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Paper 8
Date: March 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ALD SOCIAL, LLC,
Patent Owner.

IPR2023-01398 (Patent 9,198,054)
IPR2023-01399 (Patent 9,402,158)[1]

Before BARBARA A. BENOIT, SHARON FENICK, and PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENOIT, Administrative Patent Judge.

ORDER
Conduct of the Proceeding:
Setting Deadline for Filing Mandatory Notices to Avoid Adverse Judgment
37 C.F.R. §§ 42.5, 42.8(a)(2), 42.73(b)

[1] This Order addresses issues that are the same in each of the identified proceedings. The parties must obtain prior authorization to use this heading style.

On September 12, 2023, Apple Inc. ("Petitioner") filed two petitions pursuant to 35 U.S.C. §§ 311–319 to request institution of *inter partes* reviews of certain claims of U.S. Patent Nos. 9,198,054 and 9,402,158 ("the challenged patents"). *See* IPR2023-01398, Paper 1 (Petition challenging U.S. Patent No. 9,198,054); IPR2023-01399, Paper 1 (Petition challenging U.S. Patent No. 9,402,158).

Board rules require that Petitioner must serve the petition and supporting evidence relied upon in the petition "on the patent owner at the correspondence address of record for the subject patent." 37 C.F.R. § 42.105(a). United States Patent and Trademark Office (USPTO) records indicate that nine attorneys associated with Customer Number 116950 are attorneys of record for the two challenged patents. According to USPTO records, Customer Number 116950 is associated with Tarolli, Sundheim, Covell & Tummino LLP in Cleveland, Ohio. Each petition includes a certificate of service indicating service was made in accordance with 37 C.F.R. § 42.105(a) on Patent Owner at Tarolli, Sundheim, Covell & Tummino LLP, 1300 East Ninth Street, Suite 1700, Cleveland, Ohio 44114. *See* IPR2023-01398, Paper 1, 80; IPR2023-01399, Paper 1, 79.

Board rules also require Patent Owner (ALD Social, LLC) to file mandatory notices within 21 days of service of the petition. 37 C.F.R. § 42.8(a)(2). Each of the mandatory notices must include identification of (1) the real party-in-interest, (2) related judicial or administrative matters that would affect, or be affected by, a decision in the proceeding, (3) service information, and, (4) if the party is represented by counsel, then counsel must be identified. 37 C.F.R. § 42.8(b).

No counsel has yet appeared in these cases on behalf Patent Owner, and mandatory notices have not yet been filed. Nor has Patent Owner contacted the Board.

On January 25, 2024, the Chief Clerk of the Board sent a Notice of Delinquent Mandatory Notices in each case. *See* IPR2023-01398, Paper 5; IPR2023-01399, Paper 4. The Notices were sent to the attorneys of record for the challenged patents, to ALD Social LLC at its corporate address[2] provided in the latest assignment recorded at the USPTO, and to the registered agent[3] for ALD Social LLC identified in public records of the Delaware Secretary of State. *See* IPR2023-01398, Paper 5; IPR2023-01399, Paper 4. The Notices reminded the Patent Owner "to file mandatory notices pursuant to 37 C.F.R. § 42.8(a)(2) for IPR2023-01398 and IPR2023-01399." *See* IPR2023-01398, Paper 5, 3; IPR2023-01399, Paper 4, 3. Mandatory notices were not filed in either case after these Notices.[4]

On March 18, 2024, we instituted trial for each case. *See* IPR2023-01398, Paper 6; IPR2023-01399, Paper 5. As 37 C.F.R. § 42.4(c)(1) provides, notice of institution of trial was sent to the attorneys of record for the challenged patents, ALD Social LLC at its corporate address, and the registered agent for ALD Social LLC.

A party may request judgment against itself at any time during a proceeding, and certain actions are construed by the Board to be a request for adverse judgment. 37 C.F.R. § 42.73(b). One such action is abandonment of the contest. 37 C.F.R. § 42.73(b)(4).

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[2] According to the assignment document recorded at Reel 060788 / Frame 0636, ALD Social LLC is located at 220 Hunting Hill Lane, West Chester, Pennsylvania 19382.

[3] A Registered Agent, Inc., 8 The Green, Suite A, Dover, Delaware 19901.

[4] Counsel of record for the challenged patents contacted the Board to indicate that they had been prosecution counsel and have no relationship with current Patent Owner. To date, however, no "Request for Withdrawal as Attorney or Agent and Change of Correspondence Address" has been received by the USPTO.

Under the specific circumstances of this case, we determine Patent Owner's failure to file long-overdue mandatory notices required by 37 C.F.R. § 42.8(a)(2) to demonstrate Patent Owner's abandonment of the contest. Under 37 C.F.R. § 42.5(c), in the particular circumstances of this case, and in the interests of justice, **we set a deadline for Patent Owner to file mandatory notices pursuant to 37 C.F.R. § 42.8(a)(2) no later than June 10, 2024**, which is the date on which a response to the petition under 37 C.F.R. § 42.120 is due. *See* IPR2023-01398, Paper 7, 9, 12; IPR2023-01399, Paper 6, 9, 12 (Due Date 1). We would view, in the particular circumstances of this case, Patent Owner's filing of mandatory notices by the deadline as an indication that Patent Owner has not abandoned the contest.

If there are any questions pertaining to this Order, please contact the Patent Trial and Appeal Board at 571- 272-7822 or by email at Trials@uspto.gov.

It is SO ORDERED.

IPR2023-01398 (Patent 9,198,054)
IPR2023-01399 (Patent 9,402,158)

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