

From: [David Holt](#)
To: [Director_PTABDecision_Review](#)
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Subject: IPR2023-00543: Request for Director Review of the Institution Decision
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Honorable Board,

Apple Inc., the Petitioner in IPR2023-00543, respectfully recommends and requests Director Review of the Institution Decision issued by the Board in that proceeding. *Apple Inc. v. Speir Technologies Ltd.*, IPR2023-00543, Paper 8 (PTAB August 8, 2023). Concurrently herewith, Petitioner is filing "Petitioner's Request for Rehearing by the Director" in P-TACTS.

In this Institution Decision, the Board denied institution of one of two parallel filed petitions that challenged non-overlapping claims of U.S. Patent No. 7,765,399—IPR2023-00542 and IPR2023-00543. The Board's Consolidated Trial Practice Guide ("CTPG") notes that parallel petitions may give rise to "burden on the Board and the patent owner" and "fairness, timing, and efficiency concerns." However, in denying institution, the Institution Decision abused its discretion by failing to identify any specific burdens on the Board or Patent Owner or any fairness, timing, or efficiency concerns grounded in the facts of this case. Having rightly instituted IPR2023-00542, both the Patent Owner and the Board will already be considering the patentability of "similar" claims based on grounds that the Institution Decision acknowledges have a "high degree of overlap" with the grounds advanced in this Petition. Thus, there is no additional burden created by institution of this proceeding. To the contrary, the Board's decision actually invites concerns of fairness, timing, and efficiency by allowing Patent Owner to shield "similar" claims from consideration and unjustly retain the threat and monopoly of these claims in the face of a potentially contrary final written decision in instituted IPR2023-00542. As a result, this decision represents an important issue of law and policy, as this and similar decisions in the future could facilitate abuse by patent owners through purposefully delayed changes in the claims asserted in co-pending litigation.

Based on my professional judgment, I believe the Institution Decision is contrary to 35 U.S.C. 316(b), as it encourages instead of prevents threats to the integrity of the patent system and the efficient administration of the Office. Accordingly, Petitioner respectfully requests Director Review of the Institution Decision and institution of IPR2023-00543.

Sincerely,

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