

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00782 (Patent 8,646,042 B1)
IPR2024-00783 (Patent 9,679,289 B1)
IPR2024-00784 (Patent 10,073,960 B1)¹

Before THU A. DANG, DAVID C. McKONE, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ The combined caption is for administrative convenience only and does not indicate that the above-listed proceedings have been joined. The parties are not authorized to use this caption without express permission from the Board.

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BACKGROUND

Petitioner e-mailed the Board to request authorization to file preliminary replies to the Patent Owner Preliminary Responses in the above-listed proceedings on August 27, 2024. Ex. 3001. Petitioner indicated that Patent Owner opposes Petitioner's request. *Id.* The Board conducted a conference call with counsel for the parties to discuss Petitioner's request and Patent Owner's opposition on August 29, 2024. Petitioner is directed to file the transcript of the call as an exhibit once it is available.

DISCUSSION

Petitioner requests authorization to file preliminary replies to Patent Owner's Preliminary Responses of up to five pages to address what Petitioner characterizes as Patent Owner's "inconsistent and unforeseeable claim construction positions, particularly as they relate to alleged means-plus-function constructions for various terms." Ex. 3001. According to Petitioner, Patent Owner's claim construction positions are inconsistent because Patent Owner "merely speculates whether '35 U.S.C. § 112, paragraph 6, *may* be considered' without affirmatively arguing that the claims are means-plus-function claims." *Id.* Petitioner contends good cause for additional briefing exists because "(1) Patent Owner did not raise these constructions before the district court in the pending litigation (Ex. 1016) and (2) Petitioner's petitions were filed before the Patent Owner Preliminary Responses were filed in instituted IPRs Nos. 2024-00405, 2024-00407, and 2024-00573." *Id.* Petitioner does not oppose allowing Patent Owner to file sur-replies of equal length as Petitioner's preliminary replies. *Id.*

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Patent Owner opposes Petitioner's request "because 'the constructions advanced were previously ordered by the District Court and explained in Court's Memo in Support of Cla[i]m Construction Order issued in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*, No. 6.21-CV-00210 (W.D. Tex. March 5, 2021) (Exhibits 2001 and 2002),' and because "the same constructions were advanced in the Patent Owner Preliminary Responses filed in IPRs Nos. 2024-00405, 2024-00407, and 2024-00573, which asserted substantially the same art.'" Ex. 3001.

After considering the parties' arguments during the conference call and reviewing the district court documents submitted in these proceedings, we find persuasive Petitioner's argument that it could not fairly anticipate Patent Owner's claim construction positions in the Preliminary Responses. We determine Petitioner's requested briefing will assist us in deciding whether to grant institution in this proceeding. Accordingly, Petitioner's request for additional briefing is *granted*.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner may file, within five (5) business days, five (5)-page preliminary replies to the Patent Owner Preliminary Responses in each of the above-listed proceedings to address Patent Owner's claim construction positions as outlined in Petitioner's e-mail request (Ex. 3001);

FURTHER ORDERED that Patent Owner may file, within five (5) business days of Petitioner's preliminary replies, five (5)-page preliminary sur-replies in response to Petitioner's preliminary replies in each of the above-listed proceedings.

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