

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00219 (Patent 7,116,710 B1)
Case IPR2017-00210 (Patent 7,116,710 B1)¹

Before KEN B. BARRETT, TREVOR M. JEFFERSON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style of heading.

IPR2017-00210 (Patent 7,116,710 B1)

IPR2017-00219 (Patent 7,116,710 B1)

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decisions on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of U.S. Patent No 7,116,710 is unpatentable. IPR2017-00210, Paper 18; IPR2017-00219, Paper 17. We modify our Decisions on Institution to institute on all of the challenged claims and all of the grounds presented in the Petitions from IPR2017-00210 (Paper 5, 33–75) and IPR2017-00219 (Paper 5, 33–72). *See Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018), available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to change the schedule or submit further briefing, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing.

Accordingly, it is hereby:

ORDERED that our Decisions on Institution are modified to include review of all challenged claims and all grounds presented in the Petitions from IPR2017-00210 (Paper 5) and IPR2017-00219 (Paper 5); and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or any further briefing, and, if so, shall request a conference call with the panel to seek

IPR2017-00210 (Patent 7,116,710 B1)

IPR2017-00219 (Patent 7,116,710 B1)

authorization for such changes or briefing within one week of the date of this
Order.

IPR2017-00210 (Patent 7,116,710 B1)

IPR2017-00219 (Patent 7,116,710 B1)

For PETITIONER:

Richard Goldenberg

Brian M. Seeve

Dominic E. Massa

WILMER CUTLER PICKERING HALE AND DORR LLP

richard.goldenberg@wilmerhale.com

brian.seeve@wilmerhale.com

dominic.massa@wilmerhale.com

For PATENT OWNER:

Michael T. Rosato

Matthew A. Argenti

Richard Torczon

WILSON SONSINI GOODRICH & ROSATI

mrosato@wsgr.com

margenti@wsgr.com

rtorczon@wsgr.com

Todd M. Briggs

Kevin P.B. Johnson

QUINN EMANUEL URQUHART & SULLIVAN LLP

toddbriggs@quinnemanuel.com

kevinjohnson@quinnemanuel.com