UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,
v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

IPR2024-00144
Patent No. 9,369,545

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 9,369,545

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Cases

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35 U.S.C. § 315(b) 2

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	E-mail correspondence between and among Apple, DoDots, and the Board dated November 21-22, 2023

Patent Owner DoDots Licensing Solutions LLC ("DoDots" or "Patent Owner") submits this Patent Owner Preliminary Response to Apple Inc.'s ("Petitioner" or "Apple") petition (Paper No. 1, "Petition") to bring to the Board's attention and make of record DoDot's objections to the conduct of this and related proceedings seeking *inter partes* review of claims 1-16 of U.S. Patent No. 9,369,545 ("the '545 patent," Ex. 1001).

I. INTRODUCTION AND PROCEDURAL HISTORY

Having failed to have its own petition against the '545 patent instituted in IPR2023-00937, Apple now asks the Board to institute its me-too petition against the same claims of the same patent and join it with already-instituted IPR2023-00756, captioned *Samsung Electronics Co., Ltd., v. DoDots Licensing Solutions LLC*. Both Apple and Samsung have been jointly litigating the '545 patent in the district court since June 2022. Apple and Samsung have coordinated their defenses in that litigation, filing joint invalidity contentions and joint claim construction briefing. And in their respective IPRs, Samsung and Apple each took responsibility for one-half of the positions in their joint invalidity contentions. Samsung took the lead in IPR2023-00621, -00756, and -00701, while Apple took the lead in IPR2023-00937, -00938 and -00939. Yet with this improper coordinated strategy of serial petitions, Apple hit a bump in the road. Faced with denial of its own petitions, Apple now wants to jump back in bed with Samsung.

Samsung filed the first IPR directed to the '545 patent (IPR2023-00621) on March 28, 2023. Despite having litigated jointly since June 2022, and rather than appearing as co-petitioner, Apple and Samsung settled upon a divide-and-conquer strategy, with Samsung pursuing one portion of the parties' joint invalidity contentions in Samsung's -00621 petition and Apple filing its own -00937 petition two months later in May 2023, just one month before the time bar set forth in in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b).

The Board instituted Samsung's -00621 petition on October 11, 2023, and one month later, Apple filed its copycat petition and requested ***conditional*** joinder ***if, and only if***, the Board denied institution of Apple's original -00937 petition. Patent Owner sought to bring this highly irregular attempt to get a conditional second bite at the apple to the Board's attention in correspondence over the course of November 20-21, 2023. Ex. 2001. Specifically, Patent Owner stated that "Apple's and Samsung's joint and coordinated actions in the district court and IPR proceedings, and now with Apple's joinder motion, raise grounds for denying institution under Section 314(a), and issues regarding (i) real party in interest and/or privity, (ii) the serial nature of all nine IPRs against the same claims in the same patents, (iii) the Board's resources, (iv) the timeliness of Apple's joinder motion, and (v) potential abuse of the IPR process." *Id*. at 2. The Board denied

Patent Owner any relief in an email dated November 24, 2023, and stated that "[f]urther explanation for denying the request will be provided in a forthcoming order." *Id*. at 1.

The Board issued an Order on November 29, 2023, addressing, in part, Patent Owner's requests. IPR2023-00937, -00938, -00939, Paper 11. Although the Board at that time denied the requested relief, it went on to state, "we see no reason why 'discovery of . . . facts underlying [an alleged] coordinated and joint relationship between Apple and Samsung in the district court and the IPR proceedings, including real party in interest and privity, and potential abuse of the IPR process' cannot be developed during the trial phase as part of the normal discovery process and presented in the Patent Owner Responses as part of Patent Owner's full responses to the Original Apple IPRs [i.e. IPR20232023-00937, -00938, and -00939]." *Id.*, Paper 11 at 4. Of course, given that those IPRs were not instituted, those concerns cannot be addressed there.[1]

The Board went on to state, "[a]s far as 'briefing the grounds for denying institution under Section 314(a) in accordance with *General Plastic* and *Valve*' is concerned, given the short period for rendering decisions on institution in the

[1] Patent Owner notes that Apple is seeking Director Review of the denial of institution. Should the Director overturn those denials, Patent Owner reserves the right to seek such discovery and to have Apple unjoined here.

Original Apple IPRs, the request for additional briefing at this late date would not be in the interests of justice. *See* Rule 42.5(c)(3)." *Id.* That leaves only one place for the Board to address Patent Owner's concerns—here.

And on that point, the Board stated, "as to the 'propriety and timeliness of Apple's copy-cat petitions and joinder motions,' the petitions in question, and associated joinder motions, concern IPRs which, as earlier indicated, have not been paneled. We are not in a position to address matters involving IPRs on which we have not been officially paneled." But the panel deciding *these* copy-cat petitions is paneled, and Patent Owner seeks to bring to that panel's attention the manifest inequities Apple's serial petition practice raises.

II. APPLE'S GAMING OF THE IPR PROCESS AND RELIEF SOUGHT

Apple's serial IPR petitions raise concerns under 37 C.F.R § 314(a) and the Board's POP decisions in *Valve Corp. v. Elec. Scripting Prods., Inc*., (IPR2019-00064 et al., Paper 10 (May 1, 2019)) and *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, (IPR2016-01357 et al., Paper 19 (September 6, 2017)).

First, Apple could have and should have joined Samsung's original -00621 petition at the time it was filed. Apple was obviously aware of all the art and grounds raised therein, having filed joint invalidity contentions with Samsung and relying on those same references and same grounds. But Apple at the time made a

calculated decision not to join with Samsung. The reason Apple did so does not matter. The fact is, Apple made a choice and should be held to it.

Second, Apple later filed its own IPR with a different set of references and a different set of grounds, but still directed to the *same claims* of the *same patent*. And at that point, Apple again could have and should have raised all the references and grounds raised in Samsung's -00621 petition. Having not done so at that time, IPR estoppel clearly applies to Apple under the Federal Circuit's Broadcom decision. *California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022) ("estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, *but to all claims and grounds not in the IPR but which reasonably could have been included in the petition"*) (emphasis added).

Regardless of whether the Board institutes the current petition, Apple should be estopped from pursuing the grounds raised therein before the district court. Though institution of the current petition and joinder with the Samsung -00621 petition will make that plain, so too does the rule of *Broadcom*. Apple may have simply chosen to file its me-too petition to protect against the downside of Samsung settling. But to the extent that Apple believes that it has somehow gained some strategic advantage through serial petitions to ***conditionally avoid*** the

grounds raised in the current petition until its own petition was denied, Petitioner respectfully requests the Board to take note of this gamesmanship on the record.

After all, though Apple's conduct does not entail all the concerns raised by *General Plastics* and *Valve*—namely petitioners using the benefit of arguments raised in a POPR and a Board's institution decision to "road map" a serial petition for institution—it nevertheless smacks of gamesmanship that neither the Board nor the courts should condone.

In the interest of justice and fairness, Apple should be ordered to pursue ***one, and only one***, petition. Doing otherwise allows Apple to have its cake and eat it too in violation of the spirit, if not the rule, of *General Plastics* and *Valve*.

III. CONCLUSION

For the foregoing, Patent owner respectfully requests the Board to order Apple to pursue one and only one petition directed to the '545 patent.

Dated: February 16, 2024

Respectfully submitted,
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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,369,545 specified in 37 C.F.R. § 42.24 has 1331 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using automated count of typed words using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,369,545 was served electronically via email on February 16, 2024, on the following counsel of record for Petitioner:

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