From: Trials <Trials@USPTO.GOV>
Sent: Friday, November 24, 2023 1:32 PM
To: Chandran Iyer; IPR39843-0148IP1; ptabinbound@fr.com; axfptab@fr.com; jjm@fr.com; Hyun Jin In; jason.s.charkow@gmail.com; richard.juang@gmail.com; Ron Daignault; DoDotsLit; Adam Seitz; Kevin Rongish; Christina Canino; Paul Hart
Cc: Trials
Subject: RE: Conference Call re Stay of IPR2023-00937, -00938, and -00939, and Joinder in IPR2024-00143, -00144, and -00145

Counsel,

Patent Owner DoDots Licensing Solutions LLC's request for the Board to stay its decision on instituting Apple's IPR2023-00937, -00938, and -00939 in order to conduct "discovery of the facts underlying [alleged] coordinated and joint relationship between Apple and Samsung" is denied. We have a statutory obligation to issue a timely decision. See 35 U.S.C. 314(b). In the case of IPR2023-00937, for example, a decision on institution is due December 18, 2023. The request would delay the decision in abrogation of our statutory obligation. Further explanation for denying the request will be provided in a forthcoming Order.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Chandran Iyer <cbiyer@daignaultiyer.com>
Sent: Tuesday, November 21, 2023 6:30 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR39843-0148IP1 <IPR39843-0148IP1@fr.com>; ptabinbound@fr.com; axfptab@fr.com; jjm@fr.com; Hyun Jin In <in@fr.com>; jason.s.charkow@gmail.com; richard.juang@gmail.com; Ron Daignault <rdaignault@daignaultiyer.com>; DoDotsLit <DoDotsLit@daignaultiyer.com>; Adam Seitz <adam.seitz@eriseip.com>; Kevin Rongish <kevin.rongish@eriseip.com>; Christina Canino <christina.canino@eriseip.com>; Paul Hart <paul.hart@eriseip.com>
Subject: Conference Call re Stay of IPR2023-00937, -00938, and -00939, and Joinder in IPR2024-00143, -00144, and -00145

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Your Honors,

We represent Patent Owner DoDots Licensing Solutions LLC (DoDots). DoDots sued Samsung Electronics Co., LTD (Samsung) and Apple Inc. (Apple) in the Western District of Texas, case nos. 6:22-cv-00535-ADA-DTG and WDTX-6-22-cv-00533-ADA-DTG. Samsung and Apple were served with the complaints on or about

June 3, 2022, and June 1, 2022, respectively. Apple and Samsung have made joint filings in the district court litigation and served joint preliminary invalidity contentions on February 01, 2023.

Beginning on February 22, 2023 and continuing into March, Samsung subsequently filed IPR2023-00621, -00701, and -00756 based on prior art asserted in the joint preliminary invalidity conventions. Three months after Samsung's filing, Apple then filed IPR2023-00937, -00938, and -00939, also using prior art references asserted from the same joint preliminary infringement contentions. In both the Samsung and Apple petitions, they seek to invalidate the exact same claims in the same patents. Because of their coordinated joint filings and actions in the district court litigation, Apple and Samsung were obviously well aware of the prior art references used in their joint invalidity contentions and also asserted in the IPR petitions. Further, Apple and Samsung filed joint claim construction briefs in the district court litigation. Indeed, it appears that Apple and Samsung have a joint defense agreement based on their coordinated action in the district court and in the IPRs.

The Board instituted Samsung IPRs 2023-00621, -00701, and -00756. On November 13, 2023 and November 17, 2023, Apple filed copy-cat petitions IPR 2024-0014, -00144, and -00145 more than one year after the date of service of complaints and a request for joinder in Samsung's IPR2023-00621, -00701, and -00756 under 37 C.F.R §42.122. Based on Apple's and Samsung's coordinated actions and joint submissions in the district court litigation, and now Apple's joinder motions under 37 C.F.R §42.122, DoDots believes there are grounds for denying institution of Apple's IPRs 2023-00937, -00938, and -00939, which are before the Board. Specifically, Apple's IPR petitions should be dismissed under 37 C.F.R § 314(a) and the precedential decisions, *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))

In particular, DoDots submits 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.

Accordingly, we respectfully request the Board to stay its decision on instituting Apple's IPR 2023-00937, -00938, and -00939 and schedule a teleconference with the parties regarding discovery of the facts underlying the 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, and briefing the grounds for denying institution under Section 314(a) in accordance with *General Plastic* and *Valve*, and the propriety and timeliness of Apple's copy-cat petitions and joinder motions.

After Apple filed its joinder motions, it did not request a conference call with DoDots, Samsung, and the Board under the Board's Practice Guide within five business days. DoDots, therefore, submits this email so that it can be heard before the Board's impending decision on institution of IPR 2023-00937, -00938, and -00939. But as indicated in our prior communication to the Board referenced below, should the Board order the parties to meet and confer before raising the above-described issues, of course, DoDots will do so. We look forward to the Board's instructions as to how it would like to proceed.

Respectfully,
Chandran B. Iyer

cc: Hyun Jin In (Samsung's Counsel, IPR2023-00621, -00701, and -00756)

Daignault Iyer

Chandran B. Iyer
Partner

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From: Chandran Iyer <cbiyer@daignaultiyer.com>
Sent: Monday, November 20, 2023 1:32 PM
To: Trials <trials@uspto.gov>
Cc: IPR39843-0148IP1 <IPR39843-0148IP1@fr.com>; ptabinbound@fr.com <ptabinbound@fr.com>; axfptab@fr.com <axfptab@fr.com>; jjm@fr.com <jjm@fr.com>; Hyun Jin In <in@fr.com>; jason.s.charkow@gmail.com <jason.s.charkow@gmail.com>; richard.juang@gmail.com <richard.juang@gmail.com>; Ron Daignault <rdaignault@daignaultiyer.com>; DoDotsLit <DoDotsLit@daignaultiyer.com>; Adam Seitz <adam.seitz@eriseip.com>; Kevin Rongish <kevin.rongish@eriseip.com>; Christina Canino <christina.canino@eriseip.com>; Paul Hart <paul.hart@eriseip.com>
Subject: Re: Conference Call re Contingent Joinder in IPR2024-00143, -00144, -00145

To the Board,

We represent DoDots Inc. in IPR 2024-0014, -00144, and -00145. In accordance with the Board's Trial Rules and Practice Guide, the Board "encourages the use of conference calls to raise and resolve issues in an expedited manner." *See Metrics, Inc. v. Senju Pharmaceutical Co., Ltd.*, Case Nos. IPR2014-01041 and -01043 (PTAB, Sept. 9, 2014) (Obermann, APJ). Moreover, the Trial Guide notes that "[a] party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion" to discuss "timely manag[ing] the proceedings." Apple did not reach out to DoDots Inc. before sending its below request to the Board.

Accordingly, we request the Board to disregard Apple's email request and order Apple to meet and confer with DoDots and original petitioner Samsung about Apple's proposed copy-cat petition and related issues raised by IPR 2024-0014, -00144, and -00145. The parties will contact the Board once we have conducted the meet-and-confer.

Respectfully,

Chandran B. Iyer
Partner

DoDots Exhibit 2001
Apple v. DoDots - IPR2024-00144

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On Nov 17, 2023, at 5:43 PM, Paul Hart <paul.hart@eriseip.com> wrote:

To the Board,

I represent Petitioner Apple Inc. in IPR2024-00143, -00144, and -00145, which were recently filed and accompanied by contingent joinder motions ("Contingent Joinder Petitions"). The contingent joinder motions seek to join recently instituted IPR proceedings IPR2023-00621, -00756, and -00701 filed by Samsung ("Samsung IPRs") ***if, and only if***, the Board denies institution in the following proceedings filed by Apple, which have not yet reached institution: IPR2023-00937, -00938, and -00939 ("Original Apple IPRs").

The Consolidated Trial Practice Guide notes that "[a] party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion" to discuss "timely manag[ing] the proceedings."

Because Apple's joinder motions are contingent on the Board denying institution in the Original Apple IPRs, Apple proposes tabling the issue of a joinder-related conference call until institution decisions issue in the Original Apple IPRs. If the Board denies institution in the Original Apple IPRs, Apple will send an email to the Board, requesting a conference call to discuss timely managing the Samsung IPRs in the event Apple is joined.

If the Board would instead like to schedule a call before institution decisions issue in the Original Apple IPRs, counsel for Apple Inc. will make itself available at the Board's convenience.

Respectfully,

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