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Paper 11
Date: November 29, 2023

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*.

LORIN, *Administrative Patent Judge*.

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

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[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 is Judges Lorin, Obermann, and Fenick. The panel for IPR2023-00938 and -00939 is Judges Lorin, Hagy, and Fenick.

On November 17, 2023, Petitioner Apple Inc. ("Apple") notified the Board by email that it had filed contingent joinder motions in IPR2024-00143, -00144, and -00145. According to Petitioner Apple, "[t]he contingent joinder motions seek to join recently instituted IPR proceedings IPR2023-00621, -00756, and -00701 filed by Samsung ("Samsung IPRs") ***if, and only if***, the Board denies institution in the following proceedings filed by Apple, which have not yet reached a decision on institution: IPR2023-00937, -00938, and -00939 ("Original Apple IPRs"). *See* Ex. 3002, 4–5 (Original Apple IPRs); Ex. 3001, 4–5 (Samsung IPRs).

We did not respond, and do not now respond, to said notification because IPR2024-00143, -00144, and -00145 have not yet been paneled.

On November 20, 2023, by email, Patent Owner DoDots Licensing Solutions LLC ("DoDots") "request[ed] the Board . . . disregard Apple's email request and order Apple to meet and confer with DoDots and original petitioner Samsung about Apple's proposed copy-cat petition and related issues raised by IPR2024-00143, -00144, and -00145." *See* Ex. 3002, 3–4 (Original Apple IPRs); Ex. 3001, 3–4 (Samsung IPRs).

Again, we did not respond, and do not now respond, to said request because IPR2024-00143, -00144, and -00145 have not yet been paneled.

On November 21, 2023, by email, DoDots

> request[ed] the Board . . . stay its decision on instituting [the Original Apple IPRs] and schedule a teleconference with the parties regarding discovery of the facts underlying [a] coordinated and joint relationship between Apple and Samsung in the district court and the IPR proceedings, including real party in interest and privity, and potential abuse of the IPR process, and briefing the grounds for denying

institution under Section 314(a) in accordance with G*eneral Plastic*[2] and *Valve*[3], and the propriety and timeliness of Apple's copy-cat petitions and joinder motions.

See Ex. 3002, 1–3 (Original Apple IPRs); Ex. 3001, 1–3 (Samsung IPRs).

The Board responded on November 24, 2023, with an email indicating that, *inter alia*, "[t]he request would delay the decision in abrogation of our statutory obligation" and for that reason denied the request. *See* Ex. 3002, 1–3 (Original Apple IPRs); Ex. 3001, 1–3 (Samsung IPRs).

We maintain our denial of DoDots' request to stay decisions on instituting the Original Apple IPRs.

Our authorizing statute, 35 U.S.C. § 314(b), states that "the Director *shall* determine whether to institute an *inter partes* review . . . within 3 months after . . . (1) receiving a preliminary response . . . ." Emphasis added. In the case of IPR2023-00937, DoDots' Preliminary Response was received on September 18, 2023. Therefore, in the case of IPR2023-00937, a decision on institution is due December 18, 2023. DoDots' request to conduct "discovery of the facts underlying [an alleged] coordinated and joint relationship between Apple and Samsung" would delay the decision in IPR2023-00937 past the December 18 due date in abrogation of our

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[2] *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17–18 (PTAB Sept. 6, 2017) (precedential).
[3] *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, -00063, -00084, Paper 11 (PTAB April 2, 2019) (precedential); *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00064, -00065, -00085, Paper 10 (PTAB May 1, 2019) (precedential).

statutory obligation. A similar difficulty would arise for the institution decisions for IPR2023-00938 and -00939.

That being said, we see no reason why "discovery of . . . facts underlying [an alleged] coordinated and joint relationship between Apple and Samsung in the district court and the IPR proceedings, including real party in interest and privity, and potential abuse of the IPR process" cannot be developed during the trial phase as part of the normal discovery process and presented in the Patent Owner Responses as part of Patent Owner's full responses to the Original Apple IPRs.

As far as "briefing the grounds for denying institution under Section 314(a) in accordance with *General Plastic* and *Valve*" is concerned, given the short period for rendering decisions on institution in the Original Apple IPRs, the request for additional briefing at this late date would not be in the interests of justice. *See* Rule 42.5(c)(3).

Finally, as to "the propriety and timeliness of Apple's copy-cat petitions and joinder motions," the petitions in question, and associated joinder motions, concern IPRs which, as earlier indicated, have not yet been paneled. We are not in position to address matters involving IPRs on which we have not been officially paneled.

For the foregoing reasons, it is

ORDERED that Patent Owner's request that the Board stay its decisions on instituting the Original Apple IPRs is *denied*.

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