

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

QUALCOMM INCORPORATED,
Patent Owner

Case IPR2018-01250
Patent 8,447,132

**DECLARATION OF NOAH C. GRAUBART IN SUPPORT OF
PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION**

I, Noah C. Graubart, hereby declare to the following:

1. I am a member in good standing of the State Bar of Georgia, the Supreme Court of Georgia, Court of Appeals of Georgia, the Supreme Court of the United States, the U.S. Courts of Appeals for the Second, Fifth, Ninth, Eleventh, and Federal Circuits, the U.S. District Court for the District of Colorado, the U.S. District Court for the Middle and Northern Districts of Georgia, and the U.S. District Court for the Eastern District of Texas.

2. I have not been suspended or disbarred from practice before any court or administrative body.

3. I have never had an application for admission to practice before any court or administrative body denied, subject to two exceptions. Specifically, in two instances, my application to appear *pro hac vice* in the Northern District of California was denied initially based on inadvertent omission of required information (i.e., a specific identification of “the highest court of another State” to which I am admitted). *Straight Path IP Group, Inc. v. Avaya Inc.*, No. 3:14-cv-04309-WHA, Dkt. No. 16 (N.D. Cal. Oct. 30, 2014); *Straight Path IP Group, Inc. v. Avaya Inc.*, No. 3:16-cv-03459-WHA, Dkt. No. 19 (N.D. Cal. July 19, 2016). In both instances, my application to appear *pro hac vice* was subsequently granted after re-submission with the required information. *Straight Path IP Group, Inc. v. Avaya Inc.*, No. 3:14-cv-04309-WHA, Dkt. No. 20 (N.D. Cal. Oct. 31, 2014);

Straight Path IP Group, Inc. v. Avaya Inc., No. 3:16-cv-03459-WHA, Dkt. No. 23

(N.D. Cal. July 26, 2016).

4. No sanction or contempt citation has been imposed against me by any court or administrative body.

5. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations.

6. I will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

7. In the past three years, I have not applied for admission *pro hac vice*. I am currently applying for pro hac vice admission in: IPR2018-01251.

8. I am an experienced patent litigation attorney with over thirteen years of experience representing clients in cases involving smartphone software, audio and video processing, telecommunications solutions, wireless networking, optical networking, computer hardware interfaces, and semiconductor fabrication methods. I regularly litigate patent cases before the U.S. District Courts across the country, at the U.S. International Trade Commission, as well as arguing or briefing cases in the U.S. Courts of Appeals, including at the Federal Circuit.

9. I am serving as counsel for Apple Inc. in a related matter, *Qualcomm Incorporated v. Apple Inc.*, Case No. 3:17-cv-02402-CAB-MDD, pending in the United States District Court for the Southern District of California. This related litigation involves the patent at issue in this inter partes review proceeding.

10. My biography is attached hereto as Appendix A.

11. I have read and analyzed the patent-at-issue in this proceeding, the petition, the institution decision, and cited portions of the accompanying exhibits.

12. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Respectfully submitted,

Date: March 26, 2019

/Noah C. Graubart/

NOAH C. GRAUBART

Fish & Richardson P.C.

Email: Graubart@fr.com

APPENDIX A



Noah C. Graubart

Principal

📍 Atlanta, GA 📞 404-724-2820 ✉️ graubart@fr.com

Background

Noah C. Graubart has an international practice specializing in patent infringement litigation and other areas of intellectual property. Mr. Graubart regularly represents clients in U.S. District Courts across the country, at the U.S. International Trade Commission, as well as arguing or briefing cases in the U.S. Courts of Appeals, including at the Federal Circuit.

Mr. Graubart handles complex patent litigation for some of the world's most prominent technology companies, against both competitors and non-practicing entities. Mr. Graubart's practice includes experience with a diverse range of high technology litigation, including cases involving smartphone software, audio and video processing, telecommunications solutions, wireless networking, optical networking, computer hardware interfaces, and semiconductor fabrication methods.

Mr. Graubart has been accredited as a Certified Information Privacy Professional (CIPP/US), with proficiency in data privacy issues, including how to manage and secure personal information, and how to prepare and maintain effective data security and privacy policies.

Mr. Graubart serves as the Atlanta office's *Pro Bono* Coordinator and is actively involved in numerous *pro bono* causes. Mr. Graubart assisted in obtaining from the Supreme Court of Virginia a reversal and new sentencing hearing for a client facing a death sentence. He serves on the Board of Directors for the Texas Defender Service and a member of the Atlanta Advisory Committee of Kids in Need of Defense (KIND).

Prior to joining the firm, Mr. Graubart served as a law clerk for the Honorable Jerry E. Smith of the United States Court of Appeals for the Fifth Circuit.

Mr. Graubart lives in Decatur, Georgia, with his wife of fourteen years, Emily, and their three children.

Services

- Litigation
- ITC Litigation
- Patent Litigation

Education

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B.A., Northwestern University 2001
Political Science

Admissions

- Georgia 2005
- Georgia Supreme Court
- Georgia Court of Appeals
- Supreme Court of the United States
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Second Circuit
- U.S. Court of Appeals for the Fifth Circuit
- U.S. Court of Appeals for the Ninth Circuit
- U.S. Court of Appeals for the Eleventh Circuit
- U.S. District Court for the District of Colorado
- U.S. District Court for the Middle District of Georgia
- U.S. District Court for the Northern District of Georgia
- U.S. District Court for the Eastern District of Texas

Clerkships

United States Court of Appeals for the Fifth Circuit, The Honorable Jerry E. Smith, 2004 - 2005

Memberships & Affiliations

Texas Defender Service, Board of Directors

Kids in Need of Defense (KIND), Atlanta Advisory Committee

Adjunct Lecturer, Emory School of Law, Patent Litigation (Spring 2016)

Other Distinctions

Selected as a *Super Lawyers* Rising Star 2013 – 2015.

Awarded the *Daily Report's* 2014 "On the Rise" distinction, honoring 40 attorneys under age 40 predicted to make lasting contributions to Georgia's legal community.

Selected Publications and Presentations

"IP Litigation at the International Trade Commission," presented at Association of Corporate Counsel, Georgia Chapter, Atlanta, GA (July 11, 2017).

"*Daubert* and Patent Damages," presented at Midwest Intellectual Property Symposium, Indianapolis, IN (Nov. 20, 2015).

"N.D. Ga. Refuses to Lift Stay Pending IPR, Despite Conclusion of Reissue and Reexamination," *Fish Litigation Blog* (February 13, 2015).

"N.D. Ga. Rejects Indefiniteness Argument under *Nautilus v. Biosig*," *Fish Litigation Blog* (August 26, 2014).

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"A Review of Recent Patent Damages Developments," 983 PLI/Pat 239 (2009) (co-author with N. Setty), presented at PLI's "Patent Litigation 2009" (Nov. 10, 2009).

"Developments in Federal Circuit Claim Construction Jurisprudence: from *Markman* to *Texas Digital* to *Phillips* and Back Again?" presented at the Patent Claim Construction Workshop, Law Seminars International, Atlanta, GA (Apr. 27, 2007) (co-author with N. Setty).

"The Importance of Determining Alito's Brand of Conservatism," OnlineJournal.com (2005).

Experience

Patent Infringement

Realtime Adaptive Streaming LLC v. AVAYA, Inc. (D. Colo. 2018) (Brimmer, J.): Counsel for AVAYA in patent infringement litigation related to AV compression standards.

adv. Qualcomm Inc. (S.D. Cal. 2017) (Bencivengo, J.): Counsel for large electronics supplier in a patent dispute involving mobile devices.

Williams v. DJO Global, Inc., et al. (D. Utah 2017 / S.D. Cal. 2018) (Waddoups, J. / Hayes, J.): Counsel for DJO in design patent case involving orthopedic braces.

Realtime Adaptive Streaming LLC v. Sling TV, LLC, et al. (D. Colo. 2017): Counsel for ARRIS in patent infringement litigation related to AV compression standards.

SEVEN Networks LLC v. Samsung Electronics Co. Ltd., et al. (E.D. Tex. 2017) (Gilstrap, J.): Counsel for Samsung in patent infringement dispute concerning Android-related power-saving features.

Certain Consumer Electronic Devices, Including Televisions, Gaming Consoles, Mobile Phones and Tablets, and Network-Enabled DVD and Blu-Ray Players (ITC 2017) (Lord, ALJ): Counsel for Complainant ARRIS in ITC investigation of various Sony involving various consumer electronics technologies.

Certain Digital Cable and Satellite Products, Set-Top Boxes, Gateways, and Components Thereof (ITC 2017) (McNamara, ALJ): Counsel for Respondent, ARRIS, in ITC investigation involving set-top box and network gateway devices.

TiVo Inc. v. Samsung Electronics Co., Ltd., et al. (E.D. Tex. 2015) (Gilstrap, J.): Counsel for Samsung in patent infringement dispute concerning video processing in mobile devices and DVR set-top boxes.

adv. Ericsson Inc. (E.D. Tex. 2015) (Gilstrap, J.): Counsel for large electronics supplier in a patent dispute involving mobile device software.

Pactiv LLC v. Highland Packaging Solutions, Inc. (N.D. Ga. 2015) (Cohen, J.): Counsel for Highland Packaging Solutions in utility and design patent infringement case involving agricultural packaging cartons.

Optical Tech IP, LLC v. Huawei Enterprise USA, Inc., et al. (E.D. Tex. 2014) (Gilstrap, J.): Counsel for Huawei in patent infringement suit involving optical networking technology.

American Radionic Company, Inc. v. Packard Inc, et al. (M.D. Fla. 2014) (Dalton, J.): Counsel for American Radionic in patent infringement suit against competitors involving motor run capacitors for HVAC applications.

Straight Path IP Group Inc. v. AVAYA Inc. (N.D. Cal. 2014) (Alsup, J.): Counsel for AVAYA in patent infringement suit involving VoIP telephony.

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Certain Consumer Electronics Including Mobile Phones and Tablets II (ITC 2014) (Pender, ALJ): Counsel for Samsung in ITC investigation brought by Complainant Pragmatus Mobile involving wireless communication devices.

Interactive Intelligence, Inc. v. Presence Technology, LLC (N.D. Ga. 2013) (Totenberg, J.): Counsel for defendant Presence Technology in infringement suit involving contact center software.

NXP B.V. v. Research In Motion Ltd., et al. (M.D. Fl. 2012) (Conway, C.J.): Counsel for defendant BlackBerry (f/k/a Research In Motion) in patent infringement suit involving wireless communication protocols, bus interfaces, GPS power management, and semiconductor fabrication techniques.

Certain Consumer Electronics Including Mobile Phones and Tablets (ITC 2012) (Gildea, ALJ): Counsel for Samsung in ITC investigation brought by Complainant Pragmatus AV involving video conferencing technology.

Klausner Technologies/IPVX (E.D. Tex.) (Davis, J.): Counsel for various defendants, including Cisco Systems, Avaya, ShoreTel, M5 Networks, and Zeacom in infringement cases involving voicemail technology.

Bose Corp. v. SDI Technologies, Inc., et al. (D. Mass. 2009, 2013) (Young, J.): Counsel for plaintiff Bose Corp. in multiple patent infringement cases involving remote-controlled speaker systems.

Cheetah Omni LLC v. Alcatel-Lucent USA, Inc., et al. (E.D. Tex. 2011) (Davis, J.): Counsel for defendant Futurewei Technologies, Inc. in patent infringement case involving optical networking devices.

Pieczenik v. Shionogi Pharms., et al. (D. N.J. 2010) (Pisano, J.): Obtained dismissal with prejudice for defendant Shionogi in multi-defendant patent infringement case involving genetically modified cell lines and monoclonal antibodies.

SIPCO, LLC v. Control4 Corp., et al. (E.D. Tex. 2010/N.D. Ga. 2010) (Davis, J./Carnes, C.J.): Counsel for defendants Siemens Industry, Inc. and Digi International Inc. in multi-jurisdictional patent infringement case regarding wireless building control and automation systems.

SIPCO, LLC, v. Johnson Controls, Inc., et al. (E.D. Tex. 2009) (Davis, J.): Counsel for defendant Johnson Controls, Inc. in patent infringement case involving wireless networking technologies.

Synchrom Technology Inc. v. Samsung Electronics America, Inc., et al. (N.D. Ga. 2009) (Carnes, C.J.): Counsel for Samsung in patent infringement case concerning optical disk drives and interfaces.

LG Elecs., Inc. v. Petters Group Worldwide, LLC, et al. (E.D. Tex. 2008) (Folsom, J.): Counsel for LG Electronics in patent infringement case involving flat-panel televisions.

American Valve, Inc. v. United Purchasing Ass'n, LLC, et al. (D. Minn. 2008) (Frank, J.): Counsel for American Valve in patent infringement, trademark infringement, copyright infringement, misappropriation of trade secrets, and breach of contract dispute relating to cast iron ball valves.

NICE Systems, Inc. v. Witness Systems, Inc. (D. Del. 2006) (Farnan, J.): Counsel for Witness Systems in patent infringement trial relating to contact center recording and monitoring software and systems; case tried to jury in 2008, which ended in mistrial.

IP Co., LLC v. Cellnet Technology, Inc. (N.D. Ga. 2006) (Carnes, J.): Counsel for Cellnet Technology and related parties in patent infringement, patent ownership, and breach of contract dispute relating to mesh networking technology.

Witness Systems, Inc. v. NICE Systems, Inc. (N.D. Ga. 2006) (Batten, J.): Counsel for Witness Systems in patent infringement trial involving speech analytics software and systems; obtained jury verdict of infringement and precise damages demand advanced at trial.

Shaw Industries Group, Inc. v. Interface, Inc. (N.D. Ga. 2005) (Murphy, J.): Counsel for Shaw Industries in patent infringement action regarding carpet tile patent.

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STS Software Systems Ltd. v. Witness Systems, Inc. (N.D. Ga. 2004) (Story, J.): Counsel for Witness Systems in patent infringement trial involving VoIP recording patents; case tried in 2008, resulting in judgment of noninfringement.

Appellate Matters

Ahmed v. Kifle, et al. (11th Cir. 2015, 2016, 2017): Counsel for Defendant Elias Kifle in various appeals regarding alleged defamation claim filed by Ethiopian businessman against exiled Ethiopian dissident journalist.

Shaw Industries Group, Inc. v. Automated Creel Systems, Inc. (Fed. Cir. 2015): Counsel for Appellant and Cross-Appellee Shaw Industries in connection with *Inter Partes* Review of patent related to textile manufacturing creels.

Harris v. Caldwell (US 2014): Counsel for Petitioner Alvin Harris in connection with certiorari petition challenging dismissal of habeas corpus petition.

Brown v. Stephens (US 2014): Counsel for death-sentenced Petitioner Arthur Brown Jr. in connection with certiorari petition concerning denial of services in support of Mr. Brown's clemency proceedings.

Cole v. Warden, Georgia State Prison (11th Cir. 2013): Counsel for Petitioner-Appellant Bob Jay Cole in appeal of dismissal of habeas corpus petition.

Bose Corp. v. SDI Technologies, Inc., et al. (Fed. Cir. 2013): Counsel for Plaintiff-Appellant Bose Corp. in appeal of summary judgment order in patent infringement case involving remote-controlled speaker systems.

Merial Ltd., et al. v. Cipla Ltd., et al. (Fed. Cir. 2011): Counsel for Defendant-Appellant Cipla Ltd. in appeal of contempt order in patent infringement dispute involving veterinary pesticides.

Prieto v. Commonwealth of Virginia (Va. 2008): Counsel for death-sentenced Defendant-Appellant Alfredo Prieto in direct appeal of death sentence.

Canales v. Quaterman (5th Cir. 2007): Counsel for Petitioner Javier Ochoa Canales in connection with dismissal of habeas corpus petition.

Post-Grant Review Proceedings

Presence Technology, LLC v. Interactive Intelligence, Inc. (PTAB 2014): Counsel for Petitioner Presence Technology in connection with *Inter Partes* Review petition relating contact center software patent.

SDI Technologies, Inc. v. Bose Corp. (PTAB 2013, 2014): Counsel for Patent Owner Bose Corp. in connection with *Inter Partes* Reviews related to remote-controlled speaker system patent.

Trademark & Copyright Infringement

Patnaik v. Hearst Corp. et al. (C.D. Cal. 2014) (O'Connell, J.): Counsel for Canada Post Corp. in defense of claims for copyright infringement and conversion.

Microsoft Corp. v. Ebix, Inc. (N.D. Ga. 2013) (Pannell, J.): Counsel for Microsoft in copyright infringement and breach of licensing agreement case.

Bio-Kor Metics, Ltd. v. Five Star Formulators, Inc. (N.D. Cal. 2010) (Hamilton, J.): Successfully obtained temporary restraining order, preliminary injunction, and permanent injunction for plaintiff Bio-Kor Metics in trademark, trade dress, and counterfeiting dispute involving CHRISTINA® line of cosmetics and treatments.

Lynch Traditions, LLC v. World Famous Sports, Inc., et al. (M.D. Ga. 2009) (Lawson, J.): Counsel for World Famous Sports in trademark

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American Valve, Inc. v. United Purchasing Ass'n, LLC, et al. (D. Minn. 2008) (Frank, J.): Counsel for American Valve in patent infringement, trademark infringement, copyright infringement, misappropriation of trade secrets, and breach of contract dispute relating to cast iron ball valves.

False Patent Marking

*I*Rise Outreach & Learning Center, LLC v. Samsung Telecommunications America, LLC* (W.D. Mo. 2011) (Kays, J.): Successfully obtained pre-discovery dismissal for defendant Samsung in case involving allegations of false patent marking concerning consumer electronics.

Consumers Protecting Consumers, LLC v. Samsung Electronics Co., Ltd., et al. (E.D. Pa. 2011) (Tucker, J.): Successfully obtained pre-discovery dismissal for defendant Samsung in case involving allegations of false patent marking concerning consumer electronics.

Mueller v. Scantron Corp. (S.D. Cal. 2011) (Burns, J.): Successfully obtained pre-discovery dismissal for defendant Scantron Corp. in case involving allegations of false patent marking concerning test forms.

Patent Truth, LLC v. Bank of America Corp. (E.D. Pa. 2010) (O'Neill, J.): Obtained dismissal with prejudice for defendant Bank of America Corp. in case involving allegations of false patent marking concerning credit cards.

Shaw Industries Group, Inc. v. Interface, Inc. (N.D. Ga. 2007) (Murphy, J.): Counsel for Shaw Industries in false patent marking case regarding carpet tiles.

Trade Secret Misappropriation & Commercial Disputes

T&S Property Management, LLC v. CINC Systems, LLC (N.D. Ga. 2016) (Totenberg, J.): Counsel for CINC Systems in breach of contract declaratory judgment case regarding alleged unlawful copying of software.

Southwire Co. v. Novakovic (Super. Ct. Douglas County, Ga. 2011): Counsel for employee in alleged trade secret misappropriation case.

Ragsdale v. Twin City Insurance Co. (N.D. Ga. 2005) (Batten, J.): Obtained summary judgment for insureds in coverage dispute stemming from defense against allegations of misappropriation of software trade secrets.