

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.

CALIFORNIA INSTITUTE OF TECHNOLOGY,  
Patent Owner.

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Case IPR2017-00210  
Patent No. 7,116,710

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**PATENT OWNER'S PRELIMINARY RESPONSE  
PURSUANT TO 37 C.F.R. § 42.107**

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## I. INTRODUCTION

The Board should not institute *inter partes* review (IPR) on claims 1-8, 10-17 and 19-33 of U.S. Patent No. 7,116,710 (“the ’710 patent”) because petitioner Apple Inc. (“Petitioner”) has not met its burden of showing that it has a reasonable likelihood of prevailing on any of its proposed grounds for unpatentability.

**First**, review should be denied on the basis that the present petition merely recycles the very same art and arguments that have already been presented to the Office and rejected by the Board in previous IPR challenges. Petitioner acknowledges that the ’710 patent was already “challenged in two petitions for *inter partes* review” (Pet. p. 3.). The Board rejected both of those petitions. *See Hughes Network Systems, LLC and Hughes Comms., Inc. v. California Institute of Tech.*, Case No. IPR2015-00067, Paper 18 (Apr. 27, 2015); *see also Hughes Network Systems, LLC and Hughes Comms., Inc. v. California Institute of Tech.*, Case No. IPR2015-00068, Paper 18 (Apr. 27, 2015). The present petition advances the same references and arguments, placing undue burden on Caltech and wasting Board resources.

**Second**, the petition should be denied because the Petitioner fails to establish that all references in each of its grounds qualify as prior art printed publications.

**Third**, even assuming the relied-upon references do qualify as prior art—which Petitioner fails to establish—the proposed grounds of challenge fail to

demonstrate that each feature of claims 1-8, 10-17 and 19-33 of the '710 patent is found in the cited art.

Accordingly, institution of *inter partes* review should be *denied*.

## **II. THE PRESENT PETITION RECYCLES PREVIOUS CHALLENGES PRESENTED TO THE OFFICE**

The instant petition presents one in a series of challenges to the '710 patent, but rehashes substantially the same art and arguments already presented to the Office and rejected by the Board in Case Nos. IPR2015-00067 and IPR2015-00068. Accordingly, the Board should exercise its discretion in denying institution on all grounds in the petition. 35 U.S.C. § 325(d) (“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, *the same or substantially the same prior art or arguments* previously were presented to the Office.”) (emphasis added).

The present petition fails to offer any art or arguments substantially different from what has already been presented to, and rejected by, the Board. Petitioner acknowledges that the '710 patent was already “challenged in two petitions for *inter partes* review.” (Pet. p. 3.) The Board rejected both of those petitions. *See Hughes Network Systems, LLC v. California Institute of Tech.*, Case No. IPR2015-00067, Paper 18 (Apr. 27, 015); *see also Hughes Network Systems, LLC v. California Institute of Tech.*, Case No. IPR2015-00068, Paper 18 (Apr. 27, 015).

Petitioner has also filed two more pending petitions challenging claims of the '710 patent. *See* IPR2017-00211; *see also* IPR2017-00219.<sup>1</sup>

The present petition presents grounds based on the very same Frey and Divsalar references and advancing substantially the same arguments as those in one of the rejected Hughes IPRs. *Compare* IPR2015-00067, Paper 4 at 15-21 (challenging claim 1 as anticipated by Frey) *with* Pet. p. 34-42 (challenging claims 1 and 3 as anticipated by Frey); *compare* IPR2015-00067, Paper 4 at 21-41 (challenging claims based on Frey in view of Divsalar) *with* Pet. p. 42-60 (challenging claims based on Divsalar in view of Frey); *compare* IPR2015-00068, Paper 4 at 14-43 (challenging claims based in part on Divsalar) *with* Pet. p. 34-74 (challenging claims based in part on Divsalar). In addition, the claims of the '710 patent challenged in the two prior proceedings are also challenged in the instant petition. *Compare* IPR2015-00067 and IPR2015-00068 (challenging claims 1, 3-6, 15-16, and 20-22); *with* Pet. p. 4 (challenging claims 1-8, 10-17, and 19-33).

Petitioner has not explained why this petition substantially differs either from either of the Hughes petitions or either of the petitions filed concurrently with

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<sup>1</sup> Accordingly, the '710 patent has been challenged in five total IPR proceedings to date—thereby indicating patent owner harassment with serial petitions. *See, e.g., Ube Maxell Co., Ltd. v. Celgard, LLC*, Case No. IPR2015-01511, Paper 10 (Jan. 7, 2016) (denying institution of sixth petition under § 325(d)).

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