

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 IPR2017-00219¹
Patent 7,116,710 B1

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

JEFFERSON, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to File Supplemental Information
37 C.F.R. §§ 42.5 and 42.123

¹ 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.

Petitioner moves to submit supplemental information related to prior art references in accordance with 37 C.F.R. § 42.123 in IPR2017-00210 and IPR2017-00219. Paper 21 (“Mot. to Supp.”).² Patent Owner opposes Petitioner’s motion. Paper 22 (“Opp. to Mot. to Supp.”). Under 37 C.F.R. § 42.123(a), supplemental information may be submitted if the information is “relevant to a claim for which trial has been instituted” and if the party seeking to submit it requests authorization “within one month of the date the trial is instituted.”

In both IPR2017-00210 and IPR2017-00219, Petitioner argues that “Patent Owner challenged the prior art status of Frey and Divsalar in its Preliminary Response,” and seeks to submit Exhibits 1027–1041 as supplemental information “to rebut Patent Owner’s challenges and establish the prior art status of Divsalar and Frey.” Mot. to Supp. 1. Petitioner maintains that:

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 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.

Id.

Patent Owner argues that Petitioner’s intended supplemental information “fail[s] to support the specific allegations made in the petition regarding the publication dates of Frey and Divsalar.” Opp. to Mot. to Supp.

² Similar papers were filed in the two subject cases. For clarity and expediency, we treat IPR2017-00219 as representative. Unless indicated otherwise, all citations are to IPR2017-00219.

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at 5. Patent Owner contends that Petitioner's proposed supplemental exhibits are confusing and duplicative, contain speculation and hearsay, and promise to turn the proceedings into an evidentiary morass. *Id.*

Patent Owner further argues that Frey is not a reference asserted in any instituted ground in IPR2017-00219 and that Petitioner has made no effort to qualify Frey as a prior art printed publication. *Opp. to Mot. to Supp. 2, 5.* Patent Owner further argues that Petitioner's intended supplemental information "fail[s] to support the specific allegations made in the petition regarding the publication date of Divsalar." *Id.* at 5.

Each of the subject *inter partes* reviews includes at least one instituted ground in which Divsalar is asserted. Thus, Divsalar is relevant to a claim for which trial has been instituted and, therefore, so is evidence directed to its status as prior art. Notwithstanding Patent Owner's argument that the Divsalar related evidence fails to support the specific allegations in the Petition, we wish to consider the totality of the evidence concerning the publication date, and will consider any inconsistencies at the appropriate time. In a similar way, Frey is an asserted reference in an instituted grounds in IPR2017-00210, so evidence directed to Frey's status as prior art is relevant to a claim for which trial has been instituted in that case.

Patent Owner is correct to the extent it contends that Frey is not asserted specifically as a reference in any instituted ground in IPR2017-00219. *See Opp. to Mot. to Supp. 1* ("To begin with, Frey is not a reference asserted in any instituted ground."). However, Petitioner asserts that it "relied on Frey (Ex. 1202) to demonstrate a motivation to combine the prior art," *Mot. to Supp. 1*, and we note the Petition and Petitioner's declarant do cite Frey in the context of at least the asserted ground of obviousness. *See,*

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e.g., Paper 5 (“Petition”), 35, 55 (IPR2017-00219); Ex. 1206 ¶¶ 401, 458 (IPR2017-00219). Petitioner cites Frey as evidence that researchers were specifically motivated to incorporate specific teachings into Divsalar. Paper 5, 35 (IPR2017-00219). Evidence pertaining to such motivations is relevant to a claim for which trial has been instituted and, therefore, also is Frey’s status as prior art.

Patent Owner’s arguments against the Frey evidence are also based upon the assertion that Petitioner identified “a publication date of March 20, 2000” as the publication date of Frey. *Opp. to Mot. to Supp. 1*. With respect to Frey, the Petition’s Table of Exhibits identifies Frey as “published on or before March 20, 2000.” Paper 5, i (IPR2017-00219). Contrary to Patent Owner’s arguments, Petitioner’s supplemental evidence directed to dates before March 20, 2000, are not necessarily irrelevant. *See, e.g., Opp. to Mot. to Supp. 5–7* (“Exhibits 1027 and 1028 are identified as library records that allegedly show a 1999 date of publication for the conference proceedings containing Frey . . . [and] are irrelevant to the March 20, 2000 date asserted in the Motion.”). In sum, Petitioner provides sufficient evidence that the Exhibits 1027–1041 as supplemental information are relevant to the Petitioner’s contentions.

Accordingly, it is:

ORDERED that Petitioner’s Motions to Submit Supplemental Information are granted.

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