UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01319
U.S. Patent No. 9,679,289
Filing Date: December 7, 2015
Issue Date: June 13, 2017

MOTION FOR JOINDER TO *INTER PARTES* REVIEW (35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b))

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Google LLC ("Petitioner") moves for joinder with the *Inter Partes* Review of U.S. Patent No. 9,679,289 ("the '289 patent"), *Microsoft Corporation v. Proxense, LLC*, IPR2024-00407 ("the Microsoft IPR"), which has been instituted on July 22, 2024. IPR2024-00407, Paper 8.

Petitioner requests that action on this motion be held in abeyance until, and only if, Petitioner's earlier petition is denied. This motion is timely because it is filed "no later than one month after the institution date" of the Microsoft IPR. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity*, LP, IPR2019-01609, Paper 11 at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is "[t]he only timing requirement for a motion for joinder"). Petitioner understands that the petitioner in the Microsoft IPR ("Microsoft") does not oppose Petitioner's request for joinder.

Petitioner requests institution of its Petition for *Inter Partes* Review. Petitioner submits that the request for joinder is consistent with the policy objectives surrounding inter partes reviews, as it is the most expedient way "to secure the just, speedy, and inexpensive resolution of every proceeding." *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 5-6 (June 1, 2017). The present Petition and the Microsoft IPR Petition

are substantively identical with respect to the asserted grounds and supporting evidence.

Further, if joined to the Microsoft IPR, Petitioner agrees to act as an "understudy" and will not assume a lead role unless Microsoft is no longer a party to the proceeding or, otherwise, does not advance arguments for one or more claims or grounds. Accordingly, the proposed joinder will not unduly complicate the Microsoft IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the patentability of the '289 patent without prejudice to Patent Owner. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Microsoft IPR.

II. BACKGROUND AND RELATED PROCEEDINGS

Proxense, LLC (the "Patent Owner") is the owner of the '289 patent. Proxense has asserted the '289 patent against Google in *Proxense, LLC v. Google LLC*, 6:23-cv-00320 (W.D. Tex.). On January 16, 2024, Microsoft filed its IPR petition, IPR2024-00407, against the '289 patent. On July 22, 2024, the Board granted institution on the Microsoft IPR. Petitioner timely moves for joinder with the Microsoft IPR.

Separately, Petitioner filed a IPR petition, IPR2024-00783, against the '289 patent on April 19, 2024. Petitioner has concurrently filed a paper ranking the petitions in the order in which it wishes the Board to consider the merits.

III. REASONS FOR REQUESTED RELIEF

A. Legal Standard

The Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. 35 U.S.C. § 315(c); *see also Sony Mobile Comms. AB v. Ancora Technologies, Inc.*, IPR2021-00663, Paper 17 at 29-33 (P.T.A.B. June 10, 2021) ("Sony"). A petitioner may request joinder up to one month after the institution date of the proceeding to which joinder is requested, without prior authorization. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *Central Security Group – Nationwide, Inc. d/b/a Alert360 v. Ubiquitous Connectivity, LP*, IPR2019-01610, Paper 12 at 6.

B. Petitioner's Motion for Joinder is Timely

Joinder may be requested "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b).

The Microsoft IPR was instituted on July 22, 2024. Petitioner's motion for joinder is timely because it is being filed within one month after the institution date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Petitioner's Motion for Joinder. The Petition here is substantively identical to the petition in the Microsoft IPR. It presents no new grounds of unpatentability, and it relies on the same prior art. Joinder will have no impact on the schedule of the Microsoft IPR. Moreover, briefing and discovery in the Microsoft IPR will be simplified by resolving all issues in a single proceeding.

1. Joinder Will Promote an Efficient Determination of the Validity of the '289 Patent Without Prejudice to Any Party

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (P.T.A.B. Aug. 24, 2016) (internal quotations and citations omitted); *see Sony*, Paper 17 at 31. Here, joinder with the Microsoft IPR is appropriate because Petitioner asserts the same unpatentability arguments and the same grounds in its Petition as those raised in the Microsoft IPR. Both petitions contain identical grounds based on the same prior art combinations against the same claims. Petitioner also relies on substantially the same supporting evidence in its Petition as is relied on in the Microsoft IPR. Thus, the Petition and the Microsoft IPR involve identical

grounds and substantially the same arguments and evidence. Accordingly, if joinder is granted, the validity of the grounds raised in the Microsoft IPR and the Petition here can be determined in a single proceeding. Because these proceedings introduce substantially identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of the Petition and the Microsoft IPR.

2. Joinder Will Not Add Any New Grounds of Unpatentability

The Petition is based on the same grounds and combinations of prior art that the Board considered in deciding to institute the Microsoft IPR. Petitioner's supporting materials are substantially identical to those presented in the Microsoft IPR. As a condition of joinder, Petitioner agrees to proceed based on Microsoft's expert declaration and petition. Petitioner does not seek to introduce grounds or claims not in the Microsoft IPR and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond that which it may need in the Microsoft IPR, nor should the Board permit any. The Petition introduces no new substantive issues relative to the Microsoft IPR and does not seek to broaden the scope of the Microsoft IPR. *See Sony Corp. v. Memory Integrity*, LLC, IPR2015-01353, Paper 11 at 5-6 (P.T.A.B. Oct. 5, 2015) ("*Memory*") (granting motion for

joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration").

3. Joinder Will Not Affect the Schedule in the Microsoft IPR

Joinder will not impact the Microsoft IPR trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See Memory*, IPR2015-01353, Paper 11 at 6 (instituting IPR and granting motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Further, Petitioner consents to any trial schedule adopted in the Microsoft IPR. There are no new issues for the Board to address and Patent Owner will not be required to present any additional evidence or argument. The Patent Owner's Response, if any, will also not be negatively impacted because the substantive issues presented in the Petition are identical to the issues presented in the Microsoft IPR. Patent Owner will not be required to provide any additional analysis or argument beyond what it will already provide in the Microsoft IPR. Accordingly, joinder with the Microsoft IPR should not unduly burden or negatively impact any trial schedule.

4. Joinder Will Simplify Briefing Because Petitioner Agrees to Consolidated Filings and to Participate in an Understudy Role if Microsoft Remains

Petitioner agrees to take an "understudy" role in a joined proceeding, which will simplify briefing and discovery. For efficiency's sake, Petitioner will:

1. Adhere to all applicable deadlines in the Microsoft IPR;
2. Submit "consolidated" filings with the Microsoft, as set forth above in the statement of precise relief requested;
3. Refrain from requesting or reserving any additional depositions or deposition time;
4. Refrain from requesting or reserving additional oral hearing time; and
5. Assume a second-chair role as long as Microsoft remains in the proceeding.[1]

See, e.g., *HTC Corp. v. Uniloc 2017 LLC*, IPR2018-01631, Paper 9 at 7 (P.T.A.B. Jan. 25, 2019) (agreeing to "second-chair" role and other procedural concessions, such as "consolidated" responses); *Enzymotech Ltd. v. Neptune Techs.*, IPR2014-00556, Paper 19 (P.T.A.B. July 9, 2014) (agreeing to similar procedural concessions); *Gillette Co. v. Zond*, IPR2014-01016, Paper 13 (P.T.A.B. Nov. 10, 2014) (same). By Petitioner accepting an "understudy" role, the parties can comply with the trial schedule assigned to the Microsoft IPR without any duplicative efforts by the Board or Patent Owner. These steps minimize the possibility of any

[1] For clarity, should Microsoft's participation in the Microsoft IPR terminate, Petitioner would take over primary responsibility for subsequent filings and discovery.

complication or delay from joinder. *See Memory*, IPR2015-01353, Paper 11 at 6-7. Joinder will further simplify briefing because Patent Owner will no longer be burdened with preparing this response.

5. Joinder Will Not Prejudice Patent Owner

As noted above, Petitioner's joinder in the Microsoft IPR proceeding will not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced; no issues are being added; and no additional discovery, briefing, or oral argument should be necessary because of Petitioner's joinder. Rather than prejudice Patent Owner, joinder would beneficially allow Patent Owner to litigate the same patentability issues with both Microsoft and Petitioner efficiently and in a coordinated manner. Thus, joinder is in the interest of not only the Board and Petitioner, but also Patent Owner.

IV. CONCLUSION

Petitioner's requested joinder will not affect the substance, procedure, or scheduling of the Microsoft IPR. Petitioner files this motion under the statutory joinder provisions as contemplated by the AIA. Joinder will simplify the issues and promote efficiency, justice, and speed. Petitioner thus respectfully requests *inter partes* review of the '289 patent and joinder with the Microsoft IPR.

Dated: August 22, 2024

Respectfully submitted,

/Erika H. Arner/

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Lead Counsel
Reg. No. 57,540

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PETITIONER'S MOTION FOR JOINDER** was served on August 22, 2024, via FedEx Priority Overnight on the correspondence address of record indicated in the Patent Office's Patent Center system for U.S. Patent No. 9,679,289.

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A courtesy copy is also being sent via email to Patent Owner's counsel in *Proxense, LLC v. Google LLC*, No. 6:23-cv-00320 (W.D. Tex.), where Patent Owner has asserted the subject patent:

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