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Subject: RE: Apple Inc. v. THL Holding Co., LLC; IPR2024-00398, -00399, -00400
Date: Tuesday, August 20, 2024 4:13:56 PM

Counsel,

From the Board –

Petitioner's request for authorization to file an Opposition to the Requests for Rehearing in the above-identified matters is denied. Rule 42.71(d) does not include a provision for the filing of an Opposition, and the panel does not believe that additional briefing would be helpful.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, August 15, 2024 2:49 PM
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Subject: RE: Apple Inc. v. THL Holding Co., LLC; IPR2024-00398, -00399, -00400

Counsel,

At present, within the meaning of 37 C.F.R. § 42.71(d), Petitioner is not a dissatisfied party with respect to the decisions on institution in IPR2024-00398, -00399, and -00400, so there is no basis for Petitioner to request rehearing of those decisions. Should any subsequent decision—such as a decision on any of Patent Owner's requests for rehearing of the decisions on institution—render Petitioner a dissatisfied party, the deadline for Petitioner to request rehearing of that subsequent decision would be measured from the issuance of that decision.

The panel has not yet decided whether to authorize the filing of oppositions to Patent Owner's requests for rehearing, but a decision on Petitioner's request for authorization will be communicated in due course.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Jennifer Bailey <jennifer.bailey@eriseip.com>
Sent: Friday, August 9, 2024 12:19 PM
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Subject: Apple Inc. v. THL Holding Co., LLC; IPR2024-00398, -00399, -00400

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To the Board:

The undersigned is lead counsel for Petitioner, Apple Inc., for the above-referenced IPRs. Patent Owner's counsel is copied on this email.

On August 8, 2024, Patent Owner filed Requests for Rehearing in the referenced IPRs. *See* IPR2024-00398, Paper 8; IPR2024-00399, Paper 10; IPR2024-00400, Paper 9. Petitioner requests leave to file an Opposition to the Requests for Rehearing based on the following:

(1) Patent Owner's Requests are contrary to the Board's authority based on the present facts and cite outdated and inapposite law. Patent Owner cannot disclaim claims after institution and use such disclaimer as a basis for requesting non-institution, including of non-disclaimed claims. *See, e.g., LG Electronics, Inc. v. Wi-LAN Inc.*, IPR2018-000673, Paper 27, at 4-5 (PTAB Nov. 26, 2018) (rejecting Patent Owner's Motion to Dismiss the IPR, where some challenged claims disclaimed after institution and other challenged claims not disclaimed, stating the Institution Decision "remains correct based on the facts that existed at the time it was decided" and that the IPR "should proceed to a final written decision so neither party is deprived of a full and fair opportunity to develop the record") (internal quotations omitted);

(2) Patent Owner's Requests are procedurally inappropriate, as Patent Owner does not identify a basis for the Board misapprehending or overlooking a matter. *See* 37 C.F.R. § 42.71(d); and

(3) Should the Board reverse institution of the IPRs, Petitioner will be prejudiced due to the failure to fully develop the IPR record, including for claim construction. *See id.* ("[d]ismissal is not appropriate here where the record on claim construction is not yet fully developed").

Petitioner also requests the Board's guidance as to timing of a Request for Rehearing by Petitioner. Currently, any Request for Rehearing by Petitioner is due August 24, 2024. At this time, there is no basis for Petitioner to Request Rehearing of the Board's decisions in IPR2024-00398 and -00399, as both IPRs are instituted. Should the Board entertain Patent Owner's Requests and deny institution of these two IPRs, then Petitioner should be afforded the opportunity to file a Request for Rehearing, per 37 C.F.R. § 42.71(d)(2). Petitioner seeks clarification and guidance from the Board that the 30-day timeline set forth in § 42.71(d)(2) would start from any future potential denial of institution and not begin from the current institution date (July 25, 2024).

Petitioner's counsel has attempted to confer with Patent Owner's counsel regarding whether Patent Owner opposes this request and has not yet heard back.

Thank you in advance.

Jennifer C. Bailey
Lead Counsel for Petitioner, Apple Inc.

Jennifer Bailey (she/her)

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