

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner

IPR2024-00232

IPR2024-01333

U.S. Patent No. 8,352,730

REQUEST FOR ADVERSE JUDGMENT UNDER 37 C.F.R. § 42.73(b)

REQUEST TO LIFT STAY IN EPR 90/015,052

Patent Owner, Proxense LLC (“Proxense”), requests adverse judgement in IPR2024-00232 / IPR2024-01333 based on the concessions of unpatentability made when Patent Owner authorized entry of the Examiner’s amendment in EPR 90/05,052. Under 37 C.F.R. § 42.73(b), “a party may request judgement against itself at any time during a proceeding.” Pursuant to 42.73(b)(3) a party may request adverse judgment by a “concession of unpatentability.” Patent Owner has conceded the unpatentability of the claims at issue in this proceeding by authorizing entry of the Examiner’s amendment in EPR 90/015,052. As such, Patent Owner requests adverse judgment pursuant to 42.73(b)(3).

Patent Owner further requests the Board lift the stay issued in EPR 90/015,052. In deciding to lift a stay in a parallel proceeding, the Board may consider the following factors.

- Whether the factors considered when ordering the stay have changed from when stay was ordered;
- Whether the patent owner has requested adverse judgment or cancelled all claims at issue in the AIA trial proceeding;
- Whether the patent owner is requesting rehearing or appeal the final written decision in the AIA trial proceeding to the Federal Circuit;

- Whether the patent owner agrees to abide by the estoppel provisions set forth in 37 C.F.R. § 42.73(d)(3); and
- Whether lifting the stay would be in the interest of the administration of the Office and integrity of the patent system.

Notice Regarding Options for Amendments by Patent Owner through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019), 84 Fed. Reg. 16,654, 16,657 (April 22, 2019).

The factors considered when ordering the stay have changed. The stay was ordered to avoid inconsistent results between the proceedings because entry of the Examiner's amendment would affect the scope of the claims. *See* Paper 27, at 4. By requesting adverse judgment in this proceeding, Patent Owner has prevented inconsistent results by conceding the unpatentability of the claims in both proceedings. The stay was also ordered to avoid duplicated efforts by the Office. *See* Paper 27, at 4. Again, by requesting adverse judgment in this proceeding, Patent Owner has eliminated this factor by terminating this proceeding. Accordingly, the factors considered when lifting the stay have changed due to the Patent Owner requesting adverse judgment, which favors lifting the stay.

Additionally, the requesting adverse judgment by itself favors lifting the stay.

Furthermore, Patent Owner is not requesting a rehearing or appealing a final written decision by the Board to the Federal Circuit, which also favors lifting the stay.

Patent Owner is also agreeing to follow the estoppel provisions of 42.73(d)(3). The Examiner in ERP 90/015,052 has proposed an Examiner's amendment that places the claims at issue in this proceeding in condition for allowance over the primary reference being considered in both proceedings. Accordingly, when entered, the Examiner's amendment will result in claims patentably distinct from the current claims and narrower in scope. The "Board typically will lift the stay of a parallel Office proceeding if the patent owner proposes amendments in that proceeding ... that narrow the scope of claims considered in an AIA proceeding." Notice Regarding Options for Amendments by Patent Owner through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019), 84 Fed. Reg. 16,654, 16,657 (April 22, 2019). By authorizing the entry of the Examiner's amendment, Patent Owner has accepted amendments in the EPR that would narrow the scope of the claims considered in this proceeding. Accordingly, this factor strongly favors lifting the stay.

Finally, lifting the stay would allow for the efficient administration of the Office by allowing the EPR to be concluded with the mandated special dispatch. It also preserves the integrity of the patent system by allowing this the proceeding and

the EPR to reach a consistent result regarding the claims at issue. Accordingly, this factor favors lifting the stay.

As all factors favor lifting the stay, Patent Owner respectfully requests the Board lift the stay in ERP 90/015,052 upon entry Adverse Judgment.

Dated: April 15, 2025

Respectfully submitted by,

/s/ David L. Hecht
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that the Request for Adverse Judgment was served on April 15, 2025, by e-mailing copies to the e-mail addresses provided by Petitioner in the Petition.

Dated: April 15, 2025

Respectfully submitted by,

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