

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2025-00075
Patent 9,679,289 B1

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

DANG, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

On November 4, 2024, Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review of claims 1–20 of U.S. Patent No. 9,679,289 B1 (Ex. 1001, “the ’289 patent”) and a Motion for Joinder (Paper 2, “Motion” or “Mot.”) with *Google LLC v. Proxense, LLC*, IPR2024-00783 (“the Google IPR”). Proxense, LLC (“Patent Owner”) did not file an opposition to Petitioner’s Motion and has informed the Board “Patent Owner does not oppose Petitioner’s Motion for Joinder. Accordingly, should the Board grant Petitioner’s Motion, Patent Owner does not believe filing a Patent Owner Preliminary Response would benefit the Board.” *See* 37 C.F.R. § 42.25(a)(1); Ex. 3001 (“Patent Owner’s December 31, 2024 email from James A. Zak, Esq.”). Petitioner states that Petitioner understands Google LLC, the petitioner in the Google IPR, does not oppose the Motion. Mot. 1.

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314; *see* 37 C.F.R. § 42.4. Upon consideration of the Petition and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least 1 claim of the ’289 patent. Accordingly, we institute *inter partes* review of claims 1–20 of the ’289 patent. We also *grant* Petitioner’s Motion for Joinder.

A. Real Parties-in-Interest

Petitioner identifies Apple Inc. as the real party-in-interest. Pet. 84. Patent Owner has not submitted mandatory notices.

B. Related Proceedings

As required by 37 C.F.R. § 42.8(b)(2), Petitioner identifies various related matters, including the Google IPR. Pet. 85–86.

C. The '289 Patent

The '289 patent, titled “Hybrid Device Having a Personal Digital Key and Receiver-Decoder Circuit and Methods of Use,” issued on June 13, 2017, from Application No. 14/961,645, with a filing date of December 7, 2015. Ex. 1001, codes (54), (45), (21), (22). The '289 patent provides a hybrid device including a personal digital key (PDK) and a receiver-decoder circuit (RDC) that are coupled for communication with each other. *Id.* at code (57).

An illustration of the embodiment of the '289 patent's hybrid device being a part of a cell phone is depicted in Figure 12, reproduced below:

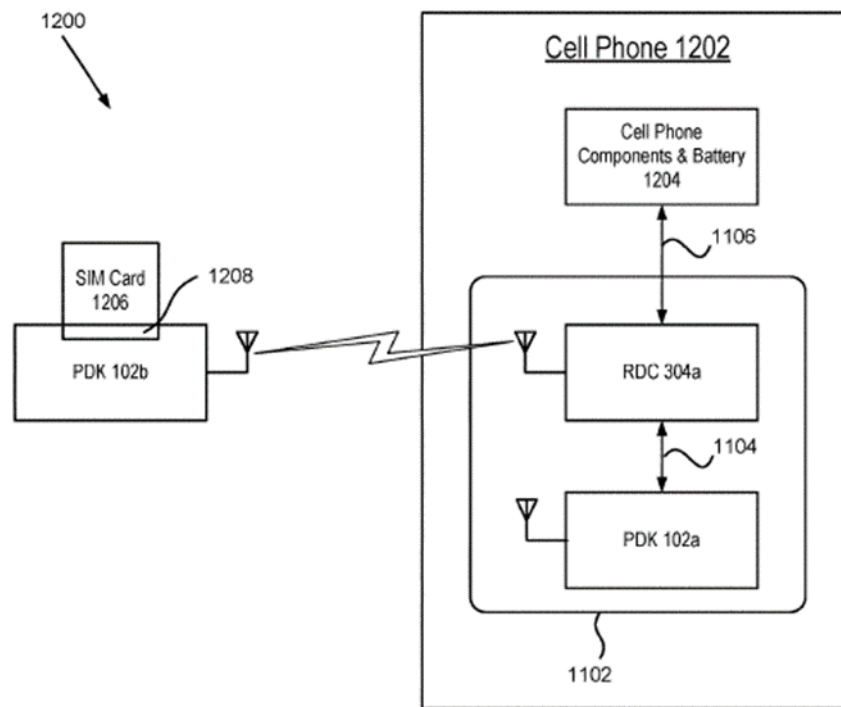


FIG. 12

Figure 12 shows system 1200 comprising PDK 102b and cell phone 1202. *Id.* at 14:47–48. As shown in Figure 12, cell phone 1202 further comprises cell phone components and battery 1204, and hybrid device 1102, wherein hybrid device 1102 includes PDK 102a and RDC 304a coupled for communication with each other via signal line 1104. *Id.* at 14:48–53. Cell phone components and battery 1204 are coupled to RDC 304a by signal line 1106, allowing RDC 304a to use the communication capabilities of cell phone 1202 to communicate with other networks and devices. *Id.* at 14:53–59.

In one embodiment, cell phone 1202 including hybrid device 1102 collectively forms a secure cell phone or generic access point. *Id.* at 14:65–67. The conventional SIM card is replaced with hybrid device 1102, which provides authorization control as well as a storage area for storing

information specific to the user. *Id.* at 15:6–11. Thus, SIM content (cell phone account, contact information, and credit card) that is normally stored in cell phone 1202 is instead stored in PDK 102b in its local memory carried by the user. *Id.* at 15:11–15.

D. Illustrative Claim

Of the challenged claims, claims 1 and 14 are independent. Independent claim 1 is illustrative of the challenged claims, and is reproduced below:

1. A hybrid device comprising:
 - an integrated, secure memory storing local, secured information; and
 - an integrated reader-decoder circuit (RDC) for communicating wirelessly with at least one external device within a proximity zone, the integrated RDC communicatively coupled to the integrated, secure memory for communication with the integrated, secure memory,
- wherein one or more of (a) the integrated RDC communicating wirelessly with the at least one external device within the proximity zone and (b) the local, secured information stored by the integrated, secure memory enables one or more of an application, a function, and a service.

Ex. 1001, 22:36–49.

E. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–20 of the '289 patent on the following grounds (Pet. 1):

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–6, 8–11, 14–19	103	Dua ² , Giobbi '157 ³
1–6, 8–11, 14–19	103	Dua, Giobbi '157, Kotola ⁴
1–7, 10, 11, 14–19	103	Buer ⁵
4, 8–10, 12, 13, 17, 20	103	Buer, Giobbi '157
4	103	Buer, Nishikawa ⁶

Petitioner relies on the Declaration of Andrew Wolfe, Ph.D.
(Ex. 1003) in support of its unpatentability contentions.

II. ANALYSIS

A. *Institution of Inter Partes Review*

We instituted an *inter parties* review in the Google IPR on all challenged claims and all asserted grounds of unpatentability. Google IPR, Paper 12. Petitioner here challenges the same claims and asserts the same

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102, 103, effective March 16, 2013. Because the application from which the '289 patent issued was a continuation of applications filed before this date, the pre-AIA versions of §§ 102, 103 apply.

² U.S. Patent Publication No. 2006/0258289 A1, published November 16, 2006, filed May 12, 2005 (Ex. 1004, “Dua”).

³ U.S. Patent Publication No. 2007/0245157 A1, published October 18, 2007, filed May 5, 2007 (Ex. 1006, “Giobbi '157”).

⁴ U.S. Patent Publication No. 2004/0176032 A1, published September 9, 2004, filed March 19, 2004 (Ex. 1017, “Kotola”).

⁵ European Patent Application No. EP 1,536,306 A1, published June 1, 2005, filed September 30, 2004 (Ex. 1005, “Buer”).

⁶ European Patent Application No. EP 1,600,885 A1, published November 30, 2005, filed February 25, 2004 (Ex. 1014, “Nishikawa”).

grounds of unpatentability as those on which we instituted the Google IPR. *See* Pet. 82 (“this Petition is substantively identical to the Google IPR Petition”); Mot. 1 (“[t]he 0075 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Google IPR”); Mot. 2 (this Petition “is substantively identical to the Google IPR”); Mot. 2–3 (“the 0075 Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Google IPR Petition”). Petitioner represents that the only differences in Petitioner’s Petition from the instituted Google IPR are “minor differences related to only other issues associated with a different party filing the petition.” Mot. 3.

Petitioner also relies on the same declarant and identical declaration as did the petitioner in the Google IPR. Mot. 3 (“the 0075 Petition . . . relies on the same expert declaration”); Mot. 4–5 (“the 0075 Petition relies on the same expert and an identical declaration”); *see also* Ex. 1003. Petitioner additionally contends *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential), is inapplicable. Mot. 7–10.

Because the issues in the instant Petition are identical to those in the Google IPR, and for the same reasons stated in our Decision on Institution in the Google IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition. *See* Google IPR, Paper 12.

B. Motion for Joinder

Joinder in an *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address how briefing and/or discovery may be simplified to minimize schedule impact. *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We determine that Petitioner has met its burden of showing that joinder is appropriate because, as set forth above, the Petition is substantively identical to the petition in the Google IPR, contains the same grounds based on the same evidence, and relies on the same declaration of Dr. Andrew Wolfe. Mot., *passim*; Ex. 1003.

Petitioner represents joinder will not unduly burden or negatively impact the Google IPR trial schedule because “Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Google IPR Petition.” Mot. 4.

Petitioner also represents that “[b]y Petitioner accepting an ‘understudy’ role, Patent Owner and Petitioner can comply with any forthcoming trial schedule and avoid any duplicative efforts by the Board or the Patent Owner.” Mot. 6; *see also* Mot. 5–6 (describing understudy role).

“Also, because the 0075 Petition relies on the same expert and an identical declaration, only a single deposition is needed for the proposed joined proceeding.” Mot. 4–5.

We determined above that the Petition warrants the institution of an *inter partes* review. Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in the Google IPR. We limit Petitioner’s participation in the Google IPR, as follows: (1) Google alone is responsible for all petitioner filings in the Google IPR until such time that it is no longer an entity in the Google IPR, and (2) Petitioner is bound by all filings by Google in the Google IPR, except for (a) filings regarding termination or settlement, and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or take any action on its own in the Google IPR, so long as Google remains as a non-terminated petitioner in the Google IPR. This arrangement promotes the just and efficient administration of the ongoing trial in the Google IPR, and protects the interests of Google as original petitioner in IPR2024-00783, and of Patent Owner.

III. CONCLUSION

For the foregoing reasons, we institute *inter partes* review of claims 1–20 of the ’289 patent based on the grounds of unpatentability set forth in the Petition. We also *grant* Petitioner’s Motion for Joinder and join Petitioner to the Google IPR (i.e., IPR2024-00783), with the limitations set forth herein.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–20 of the '289 patent with respect to all grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner's Motion for Joinder (Paper 2) is *granted*, and Petitioner is joined as a petitioner in IPR2024-00783;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2024-00783 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00783, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that all further filings in the joined proceeding are to be made only in IPR2024-00783;

FURTHER ORDERED that Petitioner's participation in IPR2024-00783 shall be limited as stated above in § II.B unless and until Google LLC is terminated from that proceeding;

FURTHER ORDERED that the case caption in IPR2024-00783 for all further submissions shall be modified to add Apple Inc. as named petitioner, and to indicate by footnote the joinder of Apple Inc. to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2024-00783.

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Sample Case Caption

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¹ Apple Inc., which filed a petition in IPR2025-00075, has been joined as a petitioner in this proceeding.