

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,

Petitioner,

v.

PROXENSE, LLC

Patent Owner

U.S. Patent No. 8,886,954

IPR2024-00846

**PATENT OWNER PROXENSE, LLC'S
UPDATED MANDATORY NOTICES**

Pursuant to 37 C.F.R. § 42.8(a)(2), Proxense, LLC (“Proxense”) submits the following updated Mandatory Notices.

I. 37 C.F.R. §42.8(b)(1): Real Party-In-Interest

In accordance with 37 C.F.R. § 42.8(b)(1), the real party-in-interest in the above IPR proceedings is Proxense, LLC, with a principal place of business at 689 NW Stonepine Drive, Bend, Oregon 97703.

II. 37 C.F.R. §42.8(b)(2): Related Matters

In accordance with 37 C.F.R. § 42.8(b)(2), Proxense identifies the following related matters:

The patent at issue is currently being asserted against Petitioner in *Proxense, LLC v. Microsoft Corp.*, No. 6.23-CV-00319 (W.D. Tex. May 2, 2023).

The patent at issue is currently being asserted in the following additional district court action:

Proxense, LLC v. Apple Inc. Case No. 6: 24-cv-00143-ADA, (W.D. Tex. Mar 18, 2024).

The patent at issue was the subject of the following instituted *inter partes* reviews:

Apple Inc. v. Proxense LLC, IPR2024-00233 (P.T.A.B. Jan. 17, 2024), in which a Final Written Decision was issued on June 17, 2025, and Request for Director Review was filed on July 2, 2025.

Family members of the Patent at issue are currently the subject of the following *ex parte* reexaminations.

1. Control No. 90/015,052, relating to U.S. Patent No. 8,352,730. Within this Re-Examination:

- A Non-Final Office Action was mailed on May 20, 2025:
 - Withdrawing the previous Final Rejection over Ludtke (U.S. Patent No. 7,188,110).
 - Asserting new grounds of rejection over Burger (U.S. Publication No. 2005/0050367) – the primary reference at issue in these proceedings – with rationale mirroring two grounds of invalidity asserted in the Petition (Paper 2) of these proceedings.
 - Finding that “In IPR2024-00775, the Board issued a final written decision on April 28, 2025, holding that original issued claims 1-17 were finally unpatentable over Burger.”
- A Non-Final Office Action was mailed on July 29, 2025:
 - Issuing an obviousness type double patenting rejection over U.S. Patent No. 8,886,954 (the patent at issue in these proceedings).

- Adopting the rationale for granting institution stated in the Institution Decision (Paper 8) of these proceedings.
- Asserting rejections over Burger on rationales different from the grounds of invalidity asserted in the Petition (Paper 2) of these proceedings.
- Abandoning the previous rationales mirroring two grounds of invalidity asserted in the Petition (Paper 2) of these proceedings.
- Reasserting the rejection based on Ludtke previously withdrawn.

2. Control No. 90/015,053, relating to U.S. Patent No. 9,298,905, in which a reexamination certificate indicating all claims are cancelled has issued.

3. Control No. 90/015,054, relating to U.S. Patent No. 10,698,989, in which a reexamination certificate indicating all claims are cancelled has issued.

III. 37 C.F.R. §42.8(b)(3) and (4): Lead and Back-Up Counsel

Lead Counsel:

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IV. 37 C.F.R. §42.8(b)(1): Service Information

Please address all correspondence to the lead and back-up counsel at the address shown above. In accordance with 37 C.F.R. § 42.8(b)(4), Proxense consents to electronic service and provides the following email address for future services:

proxense@hechtpartners.com

Proxense also identifies the following postal mailing address for service:

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Dated: August 1, 2025

Respectfully submitted, By:

/David L. Hecht/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that Patent Owner Proxense, LLC's Updated Mandatory Notices was served on August 1, 2025, by e-mailing copies to the e-mail addresses provided in Petitioner's Petition.

Dated: August 1, 2025

Respectfully submitted, By:

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