

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.*

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
Lifting Stay of Concurrent Reexamination 90/015,052
37 C.F.R. § 42.73(b); 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.

Patent Owner “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 90/015,052.” Paper 29, 1. “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).” *Id.* “Petitioner Apple agrees to Patent Owner’s request for adverse judgment in IPR2024-00232.” Ex. 3004.

Rule 47.73(b)(3) provides that “[a] party may request adverse judgment against itself at any time during a proceeding” and that “[a]ctions construed to be a request for adverse judgment include . . . [c]oncession of unpatentability . . . of the contested subject matter.” 37 C.F.R. § 42.73(b)(3). We grant Patent Owner’s request for adverse judgment.

Patent Owner also requests that we lift the stay issued in Reexamination Control No. 90/015,052 (Paper 27). Paper 29, 1–3. “Patent Owner is also agreeing to follow the estoppel provisions of 42.73(d)(3).” *Id.* at 3. Petitioner “does not oppose Patent Owner’s request to lift the stay in EPR 90/015,052,” but requests that we “include in [our] judgment a recommendation to the Examiner in EPR 90/015,052 to consider whether the Patent Owner should be estopped under 37 C.F.R. 42.73(d)(3)(i) from ‘taking action inconsistent with the adverse judgment, including obtaining in

any patent . . . [a] claim that is not patentably distinct from a finally refused or canceled claim.” Ex. 3004. We hereby lift the stay in Reexamination Control No. 90/015,052. We also recommend that the Reexamination Examiner consider whether estoppel under 37 C.F.R. § 42.73(d)(3)(i) should preclude Patent Owner from taking action inconsistent with this adverse judgment.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that adverse judgement is hereby entered against Patent Owner pursuant to 37 C.F.R. § 42.73(b) with respect to claims 1–6 and 8–17 of U.S. Patent No. 8,352,730 B2;

FURTHER ORDERED that claims 1–6 and 8–17 of U.S. Patent No. 8,352,730 B2 are cancelled;

FURTHER ORDERED that this Order constitutes a Final Written Decision under 35 U.S.C. § 318(a);

FURTHER ORDERED that the stay of Reexamination Control No. 90/015,052 (Paper 27) is lifted;

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner shall not take any action inconsistent with this adverse judgment, including obtaining in any patent a claim that is not patentably distinct from the cancelled claims in this proceeding; and

FURTHER ORDERED that this proceeding is terminated.

IPR2024-00232
Patent 8,352,730 B2

FOR PETITIONER:

Philip W. Woo
D. Stuart Bartow
Monte T. Squire
Paul Belnap
DUANE MORRIS
pwwoo@duanemorris.com
dsbartow@duanemorris.com
mtsquire@duanemorris.com
phbelnap@duanemorris.com

FOR PATENT OWNER:

David L. Hecht
James Zak
HECHT PARTNERS LLP
dhecht@hechtpartners.com
jzak@hechtpartners.com