| | |
|---|---|
| **From:** | Paul Hart |
| **To:** | Director_PTABDecision_Review |
| **Cc:** | Trials; jason.s.charkow@gmail.com; richard.juang@gmail.com; Chandran Iyer; Ron Daignault; DoDotsLit; Adam Seitz; Kevin Rongish; Christina Canino |
| **Subject:** | Re: Apple Inc. v. DoDots Licensing Solutions LLC; Director Review Requests Notification Email |
| **Date:** | Wednesday, February 28, 2024 5:20:36 PM |
| **Attachments:** | EX1018 - 37 CFR 1.11 (Rev 2, 1996).pdf<br>IPR2023-00939 407 Request for Director Review.pdf<br>EX1018 - 37 CFR 1.11 (Rev 2, 1996).pdf<br>EX1018 - 37 CFR 1.11 (Rev 2, 1996).pdf<br>IPR2023-00937 Request for Director Review.pdf<br>IPR2023-00938 083 Request for Director Review.pdf |

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

To the Director,

Per the Revised Interim Director Review Process guidelines, Petitioner Apple Inc. provides notice of the attached Requests for Director Review in the following proceedings:

- IPR2023-00937 (U.S. Patent No. 9,369,545)
- IPR2023-00938 (U.S. Patent No. 8,020,083)
- IPR2023-00939 (U.S. Patent No. 8,510,407)

In each Request, the parties are the same and the issues for which Petitioner seeks Director review are identical. Petitioner recognizes that no new evidence may be submitted with a Request for Director Review. Exhibits 1018 submitted in each of these proceedings are merely copies of an MPEP chapter applicable at a specific point in time that is relevant to the underlying arguments. For ease of reference, this archived version of the MPEP chapter was submitted as an exhibit. Petitioner does not believe this constitutes new evidence in violation of the Office guidelines.

As set forth in the attached requests, the Board denied institution, finding each Proposed Ground relied on appendices to a prior art patent that did not print with the patent and finding those appendices had not been properly incorporated by reference into that patent. Accordingly, the Board concluded the appendices could not be relied upon as prior art under §102(e).

Each of the attached Requests for Director Review were submitted to the Director because they raise an important issue of law and policy that Petitioner believes is an issue of first impression. Namely, while the requests challenge the Board's conclusion that the appendices were not properly incorporated by reference, even if the appendices had been improperly incorporated by reference by the prior art patent applicant (e.g., as a result of having used the wrong referential language to incorporate the appendices into the patent), the policy rationales underlying §102(e) strongly disfavor withdrawing the appendices from the public. Any negative consequences that result from a purportedly flawed prosecution process underlying a prior art patent should be imposed exclusively on the prior art patentee. The public should not also be punished by the USPTO withdrawing a prior art disclosure and allowing others to

patent subject matter that had been previously submitted to the Office.

Finally, as set forth in the below email chain, Petitioner inadvertently failed to sent this notification email when the Requests for Director Review were filed via P-TACTS and were served on Patent Owner's counsel.

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
www.eriseip.com

On Feb 28, 2024, at 1:52 PM, Paul Hart <paul.hart@eriseip.com> wrote:

To the Director,

First, I apologize for the miscommunications on our end. The below email was originally sent on my behalf to Trials@uspto.gov, inquiring as to the status of three Requests for Director Review we filed recently that were not reflected in the Director Review Requests Status Spreadsheet. In response, Ms. Goldschlager asked us to forward our original emails requesting Director review to Director_PTABDecision_Review@uspto.gov. Instead of forwarding the requested information, we sent the below inquiry again.

Second, today's communications revealed that my team inadvertently failed to submit our Requests for Director Review to Director_PTABDecision_Review@uspto.gov after they were filed via P-TACTS and served on Patent Owner's counsel of record.

I am attaching all three Requests for Director Review that we filed via P-TACTS, but that have not yet been submitted to Director_PTABDecision_Review@uspto.gov. The proceedings and challenged patents are listed below. In each, the parties are the same and the issues for which we seek Director Review are identical.

- IPR2023-00937 (U.S. Patent No. 9,369,545)

- IPR2023-00938 (U.S. Patent No. 8,020,083)
- IPR2023-00939 (U.S. Patent No. 8,510,407)

Please let me know if you require any additional information regarding these requests.

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
www.eriseip.com

<EX1018 - 37 CFR 1.11 (Rev 2, 1996).pdf>
<IPR2023-00937 Request for Director Review.pdf>
<EX1018 - 37 CFR 1.11 (Rev 2, 1996).pdf>
<IPR2023-00939 407 Request for Director Review.pdf>
<EX1018 - 37 CFR 1.11 (Rev 2, 1996).pdf>
<IPR2023-00938 083 Request for Director Review.pdf>

On Feb 28, 2024, at 1:22 PM, Chalynda Giles <chalynda.giles@eriseip.com> wrote:

***Sent on behalf of Paul Hart***

Good Morning,

I am writing on behalf of Petitioner, Apple Inc., in the matters of IPR2023-00937, IPR2023-00938, and IPR2023-00939. Requests for Director Review have been filed in each of the identified matters. On P-TACTs, however, IPR2023-00937 reflects a status of "Institution Denied" with no indication that the matter is currently pending Director Review. Additionally, none of the identified matters are reflected on the Director Review Requests Status Spreadsheet despite the spreadsheet having been updated after each of the Requests for Director Review had been filed. A summary chart of each of the identified matters is below:

<PastedGraphic-1.png>

Given the above, can you please confirm that each of the identified matters is currently pending director review? Additionally, if possible, are you able to clarify/correct (1) the incorrect status of IPR2023-00937 on P-TACTs; and (2) the inclusion of each of the matters from the Director Review Requests Status Spreadsheet?

Thank you.

**Chalynda Giles**
paralegal
**P** 913.777.5600 | **D** 913.777.5648
**erise IP**
7015 College Blvd., Ste. 700
Overland Park, KS 66211