

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

**PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING
PETITIONS¹**

¹ Petitioner is filing a substantively identical document in IPR2024-01399.

I. Introduction

Petitioner is concurrently filing petitions for *inter partes* review of U.S. Patent No. 8,646,042 (“the ’042 patent”) in IPR2024-01398 (“the 1398 IPR”) and IPR2024-01399 (“the 1399 IPR”). In the 1398 IPR, Petitioner seeks to join *Microsoft Corp. v. Proxense, LLC*, IPR2024-00573 (“the Microsoft IPR”). In the 1399 IPR, Petitioner seeks to join *Google LLC v. Proxense, LLC*, IPR2024-00782 (“the Google IPR”).

Since Petitioner has two concurrent petitions challenging the validity of the same patent, Petitioner hereby provides: (1) “a ranking of the petitions in the order in which it wishes the Board to consider the merits” and (2) “a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.” Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), 60.

II. Ranking of Petitions

Petitioner believes that the petitions submitted in both the 1398 IPR and the 1399 IPR are meritorious and justified. Should the Board decide to institute only a single petition and grant only a single motion for joinder against the ’042 patent, Petitioner requests that the Board institute Petitioner’s petition in the 1399 IPR and grant its Motion for Joinder of the Google IPR if the Board institutes that proceeding; otherwise, Petitioner requests that the Board institute Petitioner’s petition in the 1398 IPR.

III. Background and Related Proceedings

On February 15, 2024, Microsoft filed a petition for review of the '042 patent (“the Microsoft Petition”) in the Microsoft IPR. On June 10, 2024, Proxense, LLC (the “Patent Owner”) filed its patent owner’s preliminary response in the Microsoft IPR. On August 13, 2024, the Board granted institution of the Microsoft IPR.

Separately, on April 19, 2024, Google filed a petition (“the Google Petition”) to challenge the validity of the '042 patent in the Google IPR. The Patent Owner filed its preliminary response in the Google IPR on August 20, 2024, setting a deadline for the Board to issue an institution decision of November 20, 2024. 35 U.S.C. § 315(b).

IV. Material Differences Support Instituting Multiple Petitions

Material differences exist between the Microsoft Petition and the Google Petition. As such, Petitioner’s petitions in the 1398 IPR and the 1399 IPR are likewise materially different. For example, and as illustrated in the tables below, the two petitions raise different invalidity grounds relying on different prior art combinations, and raise different arguments.

IPR2024-01398 Petition (substantively identical to the Microsoft Petition)			
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	1, 5, 6, 8–11, 13, 14	103	Giobbi '157, Giobbi '139
2	1, 5, 6, 8–11, 13, 14	103	Giobbi '157, Giobbi '139, Dua

3	10, 11, 13, 14	103	Broadcom ²
---	----------------	-----	-----------------------

IPR2024-01399 Petition (substantively identical to the Google Petition)			
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	10	103	Dua
2	10	103	Dua, Kotola
3	1, 3-6, 8-15, and 17	103	Buer ²
4	2	103	Buer, Lee
5	12	103	Buer, Nishikawa
6	3 and 18-20	103	Buer, Hoffmann

As shown in the above tables, Petitioner’s petition in the 1398 IPR challenges different claims of the ’042 patent based on significantly different invalidity grounds than its petition in the 1399 IPR.

V. *General Plastics* Is Not Applicable

In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential). In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. The Board has applied the *General Plastic* framework to the joinder petition of a petitioner that previously filed its own petition. *Apple Inc. v. Uniloc 2017 LLC*,

² Buer and Broadcom are the same EP 1536306 reference.

IPR2020-00854, Paper 9 (PTAB Oct. 28. 2020) (precedential); *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential).

Petitioner respectfully submits that application of the *General Plastic* analysis is inapplicable here. Petitioner has not previously filed its own petition. Instead, Petitioner merely seeks to join an IPR—the Google IPR if the Board institutes, or otherwise the Microsoft IPR—that is already pending, and does not present any new grounds. As such, Petitioner respectfully submits that *General Plastic* does not apply in this circumstance because Petitioner would be taking an understudy role and the Board’s finite resources would not be impacted.

VI. Conclusion

Should the Board decide to institute only a single petition and grant only a single motion for joinder against the ’042 patent, Petitioner requests that the Board institute Petitioner’s petition in the 1399 IPR and grant its motion to join the Google IPR if the Board institutes that proceeding; otherwise, the Petitioner requests that the Board institute Petitioner’s petition in the 1398 IPR.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.