

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner,

v.

PAPST LICENSING GMBH & CO., KG,  
Patent Owner.

---

Case IPR2016-01860  
Patent 8,966,144 B2

---

Before JONI Y. CHANG, JAMES B. ARPIN, and  
MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION

Termination of *Inter Partes* Review  
35 U.S.C. §§ 315(e)(1), 316(a)(4); 37 C.F.R. § 42.72

## I. INTRODUCTION

On October, 11, 2016, Apple Inc. (“Petitioner” or “Apple”) filed a Petition, which we granted, requesting *inter partes* review of certain claims<sup>1</sup> of U.S. Patent No. 8,966,144 B2 (Ex. 1001, “the ’144 patent”). Paper 2 (“Apple Petition”); Paper 10 (“Decision on Institution” or “Dec.”). Three months later, on January 15, 2017, Apple filed two other Petitions for *inter partes* review of the challenged claims and corresponding Motions for Joinder. *See* IPR2017-00679, Papers 1–2, and IPR2017-00670, Papers 1–2. We granted those Petitions and Motions for Joinder, and, consequently, Apple was joined as a petitioner to the following proceedings: IPR2016-01212 and IPR2016-01216, in which review of the challenged claims had been granted. *See* IPR2016-01212 (Paper 21), IPR2016-01216 (Paper 22) (collectively “Joinder IPRs”).

On December 11, 2017, the Board issued Final Written Decisions in the Joinder IPRs, concluding that the challenged claims of the ’144 patent are unpatentable. *See* IPR2016-01212 (Paper 32), IPR2016-1216 (Paper 33). Accordingly, all of the claims challenged in the instant proceeding have been subject to review and addressed in a Final Written Decision under 35 U.S.C. § 318(a). Oral argument in the instant proceeding has been requested by the parties. We held in abeyance all remaining deadlines, including the requested oral argument, pending the determination of whether this proceeding should be terminated in consideration of estoppel under

---

<sup>1</sup> Claims 1–3, 5–7, 9, 15–17, 19, 21, 26, 27, 29, 34, 37–39, 41, 49, 52, 54, 56, 57, 59–64, 66, 67, 78–83, and 86 (“the challenged claims”).

35 U.S.C. § 315(e)(1) and our authority under 35 U.S.C. §§ 316(a)(4) and 37 C.F.R. § 42.72.<sup>2</sup> Paper 23 (“Order to Show Cause”).

## II. BACKGROUND

The parties do not dispute that the instant proceeding asserts unpatentability of the same set of claims of the ’144 patent, for which the Board rendered a Final Written Decision in the Joinder IPRs. The instant proceeding involves grounds based primarily on Pucci as follows (Dec. 20):

Challenged Claims	Basis	References
1–3, 5–7, 9, 15–17, 19, 21, 26, 27, 29, 34, 37–39, 41, 49, 52, 56, 57, 59–64, 67, 78–83, and 86	§ 103(a)	Pucci, <sup>3</sup> Shinosky, <sup>4</sup> Kepley, <sup>5</sup> and Schmidt <sup>6</sup>

---

<sup>2</sup> See also 35 U.S.C. § 316(b) (“In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, *the efficient administration of the Office*, and the ability of the Office to timely complete proceedings instituted under this chapter.”; emphasis added); 37 C.F.R. § 42.5(a) (“The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.”).

<sup>3</sup> Marc F. Pucci, *Configurable Data Manipulation in an Attached Microprocessor*, 4 COMPUTING SYSTEMS 217 (1991) (“Pucci”) (Ex. 1041).

<sup>4</sup> US Patent No. 4,065,644 (“Shinosky”) (Ex. 1045).

<sup>5</sup> US Patent No. 4,790,003 (“Kepley”) (Ex. 1042).

<sup>6</sup> Friedhelm Schmidt, *THE SCSI BUS AND IDE INTERFACE* (Addison-Wesley 1995) (“Schmidt”) (Ex. 1007).

Challenged Claims	Basis	References
54	§ 103(a)	Pucci, Shinosky, Kepley, Schmidt, and Li <sup>7</sup>
66	§ 103(a)	Pucci, Shinosky, Kepley, Schmidt, and Wilson <sup>8</sup>

In addition to the instant proceeding, Apple currently is maintaining four *inter partes* reviews addressing patents related to the '144 patent: IPR2016-01842 (Patent 9,189,437 B2); IPR2016-01863 (Patent 8,504,746 B2); and IPR2016-01839 and IPR2016-01864 (Patent 6,470,399 B1).

### III. ANALYSIS

According to 35 U.S.C. § 315(e)(1),

[t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

By virtue of it being joined to the Joinder IPRs, Apple is a petitioner who has obtained a final written decision on all of the challenged claims of the '144 patent. If estoppel under § 315(e)(1) applies in these circumstances, Apple may not maintain the instant proceeding. Therefore, we first determine if Apple seeks to maintain this proceeding on “any

---

<sup>7</sup> US Patent No. 5,617,423 (“Li”) (Ex. 1053).

<sup>8</sup> US Patent No. 5,353,374 (“Wilson”) (Ex. 1044).

ground that the petitioner raised or reasonably could have raised during” the Joinder IPRs, according to § 315(e)(1). If the answer is yes, and Apple is estopped, we then determine whether termination is appropriate.

*A. Estoppel*

We have stated that a ground “reasonably could have been raised” if it encompasses prior art that a “skilled searcher conducting a diligent search reasonably could have been expected to discover.” *See Praxair Dist. Inc., v. INO Therapeutics*, 2016 WL 5105519 (PTAB Aug. 25, 2016) (IPR2016-00781) (citing 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); *see id.* at S1376 (statement of Sen. Kyl) (“This [estoppel] effectively bars such a party or his real parties in interest or privies from later using inter partes review . . . against the same patent, since the only issues that can be raised in an inter partes review . . . are those that could have been raised in [an] earlier post-grant or inter partes review.”); 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley) (“It also would include a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.”).

Here, there is no question that Apple filed the Apple Petition before the petitions in the Joinder IPRs. Therefore, Apple asserted the grounds based on Pucci at least three months before it filed the Joinder IPRs. As such, there is no evidence or argument in the record that the Pucci grounds were unavailable to Apple before it filed its petitions in the Joinder IPRs.

Apple argues that it could not have raised the Pucci grounds in the Joinder IPRs because trial had been instituted already in those proceedings. Paper 27, 1–2. This is not a fact relevant to our inquiry. We focus on whether Apple did raise or reasonably could have raised the Pucci grounds when it filed the '670 and '679 petitions and requested joinder. Apple *chose* not to include any ground based on Pucci in these petitions, but rather to file petitions identical to those for which trial was instituted in the Joinder IPRs. We recognize that what Apple *chose* to do served to increase the likelihood that the Board would grant the joinder request. A petitioner, however, is not required to join another petitioner's case. Nor is a petitioner required to request joinder only as to those grounds previously instituted. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (stating that the USPTO would allow joinder as of right if a party files a petition identical to that of an instituted inter partes review, *but clarifying* that if a party seeking joinder also presents “additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent.”). Thus, the choice of what ground to raise or not to raise is that of the petitioner. And for purposes of our inquiry regarding what constitutes grounds that could have been raised, it does not matter whether the Board would have instituted on those grounds had they been presented in connection with a joinder request.<sup>9</sup>

---

<sup>9</sup> *See Sony Corp. v. Yissum Research Devel. Co.*, Case IPR2013-00327, slip op. at 12–13 (PTAB Sep. 24, 2013) (Paper 14) (Joinder motion granted

Accordingly, we do not find persuasive Apple’s argument that it is not estopped merely because the trials it sought to join already were instituted. On the record before us, we determine that the Pucci grounds asserted in the instant proceeding were grounds Apple could have raised when it filed papers to join the instituted Joinder IPRs. Further, because the Board has issued a Final Written Decision in the Joinder IPRs concerning all of the challenged claims, we determine that Apple is estopped from maintaining the instant proceeding under § 315(e)(1).

*B. Termination*

We now turn to the question of whether to terminate the instant proceeding. Patent Owner argues that the instant proceeding is the third challenge to the ’144 patent maintained by Apple, and that termination would save resources by Patent Owner and the Board in preparing for oral argument and in rendering a Final Written Decision. Paper 26, 5. Apple contends that the Board neither will conserve any resources by terminating

---

adding challenged claims to an existing *inter partes* review. The Board’s determination that the additional challenged claims are unpatentable was affirmed by our reviewing court.); *see Yissum Research Devel. Co. v. Sony Corp.*, 626 Fed. Appx. 1006 (Mem.) (Fed. Cir. 2015) (Judgment pursuant to Fed. Cir. R. 36); *but see Nidec Motor Corporation v. Zhongshan Broad Ocean Motor Co. Ltd. and Matal*, 868 F.3d 1013, 1020 (Fed. Cir. 2017), *cert. petition filed* U.S. Supreme Ct Dkt No. 17-751 (Nov. 20, 2017) (Dyk, J., concurring; “We think it unlikely that Congress intended that petitioners could employ the joinder provision to circumvent the time bar by adding time-barred issues to an otherwise timely proceeding, whether the petitioner seeking to add new issues is the same party that brought the timely proceeding, as in this case, or the petitioner is a new party.”).

the proceeding nor is authorized to do so. Paper 27, 2–5. We disagree with Apple’s contentions.

First, we have determined that Apple is estopped from maintaining the instant proceeding, and there is no need to duplicate the Board’s expenditure of resources by determining patentability of claims that already have been found unpatentable.<sup>10</sup> Contrary to Apple’s assertions, the record is not complete, and rendering a Final Written Decision here involves more than a mere “copy and paste” job by the Board. Paper 27, 2–3. The ’144 patent includes 87 claims, of which about half are challenged. The careful review of the record we undertake in developing final written decisions, however imperceptible it may seem to Petitioner, is performed in light of the papers and evidence submitted in this proceeding—not on whether a similar claim or similar disputes have been addressed in a related proceeding. Consequently, we do not agree with Apple’s contentions, and instead find that expending the Board’s resources in determining patentability of claims already determined to be unpatentable is an important consideration in our decision whether or not to terminate this proceeding.

Second, as to Apple’s contention that the Board lacks authority to terminate this proceeding, we rely on our rulemaking authority to prescribe

---

<sup>10</sup> Pursuant to 35 U.S.C. § 318(a), the Board shall issue a final written decision “with respect to the patentability of any patent claim challenged by the petitioner.” Nevertheless, a subsequent final written decision in a later-initiated review involving the same petitioner might be viewed as merely a conditional or an advisory decision with respect to the “patentability” of a claim that we previously determined to be unpatentable, unless that previous determination had been vacated or reversed by our reviewing court.



regulations for establishing and governing *inter partes* review and the relationship of such review to other proceedings under this title, as stated in § 316(a). *See supra* pg. 3 n.2. And, under this authority, we have established that the Board may “terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).” 37 C.F.R. § 42.72. It is appropriate here for us to exercise our discretion in light of Petitioner’s estoppel before the Office under § 315(e)(1) to terminate the instant proceeding without issuing a final written decision. Petitioner has no right to maintain this proceeding under that estoppel provision, and we determine that the Board will administer its resources most efficiently by focusing on determining patentability of claims for which Petitioner is not estopped.

Finally, we are not persuaded by Apple’s allegation of unfairness because of hypothetical results of potential appeals of the Final Written Decisions in the Joined IPRs. Paper 27, 3–4. That allegation is purely speculative and presumes that (1) Apple ultimately will prevail in this proceeding and (2) any final written decision in this proceeding would not be appealed. The fact remains that the Board already has expended considerable resources in rendering two Final Written Decisions concerning the ’144 patent claims in the Joinder IPRs. Providing Apple with a third opportunity is not an effective and efficient use of the Board’s resources and would undermine the statutory estoppel provisions meant to protect Patent Owner from repeated challenges to the same claims of the ’144 patent.

IPR2016-01860  
Patent 8,966,144 B2

#### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 37 C.F.R. § 42.72, this proceeding is hereby terminated; and

FURTHER ORDERED that, in light of termination of this proceeding, the parties' requests for oral argument (Papers 20, 22) are *denied* as moot.

IPR2016-01860  
Patent 8,966,144 B2

For PETITIONER:

Lori A. Gordon  
Steven W. Peters  
Yasser Mourtada  
[lgordon-ptab@skgf.com](mailto:lgordon-ptab@skgf.com)  
[speters-ptab@skgf.com](mailto:speters-ptab@skgf.com)  
[ymourtad-ptab@skgf.com](mailto:ymourtad-ptab@skgf.com)  
STERNE, KESSLER, GOLDSTEIN & FOX

For PATENT OWNER:

Gregory s. Donahue  
Minghui Yang  
[gdonahue@dpelaw.com](mailto:gdonahue@dpelaw.com)  
[myang@dpelaw.com](mailto:myang@dpelaw.com)  
[docketing@dpelaw.com](mailto:docketing@dpelaw.com)  
DiNOVO PRICE ELLWANGER & HARDY LLP

Michael R. Fleming  
[mflaming@irell.com](mailto:mflaming@irell.com)  
IRELL & MANELLA LLP

Anthony Meola  
Jason. A. Murphy  
Victor J. Baranowshi  
Arlen L. Olsen  
[ameola@iplawusa.com](mailto:ameola@iplawusa.com)  
[jmurphy@iplawsa.com](mailto:jmurphy@iplawsa.com)  
[vbaranowski@iplawusa.com](mailto:vbaranowski@iplawusa.com)  
[aolsen@iplawusa.com](mailto:aolsen@iplawusa.com)  
SCHMEISER, OLSEN & WATTS, LLP