

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Cases IPR2017-00210 and IPR2017-00219 (Patent 7,116,710 B1);
Case IPR2017-00297¹ (Patent 7,916,781 B2);
Cases IPR2017-00700 and IPR2017-00701 (Patent 7,421,032 B2)²

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

BARRETT, *Administrative Patent Judge*.

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

¹ Case IPR2017-00423 has been consolidated with IPR2017-00297.

² 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, IPR2017-00219 (Patent 7,116,710 B1)
IPR2017-00297 (Patent 7,916,781 B2)
IPR2017-00700 and IPR2017-00701 (Patent 7,421,032 B2)

The Institution Decisions in the above-captioned cases instituted trial on some but not all of the challenged claims and grounds.³ Subsequently, 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). On May 2 and 3, 2018, we modified our institution decisions to institute on all of the challenged claims and all of the grounds presented in each respective Petition.

We held oral argument in IPR2017-00700, IPR2017-00701, and IPR2017-00728 on May 8, 2018, as scheduled. At the oral argument, the parties represented that they had reached an agreement and that they jointly request that the originally non-instituted claims and grounds be withdrawn from the proceedings in all of the above-captioned cases. In light of these representations, the Board authorizes the parties to file in each respective case, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing the claims and grounds upon which we did not institute review in the original Decision on Institution. *See, e.g., Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision).

Accordingly, it is:

ORDERED that the parties are authorized to file in each case, within one week of the date of this Order, a Joint Motion to Limit the Petition by

³ In related case IPR2017-00728, we instituted trial on all of the challenged claims and on the sole asserted ground.

IPR2017-00210, IPR2017-00219 (Patent 7,116,710 B1)
IPR2017-00297 (Patent 7,916,781 B2)
IPR2017-00700 and IPR2017-00701 (Patent 7,421,032 B2)

removing the claims and grounds upon which we did not institute review in
the original Decision on Institution.

IPR2017-00210, IPR2017-00219 (Patent 7,116,710 B1)
IPR2017-00297 (Patent 7,916,781 B2)
IPR2017-00700 and IPR2017-00701 (Patent 7,421,032 B2)

For PETITIONER:

Richard Goldenberg
Dominic E. Massa
Michael Smith
Kelvin Chan
WILMER CUTLER PICKERING HALE AND DORR LLP
richard.goldenberg@wilmerhale.com
dominic.massa@wilmerhale.com
michaelh.smith@wilmerhale.com
kelvin.chan@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