UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-00783
U.S. Patent No. 9,679,289
Filing Date: April 12, 2012
Issue Date: February 4, 2014

PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS[1]

[1] Petitioner is filing a substantively identical document in IPR2024-01319.

I. Introduction

Petitioner previously filed a petition ("Original Petition") for *inter partes* review of U.S. Patent No. 9,679,289 ("the '289 patent") in IPR2024-00783, challenging the validity of claims 1-20. Petitioner has now timely filed a petition ("Joinder Petition") with a conditional motion to join Microsoft's instituted proceeding in IPR2024-00407 ("Microsoft IPR"), requesting institution and joinder be held in abeyance until, and only if, the Board declines to institute Petitioner's Original Petition. *See* Mot. for Joinder, IPR2024-01319. Since Petitioner now has two concurrent petitions challenging the validity of the same patent, Petitioner hereby provides: (1) "a ranking of the petitions in the order in which it wishes the Board to consider the merits" and (2) "a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." Consolidated Trial Practice Guide (Nov. 2019) ("CTPG"), 60.

II. Ranking of Petitions

Petitioner believes that both of its Original Petition and Joinder Petition are meritorious and justified, but should the Board decide to institute only a single petition against the '289 patent, Petitioner requests that the Board institute Petitioner's Original Petition (in IPR2024-00783).

III. Background and Related Proceedings

Proxense, LLC (the "Patent Owner") is the owner of the '289 patent. On January 16, 2024, Microsoft filed a petition for review of the '289 patent ("Microsoft Petition") in the Microsoft IPR. Separately, Petitioner filed an Original Petition[2] to challenge the validity of the '289 patent on April 19, 2024. On April 29, 2024, Patent Owner filed its patent owner's preliminary response in the Microsoft IPR. On July 22, 2024, the Board granted institution of the Microsoft IPR.

IV. Material Differences Support Instituting Multiple Petitions

Material differences exist between Petitioner's concurrent Joinder Petition and Original Petition. For example, and as illustrated in the tables below, the two petitions raise different invalidity grounds relying on different prior art combinations, and raise different arguments.

Joinder Petition (materially similar to the Microsoft Petition)			
Ground	**Claim(s) Challenged**	**35 U.S.C. §**	**Reference(s)**
1A	1-20	103	Giobbi-157, Giobbi-139
1B	1-20	103	Giobbi-157, Giobbi-139, and Dua
2A	1-8, 10-11, and 14-19	103	Broadcom[3]
2B	1-20	103	Broadcom, Giobbi-157

[2] Google's Original Petition is not a "follow-on petition" to the Microsoft Petition as that term is used in *General Plastic*. *See* Paper 1, IPR2024-00783, at 82.
[3] Broadcom and Buer are the same EP 1536306 reference.

Original Petition (IPR2024-00783)			
Ground	**Claim(s) Challenged**	**35 U.S.C. §**	**Reference(s)**
1	1-6, 8-11, and 14-19	103	Dua, Giobbi157
2	1-6, 8-11, and 14-19	103	Dua, Giobbi157, Kotola
3	1-7, 10-11, and 14-19	103	Buer[3]
4	4, 8-10, 12, 13, 17, and 20	103	Buer, Giobbi157
5	4	103	Buer, Nishikawa

As shown in the above tables, Petitioner's Original Petition challenges the '289 patent based on significantly different invalidity grounds.

I. The *General Plastic* Factors Favor Institution

The Board has applied the *General Plastic* framework to the joinder petition of a petitioner that previously filed its own petition. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28. 2020) (precedential); *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential).

A. *General Plastic* factors 1-3 weigh against discretionary denial.

General Plastic factors 1-3 weigh against discretionary denial because factor 1 is at worst neutral and there are no concerns under factors 2 and 3. *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, 00862, Paper 18 (PTAB Aug. 23, 2022).

Factor 1 is at worst neutral because the Joinder Petition does not prejudice Patent Owner. It is not uncommon for petitioners to submit more than one petition

against the same patent, and "the Board recognizes that there may be circumstances in which more than one petition may be necessary." CTPG at 59. This is especially true when the parties (Microsoft and Google) independently and separately challenged the '289 patent, using different invalidity grounds, prior art references, and arguments. Any concerns of prejudice are further alleviated by Petitioner's request to hold its Joinder Petition in abeyance until, and only if, the Board declines to institute the Original Petition. Given the timing requirements in IPRs, such a conditional request is reasonable. *Apple Inc. v. Speir Techs. Ltd.*, IPR2023-00305, Paper 9 (PTAB May 15, 2023).

Factor 2 has limited relevance here but is also, at worst, neutral. Petitioner did not "strategically stage prior art and arguments in multiple petitions." Instead, Petitioner diligently pursued its own petition based on different invalidity grounds and arguments. Further, given that the Joinder Petition is based on the same grounds and combinations of prior art in the Microsoft IPR, Petitioner has not gained any unfair advantage over Patent Owner here in filing a Joinder Petition. There is simply no risk of harassment of Patent Owner or any frustration of Congress's intent.

Factor 3 weighs against discretionary denial because there are no "road-mapping" concerns. *Code200*, at 5. The Original Petition was prepared and filed prior to any preliminary response was filed, so Petitioner could not have leveraged any patent owner response or Board decision as a roadmap in preparing its Original

Petition. Nor was the Joinder Petition prepared based on any "lessons learned from later developments," *Code200*, at 5, since that petition is a "copycat" petition that is substantially the same as the instituted Microsoft Petition and does not seek to introduce any new grounds or claims not in the Microsoft IPR.

B. *General Plastic* factors 4-7 favor institution.

Factors 4 and 5 have limited relevance but favor institution. The Original Petition was timely prepared based on different invalidity grounds and arguments. The Joinder Petition was also timely filed within the timeline set by the Board's rules, so any time elapsed between these filings is proper. Factor 7 also has limited relevance because the one-year statutory time period may be adjusted for a joined case. *Code200*, at 6. Lastly, factor 6 favors institution because there is no risk that the two petitions would undermine the Board's ability to complete the proceedings in a timely manner. While the two petitions present different invalidity grounds, they rely on some overlapping references, lowering the burden associated with consideration of the petitions. And any remaining concerns of the Board's resources or of fairness are outweighed by the benefits "of improving patent quality by reviewing the merits of the challenges raised in the petitions." *Code200*, at 6.

Date: August 22, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Supplemental Paper and Notice Ranking Petitions** was served on August 22, 2024, via email directed to counsel of record for the Patent Owner at the following:

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