UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

Case IPR2024-01327
Patent 8,886,954

PETITIONER'S CONDITIONAL MOTION FOR JOINDER

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Microsoft Corporation. ("Microsoft" or "Petitioner") **conditionally moves** for joinder with the *inter partes* review instituted against U.S. Patent No. 8,886,954 ("the '954 Patent") in *Google, LLC, v. Proxense, LLC*, IPR2024-00233 ("the 233 Proceeding"). This motion is timely filed within one month of the Board's July 24, 2024 institution decision in the 233 Proceeding.

More specifically, Microsoft respectfully requests that the Board institute review of IPR2024-01327 based on the concurrently-filed petition and that it grant this motion **if, and only if**, the Board has previously denied institution of *Microsoft Corporation, v. Proxense, LLC*, IPR2024-00846 ("the 846 Proceeding"). In making this request, Microsoft seeks to ensure that, for the patent of this request that Proxense presently asserts against Microsoft and Google[1], i) the merits of Microsoft's grounds advanced in the 846 Proceeding are reviewed by the Board and ii) Microsoft is party to one (and only one) instituted *inter partes* review proceeding, preferably the proceeding inspired by Microsoft's initial filing (i.e., the

[1] Proxense has additionally asserted patents US 8,646,042 (IPR2024-00573), US 8,352,730 (IPR2024-00775), US 9,298,905 (IPR2024-00776), US 9,679,289 (IPR2024-00407), and US 10,073,960 (IPR2024-00405) against Microsoft.

846 Proceeding) but otherwise the proceeding inspired by Google's first filing (i.e., joinder to the 233 Proceeding).

Notably, by reviewing Microsoft's grounds in the 846 Proceeding, the Board will have a more holistic view of the patent in question as a result of the 846 Proceeding advancing mappings to prior art (different than Google's prior art) that address claim construction issues raised by the Patent Owner. For example, the term "third-party trusted authority" has been the subject of much dispute in Google's 233 Proceeding, and Microsoft believes that institution of Microsoft's 846 Proceeding will address many of Patent Owner's concerns raised in the 233 Proceeding. IPR2024-00233, Papers 6, 7, and 9. Although Patent Owner has not yet filed a Patent Owner Preliminary Response in the 846 Proceeding, Microsoft's grounds will likely elicit from Patent Owner additional clarity as to their claim construction position, which will facilitate the Board's understanding in both proceedings.

In sum, should the Board agree that Microsoft's petition in the 846 Proceeding provides a fair, fulsome, and alternative analysis of the '954 patent, prior art, and claim scope—institution of the 846 Proceeding would enable the Board to arrive at a more informed decision in both proceedings. However, should the Board feel that Microsoft's petition is in some way deficient and, therefore, that

only the Google proceeding is sufficient, **then and only then**, does Microsoft request this joinder.

In this way, consistent with the goals expressed in each of the Board's *NHK*, *Fintiv*, *Snap*, *Sotera*, *General Plastic*, and *Uniloc* decisions, Microsoft seeks to promote a maximally-efficient resolution to the dispute between the parties. *See*, *e.g.*, *General Plastic Indus. Co. v. Cannon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential) ("In exercising discretion…we are mindful of the goals of the AIA–namely, to improve patent quality and make the patent system more efficient by the use of post-grant review procedures"); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) ("the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review").

If Microsoft's 846 Proceeding is instituted, Microsoft's and Google's printed publication invalidity grounds would likely be addressed by a single forum—the PTAB. This is the maximally efficient outcome, and the outcome that Microsoft seeks to promote via this conditional motion for joinder. *Cf. Snap, Inc. v. SRK Technology LLC*, IPR2020-00820 Paper 15 at 9, 19 (PTAB Oct. 21, 2020) (precedential); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019 Paper 12 at 19-21 (PTAB Dec. 1, 2020) (precedential).

However, if the Board were to decline to institute Microsoft's 846 Proceeding challenging the '954 Patent, the next-most efficient course of action would be for the Board to institute review of IPR2024-01327 and grant this motion for joinder with Google's already-instituted 233 Proceeding.

Thus, while institution of Microsoft's 846 Proceeding would maximize the likelihood of the parties avoiding the unnecessary costs of duplicative litigation in different forums on the subject of validity over the same prior art grounds, and decrease the likelihood of potentially inconsistent decisions from different forums addressing those grounds, the grant of this conditional motion for joinder also would increase the likelihood (albeit to a lesser extent) of achieving similar goals.

On the other hand, if the Board were to deny both of Microsoft's petitions against the '954 Patent (IPR2024-00846 and IPR2024-01327), Microsoft would have no choice but to pursue its printed publication invalidity defenses in district court, separate and apart from the already-instituted 233 Proceeding.

Against that outcome, institution of one petition or the other **in the alternative** would very likely confine adjudication of invalidity grounds based on printed publication prior art to the PTAB. The present circumstances therefore offer a prime opportunity for IPR to serve its intended role as a true alternative to district court litigation. *See Snap* at 9, 19; *Sotera* at 19-21.

Even beyond that point, the circumstances of the instant petition and conditional motion for joinder are materially distinct from those addressed by the Board's *Uniloc* decision. In that decision, the petitioner was said to have "failed in its first attempt to challenge the [subject] patent," and the subsequent attempt was an "end run around [a] failed petition." *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854 Paper 9 at 6-7 (PTAB Oct. 28. 2020) (precedential). Unlike *Uniloc*, the Board has yet to issue an institution decision with respect to Microsoft's 846 Proceeding, and thus, Microsoft has not had any opportunity to take advantage of such a decision as a means to correct any perceived shortcomings in its first attempt. Additionally, to the extent Proxense would argue that Apple exceeding the §315(b) bar in *Uniloc* is dispositive on its own, §315(b) explicitly allows for joinder under §315(c) over a year after a civil action has been filed.

Moreover, and as explained in more detail below, joinder as sought in the specific circumstances on which this conditional motion is premised would help to efficiently resolve the disputes among the parties, without unduly prejudicing any party. Accordingly, if the Board were to deny institution of Microsoft's 846 Proceeding challenging the '954 Patent, Microsoft respectfully submits that it should be allowed to join Google's 233 Proceeding in an "understudy" role. *See Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 4-6 (PTAB Jul. 29 2013).

II. BACKGROUND AND RELATED PROCEEDINGS

Proxense, LLC. is the purported owner of the ’954 Patent. Proxense asserted the ’954 Patent (and related patents US 8,352,730 and US 9,298,905) against each of Microsoft and Google in two separate actions: Civil Action No. 6:23-cv-00319 (WDTX) and Civil Action No. 6-23-cv-00320 (WDTX).

Microsoft is filing the instant petition addressing the ’954 patent (“Petition”) concurrently with two additional petitions (and similar conditional motions for joinder) corresponding to each of the two other patents that Proxense presently asserts against Microsoft and Google (IPR2024-01326 and IPR2024-01328).

The table below summarizes the pre-existing inter partes review proceedings.

Patent	IPR Proceeding
US 8,352,730	Microsoft: IPR2024-00775 (institution decision due Nov. 21, 2024)
	Google: IPR2024-00232 (instituted Jul. 24, 2024)
US 9,298,905	Microsoft: IPR2024-00776 (institution decision due Nov. 21, 2024)
	Google: IPR2024-00234 (instituted Jul. 23, 2024)
US 8,886,954	Microsoft: IPR2024-00846 (institution decision due Nov. 21, 2024)
	Google: IPR2024-00233 (instituted Jul. 24, 2024)

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 4-6 (PTAB Jul. 29 2013); *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at 3-4 (PTAB Sep. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-4 (PTAB Feb. 25, 2013). "The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell* at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

> [A] set forth the reasons why joinder is appropriate; [B] identify any new grounds of unpatentability asserted in the petition; [C] explain what impact (if any) joinder would have on the trial schedule for the existing review; and [D] address specifically how briefing and discovery may be simplified.

Dell at 4.

A. Joinder with the 233 Proceeding Would be Appropriate

If the Board were to deny institution of Microsoft's 846 Proceeding challenging the '954 Patent, Microsoft respectfully requests institution of the

petition for inter partes review filed concurrently herewith ("Petition"), and respectfully submits that joinder with the 233 Proceeding would be appropriate. The Petition is materially the same as the petition filed in the 233 Proceeding. The Petition and the petition in the 233 Proceeding challenge the same claims, on the same grounds and rely on the same prior art and evidence, including an identical declaration from the same expert.

Further, Microsoft agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the 233 Proceeding as instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. §315(c) permits Microsoft's joinder to the *inter partes* review instituted in the 233 Proceeding.

Further, upon joining the 233 Proceeding, Microsoft will act as an "understudy" and will not assume an active role unless the current petitioner (Google) ceases to participate in the 233 Proceeding. The current petitioner will maintain the lead role in the proceeding so long as the current petitioner remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Microsoft also will not seek additional depositions or deposition time. Microsoft further agrees to the foregoing conditions even in the event that other third-party petitioners are joined with the 233 Proceeding. Accordingly, the proposed joinder will neither unduly complicate the 233 Proceeding nor delay its schedule.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the 233 Proceeding for all interested parties. Further, joinder will narrow the issues in the co-pending district court actions because Petitioner and the current petitioner in the 233 Proceeding have each, contingent upon institution, stipulated to forego raising the grounds of unpatentability in the 233 Proceeding at the district court. Finally, joinder would not complicate or delay the 233 Proceeding, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums.

Further, joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder **would** prejudice Microsoft. Microsoft's interests may not be adequately protected in the 233 Proceeding, particularly if the current petitioner (Google) settles with the Patent Owner.

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 No. 12 at 9 (Aug. 24, 2016) (emphasis added) (internal quotations and citations omitted). Here, joinder with the 233 Proceeding is appropriate because the Petition

introduces **identical** unpatentability arguments and the **same** grounds raised in the petition of the 233 Proceeding, without any change to the facts, citations, evidence, or arguments used in demonstrating satisfaction of the implicated claims by the applied prior art. Because these proceedings introduce 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 this proceeding and the 233 Proceeding.

B. Joinder Would Not Add Any New Grounds of Unpatentability

The Petition is based on the same grounds and combinations of prior art in the 233 Proceeding. For simplicity and efficiency, Petitioner has copied the substance of the petition in the 233 Proceeding and its accompanying expert declaration. Petitioner does not seek to introduce grounds or claims not currently in the 233 Proceeding and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond that which it may need in the 233 Proceeding—nor should the Board permit any. The present Petition introduces no new substantive issues relative to the 233 Proceeding and does not seek to broaden the scope of the 233 Proceeding.

C. Joinder Would Not Impact the 233 Proceeding's Trial Schedule

Joinder will not impact the 233 Proceeding trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See Sony Corp., et*

al. v. Memory Integrity, LLC, IPR2015-01353, Paper No. 11 at 6 (granting IPR and 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 explicitly consents to the trial schedule as adopted in the 233 proceeding. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner's Response will also not be negatively impacted because the substantive issues presented in the present Petition are identical to the issues presented in the 233 Proceeding. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the petition in the 233 Proceeding. Also, because the present Petition relies on the same expert declaration, only a single deposition is needed for the proposed joined proceeding. Accordingly, joinder with the 233 Proceeding does not unduly burden or negatively impact the trial schedule.

D. Procedures to Simplify Briefing and Discovery

Microsoft explicitly agrees to take an "understudy" role, which will simplify briefing and discovery. Specifically, Microsoft explicitly agrees, upon joining the 233 Proceeding, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as the current petitioner remains an active party:

a) all filings by Petitioner in the 233 Proceeding shall be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving Petitioner;

b) Petitioner shall not be permitted to raise any new grounds not instituted by the Board in the 233 Proceeding, or introduce any argument or discovery not introduced by the current petitioner;

c) Petitioner shall be bound by any agreement between Patent Owner and the current Petitioner concerning discovery and/or depositions; and

d) Petitioner at deposition shall not receive any direct, cross examination or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the current petitioner.

See Noven Pharmaceuticals, Inc. v. Novartis AG, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015). Unless and until the current petitioner ceases to participate, Microsoft will not assume an active role in the 233 Proceeding.

Thus, by Microsoft accepting an "understudy" role, the parties can comply with the trial schedule assigned to the 233 Proceeding without needing any duplicative efforts by the Board or the Patent Owner. These steps minimize the possibility of any complication or delay from joinder. *See Sony*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would

reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an "understudy" role). Microsoft is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

For the foregoing reasons, Microsoft respectfully requests that if, and only if, the Board has previously denied institution of the 846 Proceeding, the Board institute review of IPR2024-01327 and grant this motion for joinder with IPR2024-00233.

Respectfully submitted,

Dated: 8-20-24

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on August 20, 2024, a complete and entire copy of this Petitioner's Conditional Motion for Joinder was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows::

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