

IN THE 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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IPR2017-00219  
U.S. Patent No. 7,116,710

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**JOINT MOTION TO LIMIT PETITION  
PURSUANT TO 37 C.F.R § 42.71**

## I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71 and the Board's Order dated May 8, 2018, Petitioner, Apple Inc., and Patent Owner, California Institute of Technology, jointly request that the Board limit the petition in *inter partes* review IPR2017-00219 of U.S. Patent No. 7,116,710 to the originally instituted claims 1-8, 11-17, 19-22, and 24-33. The parties respectfully request that the Board remove claims 10 and 23 from this proceeding such that claims 10 and 23 are not subject to a final written decision.

## II. STATEMENT OF FACTS

Petitioner filed a petition for *inter partes* review of claims 1-8, 10-17, and 19-33 of U.S. Patent No. 7,116,710. The Board instituted review of claims 1-8, 11-17, 19-22, and 24-33 on June 30, 2017. Claims 10 and 23 were not instituted. No alternate grounds were denied.

On April 24, 2018, the Supreme Court held that a decision to institute 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, 2018, the Board modified the institution decision to institute on all challenged claims and all grounds presented in the petition. At oral argument on May 8, 2018 for related cases IPR2017-00700, IPR2017-00701, and IPR2017-00728, the parties notified the Board of their agreement to jointly withdraw the originally non-instituted

claims and grounds in IPR2017-00219 and related cases<sup>1</sup> such that they shall not be subject to a final written decision. The Board subsequently authorized this motion in its order on May 8, 2018.

### III. SUMMARY

In light of the above, Petitioner and Patent Owner respectfully request 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.

Dated: May 15, 2018

Respectfully Submitted,

/Michael Smith/

Michael H. Smith (No. 71,190)  
*Counsel for Petitioner*

/Matthew Argenti/

Matthew Argenti (No. 61,836)  
*Counsel for Patent Owner*

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<sup>1</sup> IPRs 2017-00210, -00297, -00700, and -00701. Related case IPR2017-00728 was instituted in full.

**CERTIFICATE OF SERVICE**

I hereby certify that on May 15, 2018, I caused a true and correct copy of the foregoing materials:

- Joint Motion to Limit Petition

to be served via electronic mail on the following correspondents of record as listed in Patent Owners' Mandatory Notices:

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