

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 13, 2018, Patent Owner requested a conference call with respect to IPR2017-00210, IPR2017-00219, and IPR2017-00297 to request authorization to file a motion to strike certain purported new arguments raised in Petitioner's Reply or, in the alternative, to request authorization to file a Sur-Reply. According to Patent Owner, Petitioner's replies in IPR2017-00210, IPR2017-00219, and IPR2017-00297 included extensive new arguments and evidence, including testimony from a new declarant, Brendan Frey, Ph.D.,² and experimental data and simulations.

On February 15, 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. During the call, Petitioner stated that it had not previously apprised Patent Owner of its intention to proffer Dr. Frey's testimony before the filing of its Replies. Nevertheless, Petitioner maintained that all arguments and evidence in the Replies are responsive to Patent Owner's Responses. Petitioner also stated that additional declarations from Dr. Frey would be submitted with its Replies in the following related cases: IPR2017-00700, IPR2017-00701, and IPR2017-00728.

Generally, "[a] reply may only respond to arguments raised in the corresponding . . . patent owner response." 37 C.F.R. § 42.23(b). In accordance with this regulation, we will determine whether Petitioner's Reply, in each of the cases, contains evidence or argument that is outside the scope of Patent Owner's Response. Specifically, when we review the entire

² Petitioner had previously relied on the testimony of James A. Davis, Ph.D.

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trial record and prepare the Final Written Decision, we will determine whether the scope of Petitioner's Replies and accompanying evidence is proper. If there are improper arguments and evidence presented with Petitioner's Replies, we will, for example, only consider Petitioner's arguments and evidence that are properly rooted in the Petition. For these reasons, we are unpersuaded that a motion to strike is warranted, so we do not authorize Patent Owner to file a motion to strike.

Nevertheless, under the particular circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.20(d) and grant Patent Owner's request for authorization to file a seven-page Sur-Reply in each of the instant cases. Our decision to authorize Sur-Replies is heavily influenced by the fact that Petitioner's Replies are accompanied by and cite extensively to the testimony of a new declarant, Dr. Frey. *See, e.g.*, Ex. 1065 (declaration in IPR2017-00210). Because Petitioner indicates that new declarations from Dr. Frey will be filed in each of the pending cases, we authorize Patent Owner to file a seven-page Sur-Reply in IPR2017-00210, IPR2017-00219, IPR2017-00297, IPR2017-00700, IPR2017-00701, and IPR2017-00728. During the call, we were not persuaded that Patent Owner required its own new evidence to address the alleged new arguments and evidence in Petitioner's Replies. Consequently, in each of the cases, Patent Owner shall not introduce or file any new evidence or testimony with its Sur-Reply.

The parties are instructed to meet and confer regarding a discovery and a Sur-Reply briefing schedule in each of the aforementioned cases. The parties are to provide a joint proposed schedule for each of the cases by

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email to Trials@uspto.gov and may propose moving DUE DATE 6, if necessary, as part of their proposed Sur-Reply briefing schedule.

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a motion to strike is *denied*;

FURTHER ORDERED that Patent Owner's alternative request for authorization to file a Sur-Reply in each of the cases is *granted*;

FURTHER ORDERED that Patent Owner's Sur-Reply in each of the cases is limited to seven pages;

FURTHER ORDERED that Patent Owner and Petitioner shall propose a schedule for Patent Owner's Sur-Reply briefing by February 23, 2018;

FURTHER ORDERED that no new evidence or testimony of any kind shall be introduced or filed with Patent Owner's Sur-Reply in each of the cases; and

FURTHER ORDERED that Petitioner is not authorized to file a responsive submission.

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