Paper No. ___
Filed: April 3, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00211
Patent No. 7,116,710

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" or "Apple") has not met its burden of showing that it has a reasonable likelihood of prevailing on any of its proposed grounds of unpatentability.

The petition should be denied at least because the Petitioner failed to establish that all references in each of its grounds qualify as prior art. For example, each of the grounds of challenge relies on the "Frey Slides," which the petition vaguely alleges were "presented" at a conference. The petition, however, leaves both Caltech and the Board in the dark as to what particular prior art theory is being advanced and whether it is even one commensurate in scope with statutory restrictions on *inter partes* review under AIA §311 (*i.e.*, review based on prior art patents and printed publications). Assuming *arguendo* the Petitioner is asserting the Frey Slides as a printed publication, the evidence of such is insufficient, as Petitioner points to only a cryptic comment in an unsworn "report" lifted from a different litigation proceeding, but which is inadmissible hearsay in this proceeding. Other references, such as the Pfister Slides, (Ex. 1105), have similar problems.

Even assuming the references relied upon 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 references.

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. 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 compared to 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).[1] Petitioner has also filed two more pending petitions challenging claims of the '710 patent. *See* IPR2017-00210; *see also* IPR2017-00219.[2]

One of the rejected Hughes IPRs, IPR2015-00067, similarly presented grounds based on the references to Frey and Divsalar. Concurrent with the present petition, this Petitioner filed an IPR petition (IPR2017-00210) based on the very same Frey and Divsalar references and advancing substantially the same arguments.

The present petition differs from the -00210 petition in that the Frey reference, (Ex. 1102), has been replaced with the Frey Slides (Ex. 1113).[3] But Petitioner has not explained why either this petition or the -00210 petition

[1] Counsel for Petitioner Apple also represented Hughes in the previous Hughes district court litigation.

[2] 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)).

[3] Petitioner argues that the Frey paper (Ex. 1102) and the Frey Slides (Ex. 1113) provide substantially the same content. As such, it is unclear how petitioner believes that the present petition is meaningfully distinct from the -00210 petition or from the Hughes IPR2015-00067 case.

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