

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

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. §§ 42.123 and 42.5**

I. INTRODUCTION

On September 18, 2017, the Board issued an order granting Petitioner's request to file this motion. Paper 19. Petitioner respectfully moves to submit Exhibits 1027–1041 as supplemental information under 37 C.F.R. § 42.123 and asks the Board to exercise its authority under 37 C.F.R. § 42.5 to excuse the three-day delay requesting authorization to file the motion.

The Board instituted review of claims 11–16 of the '032 patent on August 4, 2017 on multiple grounds, including that the claims are obvious over Divsalar (Ex. 1017) in combination with other prior art references. Petitioner relied on Frey (Ex. 1010) to demonstrate a motivation to combine the prior art. Patent Owner challenged the prior art status, including that of Divsalar, in its Preliminary Response. Petitioner now seeks permission to file supplemental information to rebut Patent Owner's challenges and establish the prior art status of Divsalar and Frey. The supplemental information Petitioner requests authorization to submit takes the form of fifteen exhibits—consisting of affidavits, declarations, deposition transcripts, library records, a purchase order, shipping information, and other publications—that establish (1) the public accessibility of Divsalar no later than June 3, 1999, and (2) the public accessibility of Frey no later than March 20, 2000.

Petitioner served the supplemental information on Patent Owner on July 14, 2017 in IPR Nos. 2017-00210 and 2017-00219 directed to a related patent, and then

again on August 28, 2017 in the present case and two related cases, IPR2017-00701 and IPR2017-00728. Petitioner asked Patent Owner on August 28, 2017 whether it intended to oppose a motion to submit the supplemental information. Patent Owner, however, did not respond regarding its position until September 6, 2017. Petitioner then promptly submitted requests for authorization to file supplemental information for all three proceedings on September 7, 2017, meeting the deadlines for IPR2017-00701 and IPR2017-00728, while inadvertently missing the deadline for the present proceeding, IPR2017-00700, by three days. In each case, Patent Owner will have had over three months to consider the supplemental information before it must file its Patent Owner's response. As a result, Petitioner's submission of supplemental information will neither prejudice Patent Owner nor impact the Board's ability to complete the *inter partes* review in a timely manner. There is good cause to excuse the three-day delay in the present case and doing so is in the interests of justice. Petitioner's motion should therefore be granted.

II. ARGUMENT

A. Legal Standard

1. 37 C.F.R. § 42.123

Under 37 C.F.R. § 42.123(a), a party may submit supplemental information if:

(1) its "request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted;" and

(2) “[t]he supplemental information [is] relevant to a claim for which the trial has been instituted.” If a party seeks to submit supplemental information more than one month after the date the trial is instituted, the “motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b).

The Board has discretion to grant a motion to submit supplemental information. *South-Tek Sys., LLC v. Eng’rd Corrosion Solutions, LLC*, No. IPR2016-01351, 2017 WL 2609329, at *1 (PTAB June 15, 2017). In exercising its discretion, the Board’s “guiding principle . . . is to ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.” *Id.* (internal quotation marks and citation omitted); *see also* 37 C.F.R. § 42.1(b) (requiring the Board to construe its rules “to secure the just, speedy, and inexpensive resolution of every proceeding”). It is Petitioner’s burden to prove it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

2. 37 C.F.R. § 42.5

Under 37 C.F.R. § 42.5(b): “The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.” The Board has exercised this authority to waive the requirement of 37 C.F.R. § 42.123(b) that “the supplemental information reasonably could not have been obtained earlier”

in the interests of justice. *E.g.*, *Biomarin Pharm. Inc. v. Genzyme Therapeutic Prods. Ltd. P'Ship*, Nos. IPR2013-00534, -00537 (PTAB Jan. 7, 2015) (Paper 80); *Gen. Elec. Co. v. Univ. of Virginia Patent Found.*, Nos. IPR2016-00357, -00358, -00359 (PTAB Feb. 21, 2017) (Paper 51).

The Board also has authority to excuse a late action under 37 C.F.R. § 42.5(c)(3) for good cause or in the interests of justice. 37 C.F.R. § 42.5(c)(3) (“Late action. A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.”); *H&S Mfg. Co., Inc. v. Oxbo Int’l Corp.*, No. IPR2016-00960 (PTAB Dec. 7, 2016) (Paper 8); *Universal Remote Control, Inc. v. Universal Elecs., Inc.*, Nos. IPR2014-01102, -01103, -01104, -01106 (PTAB July 6, 2015) (Paper 26).

B. Petitioner Should Be Granted Relief Under 37 C.F.R. § 42.123.

Petitioner should be permitted to submit Exhibits 1027–1041 as supplemental information pursuant to 37 C.F.R. § 42.123. Each exhibit supports the prior art status of Divsalar and/or Frey—the primary piece of prior art upon which the Board instituted *inter partes* review and prior art showing a motivation to combine the prior art—and are therefore “relevant to a claim for which the [*inter partes* review] has been instituted.” 37 C.F.R. § 42.123(a)(2); *see South-Tek Sys.*, 2017 WL 2609329, at *2 (“Based on the above analysis, we determine that Exhibits 1028 and 1029 are relevant to this proceeding. They provide a more complete record of the

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.