Paper No. ___
Filed: September 29, 2017

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

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

I. INTRODUCTION

On September 22, 2017, Apple, Inc. ("Petitioner") filed a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a) (Paper 21) ("Motion"). Petitioner seeks to introduce 15 exhibits that were previously served on Patent Owner as Supplemental Evidence. Patent Owner California Institute of Technology ("Caltech") opposes Petitioner's motion.

The requested supplemental evidence relates to purported publication of the Frey and Divsalar references. Petitioner was already given one chance to modify the evidence relied upon in the petition on these issues when it was allowed to enter substitute exhibits prior to institution. *See* Papers 10, 12. Now, Petitioner seeks a third opportunity to present evidence that should have been included in the petition. This is remarkable considering Petitioner recycled previous petitions where the public availability of the Frey and Divsalar references was at issue.

What's more, Petitioner makes clear that the new evidence is intended to shift the case away from the grounds presented in the petition by presenting a myriad of possible publication dates. To begin with, Frey is not a reference asserted in any instituted ground. Furthermore, as discussed in more detail below, the petition made no effort to argue, much less substantiate, any particular date of

publication for Frey.[1] Yet the Motion asserts that the various exhibits in the requested supplemental information demonstrate publication in February 2000, January 2000, October 1999, or even the year 1999 generally. As such, these exhibits are not only internally contradictory so as to create an evidentiary mess, but irrelevant to the March 20, 2000 date stated in Petitioner's exhibit list and the Motion.

Finally, Petitioner has candidly acknowledged that it is attempting to preempt potential arguments in the Patent Owner Response. Petitioner expressly stated in the July 26, 2017 conference call with the Board its concern that Caltech might attempt to antedate the alleged March 20, 2000 publication date asserted regarding Frey.[2] The Board, however, has previously explained that submitting supplemental information as a vehicle to preempt a possible position the Patent Owner may take is impermissible. *Medtronic, Inc. v. Endotach LLC*, IPR2014-

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[1] The table of exhibits lists a date of March 20, 2000, but no argument or explanation is provided.

[2] The July 26, 2017 conference call involved Petitioner's request to submit the same supplemental information in IPR2017-00210 and IPR2017-00219.

00100, Paper 18 at 4 (PTAB Apr. 21, 2014) ("[S]ubmitting supplemental information under 37 C.F.R. § 42.123(a) as a vehicle to respond to a possible position that another party may take in the future is improper."). Presenting publication dates as moving targets with evolving theories of unpatentability is prejudicial to Caltech, is improper use of supplemental information, and should be denied.

II. LEGAL STANDARD

Even if the requirements of 37 C.F.R. § 42.123(a) for filing the motion are satisfied, the Board is not required to grant the motion. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015). Instead, the "guiding principle" for the Board is to "ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner." *Id.*

The Board has denied supplementation proffered to change the evidence presented in the petition, or to "bolster" a challenge based on feedback gleaned from the institution decision. *Redline Detection*, Paper 24 at 4; *see also Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30 at 5-6 (PTAB Nov. 28, 2014) (citing *ZTE v. Contentguard Holdings, Inc.*, IPR2013-00139, Paper 27 at 3 (PTAB July 30, 2013)); *Redline Detection, LLC v. Star Envirotech, Inc.*, IPR2013-00106, Paper 24 at 4 (PTAB Aug. 5, 2013), aff'd, 811 F.3d 435 (Fed. Cir. 2015)).

The use of supplemental information as a vehicle to reply to arguments

made in a preliminary response or as an attempt to preempt possible arguments a Patent Owner might take during trial is not permitted either. *VTech Commc'ns, Inc. v. Spherix Inc*., IPR2014-01432, Paper 12 at 3 (PTAB, Jan. 21, 2015); *see also Medtronic*, IPR2014-00100, Paper 18 at 4 (PTAB Apr. 21, 2014).

III. PROCEDURAL HISTORY

Petitioner's motion for supplemental information represents its third attempt to provide support for its grounds of unpatentability. *See* Motion at 10; *see generally* POPR at 2-6. The petition materials initially relied upon a draft version of the Frey paper allegedly distributed over the Internet—a theory previously rejected by the Board. *See* Ex. 1210 (original); *see also Hughes Communications, Inc. v. California Institute of Technology* (IPR2015-00067, "*Hughes*"), Paper 18 at 8-11. As to Divsalar, the petition relies on the Declaration of Robin Fradenburgh (Ex. 1219), recycled from the *Hughes* case, to support the alleged public accessibility of the reference.

Prior to institution, the Petitioner requested permission to replace certain exhibits including Frey and Divsalar with new exhibits, and filed a motion to that effect. Paper 10. The Board granted the motion. The newly-submitted evidence included a copy of Frey (Ex. 1210, replacement) which the Motion now argues was published on March 20, 2000 based on a library stamp in the document. *See* Pet. at 25. The original copy of the Divsalar exhibit (Ex. 1217, original) was also replaced

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