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Paper 8
Entered: October 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PROXSENSE LLC,
Patent Owner.

IPR2024-01333
Patent 8,352,730 B2

Before THU A. DANG, KEVIN F. TURNER, and DAVID C. McKONE, *Administrative Patent Judges.*

McKONE, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1–6 and 8–17 of U.S. Patent No. 8,352,730 B2 (Ex. 1001, "the '730 patent"). Additionally, Petitioner filed a Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) to Related *Inter Partes* Review IPR2024-00232. Paper 3 ("Joinder Mot."). In an October 1, 2024, teleconference among the panel and counsel for Petitioner, Patent Owner, and counsel for Google LLC (the petitioner in the IPR2024-00232 ("the Google IPR")), Patent Owner represented that it did not oppose Petitioner's Joinder Motion and that we should proceed to join Petitioner as a party to the Google IPR. Paper 7, 4.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2016); 37 C.F.R. § 42.4(a) (2019). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons explained below, we institute an *inter partes* review of the '730 patent. We also join Petitioner as a party to IPR2024-00232.

II. INSTITUTION OF INTER PARTES REVIEW

A. Evidence

Petitioner relies on the references listed below.

Name	Reference	Date	Exhibit No.
Ludtke	US 7,188,110 B1	Mar. 6, 2007 (filed Dec. 11, 2000)	1005
Kon	US 2002/0046336 A1	Apr. 18, 2002	1006

Petitioner also relies on the Declaration of Stephen Gray (Ex. 1003).

B. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 1):

Reference(s)	35 U.S.C. §	Claim(s) Challenged
Ludtke	§ 103(a)[1]	1, 2, 4–6, 8, 9, 11, 12, 14–17
Ludtke, Kon	§ 103(a)	3, 10, 13

C. Institution of Inter Partes Review

This Petition is substantially identical to the petition in the Google IPR, challenging the same patent and claims, based on the same grounds of unpatentability, and relying upon the same evidence (including the same prior art combinations supported by the same expert declaration). According to Petitioner, "the 1333 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 Google Petition." Joinder Mot. 3; *accord id.* at 5 ("The Google Petition and 1333 Petition

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. § 103. Because the '730 patent has an effective filing date before the effective date of the relevant provision of the AIA, we cite to the pre-AIA version of § 103.

present substantively identical grounds of rejection, including the same art combinations against the same claims.”).

Petitioner undertakes, if the Petition and Joinder Motion are granted, to assume an “understudy” role, and will not take an active role in the *inter partes* review proceeding unless the petitioner in the Google IPR ceases to participate in the instituted IPR. *Id.* at 5–6 (citing *Noven Pharmaceuticals, Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015)). Petitioner represents that it “can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner.” *Id.* at 6. Thus, Petitioner argues, “[t]hese steps will minimize any potential complications or delay that potentially may result by joinder.” *Id.*

In view of these representations by Petitioner and Patent Owner’s statement that it does not oppose joinder, and having reviewed the Petition, we determine that, under the current circumstances, it is appropriate to exercise our discretion to institute *inter partes* review of the challenged claims based upon the same grounds authorized and for the same reasons discussed in the Google DI (Google IPR, Paper 10). Petitioner has shown a reasonable likelihood that it would prevail with respect to each of the claims challenged in the Petition for the same reasons given in the Google DI considering the same issues.

III. PETITIONER’S JOINDER MOTION

As noted above, Petitioner requests joinder of this proceeding with the Google IPR. Joinder Mot. 1.

Joinder in *inter partes* review proceedings is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

"To join a party to an instituted [inter partes review (IPR)], the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). "First, the statute requires that the Director (or the Board acting through a delegation of authority) . . . determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* "Second, to effect joinder, § 315(c) requires the Director to exercise h[er] discretion to decide whether to 'join as a party' the joinder applicant." *Id.*

As the moving party, Petitioner bears the burden of proving that it is entitled to joinder. *See* 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

A motion for joinder must be filed "no later than one month after the institution date of any inter partes review for which joinder is requested." 37 C.F.R. § 42.122(b). Petitioner argues that the Joinder Motion is timely because it was filed within one month of the July 24, 2024, Google DI. Joinder Mot. 3.

Petitioner argues that the Petition "is . . . narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Google IPR." *Id.* at 1; *see also id.* at 3 ("[J]oinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an 'understudy' role."). As we explain above, the Petition is substantially identical to the petition in the Google IPR.

Petitioner is "willing to streamline discovery and briefing" and "accept an 'understudy' role." *Id.* at 1, 3; *see also id.* at 5 ("Petitioner explicitly agrees to take an 'understudy' role, as described by the Board" in *Noven Pharmaceuticals*, IPR2014-00550, Paper 38 at 5). In particular, Petitioner agrees to the following terms:

> (a) ***all*** filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Google IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Google IPR];
>
> (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Google] IPR, or introduce any argument or discovery not already introduced by [the petitioner in the Google IPR];
>
> (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Google IPR] concerning discovery and/or depositions; and
>
> (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Google IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Google IPR].

Id. at 5–6 (quoting *Noven Pharmaceuticals*, IPR2014-00550, Paper 38 at 5 (alterations by Petitioner)). Petitioner represents that it "will assume the

primary role only if Google ceases to participate in the Google IPR." *Id.* at 6.

A. Whether the Petition Warrants Institution

"The statute makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed." *Facebook*, 973 F.3d at 1332 (citing *Thyrv, Inc. v. Click-to-Call Techs., LP*, 140 S.Ct. 1367, 1377 (2020)).

As we explain above, Petitioner has shown a reasonable likelihood that it would prevail with respect to each of the claims challenged in the petition. Thus, Petitioner has shown that the Petition warrants institution.

B. Whether to Join Petitioner as a Party to the Google IPR

The Joinder Motion, filed on August 22, 2024, was filed one month after the July 24, 2024, date of the Google DI. Thus, the Joinder motion is timely. *See* 35 U.S.C. § 316(a)(12) ("The Director shall prescribe regulations— . . . (12) setting a time period for requesting joinder under section 315(c)."); 37 C.F.R. § 42.122(b) ("Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.").

As noted above, Patent Owner represented that it did not oppose Petitioner's Joinder Motion and that we should proceed to join Petitioner as a party to the Google IPR. Paper 7, 4. Petitioner represents that Google does not oppose joinder. Joinder Mot. 1.

The Petition does not present any new grounds or issues. Joinder Mot. 1, 3–5. Petitioner agrees to the schedule in the Google IPR and, thus,

has shown that the trial schedule is not likely to be affected by joinder. *Id.* at 5–6. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial.

Petitioner has agreed to an "understudy" role, which will simplify matters in the ongoing Google IPR and will be an efficient use of resources. *Id.* at 3, 5–6. Petitioner will assume a primary role only if the Google IPR petitioner ceases to participate in the IPR. *Id.* at 6.

Accordingly, we determine that Petitioner has met its burden of showing that we should exercise our discretion to join Petitioner to the Google IPR (IPR2024-00232).

IV. CONCLUSION

Petitioner has established a reasonable likelihood that it would prevail with respect to at least one claim of the '730 patent.

Our factual findings, conclusions of law, and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

Petitioner has shown that we should exercise our discretion to join Petitioner to the Google IPR (IPR2024-00232).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to claims 1–6 and 8–17 of the ’730 patent on the grounds set forth in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision;

FURTHER ORDERED that Petitioner’s Motion for Joinder with IPR2024-00232 (Paper 3) is granted, and Apple Inc. is hereby joined with Google LLC as a petitioner entity in IPR2024-00232;

FURTHER ORDERED that the grounds on which trial in IPR2024-00232 were instituted are unchanged, and no other grounds are added in IPR2024-00232;

FURTHER ORDERED that the Scheduling Order entered in IPR2024-00232 (Paper 11) shall govern the trial schedule in IPR2024-00232;

FURTHER ORDERED that Petitioner’s role in IPR2024-00232 shall be limited as stated by Petitioner in the Joinder Motion (Joinder Mot. 5–6) unless and until Google LLC is terminated from that proceeding;

FURTHER ORDERED that the case caption in IPR2024-00232 shall be changed to reflect joinder of Apple Inc. as a petitioner entity in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of IPR2024-00232; and

FURTHER ORDERED that all further filings shall be made in IPR2024-00232.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and APPLE INC.,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00232[2]
Patent 8,352,730 B2

[2] IPR2024-01333 has been joined with this proceeding.

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