

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01398

U.S. Patent No. 8,646,042

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00573**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple Inc. (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,646,042 (“’042 Patent”) (IPR2024-01398 “the 1398 Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Microsoft Corp. v. Proxense, LLC*, IPR2024-00573 (“the Microsoft IPR”).¹ The 1398 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Microsoft IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Microsoft does not oppose Petitioner’s request for joinder.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Microsoft IPR while efficiently resolving the question of the ’042 Patent’s validity in a single proceeding.

¹ Google LLC has filed a Motion for Joinder of the Microsoft IPR. *See Google LLC v. Proxense, LLC*, IPR2024-01318, Paper 3.

II. STATEMENT OF MATERIAL FACTS

1. On February 15, 2024, Microsoft Corporation filed a petition for *inter partes* review (IPR2024-00573) requesting cancellation of claims 1, 5-6, 8-11, 13-14 of the '042 Patent.

2. On August 13, 2024, the Board instituted *inter partes* review on all challenged claims and grounds. IPR2024-00573, Paper 11 (Aug. 13, 2024).

3. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1, 5-6, 8-11, 13-14 of the '042 Patent, which is substantively identical to the Microsoft IPR.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. See 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the Decision Granting Institution of *Inter Partes* Review dated August 13, 2024, (Paper 11) of the Microsoft IPR. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the 1398 Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Microsoft Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 6; (granting IPR where petitioners requested an “understudy” role); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder is Appropriate

Joinder with the Microsoft IPR is appropriate because the 1398 Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Microsoft Petition. *Id.* The 1398 Petition is substantively identical

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