

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

PROXENSE, LLC,  
Patent Owner.

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IPR2025-00075  
Patent 9,679,289 B1

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Before THU A. DANG, DAVID C. McKONE, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314  
Granting Motion for Joinder  
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

## I. INTRODUCTION

On November 4, 2024, Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review of claims 1–20 of U.S. Patent No. 9,679,289 B1 (Ex. 1001, “the ’289 patent”) and a Motion for Joinder (Paper 2, “Motion” or “Mot.”) with *Google LLC v. Proxense, LLC*, IPR2024-00783 (“the Google IPR”). Proxense, LLC (“Patent Owner”) did not file an opposition to Petitioner’s Motion and has informed the Board “Patent Owner does not oppose Petitioner’s Motion for Joinder. Accordingly, should the Board grant Petitioner’s Motion, Patent Owner does not believe filing a Patent Owner Preliminary Response would benefit the Board.” *See* 37 C.F.R. § 42.25(a)(1); Ex. 3001 (“Patent Owner’s December 31, 2024 email from James A. Zak, Esq.”). Petitioner states that Petitioner understands Google LLC, the petitioner in the Google IPR, does not oppose the Motion. Mot. 1.

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314; *see* 37 C.F.R. § 42.4. Upon consideration of the Petition and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least 1 claim of the ’289 patent. Accordingly, we institute *inter partes* review of claims 1–20 of the ’289 patent. We also *grant* Petitioner’s Motion for Joinder.

*A. Real Parties-in-Interest*

Petitioner identifies Apple Inc. as the real party-in-interest. Pet. 84. Patent Owner has not submitted mandatory notices.

*B. Related Proceedings*

As required by 37 C.F.R. § 42.8(b)(2), Petitioner identifies various related matters, including the Google IPR. Pet. 85–86.

*C. The '289 Patent*

The '289 patent, titled “Hybrid Device Having a Personal Digital Key and Receiver-Decoder Circuit and Methods of Use,” issued on June 13, 2017, from Application No. 14/961,645, with a filing date of December 7, 2015. Ex. 1001, codes (54), (45), (21), (22). The '289 patent provides a hybrid device including a personal digital key (PDK) and a receiver-decoder circuit (RDC) that are coupled for communication with each other. *Id.* at code (57).

An illustration of the embodiment of the '289 patent's hybrid device being a part of a cell phone is depicted in Figure 12, reproduced below:

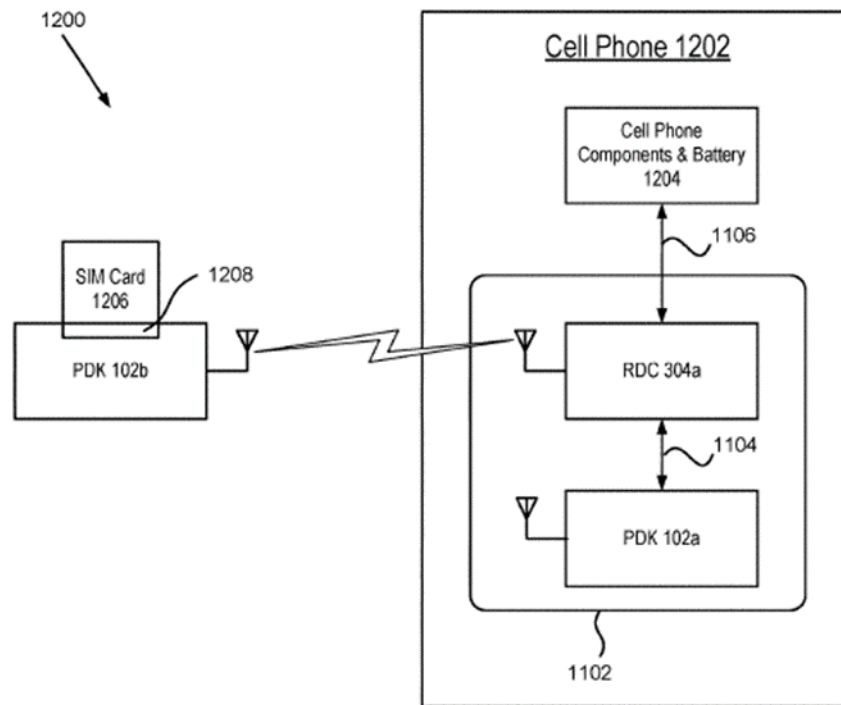


FIG. 12

Figure 12 shows system 1200 comprising PDK 102b and cell phone 1202. *Id.* at 14:47–48. As shown in Figure 12, cell phone 1202 further comprises cell phone components and battery 1204, and hybrid device 1102, wherein hybrid device 1102 includes PDK 102a and RDC 304a coupled for communication with each other via signal line 1104. *Id.* at 14:48–53. Cell phone components and battery 1204 are coupled to RDC 304a by signal line 1106, allowing RDC 304a to use the communication capabilities of cell phone 1202 to communicate with other networks and devices. *Id.* at 14:53–59.

In one embodiment, cell phone 1202 including hybrid device 1102 collectively forms a secure cell phone or generic access point. *Id.* at 14:65–67. The conventional SIM card is replaced with hybrid device 1102, which provides authorization control as well as a storage area for storing

information specific to the user. *Id.* at 15:6–11. Thus, SIM content (cell phone account, contact information, and credit card) that is normally stored in cell phone 1202 is instead stored in PDK 102b in its local memory carried by the user. *Id.* at 15:11–15.

*D. Illustrative Claim*

Of the challenged claims, claims 1 and 14 are independent. Independent claim 1 is illustrative of the challenged claims, and is reproduced below:

1. A hybrid device comprising:
  - an integrated, secure memory storing local, secured information; and
  - an integrated reader-decoder circuit (RDC) for communicating wirelessly with at least one external device within a proximity zone, the integrated RDC communicatively coupled to the integrated, secure memory for communication with the integrated, secure memory,
- wherein one or more of (a) the integrated RDC communicating wirelessly with the at least one external device within the proximity zone and (b) the local, secured information stored by the integrated, secure memory enables one or more of an application, a function, and a service.

Ex. 1001, 22:36–49.

*E. The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–20 of the '289 patent on the following grounds (Pet. 1):

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