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Subject:	IPR2023-00638-641 – T-Mobile USA, Inc. v. VoIP-Pal.com – Petitioner's Requests for Director Rehearing on Discretionary Denial of Copycat Petitions and Request to File Exhibits
Date:	Monday, August 28, 2023 9:46:09 PM
Attachments:	2023-08-28 Request for Director Review IPR2023-00638.pdf 2023-08-28 Request for Director Review IPR2023-00639.pdf 2023-08-28 Request for Director Review IPR2023-00640.pdf 2023-08-28 Request for Director Review IPR2023-00641.pdf Exhibit 1027 - VoIP status update 2023-07-11.pdf Exhibit 1028 - VoIP status update 2023-06-26.pdf Exhibit 1029 - VoIP status update 2023-08-01.pdf Exhibit 1030 - Email 2023-06-23.pdf Exhibit 1031 - Law360.pdf

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Dear Director Vidal:

Petitioner T-Mobile USA, Inc. respectfully notifies the Director and the parties of its attached Requests for Director Review ("Requests"), which respond to the Board's Decision Denying Institution of *Inter Partes* Review and Petitioner's associated Motion for Joinder in IPR2023-00638 – IPR2023-00641 ("Institution Decision"), and which will be filed pursuant to 37 C.F.R. § 42.71(d) and the Revised Interim Director Review Process ("Interim Process").

The Requests present important issues affecting a significant number of PTAB proceedings in which *General Plastic* discretionary denial arguments are made in "copycat" petitions seeking to join instituted IPR proceedings. The Board here discretionarily denied institution of Petitioner's second copycat IPR petitions under 35 U.S.C. § 314(a) based on its analysis of the *General Plastic* factors. As explained in the Requests, the Board treated its own denial of Petitioner's previous copycat petitions as a decision on the merits and did not apply the Director's precedential guidance for second-filed petitions in *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, -00862, Paper 18 (PTAB Aug. 23, 2022), at 4-5.

The Director's authoritative guidance on how earlier-filed copycat petitions should be treated under *General Plastic* and *Code200* would prevent confusion on the part of practitioners and parties, and would prevent inconsistent treatment by the Board. The decision by the Board here, as detailed in the Requests, provides a vivid example of the problems that will continue to arise in the absence of authoritative guidance. As explained in the Requests, Patent Owner selectively dismissed its claims against the lead and back-up petitioners in order to: a) terminate the instituted IPR proceedings; and b) prevent Petitioner from joining these instituted IPR proceedings. The Board's decision inadvertently condones this conduct, which is detrimental both to petitioners seeking to join instituted IPRs, who are unfairly penalized by the patent owner's gamesmanship, and to the public because patents the Board has already found to have a reasonable likelihood of invalidity are permitted to survive the IPR process without a final decision on the merits despite a willing petitioner ready to continue the review. Petitioner urges that the Director apply the policy considerations behind *Code200* to clarify that denial of a previous copycat petition because the

underlying petition was denied institution is not a denial "on the merits" and does not prevent a petitioner from seeking to join a different, instituted review.

Section 3.E of the Interim Process states that a Request for Rehearing by the Director "may not introduce new evidence and, accordingly, exhibits may not be entered in support of the request." Section 3.E, however, allows exceptions regarding new evidence upon "authorization by the Director, which may be requested by submitting an email to Director_PTABDecision_Review@uspto.gov." Subject to Section 3.E, Petitioner respectfully requests authorization for five new exhibits, as described below.

In this case, Petitioner seeks to provide the Director with five new exhibits relevant to the above public policy considerations. These exhibits are: a) three publicly available press releases written by Patent Owner discussing the Board's Institution Decisions; b) one publicly available article discussing the Board's Institution Decisions; and c) one email exchange between the Petitioner, Patent Owner, and the Board regarding Petitioner's request to schedule a conference call shortly before the Institution Decisions. None of these exhibits existed at the time of the previous briefing. For at least the above reasons, Petitioner respectfully seeks authorization to file these five new exhibits as part of its upcoming Request.

Petitioner appreciates the Director's consideration of its Requests.

Respectfully submitted,

/s/ Kourtney Mueller Merrill

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