

From: [Usman Khan](#)
To: [Trials](#); [James Zak](#); dhecht@hechtpartners.com; [Selina Kyle](#); [Woo, Philip](#); [Squire, Monté T.](#); [Karl Renner](#); [IPR42342-01361P1](#); [Roberto Devoto](#)
Subject: RE: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement
Date: Friday, April 11, 2025 10:54:37 AM

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Your Honors:

As ordered by the Board on April 8, 2025, Microsoft has conferred with Proxense. In view of the representations and information provided to Microsoft during the meet and confer including Proxense's email to Microsoft on April 10, 2025, Microsoft does not object to Proxense's request for adverse judgement. For Your Honors' reference and to the extent it may be helpful for your Honors' consideration, a copy of the meet and confer emails between Microsoft and Proxense is provided below.

Sincerely,

Usman Khan, Ph.D., J.D.
Principal ■ Fish & Richardson P.C.
T: +1 (202) 626-6383 | khan@fr.com | [Bio](#)

From: David Hecht <dhecht@hechtpartners.com>
Sent: Thursday, April 10, 2025 1:44 PM
To: Usman Khan <khan@fr.com>
Cc: Roberto Devoto <devoto@fr.com>; Karl Renner <renner@fr.com>; Proxense <proxense@hechtpartners.com>; James Zak <jzak@hechtpartners.com>
Subject: Re: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

Usman,

Proxense did not previously indicate that it was disclaiming any of the claims. Such action would require filing a statutory disclaimer under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a), which Proxense has no intention of doing.

As stated in our e-mail of Friday, April 4, Proxense intends to request adverse judgment in IPR2024-00232 and IPR2024-00775, conceding the unpatentability of the claims challenged in each of those proceedings. Accordingly, the Request for Adverse Judgment will be made

Ex. 3001
IPR2024-00775

under 37 C.F.R. 42.73(b)(3).

Proxense made a similar concession during EPR 90/015,052. The first was in the Response under 37 C.F.R. § 1.111, filed January 27, 2025, where Proxense contingently conceded unpatentability by authorizing the Examiner to enter one of two Examiner's Amendments proposed in the Interview Summary mailed December 17, 2024. *See* EPR 90/015,052, Response filed January 27, 2025, 32-37

“Should the Examiner not find the remarks presented above persuasive, Patent Owner authorizes the Examiner to enter the Examiner's Amendment of her choice for each of independent claims 1, 8, 12, and 15.”

However, the Examiner issued a Final Office action specifying her choice but not entering the Examiner's Amendment. EPR 90/015,052, Final Office Action mailed March 3, 2025, 32:

“Lastly, as presented by the Examiner in the Interview Summary mailed December 17, 2024, the claims would be allowed if amended to recite:

receiving an access message by an application from the agent allowing the user to access the application, wherein the application is selected from a group consisting of a casino machine, a keyless lock, a garage door opener, an ATM machine, a hard drive, computer software, a web site and a file.

This proposed amendment is supported by the '730 Patent at col. 5, lines 23-26.”

This left Proxense unsure of whether it had effectively conceded unpatentability and whether the concession was accepted. Thus, it seemed inappropriate to request Adverse Judgment under 42.73(c) at that time.

To continue its efforts to accept the Examiner's Amendment and concede unpatentability, Proxense filed an Amendment under 37 C.F.R. § 1.116 on March 8, 2025, in which Proxense “respectfully request[ed] the Claims be amended ... to accept and incorporate the Examiner's amendment proposed in the Final Office Action mailed March 3, 2025.” EPR 90/015,052, Amendment under § 1.116 filed March 8, 2025. While the Amendment has been received, it has not been entered.

As the Examiner's amendment would have been entered within 30 days after filing, well before Proxense would have had to advance further arguments in the IPR, it seemed prudent to wait until the Examiner's amendment was entered before requesting Adverse Judgment.

The stay complicated things and was unexpected considering the Board instituted IPR2024-

00232 fully aware of and despite the pending EPRs and did not stay the EPR at that time.
IPR2024-00232, Paper 10 (Institution), 3:

“Petitioner states 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 notes two additional reexaminations of patents related to the ’730 patent, Application 90/015,053, reexamining the ’905 patent, and Application No. 90/015,054, reexamining U.S. Patent No. 10,698,989. Prelim. Resp. 14.”

Proxense intends to proceed on the assumption that concession made in the acceptance of the Examiner’s Amendment that was filed March 8, 2025, was effective when filed. Under this assumption, Proxense will be requesting adverse judgment.

Proxense will not act inconsistent with 37 C.F.R. 42.73(d). Additionally, the Office has already determined that the Examiner’s Amendment makes otherwise unpatentable claims patentable and thus patentably distinct from the current claims of the 730 Patent.

We hope this detailed response answers your questions.

Best,
David

David L. Hecht
Hecht Partners LLP

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From: Usman Khan <khan@fr.com>
Date: Wednesday, April 9, 2025 at 6:33 PM
To: David Hecht <dhecht@hechtpartners.com>, James Zak <jzak@hechtpartners.com>
Cc: Roberto Devoto <devoto@fr.com>, Karl Renner <renner@fr.com>
Subject: RE: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

Hi David:

We will take you up on your offer to discuss our questions over email. If after our initial exchange, we think a follow up call may help resolve any remaining lack of clarity, we will let you know.

As you may know, under [37 CFR 42.73](#), adverse judgement may be requested under certain circumstances. Under 37 CFR 42.73(b), "Actions construed to be a request for adverse judgment include:

- (1) Disclaimer of the involved application or patent;
- (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
- (3) Concession of unpatentability or derivation of the contested subject matter; and
- (4) Abandonment of the contest."

You previously indicated that you are disclaiming all the claims in the 730 patent. **Can you confirm that Proxense's disclaiming of all the 730 patent claims is consistent with 37 CFR 42.73(b)(2) above? Are there any other actions noted above that you would like to invoke with your request for adverse judgement?**

Section (d) of 37 CFR 42.73 relates to the estoppel provision. **Consistent with 37 CFR 42.73(d)(3)(i), can you confirm that Proxense will not pursue claims in any other proceeding unless those claims are patentably distinct from the claims you are canceling by virtue of the adverse judgement?**

We look forward to receiving your response.

Best,

Usman Khan, Ph.D., J.D.

Principal ■ Fish & Richardson P.C.

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From: Usman Khan

Sent: Wednesday, April 09, 2025 3:07 PM

To: David Hecht <dhecht@hechtpartners.com>; James Zak <jzak@hechtpartners.com>

Cc: Roberto Devoto <devoto@fr.com>; Karl Renner <renner@fr.com>

Subject: RE: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

Hi David:

I am traveling today, but will be in touch with you shortly. Appreciate the follow up.

Regards,

Usman Khan, Ph.D., J.D.

Principal ■ Fish & Richardson P.C.

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From: David Hecht <dhecht@hechtpartners.com>

Sent: Wednesday, April 09, 2025 2:43 PM

To: Usman Khan <khan@fr.com>; James Zak <jzak@hechtpartners.com>

Cc: Roberto Devoto <devoto@fr.com>; Karl Renner <renner@fr.com>

Subject: Re: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

I take it from the lack of any response that you don't have any questions from us.

Happy to speak 4/10 at 130 EST – but I'm not sure there will be much to say.

If you'd like to reach me day or night, my cell is 646-266-8753.

David L. Hecht

Hecht Partners LLP

125 Park Ave. 25th Floor

New York, NY 10017

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From: David Hecht <dhecht@hechtpartners.com>

Date: Tuesday, April 8, 2025 at 9:23 PM

To: Usman Khan <khan@fr.com>, James Zak <jzak@hechtpartners.com>

Cc: Roberto Devoto <devoto@fr.com>, Karl Renner <renner@fr.com>

Subject: Re: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

Are you available any time tomorrow, or we can just correspond over email. The Board did not instruct us to confer telephonically. What is Microsoft's position? To the extent you have any questions for us, we'd be happy to answer them to the best of our ability -- though there is not much to add.

David L. Hecht

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From: Usman Khan <khan@fr.com>

Sent: Tuesday, April 8, 2025 9:21 PM

To: James Zak <jzak@hechtpartners.com>; David Hecht <dhecht@hechtpartners.com>

Cc: Roberto Devoto <devoto@fr.com>; Karl Renner <renner@fr.com>

Subject: RE: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

Hi James, David:

Per the Board's order, Proxense and Microsoft are to meet and confer by April 11. We are available at the times noted below for the meet and confer. Please let us know if any of these times work for you, and, if not, please propose alternative times. Thanks.

- 4/10 @ 130-2 pm EST
- 4/11 @ 1030 am-12 pm, 230-3 pm EST

Regards,

Usman Khan, Ph.D., J.D.

Principal ■ Fish & Richardson P.C.

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From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, April 08, 2025 11:51 AM

To: James Zak <jzak@hechtpartners.com>; dhecht@hechtpartners.com; Selina Kyle <admin@hechtpartners.com>; Woo, Philip <PWWoo@duanemorris.com>; Usman Khan <khan@fr.com>; Squire, Monté T. <MTSquire@duanemorris.com>; Karl Renner <renner@fr.com>; IPR42342-0136IP1 <IPR42342-0136IP1@fr.com>; Roberto Devoto <devoto@fr.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

[This email originated outside of F&R.]

Counsel,

Patent Owner is authorized under 37 CFR 42.73(b) to request adverse judgment against itself at any time during the proceedings. Thus, Patent Owner may file a request for adverse judgment in each of IPR2024-00232 and IPR2024-00775. Patent Owner and Microsoft are directed to meet and confer by April 11, 2025, after which Microsoft shall indicate by reply to this email whether it intends to oppose a request for adverse judgment in IPR2024-00775 and whether it intends to oppose lifting the stay in ex parte reexamination 90/015,052.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: James Zak <jzak@hechtpartners.com>

Sent: Monday, April 7, 2025 10:02 AM

To: Trials <Trials@USPTO.GOV>

Cc: David Hecht <dhecht@hechtpartners.com>; Selina Kyle <admin@hechtpartners.com>; Woo, Philip <PWWoo@duanemorris.com>; khan@fr.com; Squire, Monté T. <MTSquire@duanemorris.com>; Karl Renner <renner@fr.com>; IPR42342-0136IP1@fr.com; devoto@fr.com

Subject: IPR2024-00232 and IPR2024-00775 - Request for Permission to File Adverse Judgement

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Honorable Board,

Patent Owner Proxense respectfully requests authorization to file Requests for Adverse Judgment under 37 C.F.R. § 42.73 in IPR2024-00232 and IPR2024-00775, and to lift the stay in EPR 90/015,052.

Proxense has met and conferred with Petitioners’ counsel over several days via email and has responded to all questions posed. However, Petitioners Apple and Microsoft have not yet stated their positions regarding the request.

Should the Board believe a conference call would be beneficial, the parties will promptly provide a list of mutually agreeable times.

Respectfully submitted,

James A. Zak, Esq.

Reg. No. 60190

Counsel for Patent Owner

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