

**From:** Chandran Iyer <[cbiyer@daignaultiyer.com](mailto:cbiyer@daignaultiyer.com)>

**Sent:** Thursday, April 11, 2024 6:18 PM

**To:** Paul Hart <[paul.hart@eriseip.com](mailto:paul.hart@eriseip.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** IPR39843-0148IP1@fr.com; [ptabinbound@fr.com](mailto:ptabinbound@fr.com); [axfptab@fr.com](mailto:axfptab@fr.com); [jjm@fr.com](mailto:jjm@fr.com); [in@fr.com](mailto:in@fr.com); [jason.s.charkow@gmail.com](mailto:jason.s.charkow@gmail.com); [richard.juang@gmail.com](mailto:richard.juang@gmail.com); Ron Daignault <[rdaignault@daignaultiyer.com](mailto:rdaignault@daignaultiyer.com)>; DoDotsLit <[DoDotsLit@daignaultiyer.com](mailto:DoDotsLit@daignaultiyer.com)>; Adam Seitz <[adam.seitz@eriseip.com](mailto:adam.seitz@eriseip.com)>; Kevin Rongish <[kevin.rongish@eriseip.com](mailto:kevin.rongish@eriseip.com)>; Christina Canino <[christina.canino@eriseip.com](mailto:christina.canino@eriseip.com)>

**Subject:** Re: Status Update re Contingent Joinder in IPR2024-00143, -00144, -00145

Your Honors,

We represent Patent Owner DoDots Licensing Solutions LLC (DoDots).

As the Board is aware and by way of background, DoDots sued Samsung Electronics Co., LTD (Samsung) and Apple Inc. (Apple) in the Western District of Texas, case nos. 6:22-cv-00535-ADA-DTG and WDTX-6-22-cv-00533-ADA-DTG. Samsung and Apple were served with the complaints on or about June 3, 2022, and June 1, 2022, respectively.

Beginning on February 22, 2023 and continuing into March, Samsung filed IPR2023-00621, -00701, and -00756 based on prior art asserted in the joint preliminary invalidity contentions. Three months after Samsung's filing, Apple then filed their original IPRs, IPR2023-00937, -00938, and -00939, also using prior art references asserted from the same joint preliminary invalidity contentions. In both the Samsung and Apple petitions, they seek to invalidate the exact same claims in the same patents. Because of their coordinated joint filings and actions in the district court litigation, Apple and Samsung were obviously well aware of the prior art references used in their joint invalidity contentions and also asserted in the IPR petitions. Further, Apple and Samsung filed joint claim construction briefs in the district court litigation. Indeed, it appears that Apple and Samsung have a joint defense agreement based on their coordinated action in the district court and in the IPRs.

The Board instituted Samsung IPRs 2023-00621, -00701, and -00756. On November 13, 2023 and November 17, 2023, Apple filed copy-cat petitions IPR 2024-00143, -00144, and -00145 more than one year after the date of service of complaints and a request for joinder in Samsung's IPR2023-00621, -00701, and -00756 under 37 C.F.R §42.122. On December 15, 2023 and January 3, 2024, the Board denied institution of Apple's original IPRs 2023-00937, -00938, and -00939. Apple subsequently filed Requests for Director Review on January 16, 2024 and February 2, 2024 in their original IPRs, which the Director denied on March 27, 2024.

In view of Apple and Samsung's coordinated actions in the district court and IPR proceedings and the denial of Apple's original IPRs and Director Review, DoDots writes to inform the Board that it does not oppose Apple's conditional motion for joinder of Apple's copy-cat petitions to Samsung IPRs 2023-00621, -00701, and -00756.

Respectfully,  
Chandran B. Iyer



Chandran B. Iyer  
Partner

Daignault Iyer LLP  
202.330.1666  
[cbiyer@daignaultiyer.com](mailto:cbiyer@daignaultiyer.com)  
[daignaultiyer.com](http://daignaultiyer.com)

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**From:** Paul Hart <[paul.hart@eriseip.com](mailto:paul.hart@eriseip.com)>  
**Sent:** Monday, April 1, 2024 4:50 PM  
**To:** Trials <[trials@uspto.gov](mailto:trials@uspto.gov)>  
**Cc:** IPR39843-0148IP1@fr.com <[IPR39843-0148IP1@fr.com](mailto:IPR39843-0148IP1@fr.com)>; [ptabinbound@fr.com](mailto:ptabinbound@fr.com) <[ptabinbound@fr.com](mailto:ptabinbound@fr.com)>; [axfptab@fr.com](mailto:axfptab@fr.com) <[axfptab@fr.com](mailto:axfptab@fr.com)>; [jjm@fr.com](mailto:jjm@fr.com) <[jjm@fr.com](mailto:jjm@fr.com)>; [in@fr.com](mailto:in@fr.com) <[in@fr.com](mailto:in@fr.com)>; [jason.s.charkow@gmail.com](mailto:jason.s.charkow@gmail.com) <[jason.s.charkow@gmail.com](mailto:jason.s.charkow@gmail.com)>; [richard.juang@gmail.com](mailto:richard.juang@gmail.com) <[richard.juang@gmail.com](mailto:richard.juang@gmail.com)>; Chandran Iyer <[cbiyer@daignaultiyer.com](mailto:cbiyer@daignaultiyer.com)>; Ron Daignault <[rdaignault@daignaultiyer.com](mailto:rdaignault@daignaultiyer.com)>; DoDotsLit <[DoDotsLit@daignaultiyer.com](mailto:DoDotsLit@daignaultiyer.com)>; Adam Seitz <[adam.seitz@eriseip.com](mailto:adam.seitz@eriseip.com)>; Kevin Rongish <[kevin.rongish@eriseip.com](mailto:kevin.rongish@eriseip.com)>; Christina Canino <[christina.canino@eriseip.com](mailto:christina.canino@eriseip.com)>  
**Subject:** Status Update re Contingent Joinder in IPR2024-00143, -00144, -00145

To the Board,

I represent Petitioner Apple Inc. in IPR2024-00143, -00144, and -00145, which were copycat petitions accompanied by contingent joinder motions ("Contingent Joinder Petitions"). The contingent joinder motions sought to join 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: IPR2023-00937, -00938, and -00939 ("Original Apple IPRs").

The Original Apple IPRs were initially denied institution, but Apple sought Director Review of those institution denials. On March 27, 2024, Director Vidal denied Apple's Requests for Director Review. Accordingly, the Original Apple IPRs have been finally denied and Apple believes its Contingent Joinder Petitions are now ripe.

Respectfully,

Paul Hart | Shareholder  
Erise IP, P.A.  
717 17th St.  
Suite 1400  
Denver, CO 80202  
(main) 913-777-5600  
(direct) 720-689-5441  
(fax) 913-777-5601  
[paul.hart@eriseip.com](mailto:paul.hart@eriseip.com)  
[www.eriseip.com](http://www.eriseip.com)

On Nov 17, 2023, at 3:43 PM, Paul Hart <[paul.hart@eriseip.com](mailto:paul.hart@eriseip.com)> wrote:

To the Board,

I represent Petitioner Apple Inc. in IPR2024-00143, -00144, and -00145, which were recently filed and accompanied by contingent joinder motions ("Contingent Joinder Petitions"). The 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 institution: IPR2023-00937, -00938, and -00939 ("Original Apple IPRs").

The Consolidated Trial Practice Guide notes that "[a] party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion" to discuss "timely manag[ing] the proceedings."

Because Apple's joinder motions are contingent on the Board denying institution in the Original Apple IPRs, Apple proposes tabling the issue of a joinder-related conference call until institution decisions issue in the Original Apple IPRs. If the Board denies institution in the Original Apple IPRs, Apple will send an email to the Board, requesting a conference call to discuss timely managing the Samsung IPRs in the event Apple is joined.

If the Board would instead like to schedule a call before institution decisions issue in the Original Apple IPRs, counsel for Apple Inc. will make itself available at the Board's convenience.

Respectfully,

Paul Hart | Shareholder  
Erise IP, P.A.  
717 17th St.  
Suite 1400  
Denver, CO 80202  
(main) 913-777-5600  
(direct) 720-689-5441  
(fax) 913-777-5601  
[paul.hart@eriseip.com](mailto:paul.hart@eriseip.com)  
[www.eriseip.com](http://www.eriseip.com)