

From: [Director_DI](#)
To: [Paul Hart](#); [Director_DI](#); [Director Discretionary Decision](#)
Cc: [Douglas, Christopher](#); [Bradley, Kirk](#); [Wroblewski, Karlee](#); [Young, Jacob](#); [Rubschlager, Katherine](#); [Welch, Emily](#); [Beaton, Erin](#); [Nunez, Nicolette](#); [Adam.Seitz@eriseip.com](#); [Eric.Brueckner@eriseip.com](#); [Christina.Canino@eriseip.com](#); [Khoa.Vu@eriseip.com](#); [Graeme.Gillespie@eriseip.com](#); [PTAB@eriseip.com](#); [Sten.Larson@eriseip.com](#)
Subject: RE: Requesting Permission to File Motions to Dismiss Petitions (Pre-Institution) in IPR2025-01232, -01233, -01236, and -01239
Date: Thursday, November 20, 2025 4:53:03 PM

Petitioner is authorized to file a motion under 37 C.F.R. 42.71(a) in IPR2025-01232, -01233, and -01239 to dismiss the petition. Petitioner should file by COB on Friday, November 21, 2025.

From: Paul Hart <paul.hart@eriseip.com>
Sent: Tuesday, November 18, 2025 11:09 AM
To: Director_DI <Director_DI@uspto.gov>
Cc: Douglas, Christopher <Christopher.Douglas@alston.com>; Bradley, Kirk <Kirk.Bradley@alston.com>; Wroblewski, Karlee <Karlee.Wroblewski@alston.com>; Young, Jacob <Jacob.Young@alston.com>; Rubschlager, Katherine <Katherine.Rubschlager@alston.com>; Welch, Emily <Emily.Welch@alston.com>; Beaton, Erin <Erin.Beaton@alston.com>; Nunez, Nicolette <Nicolette.Nunez@alston.com>; Adam.Seitz@eriseip.com; Eric.Brueckner@eriseip.com; Christina.Canino@eriseip.com; Khoa.Vu@eriseip.com; Graeme.Gillespie@eriseip.com; PTAB@eriseip.com; Sten.Larson@eriseip.com
Subject: Requesting Permission to File Motions to Dismiss Petitions (Pre-Institution) in IPR2025-01232, -01233, -01236, and -01239

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Honorable Director,

Petitioner Apple Inc. (“Apple”) respectfully requests permission to file motions to dismiss the following Petitions for *Inter Partes* Review (“IPR”): IPR2025-01232, -01233, -01236, and -01239.

Apple filed eight Petitions IPR on August 5, 2025, challenging each of eight patents that Patent Owner asserted in parallel litigation. On September 23, 2025, Patent Owner dismissed four patents with prejudice from the parallel litigation. Patent Owner then filed discretionary denial briefs on October 6-7, 2025, arguing (in part) that it is an inappropriate use of Board resources to institute review for the patents dismissed from the litigation. On October 29, 2025, before filing oppositions to Patent Owner’s discretionary denial briefs, Apple asked Patent Owner to discuss terminating the IPR proceedings for the dismissed patents in exchange for a covenant-not-to-sue on those patents. To date, Patent Owner has not responded to Apple’s offer and no

discussions have occurred.

As Apple explained in its opposition discretionary denial briefs, Apple seeks to avoid expending Board resources unnecessarily. Accordingly, despite Patent Owner's refusal to engage in a discussion concerning a covenant-not-to-sue on the dismissed patents, and in view of the various preclusion doctrines available to Apple concerning the dismissed patents, Apple is willing to terminate the IPR proceedings concerning the dismissed patents so that the Board can focus its valuable resources on the Petitions where invalid patents continue to be asserted against Apple and others in the industry. Accordingly, Apple requests permission to dismiss its Petitions for IPR challenging the four patents that were dismissed with prejudice from the parallel litigation: IPR2025-01232, -01233, -01236, and -01239.

Good cause exists to dismiss these Petitions for IPR, including that it will preserve resources of the Board and the Parties. Apple hopes these preserved resources can be used to review the IPR challenges to the four patents that remain asserted in the parallel litigation: IPR2025-01234, -01235, -01237, and -01238.

Respectfully,

Paul Hart
shareholder

p 913.777.5600 | **d** 720.689.5441
717 17th Street, Suite 1400
Denver, CO 80202



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