

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,  
Patent Owner.

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Case IPR2017-00701  
Patent 7,421,032 B2

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

BARRETT, *Administrative Patent Judge*.

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

The Institution Decision in this case instituted trial on some but not all of the challenged claims. Paper 14. 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 3, 2018, we modified our institution decision in light of *SAS* to institute trial on all of the challenged claims and all of the grounds presented in the Petition (Paper 3). Paper 60.

As authorized by our Order of May 8, 2018 (Paper 63), the parties filed a Joint Motion to Limit the Petition. Paper 64. Specifically, the parties requested “that the Board remove claims 2 and 3 of U.S. Patent No. 7,421,032 from this proceeding, and limit the petition in the present *inter partes* review to claims 1 and 4-10.” *Id.* at 3. Removing claims and 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 Petition. As such, the following claims and ground of unpatentability are removed from dispute in this proceeding:

References	Basis	Claims Challenged
Ping, MacKay, Divsalar, and Luby97	35 U.S.C. § 103(a)	2 and 3

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It is:

ORDERED that the Joint Motion to Limit the Petition is *granted*; and  
FURTHER ORDERED that the Petition is limited to the following  
claims and ground of unpatentability:

References	Basis	Claims Challenged
Ping, MacKay, Divsalar, and Luby97	35 U.S.C. § 103(a)	1 and 4–10

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