

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00700
Patent 7,421,032

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION**

I. INTRODUCTION

On September 22, 2017, Apple, Inc. (“Petitioner”) filed a Motion to Submit Supplemental Information under 37 C.F.R. §§ 42.123 and 42.5 (Paper 21) (“Motion”). Petitioner seeks to introduce 15 exhibits that were previously served on Patent Owner as Supplemental Evidence. Patent Owner California Institute of Technology (“Caltech”) opposes Petitioner’s motion.

Rule 123(a) applies to requests made within one month of institution. Rule 123(b) applies to requests made later than one month from institution. The present case presents the latter scenario. Petitioner does not meet the higher threshold showing required under Rule 123(b), nor could it as there is no reasonable excuse for its delay. Petitioner admits as much by requesting a waiver of the rules governing submission of supplemental information. The motion should be denied on that basis, as Petitioner cannot show its unexplained delay should be excused.

Further, the Motion should also be denied for reasons extending beyond the timeliness issue to the merits of the supplemental information request. The requested supplemental evidence relates to purported publication of the Frey and Divsalar references. Petitioner was already given one chance to modify the evidence relied upon in the petition on these issues when it was allowed to enter substitute exhibits prior to institution. *See* Papers 10, 12. Now, Petitioner seeks a third opportunity to present evidence that should have been included in the

petition. This is remarkable considering Petitioner recycled previous petitions where the public availability of Frey and Divsalar was at issue.

What's more, Petitioner makes clear that the new evidence is intended to shift the case away from the grounds presented in the petition by presenting a myriad of possible publication dates. To begin with, Frey is not a reference asserted in any instituted ground. Furthermore, as discussed below, the petition made no effort to argue, much less substantiate, any particular date of publication for Frey.¹ Yet the Motion asserts that the various exhibits in the requested supplemental information demonstrate publication in February 2000, January 2000, October 1999, or even the year 1999 generally. As such, these exhibits are not only internally contradictory so as to create an evidentiary mess, but irrelevant to the March 20, 2000 date stated in Petitioner's exhibit list and the Motion.

Finally, Petitioner has candidly acknowledged that it is attempting to preempt potential arguments in the Patent Owner Response. Petitioner expressly stated in the July 26, 2017 conference call with the Board its concern that Caltech

¹ The table of exhibits lists a date of March 20, 2000, but no argument or explanation is provided.

might attempt to antedate the alleged March 20, 2000 publication date asserted regarding Frey.² However, submitting supplemental information as a vehicle to preempt a possible position the Patent Owner may take is impermissible.

Medtronic, Inc. v. Endotach LLC, IPR2014-00100, Paper 18 at 4 (Apr. 21, 2014)

(“[S]upplemental information . . . to respond to a possible position that another party may take in the future is improper.”). Presenting publication dates as moving targets with evolving theories of unpatentability is prejudicial to Caltech, is improper use of supplemental information, and should be denied.

II. LEGAL STANDARD

Even if the requirements of 37 C.F.R. § 42.123(a) for filing the motion are satisfied, the Board is not required to grant the motion. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015). Instead, the “guiding principle” for the Board is to “ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.” *Id.*

The Board has denied supplementation proffered to change the evidence presented in the petition, or to “bolster” a challenge based on feedback gleaned

² That call involved IPR2017-00210 and -00219.

from the institution decision. *Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30 at 5-6 (Nov. 28, 2014); *Redline Detection, LLC v. Star Envirotech, Inc.*, IPR2013-00106, Paper 24 at 4 (Aug. 5, 2013), *aff'd*, 811 F.3d 435 (Fed. Cir. 2015)).

The use of supplemental information as a vehicle to reply to arguments made in a preliminary response or as an attempt to preempt possible arguments a Patent Owner might take during trial is not permitted either. *VTech Commc'ns, Inc. v. Spherix Inc.*, IPR2014-01432, Paper 12 at 3 (, Jan. 21, 2015); *see also Medtronic*, IPR2014-00100, Paper 18 at 4 (Apr. 21, 2014).

III. PROCEDURAL HISTORY

Petitioner's motion for supplemental information represents its third attempt to provide support for its grounds of unpatentability. *See* Motion at 11; Paper 10. The petition materials initially relied upon a draft version of the Frey paper allegedly distributed over the Internet—a theory previously rejected by the Board. *See* Ex. 1010 (original); *see also Hughes Communications, Inc. v. California Institute of Technology* (IPR2015-00067, “*Hughes*”), Paper 18 at 8-11. As to Divsalar, the petition relies on the Declaration of Robin Fradenburgh (Ex. 1019), recycled from the *Hughes* case, to allege public accessibility of the reference.

Prior to institution, the Petitioner requested permission to replace certain exhibits including Frey and Divsalar with new exhibits, and filed a motion to that

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