

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

IPR2023-00937 (Patent 9,369,545 B2)
IPR2023-00938 (Patent 8,020,083 B1)
IPR2023-00939 (Patent 8,510,407 B1)¹

Before HUBERT C. LORIN, GRACE KARAFFA OBERMANN,
AMBER L. HAGY, and SHARON FENICK, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one order to be entered in each case. The parties are not authorized to use a caption identifying multiple cases. This is not an expanded panel. The panel for IPR2023-00937 includes Judges Lorin, Obermann, and Fenick. The panel for IPR2023-00938 and IPR2023-00939 includes Judges Lorin, Hagy, and Fenick.

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Petitioner requests authorization to file preliminary replies to Patent Owner's Preliminary Responses ("Prelim. Resp.")² "limited to PO's arguments concerning Slivka's appendices." Ex. 3001³. Petitioner indicates that Patent Owner opposes the request. *Id.* Patent Owner opposes because "both parties have already explained in their respective papers the reasons why the appendices are or are not part of the Slivka prior art reference. No additional papers on this issue are needed. For this reason, [Petitioner] does not believe that a do-over in the form of a reply should be permitted." *Id.*⁴

After consideration of the record, we believe that it may be useful to the Board for the parties to further address whether the appendices are or are not part of the Slivka prior art reference.

Slivka (Patent 6,061,69; Ex. 1004⁵) is applied as the primary reference in all the proposed grounds of unpatentability presented in the Petitions ("Pet.")⁶.

Petitioner contends that "Slivka was filed December 6, 1996, and issued May 9, 2000, qualifying as prior art at least under 35 U.S.C.

² See IPR2023-00937, Paper 6; IPR2023-00938, Paper 7; IPR2023-00939, Paper 6.

³ Entered in IPR2023-00937, IPR2023-00938, IPR2023-00939.

⁴ The parties appear to be at odds over whether Petitioner conferred with Patent Owner over the requested relief. Ex. 3001. To the extent that had not been done here, Petitioner is directed to meet and confer with Patent Owner prior to submitting any future email communications to the Board.

⁵ IPR2023-00937, IPR2023-00938, IPR2023-00939.

⁶ See IPR2023-00937, Paper 1, 7; IPR2023-00938, Paper 1, 5; IPR2023-00939, Paper 1, 7.

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§ 102(e) (pre-AIA).” IPR2023-00937, Pet. 9 (citing Ex. 1004, (22), (45)).⁷

Petitioner contends that “Slivka’s specification incorporates several appendices stamped with the filing date, December 6, 1996.” IPR2023-00937, Pet. 9 (citing Ex. 1005, 69-245)⁸. According to Petitioner, “Slivka’s appendices qualify as prior art at least under 35 U.S.C. § 102(e) (pre-AIA)” because, *inter alia*, “**the entire disclosure** of a U.S. patent and...can be relied on to reject the claims.” *Id.* (citing, *inter alia*, MPEP § 2136.02)⁹.

Patent Owner responds, *inter alia*, that “[t]he fact is, the Slivka application does not incorporate the appendices because the Slivka applicant *expressly* noted that the appendices were being submitted separate from the specification.” IPR2023-00937, Prelim. Resp. 27 (citing Ex. 2007).¹⁰ “[T]he transmittal letter expressly identifies the appendices as being submitted separate from the ‘34 pages of specification.’” *Id.* at 26 (citing Ex. 2011)¹¹.

This raises an issue as to the effect of this incorporation of appendices in an application.

⁷ See also IPR2023-00938, Pet. 8 (citing Ex. 1004, (22), (45)); IPR2023-00839, Pet. 10 (citing Ex. 1004, (22), (45)).

⁸ See also IPR2023-00938, Pet. 8; IPR2023-00839, Pet. 10.

⁹ See also IPR2023-00938, Pet. 8; IPR2023-00839, Pet. 10.

¹⁰ See also IPR2023-00938, Prelim. Resp. 27–28 (citing Ex. 2009); Prelim. Resp. 27 (citing Ex. 2007).

¹¹ See also IPR2023-00938, Prelim. Resp. 26 (citing Ex. 2009); Prelim. Resp. 26 (citing Ex. 2011).

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Given that the resolution of this issue may be an important factor in deciding whether to institute *inter partes* review, we determine good cause exists to support Petitioner's request for a reply to Patent Owner's Preliminary Response to address the issue. *See* 37 C.F.R. § 42.108(c).

Accordingly, Petitioner's request for authorization to file a preliminary reply limited to addressing whether the appendices are incorporated in the Slivka application is *granted*. We also authorize Patent Owner to file a preliminary sur-reply limited to responding to Petitioner's preliminary reply.

For the foregoing reasons, it is

ORDERED that Petitioner's request for authorization to file a preliminary reply to the Preliminary Response limited to addressing whether the appendices are incorporated in the Slivka application is *granted*, and that the preliminary reply shall be limited to three pages and shall be filed within five business days after the date of this ORDER;

FURTHER ORDERED that Patent Owner may file a preliminary sur-reply, limited to three pages, within five business days from the date the preliminary reply is filed; and,

FURTHER ORDERED that no new evidence or exhibits are permitted in connection with the respective preliminary reply and preliminary sur-reply.

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