

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

Case IPR2024-00233¹
Patent No. 8,886,954

**PETITIONER’S OPENING BRIEF REGARDING ESTOPPEL
AGAINST PATENT OWNER**

¹ IPR2024-01334 has been joined to this proceeding (“the ’954 IPR”).

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I. INTRODUCTION

Apple Inc. (“Petitioner” or “Apple”) respectfully submits this Opening Brief Regarding Estoppel Against Patent Owner Proxense, LLC (“Patent Owner” or “Proxense”). Proxense concedes in its request for adverse judgment filed in IPR2024-00232 (the “’730 IPR”) that the claims of U.S. Pat. No. 8,352,730 (the “’730 Patent”) are unpatentable over the prior art. Because of the substantial identity in claim language and scope between the canceled claims of the ’730 Patent and the claims of U.S. Pat. No. 8,886,954 (the “’954 Patent”), and because Proxense did not make any separate, distinct arguments for the patentability of the ’954 Patent claims in this proceeding, Proxense should be collaterally estopped from arguing the patentability of the ’954 Patent claims over those same prior art grounds. *See Ohio Willow Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013) (“If the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies.”). Thus, the ’954 Patent claims are unpatentable for the same reasons over the same prior art as the canceled ’730 Patent claims.

II. PATENT OWNER IS COLLATERALLY ESTOPPED FROM ARGUING THE PATENTABILITY OF THE ’954 PATENT CLAIMS

The ’954 Patent is a continuation of the ’730 Patent, and thus is part of the same family and has the same specification. *Compare* ’730 IPR, Ex. 1001 (’730 Patent), Title, Abstract, Specification, Figures *with*, ’954 IPR, Ex. 1001 (’954

Patent), Title, Abstract, Specification, Figures. The '730 and '954 claims are substantially identical. *Compare e.g.*, '730 IPR, Ex. 1001, claims 1, 12 *with*, '954 IPR, Ex. 1001, claims 1, 16. Petitioner challenged both the '730 and '954 claims based on the same prior art grounds: Ground 1 based on Ludtke, and Ground 2 based on the combination of Ludtke and Kon. '730 IPR, Pet. 5–69 *with*, '954 IPR, Pet. 5–68. While there are some differences in claim limitations as between the claims of the '730 and '954 Patents, Proxense in the IPR proceedings did not make any distinct or separate arguments based on these differences, or otherwise indicate that the claims are patentably distinct or have a different scope. *See generally* '730 IPR, POR 1–2, 8–26; '954 IPR, POR 1–2, 8–25. Instead, Proxense relied on the same arguments for the patentability of the challenged claims in both IPRs. *Compare* '730 IPR, POR 1–2, 8–26 *with*, '954, POR 1–2, 8–25; *compare* '730 IPR, PO Sur-Reply 10–20 *with*, '954 IPR, PO Sur-Reply 10–18; *see, e.g.*, Ex. 1028 at 8–9.

Collateral estoppel prevents Proxense from re-litigating in the '954 IPR the issue of whether Ludtke and/or Kon teaches substantially the same disputed claims limitations of the '954 Patent, after Proxense has already admitted so in the '730 IPR. Collateral estoppel applies where: (1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the

prior action featured full representation of the estopped party. *VirnetX Inc. v Apple, Inc.*, 909 F.3d 1375, 1377 (Fed. Cir. 2018) (citation omitted).

First, the prior '730 IPR presented issues substantially identical to those presented in the '954 IPR. For example, in the '730 IPR, the issue of whether Ludtke discloses or renders obvious the “receiving an access message from the agent allowing the user access to an application” limitation of claim 1 of the '730 Patent was presented. '730 IPR, Pet. 32–36; POR 17–25. Similarly, in the '954 IPR, this same issue was presented as to the substantially identical “receiving, at an application, an access message from the trusted authority...allowing the user access to the application” limitation of claim 1 of the '954 Patent. '954 IPR, Pet. 28–32; POR 17–25. Both IPRs also addressed and presented the issue of whether Ludtke discloses or renders obvious all of the other substantially identical limitations of claim 1 of the '730 Patent and claim 1 of the '954 Patent. *Compare* '730 IPR, Pet. 8–36 *and* POR 8–25 *with*, '954 IPR, Pet. 8–32 *and* POR 8–25.

Second, in the '730 IPR, the issue of patentability and whether the prior art discloses or renders obvious substantially the same limitations at issue in the '954 IPR were raised, extensively briefed, argued, and litigated in the parties' papers filed in the '730 IPR. *See* IPR2024-00232, Pet. 5–69; POR 8–25; Pet. Reply 7–16; PO Sur-Reply 10–19; *M2M Solutions LLC v. Amazon.com, Inc.*, No. 2022-1122, 2023 WL 2154964, at *4 (Fed. Cir. Feb. 22, 2023) (affirming the Board's decision that

patent owner is collaterally estopped from arguing that prior art failed to disclose substantially identical limitation litigated in prior IPR). Proxense relied on substantially identical arguments regarding the patentability of the '730 claims and the '954 claims over identical prior art grounds asserted in both IPRs: Ludtke (Ground 1), and the combination of Ludtke and Kon (Ground 2). *Compare* '730 IPR, POR 1–2, 8–26 *and* PO Sur-Reply 10–20 *with*, '954 IPR, POR 1–2, 8–25 *and* PO Sur-Reply 10–18; *see also* Ex. 1028 at 8–9. Regarding the '954 Patent limitation that the access message is received “at an application,” Proxense basically admitted that it did not raise this as a separate argument in the '954 IPR. '954 IPR, Hrg. Tr., Paper 31 at 44:24–45:9.

Third, the judgment in the '730 IPR necessarily required determination of the identical issue in the request for adverse judgment. Proxense expressly “conceded the unpatentability of the claims at issue in this proceeding” over the same prior art grounds asserted in the '954 IPR. '730 IPR, Paper 33 at 3 (entering “Judgment” and “Final Written Decision” ordering “that claims 1–6 and 8–17 of U.S. Patent No. 8,352,730 B2 are cancelled”). Proxense’s concession of unpatentability constitutes an admission on the issue of whether Ludtke discloses “receiving an access message from the agent allowing the user access to an application” and thus, via Proxense’s own admission a substantially identical issue in the '954 IPR that was adjudged and necessarily determined in the '730 IPR. While Proxense tried to argue at the hearing

that its request for adverse judgment on the '730 claims was “not acknowledging directly that any of the prior art is directly applicable,” Proxense admitted that “We’re saying that this is unpatentable.” ’954 IPR, Hrg. Tr., Paper 31 at 49:2–5.

Fourth, Proxense had full representation by counsel throughout the prior proceeding. Indeed, in the '730 IPR, Proxense was represented by the same law firm and attorney, Hecht Partners LLP and David L. Hecht ('730 IPR, Paper 28 at 3), that represents Proxense in the '954 IPR (Paper 27 at 2) and the related district court litigation (Ex. 1031 at 1–2).

Accordingly, because the criteria for collateral estoppel are met, Proxense is precluded from arguing that the same prior art asserted in the '730 IPR (Ludtke and/or Kon) does not disclose or render obvious substantially the same disputed claim limitations at issue in the '954 IPR.

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Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a complete and entire copy of the foregoing PETITIONER’S OPENING BRIEF REGARDING ESTOPPEL AGAINST PATENT OWNER was served electronically on May 8, 2025, on counsel of record for the Patent Owner as follows:

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