

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00210
Patent 7,116,710

PATENT OWNER'S REQUEST FOR REHEARING
37 CFR §42.71(d)

I. PRECISE RELIEF REQUESTED

Patent Owner California Institute of Technology (“Caltech”) requests the Board to reconsider and withdraw its decision (Paper 32) granting the motion of Petitioner Apple Inc. (“Petitioner”) to file supplemental information (Paper 22). The decision is inconsistent with Board decisions on similar motions and is deeply prejudicial to Caltech in both its timing and its scope. Because the Board misapprehended or overlooked these issues in granting Petitioner’s motion, the Board’s decision should be withdrawn and the motion denied. *See* 37 C.F.R. § 42.71(d).

II. MATTERS MISAPPREHENDED OR OVERLOOKED

A. Improper purpose misapprehended

Petitioner candidly admitted that it wished to introduce supplemental evidence to preempt any Caltech attempt at antedating. Paper 23, 2. Such preemption is improper, however. *Medtronic, Inc. v. Endotach LLC*, IPR2014-00100, Paper 18, 4 (2014) (explaining that preempting future argument and shifting the ground of unpatentability are not proper uses of supplemental information); *see also* Paper 23, 2-3, 12.

The Board’s decision to grant Petitioner’s supplemental information request placed Caltech in a Catch-22 where it had to file its Patent Owner response without the benefit of knowing what, if any, publication dates were being asserted beyond

those specifically identified in the petition. It is not Caltech's or the Board's burden to figure out whether an unspecified date is or is not supported by the record. *See Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1364 (Fed. Cir. 2015) ("A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.") (citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999)).

While the Board cites relevance as its reason to admit this supplemental evidence (Paper 32, 3), relevance is a necessary but not sufficient condition. After all, even relevant evidence may be unfairly prejudicial or confusing. *See, e.g.*, FRE 403. Petitioner has been permitted to shift its theory of unpatentability long after the institution decision. Caltech is left to assess this evidence without the benefit of analysis from the petition or the institution decision. Inevitably, Petitioner will raise arguments in its reply that it will insist Caltech should have anticipated from the supplemental evidence. The Board should require Petitioner to present its evidence in the ordinary course of the proceeding (evidence supporting the petition with the petition; evidence supporting the reply with the reply). *Medtronic*, IPR2014-00100, Paper 18, 4. Petitioner should not be repeatedly permitted to change the record during Caltech's response periods.

B. Prejudicial timing overlooked

Petitioner waited until the very end of the one-month period (or longer in

IPR2016-00700) to submit evidence that it should have provided with its petition. Petitioner's only justification for not providing the evidence with its petition was that it did not believe it needed to do so. Paper 22, 10. "The Board may take into account whether the supplemental information was reasonably available to the petitioner at the time the petition was filed." *Lab. Francais du Fractionnement v. Novo Nordisk Healthcare*, IPR2017-00028, Paper 22, 4 (2017). Petitioner's choice not to file (or brief) this evidence with its petition but wait until after institution has yielded Petitioner a windfall in the form of (1) avoiding the petition word limits, (2) bolstering its challenge by shifting away from the publication dates asserted in the petition, and (3) limiting the time between the decision on the motion and the due date for Caltech's response. *Id.* (explaining bolstering is an improper use of supplemental information).

Remarkably, Petitioner argued "Patent Owner will have had over two months to consider the supplemental information before it must file its Patent Owner's response." Paper 22, 2. Petitioner's argument assumes that Caltech is responsible for addressing the information from the time it was proffered rather than from the time the Board granted its entry, which effectively shifts Petitioner's burden as movant to Caltech to assume the motion will be granted and prepare accordingly. 37 CFR §42.20(c). In any event, the motion was not granted until October 27, four months after institution, leaving only a single business day (the

following Monday) for cross examination. Paper 28, 1. What's more, Petitioner did not actually file the exhibits until after the discovery period had closed. 37 CFR §42.53(d)(2).

The Board overlooked how prejudicial the extremely late addition of this evidence to the record would be to Caltech. *See, e.g.*, Paper 23, 11. The decision left scant time to assess the impact of the supplemental information on Caltech's defense and no time for cross examination or related discovery.

III. CONCLUSION

The Board overlooked the extreme prejudice created by the tardy seeking and granting of supplemental evidence. The Board misapprehended the improper nature of the supplementation and the confusion and hardship that its out-of-sequence entry necessarily creates. The relief Petitioner requested was unwarranted and unduly prejudicial. Paper 32 should be withdrawn.

Respectfully submitted,

Date: November 13, 2017

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