Paper No. ___
Filed: November 13, 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 IPR2017-00700
Patent 7,421,032

PATENT OWNER'S REQUEST FOR REHEARING
37 CFR §42.71(d)

I. PRECISE RELIEF REQUESTED

Patent Owner California Institute of Technology ("Caltech") requests the Board to reconsider and withdraw its decision (Paper 27) granting the motion of Petitioner Apple Inc. ("Petitioner") to file supplemental information (Paper 21). The decision is inconsistent with Board decisions on similar motions and is deeply prejudicial to Caltech in both its timing and its scope. Because the Board misapprehended or overlooked these issues in granting Petitioner's motion, the Board's decision should be withdrawn and the motion denied. *See* 37 C.F.R. § 42.71(d).

II. MATTERS MISAPPREHENDED OR OVERLOOKED

A. Improper purpose misapprehended

Petitioner candidly admitted that it wished to introduce supplemental evidence to preempt any Caltech attempt at antedating. Paper 22, 2-3. Such preemption is improper, however. *Medtronic, Inc. v. Endotach LLC*, IPR2014-00100, Paper 18, 4 (2014) (explaining that preempting future argument and shifting the ground of unpatentability are not proper uses of supplemental information); *see also* Paper 22, 3-4, 15.

The Board's decision to grant Petitioner's supplemental information request places Caltech in a Catch-22 where it has to file its Patent Owner response without the benefit of knowing what, if any, publication dates are being asserted beyond

those specifically identified in the petition. It is not Caltech's or the Board's burden to figure out whether an unspecified date is or is not supported by the record. *See Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1364 (Fed. Cir. 2015) ("A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.") (citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999).

While the Board cites relevance as its reason to admit this supplemental evidence (Paper 27, 4), relevance is a necessary but not sufficient condition. After all, even relevant evidence may be unfairly prejudicial or confusing. *See, e.g.*, FRE 403. Petitioner has been permitted to shift its theory of unpatentability long after the institution decision. Caltech is left to assess this evidence without the benefit of analysis from the petition or the institution decision. Inevitably, Petitioner will raise arguments in its reply that it will insist Caltech should have anticipated from the supplemental evidence. The Board should require Petitioner to present its evidence in the ordinary course of the proceeding (evidence supporting the petition with the petition; evidence supporting the reply with the reply). *Medtronic*, IPR2014-00100, Paper 18, 4. Petitioner should not be repeatedly permitted to change the record during Caltech's response periods.

III. CONCLUSION

The Board misapprehended or overlooked the improper nature of the

supplementation and the confusion and hardship that its out-of-sequence entry necessarily creates. The relief Petitioner requested was unwarranted and unduly prejudicial. Paper 27 should be withdrawn.

Respectfully submitted,

Date: November 13, 2017

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
Reg. No. 52,182

CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Request for Rehearing was served on this 13th day of November, 2017, on the Petitioner at the electronic service addresses of the Petitioner as follows:

Richard Goldenberg
Dominic Massa
Michael H. Smith
WILMER CUTLER PICKERING HALE AND DORR LLP
richard.goldenberg@wilmerhale.com
dominic.massa@wilmerhale.com
michaelh.smith@wilmerhale.com

Respectfully submitted,

Date: November 13, 2017

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
Reg. No. 52,182