

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,  
Patent Owner.

---

IPR2023-00701  
Patent 8,510,407 B1

---

Before HUBERT C. LORIN and SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceeding*  
37 C.F.R. § 42.5; 37 C.F.R. § 42.108(c)

Samsung Electronics Co., Ltd. (“Petitioner”) filed a Petition for an *inter partes* review (Paper 2) challenging claims 1–24 of U.S. Patent No. 8,510,407 B1 (Ex. 1001). DoDots Licensing Solutions LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Each of Petitioner and Patent Owner has identified *DoDots Licensing Solutions LLC v. Samsung Electronics Co., Ltd.*, 6:22-cv-00535, pending in the United States District Court for the Western District of Texas (“the related litigation”) as a related matter. Petition 105–106; Paper 3 (Patent Owner’s Mandatory Notices), 2.

Petitioner emailed the Board on August 22, 2023 requesting authorization to file a preliminary reply responding to Patent Owner’s arguments regarding (i) the claim construction standard used in the expert declaration, (ii) allegations of inconsistent positions taken by Petitioner in the related litigation, and (iii) arguments relating to our discretion under *Fintiv*.<sup>1</sup> Petitioner noted Patent Owner’s opposition to this request, and request to be heard. We held a teleconference on August 24, 2023 with the parties regarding this matter.

During the teleconference, we heard the arguments by each party. We determined that certain of the issues could not have been reasonably anticipated and addressed and that the panel would benefit from briefing by the parties addressing the issues.

Therefore, we instructed the parties during the conference that we would authorize Petitioner to file a Preliminary Reply and Patent Owner a

---

<sup>1</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

Preliminary Sur-reply. We also informed the parties that we would issue this order to memorialize this instruction.

The supplemental briefing authorized is limited as discussed below.

### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file, by August 31, 2023, a seven-page Preliminary Reply, limited to responding to Patent Owner's arguments regarding (i) the claim construction standard used in the expert declaration, (ii) allegations of inconsistent positions taken by Petitioner in the related litigation, and (iii) arguments relating to our discretion under *Fintiv*; and

FURTHER ORDERED that Patent Owner is authorized to file, no later than seven business days after the filing of Petitioner's Preliminary Reply, a responsive seven-page Preliminary Sur-reply.

IPR2023-00701  
Patent 8,510,407 B1

For PETITIONER:

W. Karl Renner  
Jeremy J. Monaldo  
Hyun Jin In  
FISH & RICHARDSON P.C.  
axf-ptab@fr.com  
jjm@fr.com  
in@fr.com

For PATENT OWNER:

Jason S. Charkow  
Richard Juang  
Chandran B. Iyer  
Ronald M Daignault  
DAIGNAULT IYER LLP  
jason.s.charkow@dagnaultiyer.com  
richard.juang@gmail.com  
cbiyer@dagnaultiyer.com  
rdaignault@dagnaultiyer.com