

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00232¹
Patent 8,352,730 B2

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

McKONE, *Administrative Patent Judge.*

ORDER
Staying Concurrent Reexamination
35 U.S.C. § 325(d)

¹ IPR2024-01333 has been joined with this proceeding.

Google LLC filed a Petition (Paper 1, “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”). Pet. 5. We instituted a trial on July 24, 2024. Paper 10. Apple, Inc. (“Petitioner”) joined the proceeding as a party on October 8, 2024, filing a duplicate petition. Paper 13. We terminated the proceeding as to Google, leaving Apple as the sole Petitioner. Paper 21. An oral argument in this proceeding is scheduled for April 22, 2025. Paper 26. A final written decision is due by July 24, 2025. *See* 35 U.S.C. 316(a)(11).

In the Petition, Petitioner stated that the ’730 patent is the subject of *ex parte* reexamination in *In re Proxense, LLC*, Application No. 90/015,052 (filed June 8, 2022) (“the ’052 reexam”). Pet. 75. Patent Owner’s Mandatory Notices omitted the ’052 reexam from the listed Related Matters pursuant to 37 C.F.R. § 42.8(b)(2). Paper 4. Patent Owner filed no updated Mandatory Notices pursuant to 37 C.F.R. § 42.8(a)(3).²

By email to the Board on March 25, 2025 (Ex. 3003), the parties notified the panel of a March 3, 2025, Office Action in the ’052 reexam in which the Examiner proposed an Examiner’s amendment to the claims. The parties indicate that the claims of the ’730 patent pending before the Office may change if the Examiner enters the amendment. Also on March 25, 2025, in violation of the Scheduling Order (Paper 11, at 2), Patent Owner submitted an unauthorized brief by email detailing communications in the ’052 reexamination that occurred at least as early as December 2024. Although we do not consider these arguments, Patent Owner’s email illustrates its awareness of the ’052 reexam and the impact it might have on

² Patent Owner’s Mandatory Notices filed in IPR2024-01333 (Paper 5) lists the ’052 reexam as a related matter.

this proceeding. Nevertheless, Patent Owner did not file updated Mandatory Notices identifying such developments in the '052 reexam.

We held a conference call with the parties on March 27, 2025. Petitioner urges us to stay the '052 reexam because it would be more efficient and because of the risk of inconsistent results if it were to proceed. Patent Owner argues that a stay would be prejudicial to Patent Owner and would be inefficient given the work that the reexamination Examiner has already done. Patent Owner further stated that, if the Examiner does issue such an amendment, Patent Owner likely would ask us to dispose of the current proceeding adverse to Petitioner, either through dismissal or a final written decision.

The Board will not ordinarily stay a reexamination because, in absence of good cause, reexaminations are conducted with special dispatch. However, good cause exists in this case.

In deciding whether to grant a stay of a parallel proceeding involving the same patent within the Office, the Office (typically the Board) may consider a number of factors, including, but not limited to:

- Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding;
- Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;
- Whether the concurrent parallel Office proceeding will duplicate efforts within the Office;
- Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding);

- Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
- The respective timeline and stage of each proceeding;
- The statutory deadlines of the respective proceedings;
- Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

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).

All of the claims at issue in this proceeding are subject to the '052 reexam. Aug. 2, 2022, Decision on Request for *ex parte* Reexamination (Ex. 2022), 4. The '052 reexam also considers the patentability of the claims over Ludtke, the primary reference in this proceeding. *Id.* Thus, the concurrent '052 reexam has and will continue to duplicate efforts within the Office. These factors weigh in favor of staying the '052 reexam.

Continuing to conduct the '052 reexam concurrently with the instant proceeding could potentially result in inconsistencies between the proceedings. *Cf. CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 15 (PTAB Nov. 6, 2012). In particular, the parties expect the Examiner to amend the claim scope in the '052 in a way that could affect claim scope in the instant proceeding. The parties' March 25, 2025, email raises this issue specifically. Thus, these factors also favor staying the '052 reexam.

Both the instant proceeding and the '052 reexam are far along. However, the instant proceeding is subject to a statutory deadline of July 24, 2025, for issuing a final written decision. Thus, a stay of the '052 reexam pending the outcome of this proceeding will be short, unless the parties

pursue appeals of any final written decision in this proceeding. A final written decision in this proceeding likely will simplify issues in the '052 reexam. Thus, these factors favor staying the '052 reexam.

Under the circumstances of this case, we find good cause to exercise our discretion to stay the '052 reexam pending the termination or completion of this proceeding.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *ex parte* Reexamination No. 90/015,052 is stayed pending the termination or completion IPR2024-00232;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/015,052 are tolled for the duration of the stay, and no further papers shall be filed in the reexamination while this stay remains in place, without authorization; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting the time periods for responding to any outstanding papers in Reexamination Control No. 90/015,052.

IPR2024-00232
Patent 8,352,730 B2

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