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Paper 28
Entered: January 10, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO., KG,
Patent Owner.

Case IPR2016-01860
Patent 8,966,144 B2

Before JONI Y. CHANG, JAMES B. ARPIN, and
MIRIAM L. QUINN, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

DECISION
Termination of *Inter Partes* Review
35 U.S.C. §§ 315(e)(1), 316(a)(4); 37 C.F.R. § 42.72

I. INTRODUCTION

On October, 11, 2016, Apple Inc. ("Petitioner" or "Apple") filed a Petition, which we granted, requesting *inter partes* review of certain claims[1] of U.S. Patent No. 8,966,144 B2 (Ex. 1001, "the '144 patent"). Paper 2 ("Apple Petition"); Paper 10 ("Decision on Institution" or "Dec."). Three months later, on January 15, 2017, Apple filed two other Petitions for *inter partes* review of the challenged claims and corresponding Motions for Joinder. *See* IPR2017-00679, Papers 1–2, and IPR2017-00670, Papers 1–2. We granted those Petitions and Motions for Joinder, and, consequently, Apple was joined as a petitioner to the following proceedings: IPR2016-01212 and IPR2016-01216, in which review of the challenged claims had been granted. *See* IPR2016-01212 (Paper 21), IPR2016-01216 (Paper 22) (collectively "Joinder IPRs").

On December 11, 2017, the Board issued Final Written Decisions in the Joinder IPRs, concluding that the challenged claims of the '144 patent are unpatentable. *See* IPR2016-01212 (Paper 32), IPR2016-1216 (Paper 33). Accordingly, all of the claims challenged in the instant proceeding have been subject to review and addressed in a Final Written Decision under 35 U.S.C. § 318(a). Oral argument in the instant proceeding has been requested by the parties. We held in abeyance all remaining deadlines, including the requested oral argument, pending the determination of whether this proceeding should be terminated in consideration of estoppel under

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[1] Claims 1–3, 5–7, 9, 15–17, 19, 21, 26, 27, 29, 34, 37–39, 41, 49, 52, 54, 56, 57, 59–64, 66, 67, 78–83, and 86 ("the challenged claims").

35 U.S.C. § 315(e)(1) and our authority under 35 U.S.C. §§ 316(a)(4) and 37 C.F.R. § 42.72.[2] Paper 23 ("Order to Show Cause").

II. BACKGROUND

The parties do not dispute that the instant proceeding asserts unpatentability of the same set of claims of the '144 patent, for which the Board rendered a Final Written Decision in the Joinder IPRs. The instant proceeding involves grounds based primarily on Pucci as follows (Dec. 20):

Challenged Claims	Basis	References
1–3, 5–7, 9, 15–17, 19, 21, 26, 27, 29, 34, 37–39, 41, 49, 52, 56, 57, 59–64, 67, 78–83, and 86	§ 103(a)	Pucci,[3] Shinosky,[4] Kepley,[5] and Schmidt[6]

[2] *See also* 35 U.S.C. § 316(b) ("In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, *the efficient administration of the Office*, and the ability of the Office to timely complete proceedings instituted under this chapter."; emphasis added); 37 C.F.R. § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.").

[3] Marc F. Pucci, *Configurable Data Manipulation in an Attached Microprocessor*, 4 COMPUTING SYSTEMS 217 (1991) ("Pucci") (Ex. 1041).

[4] US Patent No. 4,065,644 ("Shinosky") (Ex. 1045).

[5] US Patent No. 4,790,003 ("Kepley") (Ex. 1042).

[6] Friedhelm Schmidt, THE SCSI BUS AND IDE INTERFACE (Addison-Wesley 1995) ("Schmidt") (Ex. 1007).

Challenged Claims	Basis	References
54	§ 103(a)	Pucci, Shinosky, Kepley, Schmidt, and Li[7]
66	§ 103(a)	Pucci, Shinosky, Kepley, Schmidt, and Wilson[8]

In addition to the instant proceeding, Apple currently is maintaining four *inter partes* reviews addressing patents related to the '144 patent: IPR2016-01842 (Patent 9,189,437 B2); IPR2016-01863 (Patent 8,504,746 B2); and IPR2016-01839 and IPR2016-01864 (Patent 6,470,399 B1).

III. ANALYSIS

According to 35 U.S.C. § 315(e)(1),

> [t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

By virtue of it being joined to the Joinder IPRs, Apple is a petitioner who has obtained a final written decision on all of the challenged claims of the '144 patent. If estoppel under § 315(e)(1) applies in these circumstances, Apple may not maintain the instant proceeding. Therefore, we first determine if Apple seeks to maintain this proceeding on "any

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[7] US Patent No. 5,617,423 ("Li") (Ex. 1053).

[8] US Patent No. 5,353,374 ("Wilson") (Ex. 1044).

ground that the petitioner raised or reasonably could have raised during" the Joinder IPRs, according to § 315(e)(1). If the answer is yes, and Apple is estopped, we then determine whether termination is appropriate.

A. Estoppel

We have stated that a ground "reasonably could have been raised" if it encompasses prior art that a "skilled searcher conducting a diligent search reasonably could have been expected to discover." *See Praxair Dist. Inc., v. INO Therapeutics*, 2016 WL 5105519 (PTAB Aug. 25, 2016) (IPR2016-00781) (citing 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); *see id.* at S1376 (statement of Sen. Kyl) ("This [estoppel] effectively bars such a party or his real parties in interest or privies from later using inter partes review . . . against the same patent, since the only issues that can be raised in an inter partes review . . . are those that could have been raised in [an] earlier post-grant or inter partes review."); 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley) ("It also would include a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.").

Here, there is no question that Apple filed the Apple Petition before the petitions in the Joinder IPRs. Therefore, Apple asserted the grounds based on Pucci at least three months before it filed the Joinder IPRs. As such, there is no evidence or argument in the record that the Pucci grounds were unavailable to Apple before it filed its petitions in the Joinder IPRs.

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