

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 IPR2017-00219 (Patent 7,116,710 B1);
Cases IPR2017-00700, IPR2017-00701, and
IPR2017-00728 (Patent 7,421,032 B2)¹

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

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Requests for Reconsideration
37 C.F.R. § 42.71

¹ This Decision will be entered in each case. The parties are not authorized to use this caption style.

IPR2017-00210, IPR2017-00219 (Patent 7,116,710 B1)
IPR2017-00700, IPR2017-00701, IPR2017-00728 (Patent 7,421,032 B2)

I. Introduction

Patent Owner California Institute of Technology filed, in each of the above-captioned cases, a Request for Rehearing. *E.g.*, IPR2017-00210, Paper 36. Patent Owner requests that we reconsider and withdraw our orders in each case granting Petitioner’s Motion to Submit Supplemental Information. *E.g.*, IPR2017-00210, Paper 32 (“Order”). The Requests for Rehearing (collectively, “Request” or “Req. Reh’g”) are similar in each of the cases captioned above. Unless otherwise indicated, citations herein are to the papers filed in IPR2017-00210.

Patent Owner’s Request alleges that “[t]he decision is inconsistent with Board decisions on similar motions and is deeply prejudicial to Caltech in both its timing and its scope . . . [and] the Board misapprehended or overlooked these issues in granting Petitioner’s motion.” Req. Reh’g 1.

For the reasons set forth below, each Request for Rehearing is *denied*.

II. Legal Standard

Under the rules governing requests for rehearing on a decision on a motion, the decision is reviewed for an abuse of discretion. 37 C.F.R. § 42.71(b). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). Further, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

III. Analysis

In light of Patent Owner’s arguments, it is important to note that Petitioner’s Motion to Submit Supplemental Information (Paper 22) pertains to the filing of exhibits, not the filing of substantive briefs containing arguments. Petitioner moved to submit supplemental information regarding the prior art status of two references, stating that Patent Owner challenged, in its Preliminary Response, the prior art status of those references. *Id.* at 1. Patent Owner filed an Opposition to Petitioner’s Motion to Submit Supplemental Information (Paper 23, “Patent Owner’s Opposition”).

Patent Owner argues that we “misapprehended the improper nature of the supplementation.” Req. Reh’g 4; *see id.* at 1–2 (argument under the heading “Improper purpose misapprehended”). Specifically, Patent Owner contends that “Petitioner has been permitted to shift its theory of unpatentability long after the institution decision.” *Id.* at 2. Patent Owner speculates that “[i]nvariably, Petitioner will raise arguments in its reply that it will insist Caltech should have anticipated from the supplemental evidence.” *Id.*; *see id.* at 1–2 (Patent Owner asserting that it had to file its Response to the Petition “without the benefit of knowing what, if any, publication dates were being asserted beyond those specifically identified in the petition.”). First, it is unclear to us where such an alleged shift in Petitioner’s theory of unpatentability has occurred as Petitioner has not filed its Reply Brief, yet. Second, Patent Owner’s argument, in effect, is that Petitioner *may* take a particular position or *may* make certain arguments in the yet-to-be-filed Reply Brief. We decline to join Patent Owner in speculating as to what Petitioner may do in the future. We will address

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those matters when and if they are raised, and are not persuaded that we misapprehended any argument regarding “improper nature.”

Patent Owner also argues in some, but not all, of the above-captioned cases, that we “overlooked how prejudicial the extremely late addition of this evidence to the record would be to Caltech.” *E.g.*, IPR2017-00210, Req. Reh’g 4 (citing Paper 23 (Patent Owner’s Opposition), 11). Patent Owner does not indicate clearly where all of the arguments it now makes were made previously. Much of that section of the Request cites directly to Petitioner’s Motion (Paper 22), rather than Patent Owner’s Opposition, which suggests that these arguments were not raised before. We could not have overlooked arguments not made. Moreover, the pertinent section of the Request contains a single citation to Patent Owner’s Opposition. *See* Req. Reh’g 4 (citing “*See, e.g.*, Paper 23, 11.”). The cited page of Patent Owner’s Opposition has only a passing reference to the issue of prejudice, and that is in the context of the speculative argument that allowing Petitioner to “alter . . . the petition case long after the petition filing” would be prejudicial. Patent Owner’s Opposition (Paper 23), 11. As above, these assertions of prejudice are rooted primarily in speculation as to what arguments Petitioner may make in the future. We fail to see how Patent Owner has been unduly prejudiced by events that have yet to occur, and are not persuaded that we overlooked such arguments.

As mentioned above, Patent Owner argues that “[t]he decision is inconsistent with Board decisions on similar motions.” Req. Reh’g 1. Patent Owner does not describe how the decisions in the present cases purportedly are inconsistent with other panels’ decisions. For example,

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Patent Owner does not describe the facts of those other decisions, does not compare such factual underpinnings to those of the cases before us now, and does not address the dissimilarities.

In its Request, Patent Owner cites, at page 1 of the Request, *Medtronic, Inc. v. Endotach LLC*, IPR2014-00100, Paper 18. In that case, “Petitioner filed a paper requesting authorization to file a motion to submit supplemental information ‘to present additional grounds of unpatentability.’” *Id.* at 3 (quoting Paper 17, the petitioner’s request). Specifically, Petitioner sought to file infringement contentions from a related district court litigation and three additional prior art references. *Id.* at 3–4.

Patent Owner also cites, at page 3 of the Request, *Laboratoire Francais du Fractionnement v. Novo Nordisk Healthcare*, IPR2017-00028, Paper 22 (2017). In that case, the petitioner sought to file a new reference and the panel stated “[i]n essence, Petitioner seeks to bolster its Petition by introducing new prior art teachings in response to arguments presented in Patent Owner’s Preliminary Response.” *Id.* at 2, 4.

We are not persuaded that the facts underlying the cited decisions of other panels are so similar to those facts before us to yield inconsistent outcomes. Notwithstanding Patent Owner’s speculation as to what Petitioner may argue, we do not understand Petitioner to be introducing new proposed grounds of patentability or new prior art teachings. Thus, we do not agree that our decisions to grant Petitioner’s motions are inconsistent with these other Board decisions.²

² We additionally observe that the Board decisions cited by Patent Owner are routine opinions. They are not binding authorities.

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