

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00728
Patent 7,421,032

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

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 1227–1241 as supplemental information under 37 C.F.R. § 42.123(a).

The Board instituted *inter partes* review of claims 18–23 of U.S. Patent No. 7,421,032 (the “’032 patent”) on August 21, 2017 as obvious over Divsalar (1217) in combination with other prior art references. Petitioner relied on Frey (1210) 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, IPR2017-00700 and IPR2017-00701. 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. 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. Petitioner's motion should therefore be granted.

II. ARGUMENT

A. Legal Standard

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."

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).

B. Petitioner Is Entitled To Relief Under 37 C.F.R. § 42.123(a).

Petitioner should be permitted to submit Exhibits 1227–1241 as supplemental information pursuant to 37 C.F.R. § 42.123(a). Petitioner requested authorization to submit its motion on September 7, 2017, and in response to that request the Board held a conference call on September 14, 2017, less than one month after the Board instituted *inter partes* review. *See* 37 C.F.R. § 42.123(a)(1).

Further, 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 public availability of the EPRI reference.”); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, No.

IPR2013-00369, at 3 (PTAB Feb. 5, 2014) (Paper 37) (“Evidence that allegedly confirms the public accessibility of references that serve as the basis of the grounds of unpatentability authorized in this proceeding is relevant to the claims . . . for which this trial was instituted.”).

Patent Owner challenged the prior art status, including that of Divsalar, in its Preliminary Response. *See* Paper 13 at 6, fn. 4. As detailed below, Exhibits 1227–1241 counter Patent Owner’s argument and establish the public accessibility of Divsalar no later than June 3, 1999 and Frey no later than March 20, 2000:

1. Library Records and Related Declarations. Exhibits 1227–1231 establish the dates by which Divsalar and Frey were published and/or publicly available at certain libraries.

- Exhibits 1227 and 1228 are library records from the Jet Propulsion Laboratory¹ indicating that the 37th Annual Allerton Conference Proceedings—in which Frey appeared—was published in 1999.
- Exhibit 1229 is a library record indicating that the 36th Annual Allerton Conference Proceedings—in which Divsalar appeared—was published by June

¹ Jet Propulsion Laboratory is a division of Patent Owner. *See* JET PROPULSION LAB | CALTECH, <http://www.caltech.edu/content/jet-propulsion-laboratory> (last visited Aug. 4, 2017).

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