

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00297¹
Patent 7,916,781 B2

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

HUDALLA, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Limit the Petitions
37 C.F.R. §§ 42.1(b), 42.71

¹ Case IPR2017-00423 has been consolidated with this proceeding.

The Institution Decisions in this consolidated case instituted trial on some but not all of the challenged claims and some but not all of the challenged grounds. Papers 16, 18. Subsequently, on April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). By our Order of May 2, 2018, we modified our institution decisions in light of *SAS* to institute trial on all of the challenged claims and all of the grounds presented in the Petitions from IPR2017-00297 (Paper 5) and IPR2017-00423 (Paper 5). Paper 61.

As authorized by our Order of May 8, 2018 (Paper 62), the parties filed a Joint Motion to Limit the Petitions. Paper 63. Specifically, the parties requested

that the Board remove claims 3-12 and 17 of U.S. Patent No. 7,916,781 and alternate grounds for claims 19, 20, and 21 from this proceeding, and limit the petition[s] in the present *inter partes* review to grounds that claims 13-15, 18, and 22 are rendered obvious by the combination of Ping and MacKay, claim 16 is rendered obvious by the combination of Ping, MacKay, and Coombes, and claims 19-21 are anticipated by Ping.

Id. at 3. Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this consolidated proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b).

Accordingly, we *grant* the Joint Motion to Limit the Petitions. As such, the following claims and grounds of unpatentability are removed from dispute in this consolidated proceeding:

Reference(s)	Basis	Claim(s) Challenged	Petition
Ping and Divsalar	35 U.S.C. § 103(a)	3, 5–8, 10, and 12	IPR2017-00297, Paper 5
Ping, Divsalar, and MacKay	35 U.S.C. § 103(a)	9	IPR2017-00297, Paper 5
Ping, Divsalar, and Coombes	35 U.S.C. § 103(a)	4 and 11	IPR2017-00297, Paper 5
Ping and MacKay	35 U.S.C. § 103(a)	17, 19–21	IPR2017-00423, Paper 5

Accordingly, it is:

ORDERED that the Joint Motion to Limit the Petitions is *granted*;

and

FURTHER ORDERED that the Petitions are limited to the following claims and grounds of unpatentability:

Reference(s)	Basis	Claim(s) Challenged	Petition
Ping	35 U.S.C. § 102(b)	19–21	IPR2017-00297, Paper 5
Ping and MacKay	35 U.S.C. § 103(a)	13–15, 18, and 22	IPR2017-00423, Paper 5
Ping, MacKay, and Coombes	35 U.S.C. § 103(a)	16	IPR2017-00423, Paper 5

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