

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and APPLE INC.,
Petitioner,

v.

PROXSENSE LLC,
Patent Owner.

IPR2024-00234¹
Patent 9,298,905 B1

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

TURNER, *Administrative Patent Judge.*

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

¹ IPR2024-01335 has been joined with this proceeding.

Google LLC filed a Petition (Paper 1) requesting *inter partes* review of claims 1–7 and 9–18 of U.S. Patent No. 9,298,905 B1 (Ex. 1001, “the ’905 Patent”). We instituted an *inter partes* review of the challenged claims the ’905 Patent. *See* Paper 10. Subsequently, Apple Inc. filed a petition against the same claims, applying the same grounds of unpatentability, and we instituted in that proceeding (IPR2024-01335), and joined Apple Inc. as a party to this proceeding. *See* Paper 14.

On October 16, 2024, Proxense, LLC (“Patent Owner”) filed a Request for Adverse Judgment, indicating to the Board that it had filed a statutory disclaimer under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) of all claims at issue in this *inter partes* review proceeding, “thereby rendering the proceedings moot.” Paper 15, 2. A copy of the disclaimer, as well as electronic acknowledgement receipt of its filing, may be found in Exhibit 3003. Patent Owner additionally indicated that it would be filing requests for adverse judgment in related proceedings (IPR2024-00776, IPR2024-01328), also involving the ’905 Patent (*see* Paper 13, 5), but those filings have yet to be made.

A party may request adverse judgment against itself at any time. 37 C.F.R. § 42.73(b). Here, Patent Owner requests adverse judgment because no claims remain in the trial after Patent Owner’s disclaimer of all the claims at issue in this proceedings. *See* 37 C.F.R. § 42.73(b)(2). We *grant* Patent Owner’s request and enter judgment against Patent Owner under 37 C.F.R. § 42.73(b) in this proceeding.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for adverse judgment is *granted*, and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1–7 and 9–18 of U.S. Patent No. 9,298,905 B1.

IPR2024-00234
Patent 9,298,905 B1

PETITIONER (Google):

Erika H. Arner
Kara A. Specht
Cory C. Bell
Safiya Aguilar
Shawn Chang
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
erika.arner@finnegan.com
safiya.aguilar@finnegan.com
shawn.chang@finnegan.com
kara.specht@finnegan.com
cory.bell@finnegan.com
Google-Proxense-IPRs@finnegan.com

PETITIONER (Apple):

Philip W. Woo
D. Stuart Bartow
Monté T. Squire
Paul Belnap
DUANE MORRIS LLP
PWWoo@duanemorris.com
DSBartow@duanemorris.com
MTSquire@duanemorris.com
PHBelnap@duanemorris.com

PATENT OWNER:

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