Paper No. ___
Filed: April 7, 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 IPR2017-00297
Patent No. 7,916,781

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 3-12 and 19-21 of U.S. Patent No. 7,916,781 ("the '781 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.

As an initial matter, review should be denied on the basis that the present petition rehashes substantially the same art and arguments that have already been presented to the Office and rejected by the Board in a previous IPR challenge. Petitioner acknowledges that the '781 patent was already "challenged in one petition for *inter partes* review." Pet. at 1; *see also* IPR2015-00059. The previous petition similarly relied on Ping alone or in view of the Luby '909 Patent or the Patterson '999 Patent. The Board denied institution as to all grounds that relied on Ping alone or in view of other references. *Hughes Network Systems, LLC v. California Institute of Tech.*, Case No. IPR2015-00059, Paper 18 at 14-16. In this instance, Petitioner essentially recycles the same Ping-based arguments. The current Ground 2 (anticipation based on Ping) has no substantive differences compared to what the Board previously considered and rejected. For the remaining grounds, the petition adds Divsalar as a contingency plan to the same Ping/anticipation argument, and substitutes MacKay for the Luby '909 Patent and

Coombes for the Patterson '999 Patent to present substantially the same disclosures and arguments that the Board considered and rejected in the prior petition.

The proposed grounds of challenge should also be rejected on the merits. The petition materials fail to demonstrate that each feature of claims 3-12 and 19-21 of the '781 patent is found in the cited art. Multiple aspects of the claimed subject matter are missing from the asserted references.

Moreover, the Petitioner has failed to demonstrate that one of ordinary skill in the art would reasonably have combined the references as proposed. The arguments advanced in the petition essentially amount to little, if anything, beyond assertions that the cited references are analogous art. The Board has rejected such assertions as insufficient motivation to specifically combine teachings in particular ways. Any additional explanation provided in the petition is insufficient, lacks the requisite logical underpinnings, or both, and should be dismissed.

Accordingly, institution of *inter partes* review should be *denied*.

II. THE PRESENT PETITION RECYCLES PREVIOUS CHALLENGES REJECTED BY THE OFFICE

The instant petition presents one in a series of challenges to the '781 patent, but rehashes substantially the same art and arguments already presented to the Office and rejected by the Board. Accordingly, the Board should exercise its discretion in denying institution on all grounds in the petition. 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 from what the Board has already rejected. Petitioner acknowledges that the'781 patent was already "challenged in one petition for *inter partes* review." Pet. at 1. In the prior petition, the Board rejected grounds substantially the same as the grounds Petitioner presents in this instance. *See Hughes Network Systems, LLC v. California Institute of Tech.*, Case No. IPR2015-00059, Paper 18 (Apr. 27, 2015).[1]

For example, the rejected grounds in the Hughes petition challenged claims 1-7, 13-16, and 19 as either anticipated by Ping or obvious over Ping in view of the '999 patent (U.S. Patent No. 4,623,999) and/or the Luby '909 patent (U.S. Patent No. 6,081,909). *Id.* at 8. Here, each of the grounds in the instant petition challenges claims 1-8, 10-12, and 19-21 as either anticipated by the same Ping reference or obvious over the Ping reference in view of Divsalar. *Compare* Pet. at 34-70 *with*

[1] Petitioner has also filed another pending petition challenging claims of the '781 patent. *See Apple Inc. v. Cal. Inst. of Tech.*, Case No. IPR2017-00423, Paper 5 (PTAB Dec. 12, 2016).

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