

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner

v.

DODOTS LICENSING SOLUTIONS LLC,  
Patent Owner

---

Case IPR2024-00145  
Patent No. 8,510,407

---

**PETITIONER'S CONDITIONAL MOTION FOR JOINDER**

## I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Apple Inc. (“Apple” or “Petitioner”) **conditionally moves** for joinder with the *inter partes* review instituted against U.S. Patent No. 8,510,407 (“the ’407 Patent”) in *Samsung Electronics Co., Ltd. v. DoDots Licensing Solutions LLC*, IPR2023-00701 (“the Samsung Proceeding”). This motion is timely filed no later than one month after the Board’s institution decision in the Samsung Proceeding on October 23, 2023.

More specifically, Apple respectfully requests that the Board institute review in this proceeding (IPR2024-00145) and grant this joinder motion **if, and only if**, the Board has previously denied institution in *Apple Inc., v DoDots Licensing Solutions LLC*, IPR2023-00939 (“the Apple Proceeding”). Conversely, if the Board institutes review in the Apple Proceeding, Apple withdraws this motion. Apple makes this request to ensure that it is a named petitioner in one—**and only one**—instituted *inter partes* review proceeding. In this way, consistent with the Board’s policy goals, Apple seeks a fair and efficient resolution to its dispute with Patent Owner.

To be clear, Apple prefers and requests initial consideration of its petition (“Original Petition”) in the Apple Proceeding. Apple’s Original Petition presents a compelling case of obviousness based on prior art and arguments that the Office has not yet considered. Patent Owner’s Preliminary Response (“POPR”) in the Apple Proceeding does not dispute that the substance of the disclosures relied upon in the

Proposed Grounds satisfy each limitation in the Challenged Claims. Instead, the POPR asks the Board to exclude portions of a key reference (“Slivka”) because they were submitted as appendices with the Slivka application and did not publish as part of the Slivka patent. *See generally* IPR2023-00939, Paper 7. As set forth in Apple’s Preliminary Reply, Patent Owner’s position mischaracterizes the facts and governing law and should be rejected. IPR2023-00939, Paper 9.

Instituting review in the Apple Proceeding would promote efficiency for all—the parties, the Board, and the District Court. For one, institution of the Apple Proceeding would trigger Apple’s contingent stipulation stated in the Original Petition:

“[I]f the instant IPR is instituted, [Apple] will not pursue in the parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.”<sup>1</sup>

Moreover, institution could preclude or abridge a jury trial on validity by encouraging a stay and/or leading to a final written decision that estops Apple under 35 U.S.C. § 315(e)(2) from asserting certain printed publication grounds in the district court litigation. The scope of the estoppel would be broader if the Apple Proceeding is instituted and proceeds to a final decision than if Apple is merely joined to the Samsung Proceeding. *See Network-1 Techs., Inc. v. Hewlett-Packard*

---

<sup>1</sup> IPR2023-00939, Paper 7, 75-76.

*Co.*, 981 F.3d 1015, 1026-28 (Fed. Cir. 2020) (finding the scope of estoppel narrowed when a petitioner was limited to joining an instituted proceeding).

However, if the Board were to decline to institute review in the Apple Proceeding, the next best course of action would be to institute review here and grant this motion for joinder with the Samsung Proceeding. As with the Apple Proceeding (albeit to a lesser extent), institution and joinder would promote efficiency in the district court litigation and would do so at no expense or prejudice to Patent Owner. On the other hand, if the Board were to deny Apple any opportunity to participate in *inter partes* review, Apple would have no choice but to pursue its printed publication invalidity defenses in the litigation, separate and apart from the already-instituted Samsung Proceeding. The Board should avoid this scenario, as it departs from the congressional objective that AIA proceedings serve as “a less-expensive alternative to district court litigation to resolve certain patentability issues.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 28 (PTAB Oct. 17, 2022).

Under the specific circumstances on which this conditional motion is premised, joinder would help efficiently resolve the parties’ disputes without undue prejudice. As such, if the Board were to deny institution in the Apple Proceeding, Apple respectfully submits that it should be allowed to join the Samsung Proceeding in an “understudy” role. *See Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 4-6 (PTAB Jul. 29, 2013) (“*Dell*”).

## II. BACKGROUND AND RELATED PROCEEDINGS

DoDots Licensing Solutions LLC is the purported owner of the '407 Patent. DoDots asserted the '407 Patent against Apple in *DoDots Licensing Solutions LLC v. Apple Inc., et al.*, Case 6:22-cv-00533-ADA (WDTX). DoDots asserted the same patents against Samsung in *DoDots Licensing Solutions LLC v. Samsung Electronics Co., Ltd. et al.*, Case 6:22-cv-00535 (WDTX).

On March 10, 2023, Samsung Electronics Co., Ltd. petitioned for *inter partes* review of the '407 patent in the Samsung Proceeding (IPR2023-00701). The Board instituted *inter partes* review in the Samsung Proceeding on October 23, 2023. On May 23, 2023, entirely independent of Samsung and based on different prior art, Apple petitioned for review of the '407 patent in the Apple Proceeding (IPR2023-00939). Apple now seeks joinder to the Samsung Proceeding challenging the '407 patent **if, and only if**, the Board denies institution in the Apple Proceeding challenging that same patent.

## III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The Board has discretion to join a party that properly files an *inter partes* review petition to an existing instituted proceeding addressing the same patent. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell* at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at 3-4 (PTAB Sep. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-4 (PTAB Feb. 25, 2013). “The Board will determine whether to grant joinder

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.