

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 B2

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

BARRETT, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of U.S. Patent No. 7,421,032 B2 (“the ’032 patent,” Ex. 1001). Paper 5. The Petition challenged the patentability of claims 11–17 of the ’032 patent on various grounds of obviousness under 35 U.S.C. § 103. California Institute of Technology (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 13.

On August 4, 2017, an *inter partes* review was instituted on Petitioner’s obviousness challenge of claims 11, 12, and 14–16 based on Ping, MacKay, and Divsalar, and of claim 13 based on Ping, MacKay, Divsalar, and Luby97. Paper 14. However, the instituted review did not include Petitioner’s obviousness challenge of claim 17 based on Ping, MacKay, Divsalar, and Pfister Slides.

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the ’032 patent is unpatentable. Paper 14, 24. We modify our institution decision to institute on all of the challenged claims and all of the grounds presented in the Petition. *See Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018), available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

The oral argument in this matter currently is scheduled for Tuesday, May 8, 2018. The parties shall confer to discuss the impact, if any, of this

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Order on the current schedule. If, after conferring, the parties wish to change the schedule or submit further briefing, the parties either must, no later than 1 pm ET on Friday, May 4, 2018, request a conference call with the panel to seek authorization for such changes or briefing, or must be prepared to discuss the matter at the hearing currently scheduled for May 8, 2018.

In consideration of the foregoing, it is hereby:

ORDERED that our institution decision is modified to include review of all challenged claims and all grounds presented in the Petition; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or any further briefing, and, if so, shall, in accordance with the instructions above, request a conference call with the panel to seek authorization for such changes or briefing or shall be prepared to discuss the matter at the May 8, 2018, hearing.

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