

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 B1

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

The Institution Decision in this case instituted trial on some but not all
of the challenged claims and some but not all of the challenged grounds.

Paper 18. Subsequently, on April 24, 2018, the Supreme Court held that a

decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–59 (2018). By our Order of May 2, 2018, we modified our institution decision in light of *SAS* to institute trial on all of the challenged claims and all of the grounds presented in the Petition (Paper 5). Paper 69.

As authorized by our Order of May 8, 2018 (Paper 70), the parties filed a Joint Motion to Limit the Petition. Paper 71. Specifically, the parties requested “that the Board remove claims 10 and 23 of U.S. Patent No. 7,116,710 from this proceeding, and limit the petition in the present *inter partes* review to claims 1–8, 11–17, 19–22, and 24–33.” *Id.* at 3. Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this consolidated proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b).

Accordingly, we *grant* the Joint Motion to Limit the Petition. As such, the following grounds of unpatentability are removed from dispute in this proceeding: (1) Claim 10 as unpatentable under 35 U.S.C. § 103(a) over Frey, Divsalar, and Pfister Slides; and (2) claim 23 as unpatentable under 35 U.S.C. § 103(a) over Frey, Divsalar, Luby97, and Pfister Slides.

It is:

ORDERED that the Joint Motion to Limit the Petition is *granted*; and
FURTHER ORDERED that the Petition is limited to the following claims and grounds of unpatentability:

Claims 1 and 3 of U.S. Patent No. 7,116,710 B1 as anticipated by Frey pursuant to 35 U.S.C. § 102(b);

Claims 1–8 and 11–14 of U.S. Patent No. 7,116,710 B1 as obvious over Divsalar and Frey; and

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Claims 15–17, 19–22, and 24–33 of U.S. Patent No. 7,116,710 B1 as obvious over Divsalar, Frey, and Luby97.

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