

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

IPR2024-00145
Patent 8,510,407 B1

Before HUBERT C. LORIN, AMBER L. HAGY, and SHARON FENICK,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. *Background and Summary*

On November 17, 2023, Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–24 (“the Challenged Claims”) of U.S. Patent No. 8,510,407 B1 (Ex. 1001, “the ’407 Patent”). With the Petition, Petitioner filed a Motion for Joinder (Paper 3, “Motion” or “Mot.”), conditionally seeking to join as a party to *Samsung Electronics Co. Ltd. v. DoDots Licensing Solutions LLC*, IPR2023-00701 (“the Samsung IPR”). On February 16, 2024, DoDots Licensing Solutions LLC (“Patent Owner”) filed a preliminary response to the Petition (Paper 7, “PO Prelim. Resp.”). On April 11, 2024, Patent Owner notified the Board through email that Patent Owner “does not oppose Apple’s conditional motion for joinder.” Exhibit 3001, 1.

The Board has authority to determine whether to institute an *inter partes* review. See 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a) (2020). Under 35 U.S.C. § 314(a), an *inter partes* review may not be authorized unless the information in the Petition and any preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons that follow, we institute an *inter partes* review as to the challenged claims of the ’407 patent on all grounds of unpatentability presented. We also grant Petitioner’s Motion for Joinder.

B. *Real Parties In Interest*

Petitioner identifies only itself as a real party in interest. Pet. 90. Patent Owner identifies only itself as a real party in interest. Paper 5 (Patent Owner’s Mandatory Notices), 1.

C. Related Matters

In addition to the Samsung IPR, the parties collectively identify *DoDots Licensing Solutions LLC v. Apple Inc. et al.*, CA No. 6:22-cv-00533 (WDTX May 24, 2022), and *DoDots Licensing Solutions LLC v. Samsung Electronics Co., Ltd. et al.*, CA No. 6:22-cv-00535 (WDTX May 24, 2022), as related to the '407 Patent. Pet. 90; Paper 5, 1–2.

Patent Owner additionally identifies that the '407 patent was also the subject of *Apple Inc. v. DoDots Licensing Solutions LLC*, IPR2023-00939, and *In re DoDots Licensing Solutions LLC*, Case No. 24-100 (Fed. Cir.). Paper 5, 2.

D. The '407 Patent (Ex. 1001)

The title of the '407 patent is “Displaying Time-Varying Internet Based Data Using Application Media Packages.” Ex. 1001, code (54). The '407 patent discloses, in part, a software component for accessing and displaying network content. *Id.* at code (57). This component, termed a Networked Information Monitor (NIM) is a “fully configurable frame with one or more controls” with content optionally presented through the frame. *Id.* at 2:61–63, 5:21–24. When a NIM is opened by a user, the frame is presented in the user’s display and network content is retrieved and presented in a viewer enclosed by the frame. *Id.* at 19:63–20:30. The network content may be identified via URLs (uniform resource locators) included in the NIM definition. *Id.* at code (57), 20:24–27. The network content is time-varying, e.g., as in an image that varies over time. *Id.* at code (57). The Specification describes that the frame according to the invention “stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser.” *Id.* at 5:24–28.

Figure 9B, reproduced immediately below, illustrates a pack, that is a customized arrangement of NIMs created by a user. *Id.* at 3:50–51, 16:10–29,

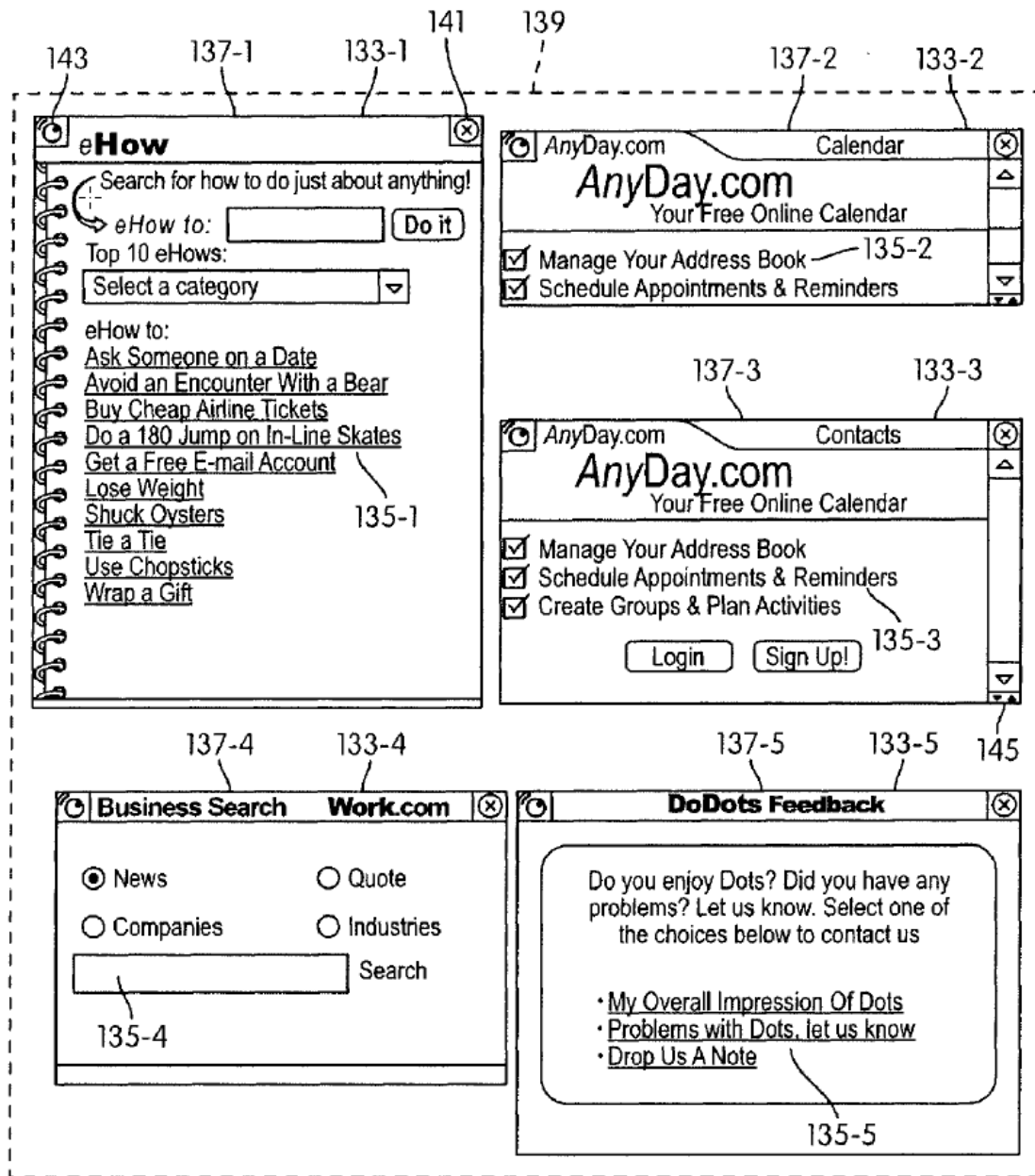


FIG. 9B

Figure 9B illustrates pack 139, which includes five NIMs 133-1 through 133-5. *Id.* at 16:65–66. Each NIM 133 includes viewer 135 for viewing

content and frame 137 for providing user functionality. *Id.* at 16:66–17:1. Frame 137 for each NIM 133 provides functions and controls for manipulating the visual manifestation of NIM 133, for example dismiss button 141 that can be used to dismiss the NIM, menu button 143 that causes a menu to appear, control button 145 that can resize the NIM, and forward and backward controls. *Id.* at 17:16–43, 22:24–61. Content may be retrieved from content servers via URLs identified in the NIM definition for placement in the NIM frame. *Id.* at 21:21–31.

Figure 11, reproduced immediately below, is a flow chart of steps taken to present a NIM to a user. *Id.* at 3:56–58, 20:7–8.

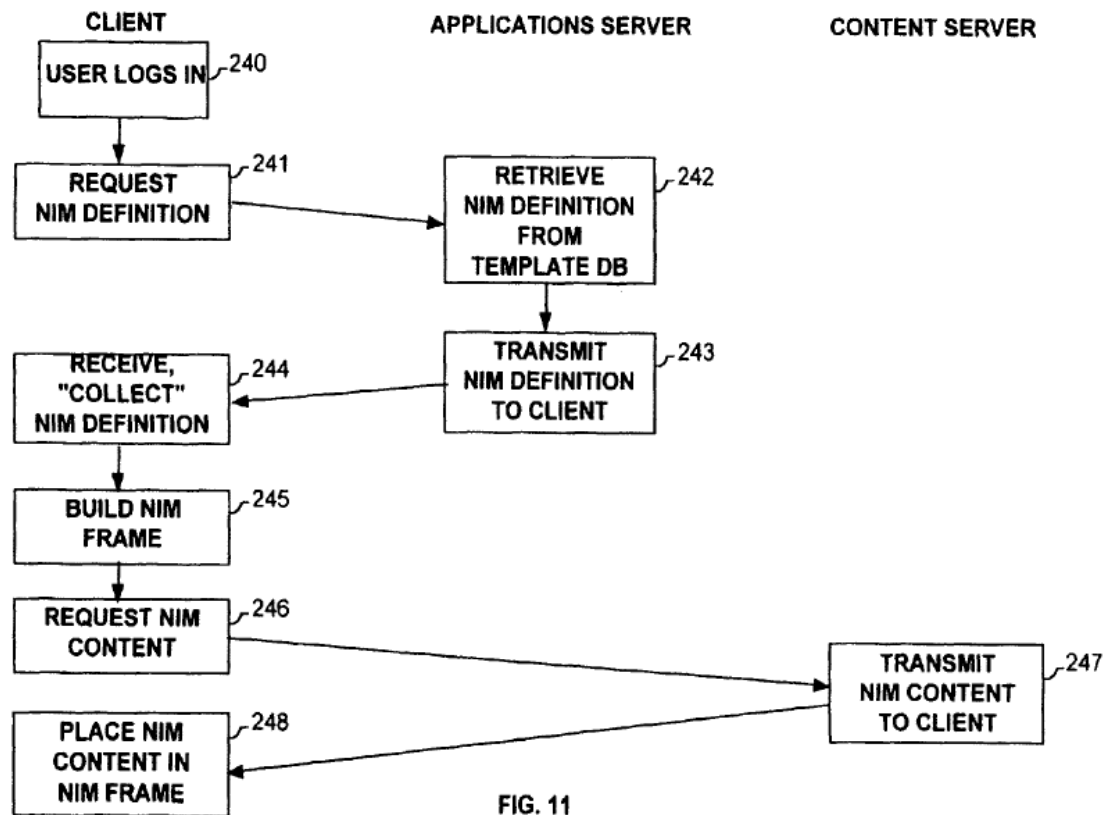


Figure 11 depicts a user's client device making requests to an applications server and a content server, leading to the display of a NIM. *Id.*

at 20:7–30. The applications server responds to a request by the user’s client for a NIM definition and transmits it to the client. *Id.* at 20:18–23. The client requests the necessary content elements from the URLs in the NIM definition from the corresponding content server that supplies them to the client. *Id.* at 20:24–30. The client creates the NIM frame and places the content in a viewer within the frame. *Id.* at 20:23–24, 20:28–32. This allows the user to preview the NIM or to “collect” it (add it to their user profile), and to interact with the NIM as displayed. *Id.* at 14:20–35, 19:51–60, 20:30–46, 20:66–21:4.

E. Illustrative Claim

Claims 1 and 13 are the two independent claims among the challenged claims. Claim 1 is reproduced below with Petitioner’s limitation designations added in brackets for ease of reference:

1. A client computing device configured to access content over a network, the client computing device comprising:

[1.1] electronic storage configured to store networked information monitor template associated with a networked information monitor, the networked information monitor template having therein a definition of a viewer graphical user interface having a frame within which time-varying content in a web browser-readable language may be presented on a display associated with the client computing device, wherein the frame of the viewer graphical user interface lacks controls for enabling a user to specify a network location at which content for the networked information monitor is available; and

[1.2] one or more processors configured to execute one or more computer program modules, the one or more computer program modules being configured to access the networked information monitor defined by the networked information monitor template, wherein

accessing the networked information monitor defined by the networked information monitor template results in:

- [1.3] transmission, over a network to a web server at a network location, of a content request for content to be displayed within the frame of the viewer graphical user interface defined by the networked information monitor template;
- [1.4] reception, over the network from the web server at the network location, of content transmitted from the web server in response to the content request, the content being time-varying;
- [1.5] presentation, on the display, of the viewer graphical user interface defined by the networked information monitor template outside of and separate from any graphical user interface of any other application; and
- [1.6] presentation, on the display within the frame of the viewer graphical user interface defined by the networked information monitor, of the time-varying content received from the web server.

Ex. 1001, 42:28–64.

F. Evidence

Petitioner relies on the following references:

Reference	Description	Exhibit
Beer	US 5,793,368	Ex. 1007
Buchholz et al. (“Buchholz”)	US 6,088,340	Ex. 1009
Brown et al. (“Brown”)	US 6,278,448 B1	Ex. 1005
Wecker et al. (“Wecker”)	US 6,449,638 B1	Ex. 1006
Shimada et al. (“Shimada”)	US 6,789,263 B1	Ex. 1008

Petitioner additionally relies on a declaration of Douglas C. Schmidt (Ex. 1003). Pet. 1.

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–24 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–4, 7–11, 13–16, 19–23	103	Brown
1–4, 7–16, 19–23	103	Brown, Wecker
5, 6, 17, 18	103	Brown, Beer
5, 6, 17, 18	103	Brown, Wecker, Beer
1–24	103	Shimada, Buchholz

Pet. 1.

II. ANALYSIS

A. Institution of Inter Partes Review

We instituted an *inter partes* review in the Samsung IPR on all challenged claims and all asserted grounds of unpatentability. Samsung IPR, Paper 10; *see also* Samsung IPR, Paper 2 (the “Samsung Petition”). Petitioner here challenges the same claims and asserts the same grounds of unpatentability as those on which we instituted the Samsung IPR. *Compare* Pet. 1, *with* Samsung Petition, 1. Petitioner also relies on an identical declaration from the same declarant as relied upon by the petitioner in the Samsung IPR. Mot. 6 & n.2; Ex. 1003.

Because the grounds of unpatentability in the instant Petition are identical to those in the Samsung IPR, for the same reasons stated in our Decision to Institute in the Samsung IPR we institute *inter partes* review in

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the claims at issue have an effective filing date prior to the effective date of the AIA’s amendments to 35 U.S.C. § 103, we apply the pre-AIA version of § 103 in this Decision. *See* Ex. 1001, codes (22), (63).

this proceeding on the grounds presented in the Petition. *See* Samsung IPR, Paper 10, 21–47 (analyzing challenges in the Samsung Petition).

B. Motion for Joinder

Joinder in an *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

To join Petitioner to the instituted Samsung IPR, the Board first determines whether the Petition “warrants” institution under § 314, which we determined above. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). The Board next determines whether to exercise “discretion to decide whether to ‘join as a party’ the joinder applicant,” who is the Petitioner in this proceeding. *Id.*

Petitioner timely filed its Motion for Joinder on November 17, 2023. *See* Mot. Petitioner’s Motion was conditional and requested that the Board grant joinder if, and only if, the Board had previously denied IPR2023-00939. *Id.* at 2. Conversely, if the Board instituted review in IPR2023-00939, Petitioner would withdraw the motion. *Id.* The Board denied institution of review in IPR2023-00939. IPR2023-00939, Paper 12 (PTAB Jan. 3, 2024). Director Review of the decision denying institution was requested by Petitioner but denied by the Director. IPR2023-00939, Paper 13 (Petitioner’s Request for Rehearing by Director, filed Feb. 2, 2024); IPR2023-00939, Paper 14 (PTAB Mar. 27, 2024) (denying Director Review request); *see* IPR2023-00939, Ex. 3100; IPR2023-00939, Ex. 3101.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We determine that Petitioner has met its burden of showing that joinder is appropriate because, as set forth above, the Petition (1) is materially the same as the Samsung Petition, (2) contains the same grounds based on the same evidence, and (3) would promote efficiency. *See* Mot. 3, 6. Petitioner represents that joinder will not unduly burden Patent Owner or negatively impact the Samsung trial schedule. *Id.* at 7.

Petitioner also represents that it will join “in an understudy role” and will not assume an active role unless the current petitioner in the Samsung IPR ceases to participate in the Samsung IPR. *Id.* Petitioner represents that in its understudy role, it agrees that the following conditions will apply:

a) all filings by Apple in the Samsung [IPR] shall be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving Apple;

b) Apple shall not be permitted to raise any new grounds not instituted by the Board in the Samsung [IPR], or introduce any argument or discovery not introduced by the current petitioner;

c) Apple shall be bound by any agreement between Patent Owner and the current petitioner concerning discovery and/or depositions; and

d) Apple at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted under either 37

C.F.R. § 42.53 or any agreement between Patent Owner and the current petitioner.

Id. at 9–10.

Patent Owner did not timely file an opposition to the motion. *See* 37 C.F.R. § 42.23 (setting default filing times). In its Preliminary Response, Patent Owner presented certain arguments “to bring to the Board’s attention and make of record [Patent Owner]’s objections to the conduct of this and related proceedings” and to argue that Petitioner should only be able to pursue one *inter partes* proceeding against the ’407 patent. PO Prelim. Resp. 1, 6. Patent Owner communicated with the Board via email on April 11, 2023, stating that it was writing “to inform the Board that [Patent Owner] does not oppose Apple’s conditional motion for joinder” here. Exhibit 3001, 1.

We determine above that the Petition warrants the institution of an *inter partes* review. Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing proceedings of the Samsung IPR. We limit Petitioner’s participation in the Samsung IPR as follows: (1) the current petitioner is responsible for all petitioner filings in the proceeding until such time that it is no longer an entity in the proceeding; and (2) Petitioner is bound by all filings by the current petitioner in the proceeding, except for (a) filings regarding termination or settlement, and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or take any action on its own in the proceeding, so long as the current petitioner remains as a non-terminated petitioner in the proceeding. In the event the Board terminates Samsung as a

party in the Samsung IPR, Petitioner shall take on the role of lead petitioner in the Samsung IPR.

This arrangement promotes the just and efficient administration of the ongoing trial in the Samsung IPR, and protects the interests of Samsung as the original petitioner in that proceeding and of Patent Owner.

III. CONCLUSION

For the foregoing reasons, we institute *inter partes* review of the challenged claims of the '407 patent based on the grounds of unpatentability set forth in the Petition. We grant the Petitioner's Motion for Joinder and join Petitioner to IPR2023-00701, with the limitations set forth herein.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–24 of the '407 patent on all the grounds set forth in the Petition;

FUTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner's Motion for Joinder is granted, and Petitioner is joined as a petitioner in IPR2023-00701, subject to the above-described limitations in Petitioner's participation in that proceeding;

FUTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2023-00701 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the schedule order in IPR2023-00701, and any modifications thereto, shall govern the schedule of the proceeding;

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FURTHER ORDERED that all further filings are to be made in
IPR2023-00701;

FURTHER ORDERED that the case caption in IPR2023-00701 for all
further submissions shall be modified to add Apple Inc., as a named
Petitioner via footnote indicating the joinder of Petitioner as a party to that
proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this decision shall be entered
into the record in IPR2023-00701.

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Sample Case Caption

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,¹
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Patent Owner.

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¹ The Board joined Apple Inc. as a party (Petitioner) to this proceeding.