE**

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## I. INTRODUCTION

Patent Owner's Opposition does not challenge the substance of Petitioner's objections: FRE 702 and 802 prohibit a party from relying on hearsay statements of an individual who had never looked at the '002 patent as reliable expert testimony on the meaning of a claim term of the '002 patent. Instead, Patent Owner sidesteps the issue by mischaracterizing its reliance on Exhibit 2004 as extremely limited: only to the fact that certain statements were made, and not for the truth of their substance. Opposition, 2 ("...his testimony is evidence that Qualcomm's reliance on the IEEE dictionary definition would not be unreasonable to a POSA").

Patent Owner's characterization of its reliance on Exhibit 2004 as so limited cannot be reconciled with the record of these proceedings. Patent Owner has repeatedly attempted to rely on the *substance* of the statements in the Exhibit as evidence of the meaning of "clock" to a POSA. *See* POR, 14-15; Sur-Reply, 10.

[A]ddressing the meaning of the term "clock," **Dr. Alpert told the Board** that the term "clock" **should be interpreted as** "a periodic signal used for synchronization." Ex. 2004 at 3-4. Dr. Alpert stated that the "definition ['a periodic signal used for synchronization'] is consistent with the broadest reasonable interpretation of the term ['clock']." *Id.* **Dr. Alpert's Statement provides further support for Qualcomm's proposed construction.**

POR, 15. Patent Owner likewise argued in its Sur-Reply that the substance of Dr. Alpert’s analysis was relevant to the meaning of “clock signal” in this proceeding because **“Dr. Alpert did not qualify his opinion on the meaning of ‘clock’ to indicate that it was specific to that previous proceeding or the patent involved therein.”** Sur-Reply, 10.

Even in its Opposition to Petitioner’s Motion to Exclude, Patent Owner admits that it relies on the statements in the Exhibit for their substance, as “plainly relevant to the meaning of the claim term as understood by a POSA.” Opposition, 3; *see also id.*, 2 (describing Exhibit 2004 as “extrinsic evidence that Apple’s proposed definition for a term is not the broadest reasonable interpretation understood by a POSA.”) Thus, Patent Owner has repeatedly relied on Exhibit 2004 both (a) for the truth of the statements contained therein, and (b) as evidence of how a POSA would interpret a claim term. Both uses are precluded by the Federal Rules of Evidence. FRE 702, 802.

#### **A. EXHIBIT 2004 IS INADMISSIBLE UNDER FRE 702**

Patent Owner’s representation that “Exhibit 2004 is not being provided as expert testimony” (Opposition, 2) is contradicted by its own arguments. Patent Owner admittedly seeks to rely on Alpert’s **“opinion on the meaning of ‘clock’”** and “the meaning of the [term clock] **as understood by a POSA.**” Sur-Reply, 10; Opposition, 3. Patent Owner’s characterization of the opinions in Exhibit 2004 as

generic is a misrepresentation; as explained in Petitioner’s Motion, the opinions in Exhibit 2004 are specific to a different patent and a different proceeding. But even accepting Patent Owner’s characterizations, Patent Owner cannot rely on the “opinions” in Exhibit 2004 without first establishing that those opinions are reliably based on the facts of the present case: the applicable POSA, at the applicable time period, based on the applicable intrinsic record. Patent Owner made no attempt to do so, instead effectively conceding that Exhibit 2004 does not constitute reliable expert testimony as to the proper interpretation of “clock signal” in the ’002 patent. Opposition, 2 (“Qualcomm does not offer Exhibit 2004 as expert testimony—the contents of Exhibit 2004 were prepared for a different proceeding, as Apple notes.”)

Exhibit 2004 includes no analysis of how the applicable POSA, reading the ’002 patent at the applicable time, would interpret the term “clock signal” in the context of the ’002 patent. Thus, those opinions are not reliable expert testimony in this proceeding, and should be excluded under FRE 702.

## **B. EXHIBIT 2004 IS INADMISSIBLE UNDER FRE 802**

As demonstrated above, Patent Owner has consistently relied on Exhibit 2004 for the truth of the matter asserted: how a POSA would interpret the term “clock.” Thus, the Exhibit is inadmissible under FRE 802.

Patent Owner’s response to Petitioner’s motion is nonsensical. Patent Owner claims that it relies on Exhibit 2004 for the limited purpose of evidence that another

person at another point in time has relied on an IEEE dictionary. But Petitioner does not challenge Patent Owner's ability to introduce the IEEE dictionary into the record of these proceedings.

Patent Owner's case law discussion is likewise entirely off-point and nonresponsive. Exhibit 2004 is not prior art that was available to a POSA "at the relevant time." Opposition, 3; cf. *EMC Corp. v. PersonalWeb Techs., LLC*, IPR2013-00084, 2014 WL 2090663, at \*13, \*23-26 (PTAB May 15, 2014) (discussing whether a manual for a shareware software program posted to an electronic Bulletin Board System is a "printed publication" under 35 U.S.C. § 102(b)). Exhibit 2004 also is not the inventor's own explanation of the state of the art at the time of his or her own invention. *Neev v. AbbottMed. Optics, Inc.*, No. 09-146 RBK, 2012 WL 1066797, at \*13-14 (D. Del. Mar. 26, 2012) (discussing that the inventor's own discussion of the state of the art presented in "Plaintiff's Opening Markman Brief" were offered for their effect on a POSA and not to prove the novelty of the invention). Instead, it is an expert declaration prepared in a different proceeding for a different patent **more than eight years after** the filing date of the '002 patent. Thus, the District Court and PTAB decisions that Patent Owner cites are simply irrelevant.

Exhibit 2004 is testimony submitted during a different proceeding related to a different patent, yet relied upon in this proceeding for the truth of its statements

about how a POSA would interpret the term “clock.” Thus, those statements are hearsay, and should be excluded under FRE 802. *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 54, 38-42, (PTAB 2016).

### **C. EXHIBIT 2004 IS INADMISSIBLE UNDER FRE 402**

Patent Owner’s argument for the relevance of Exhibit 2004 only serves to highlight its reliance on the truth of the testimony provided therein. If, as Patent Owner contends, “Dr. Alpert’s testimony **is plainly relevant** to the meaning of the claim term as understood by a POSA” (Opposition, 3) then it is inadmissible under either or both FRE 702 and 802 for the reasons set forth above and in Petitioner’s Motion. The Exhibit cannot, at the same time, both be relevant to proving the truth of how a POSA would have interpreted a claim term, yet only be relied upon to support the use of a particular dictionary. Patent Owner’s attempt to salvage Exhibit 2004 only emphasizes its inadmissibility.

## **II. CONCLUSION**

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

Respectfully submitted,

Date: September 30, 2019

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.8(b), the undersigned certifies that on September 30, 2019, a complete and entire copy of this Petitioner's Reply To Patent Owner's Opposition To 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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