

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

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

I. INTRODUCTION

On July 31, 2017, the Board issued an order granting Petitioner’s request to file this motion. Paper 20. Petitioner respectfully moves to submit Exhibits 1227–1241 as supplemental information under 37 C.F.R. § 42.123(a).

The Board instituted *inter partes* review of claims 1–8, 11–17, 19–22, and 24–33 of U.S. Patent No. 7,116,710 (the “’710 patent”) on June 30, 2017 on multiple grounds, including that the claims are obvious over Divsalar¹ in combination with other prior art references. Petitioner relied on Frey² to demonstrate a motivation to combine the prior art. Patent Owner challenged the prior art status of Frey and Divsalar in its Preliminary Response. Petitioner now seeks permission to file supplemental information to rebut Patent Owner’s challenges and establish the prior art status of Divsalar and Frey. The supplemental information Petitioner requests authorization to submit takes the form of fifteen exhibits—consisting of affidavits, declarations, deposition transcripts, library records, a purchase order, shipping

¹ Dariush Divsalar, et al., *Coding Theorems for “Turbo-Like” Codes*, PROCEEDINGS OF THE 36TH ALLERTON CONFERENCE ON COMMUNICATION, CONTROL, AND COMPUTING, Sept. 23–25, 1998, at 201–209 (Ex. 1203, “Divsalar”).

² Brendan J. Frey and David J.C. MacKay, *Irregular Turbocodes*, PROCEEDINGS OF THE 37TH ALLERTON CONFERENCE ON COMMUNICATION, CONTROL, AND COMPUTING (1999) at 241–248 (Ex.1202, “Frey”).

information, and other publications—that establish (1) the public accessibility of Divsalar no later than June 3, 1999, and (2) the public accessibility of Frey no later than March 20, 2000.

Petitioner served the supplemental information on Patent Owner on July 14, 2017, and requested authorization to file this motion shortly thereafter. Patent Owner will have had over two months to consider the supplemental information before it must file its Patent Owner’s response. As a result, Petitioner’s submission of supplemental information will neither prejudice Patent Owner nor impact the Board’s ability to complete the *inter partes* review in a timely manner. Petitioner’s motion should therefore be granted.

II. ARGUMENT

A. Legal Standard

Under 37 C.F.R. § 42.123(a), a party may submit supplemental information if: (1) its “request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted;” and (2) “[t]he supplemental information [is] relevant to a claim for which the trial has been instituted.”

The Board has discretion to grant a motion to submit supplemental information. *South-Tek Sys., LLC v. Eng’rd Corrosion Solutions, LLC*, No. IPR2016-01351, 2017 WL 2609329, at *1 (PTAB June 15, 2017). In exercising

its discretion, the Board’s “guiding principle . . . is to ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.” *Id.* (internal quotation marks and citation omitted); *see also* 37 C.F.R. § 42.1(b) (requiring the Board to construe its rules “to secure the just, speedy, and inexpensive resolution of every proceeding”).

It is Petitioner’s burden to prove it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

B. Petitioner Is Entitled To Relief Under 37 C.F.R. § 42.123(a).

Petitioner should be permitted to submit Exhibits 1227–1241 as supplemental information pursuant to 37 C.F.R. § 42.123(a). Petitioner requested authorization to submit its motion on July 23, 2017, and in response to that request the Board held a conference call on July 26, 2017, less than one month after the Board instituted *inter partes* review. *See* 37 C.F.R. § 42.123(a)(1).

Further, each exhibit supports the prior art status of Divsalar and/or Frey—the primary piece of prior art upon which the Board instituted *inter partes* review and prior art showing a motivation to combine the prior art—and are therefore “relevant to a claim for which the [*inter partes* review] has been instituted.” 37 C.F.R. § 42.123(a)(2); *see South-Tek Sys.*, 2017 WL 2609329, at *2 (“Based on the above analysis, we determine that Exhibits 1028 and 1029 are relevant to this proceeding. They provide a more complete record of the public availability of the EPRI

reference.”); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, No.

IPR2013-00369, at 3 (PTAB Feb. 5, 2014) (Paper 37) (“Evidence that allegedly confirms the public accessibility of references that serve as the basis of the grounds of unpatentability authorized in this proceeding is relevant to the claims . . . for which this trial was instituted.”).

Patent Owner challenged the prior art status of Divsalar and Frey in its Preliminary Response. *See* Paper 16 at 8–9, 32. As detailed below, Exhibits 1227–1241 counter Patent Owner’s argument and establish the public accessibility of Divsalar no later than June 3, 1999 and Frey no later than March 20, 2000:

1. Library Records and Related Declarations. Exhibits 1227–1231 establish the dates by which Divsalar and Frey were published and/or publicly available at certain libraries.

- Exhibits 1227 and 1228 are library records from the Jet Propulsion Laboratory³ indicating that the 37th Annual Allerton Conference Proceedings—in which Frey appeared—was published in 1999.
- Exhibit 1229 is a library record indicating that the 36th Annual Allerton

³ Jet Propulsion Laboratory is a division of Patent Owner. *See* JET PROPULSION LAB | CALTECH, <http://www.caltech.edu/content/jet-propulsion-laboratory> (last visited Aug. 4, 2017).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.