

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PINN, INC.,
Patent Owner.

IPR2021-00220, IPR2021-00221
Patent 10,455,066 B2¹

Before JAMESON LEE, KARL D. EASTHOM, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

On March 18, 2021, with Board authorization, Petitioner, Apple Inc.,
filed a Motion to Dismiss the Petition in each of these proceedings.

¹ Because this decision resolves issues that are identical in both cases, we
exercise our discretion to issue a single decision to be entered in each case.

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IPR2021-00220, Paper 9 (“Mot.”); IPR2021-00221, Paper 9.² Petitioner represents that Patent Owner, Pinn, Inc., does not oppose the relief requested in the motion. Mot. 2.

As Petitioner points out, the instant Petitions (IPR2021-00220, Paper 2 (“Pet.”); IPR2021-00221, Paper 2) are the second and third petitions filed by Petitioner challenging claims of U.S. Patent No. 10,455,066 B2 (“the ’066 patent”). Mot. 2–3. In the earlier proceeding, PGR2020-00066, the Board exercised its discretion to deny institution under 35 U.S.C. § 324(a), having determined “that instituting a post-grant review would be an inefficient use of Board resources” in view of the related district court proceeding involving the ’066 patent. *Apple Inc. v. Pinn, Inc.*, PGR2020-00066, Paper 16 at 21 (PTAB Dec. 8, 2020); *see* Mot. 3. That district court proceeding remains pending. *See, e.g.*, Pet. 80; Paper 6, 2 (Patent Owner’s Mandatory Notices).

Petitioner submits that dismissal of the Petitions is appropriate because these proceedings are in a preliminary stage and the Board has not issued decisions on institution, which are due on May 23, 2021. Mot. 4. Petitioner contends it would be appropriate to dismiss the Petitions “to preserve the Board’s and parties’ resources and promote a speedy and inexpensive resolution to this dispute.” *Id.* Petitioner also notes that it is barred from filing another petition for review of the ’066 patent because Patent Owner served its complaint alleging infringement of the ’066 patent

² The motions are substantively identical. Unless otherwise noted, citations are to the papers filed in IPR2021-00220.

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more than one year ago. *Id.* Thus, Petitioner asserts, dismissal of the Petitions does not prejudice Patent Owner. *Id.*

Under 37 C.F.R. § 42.71(a), “[t]he Board may take up petitions or motions for decisions in any order, [and] may grant, deny, or dismiss any petition or motion.” These proceedings are at an early stage, and although the Board has expended some resources in its initial review of the Petitions, under the circumstances presented here we are persuaded it is appropriate to dismiss the Petitions and terminate the proceedings to promote efficiency and minimize unnecessary costs.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that Petitioner’s Motion to Dismiss in IPR2021-00220 is *granted*;

FURTHER ORDERED that the Petition in IPR2021-00220 is *dismissed* and the proceeding in IPR2021-00220 is *terminated*;

FURTHER ORDERED that Petitioner’s Motion to Dismiss in IPR2021-00221 is *granted*; and

FURTHER ORDERED that the Petition in IPR2021-00221 is *dismissed* and the proceeding in IPR2021-00221 is *terminated*.

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