

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Cases IPR2017-00210 and IPR2017-00219 (Patent 7,116,710 B1);
Case IPR2017-00297 (Patent 7,916,781 B2)
Cases IPR2017-00700, IPR2017-00701, and
IPR2017-00728 (Patent 7,421,032 B2)¹

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

JEFFERSON, *Administrative Patent Judge*.

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

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style of heading.

IPR2017-00210, IPR2017-00219 (Patent 7,116,710 B1)
IPR2017-00297 (Patent 7,916,781 B2)
IPR2017-00700, IPR2017-00701, and IPR2017-00728 (Patent 7,421,032 B2)

On February 6, 2018, a conference call with counsel for Petitioner, Apple, Inc., and counsel for Patent Owner, California Institute of Technology, was held with Judges Barrett, Jefferson, and Hudalla, to address Patent Owner's request to file a motion to strike cross-examination testimony of Patent Owner's declarants, Dr. Mitzenmacher and Dr. Divsalar, pursuant to 37 C.F.R. § 42.53(d)(5)(ii) and/or sanction Petitioner for such cross-examination, pursuant to 37 C.F.R. § 42.12. Patent Owner alleges "discovery misconduct includ[ing] extensive and repeated violations of Bd.Rule 42.53(d)(5)(ii), which expressly limits cross-examination to the scope of the witness' direct testimony."

Having heard from the parties on these issues, we authorize Patent Owner to file a 10-page motion identifying the portions of the deposition transcripts in which the alleged discovery misconduct took place, the basis for its misconduct contentions, and the relief sought. We also authorize Petitioner to file a 10-page paper in opposition to Patent Owner's motion. At Patent Owner's request, we additionally authorize Patent Owner to file a table identifying, with specificity, the portions of the depositions deemed beyond the scope of the direct testimony. *See* 37 C.F.R. § 42.53(d)(5)(ii). In response, we authorize Petitioner to provide a tabular listing identifying the direct testimony or other papers which support its cross-examination of Patent Owner's declarants. The tabular listing from both parties are to supplement the parties' papers and should not be used for substantive arguments.

Patent Owner shall file its motion on or before February 15, 2018.
Petitioner shall file its opposition on or before February 27, 2018. For those

IPR2017-00210, IPR2017-00219 (Patent 7,116,710 B1)
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cases where the deposition transcripts of Patent Owner's declarants are not in the record at the time of Patent Owner's motion filing, Patent Owner shall file the transcripts in question as exhibits with its motion. In those cases, Petitioner shall not later file duplicate transcripts.

No reply is authorized at this time.

Accordingly, it is:

ORDERED that Patent Owner is authorized to file a combined Motion to Strike Cross-Examination Testimony and Motion for Sanctions as discussed herein, no later than February 15, 2018;

FURTHER ORDERED that Patent Owner is authorized to file an Opposition to Patent Owner's motion, no later than February 27, 2018.

IPR2017-00210, IPR2017-00219 (Patent 7,116,710 B1)
IPR2017-00297 (Patent 7,916,781 B2)
IPR2017-00700, IPR2017-00701, and IPR2017-00728 (Patent 7,421,032 B2)

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