

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 B2)
Case IPR2017-00701 (Patent 7,421,032 B2)
Case IPR2017-00728 (Patent 7,421,032 B2)¹

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

BARRETT, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to File Supplemental Information
37 C.F.R. §§ 42.5 and 42.123

¹ This Decision will be entered in each case. The parties are not authorized to use this caption style.

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Petitioner moves to submit supplemental information related to prior art references in accordance with 37 C.F.R. § 42.123. Paper 21² (“Mot. to Supp.”). In IPR2017-00700, Petitioner also requests that “the Board . . . exercise its authority under 37 C.F.R. § 42.5 to excuse the three-day delay requesting authorization to file the motion.” IPR2017-00700, Mot. to Supp., 1. Patent Owner opposes Petitioner’s motion. Paper 22 (Opp. to Mot. to Supp.”).

Under 37 C.F.R. § 42.123(a), supplemental information may be submitted if the information is “relevant to a claim for which trial has been instituted” and if the party seeking to submit it requests authorization “within one month of the date the trial is instituted.” That rule further provides:

(b) Late submission of supplemental information. A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. 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.

Petitioner argues that “Patent Owner challenged the prior art status, including that of Divsalar, in its Preliminary Response,” and seeks to submit Exhibits 1027–1041 as supplemental information “to rebut Patent Owner’s challenges and establish the prior art status of Divsalar [Ex. 1017] and Frey [Ex. 1010].” Mot. to Supp. 1. Petitioner maintains that:

² Similar papers were filed in the three subject cases. For clarity and expediency, we treat IPR2017-00700 as representative. Unless indicated otherwise, all citations are to IPR2017-00700.

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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.

Id.

Patent Owner argues that Frey is not a reference asserted in any instituted ground, and that Petitioner has made no effort to qualify Frey as a prior art printed publication. *Opp. to Mot. to Supp. 2*, 9. Patent Owner further argues that Petitioner’s intended supplemental information “fail[s] to support the specific allegations made in the petition regarding the publication date of Divsalar.” *Id.* at 9.

Each of the subject *inter partes* reviews includes at least one instituted ground in which Divsalar is asserted. Thus, Divsalar is relevant to a claim for which trial has been instituted and, therefore, so is Petitioner’s supplemental information directed to its status as prior art. Notwithstanding Patent Owner’s argument that the Divsalar-related supplemental information fails to support the specific allegations in the Petition, we wish to consider the totality of the evidence concerning the publication date, and will consider any inconsistencies at the appropriate time.

Regarding Petitioner’s intended supplemental information directed to Frey, Patent Owner is correct that Frey is not listed specifically as a reference in any instituted ground. *See Opp. to Mot. to Supp. 2* (“To begin with, Frey is not a reference asserted in any instituted ground.”). However, Petitioner asserts that it “relied on Frey (Ex. 1010) to demonstrate a

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motivation to combine the prior art,” Mot. to Supp. 1, and we note the Petition and Petitioner’s expert cite Frey in the context of at least the asserted ground of obviousness over Ping, MacKay, and Divsalar, *see, e.g.*, IPR2017-00700, Pet. 44; Ex. 1004 ¶ 120. Specifically, Petitioner cites Frey for the proposition that “the use of a repeater in implementing an outer coder was common in the prior art.” IPR2017-00700, Pet. 44. As such, Petitioner’s intended supplemental information pertaining to whether such subject matter was common in the prior art is relevant to a claim for which trial has been instituted.

Furthermore, many of Patent Owner’s arguments against the Frey evidence are based upon the assertion that Petitioner identified “a date of March 20, 2000” as the publication date of Frey. Opp. to Mot. to Supp. 2 n.1 (referring to the Petition’s table of exhibits); *see also, e.g., id.* at 9 (“the proposed supplemental evidence fails to support the March 20, 2000 date now asserted.”). However, the Petition’s Table of Exhibits actually identifies Frey as “published on or before March 20, 2000.” Contrary to Patent Owner’s arguments, Petitioner’s intended supplemental information directed to dates before March 20, 2000, is not necessarily irrelevant. *See, e.g.*, Opp. to Mot. to Supp. 9–10 (“Exhibits 1027 and 1028 are identified as library records that allegedly show a 1999 date of publication for the conference proceedings containing Frey . . . [and] are irrelevant to the March 20, 2000 date asserted in the Motion.”).

For these reasons, we determine that Exhibits 1027–1041 are “relevant to a claim for which trial has been instituted” in accordance with § 42.123(a).

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Regarding the timing of Petitioner's request for authorization in IPR2017-00700, Petitioner contends there is good cause for us to excuse Petitioner's late request and to allow Petitioner's intended supplemental information "because it will maintain consistency across IPRs on the same patent." Mot. to Supp. 14. Petitioner also notes it timely served the intended supplemental information. *Id.* at 1–2, 14. Patent Owner argues that the delay in knowing whether the exhibits will be placed in the record has prejudiced Patent Owner and that there is no reasonable excuse for Petitioner's three-day lateness in requesting authorization to file the present motion in IPR2017-00700. Opp. to Mot. to Supp. 1, 7–8.

Petitioner sought, via an email to the Board on September 7, 2017, a conference call with the panel seeking authorization to file the present motion. In IPR2017-00701 and IPR2017-00728, Petitioner timely sought authorization to file the motion within one month of institution (August 8, 2017, and August 21, 2017, respectively). In IPR2017-00700, the email was sent one month and three days after the date of institution (August 4, 2017). We excuse Petitioner's three-day-late request to file a motion in IPR2017-00700. Petitioner represents that it served on Patent Owner the subject exhibits in July and August of 2017, months prior to the due date for Patent Owner's Response. Mot. 1–2. We are not persuaded that the three-day delay resulted in undue prejudice to Patent Owner. We also are persuaded that it is the interests of justice to maintain consistency across the *inter partes* reviews in this family of cases.

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