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Paper 9
Entered: October 3, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00405 (Patent 10,073,960 B1)
IPR2024-00407 (Patent 9,679,289 B1)
IPR2024-00573 (Patent 8,646,042 B1)
IPR2024-01326 (Patent 8,352,730 B2)
IPR2024-01327 (Patent 8,886,954 B1)
IPR2024-01328 (Patent 9,298,905 B1)[1]

Before THU A. DANG, KEVIN F. TURNER, DAVID C. MCKONE, and NORMAN H. BEAMER, *Administrative Patent Judges*.[2]

MCKONE, *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.
[2] The four listed judges represent overlapping panels on several proceedings. This is not an expanded panel.

BACKGROUND

Apple Inc. ("Apple") e-mailed the Board to request a conference call to discuss its motions for joinder filed in IPR2024-01398 and IPR2024-01399. Apple seeks to join IPR2024-00573 and IPR2024-00782, respectively. On October 1, 2024, the Board conducted a conference call with counsel for Apple, Google LLC ("Google"), Microsoft Corporation ("Microsoft"), and Proxense, LLC ("Proxense" or "Patent Owner") to discuss how to timely manage the proceedings. A court reporter was not present on the call. This Order serves as the official record of the teleconference.

DISCUSSION

In IPR2024-01398 and IPR2024-01399, Apple seeks to join IPR2024-00573 and IPR2024-00782. However, there are several pending motions for joinder filed in the above-listed proceedings. We raised the additional cases beyond IPR2024-01398 and IPR2024-01399 in order to manage these cases efficiently and because counsel for all four parties attended the teleconference.[3] A table summarizing the motions for joinder is below.

Petitioner	Proceeding	Proceeding to join	Challenged Patent
Google	IPR2024-01318	IPR2024-00573	8,646,042 B1
Google	IPR2024-01319	IPR2024-00407	9,679,289 B1
Google	IPR2024-01320	IPR2024-00405	10,073,960 B1

[3] We reminded counsel for Patent Owner to make formal appearances in, and submit mandatory notices in, IPR2024-01318, IPR2024-01319, IPR2024-01320, IPR2024-01398, and IPR2024-01399. *See* 37 C.F.R. §§ 42.8, 42.10(a)–(b).

IPR2024-00405 (Pat. 10,073,960 B1); IPR2024-00407 (Pat. 9,679,289 B1); IPR2024-00573 (Pat. 8,646,042 B1); IPR2024-01326 (Pat. 8,352,730 B2); IPR2024-01327 (Pat. 8,886,954 B1); IPR2024-01328 (Pat. 9,298,905 B1)

Petitioner	Proceeding	Proceeding to join	Challenged Patent
Microsoft	IPR2024-01326	IPR2024-00232	8,352,730 B2
Microsoft	IPR2024-01327	IPR2024-00233	8,886,954 B1
Microsoft	IPR2024-01328	IPR2024-00234	9,298,905 B1
Apple	IPR2024-01333	IPR2024-00232	8,352,730 B2
Apple	IPR2024-01334	IPR2024-00233	8,886,954 B1
Apple	IPR2024-01335	IPR2024-00234	9,298,905 B1
Apple	IPR2024-01398	IPR2024-00573	8,646,042 B1
Apple	IPR2024-01399	IPR2024-00782	8,646,042 B1

During the conference call, counsel for Apple, Google, Microsoft, and Patent Owner discussed the pending motions for joinder.

Apple explained that it was sued by Patent Owner more than ten months after Google and Microsoft and could have filed its own independent petitions for *inter partes* review. However, Apple represents that it decided to file joinder petitions seeking *inter partes* review with accompanying motions for joinder in order to save the parties' and the Board's resources. Consistent with its Motions for Joinder, Apple reiterated that it intends to take an understudy role in the proceedings it seeks to join unless the other petitioner(s) are dismissed from the proceedings. Apple also represented that it included stipulations under *Sand Revolution* in each of its joinder petitions to indicate that will not pursue the grounds raised in its petition in the parallel district court litigation with respect to the claims for which trial is instituted if the proceeding is instituted and joinder is granted. *See Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019- 01393, Paper 24 at 7 (PTAB Jun. 16, 2020).

Apple filed a document ranking its joinder petitions and motions for joinder in IPR2024-01398 and IPR2024-01399. Apple indicated that its

joinder petition and motion for joinder in IPR2024-01399 takes precedence over its joinder petition and motion for joinder in IPR2024-01398 if the Board determines that it will only institute one of the joinder petitions in IPR2024-01398 and IPR2024-01399.

Google stated that it filed its joinder petitions and motions for joinder conditionally and with rankings. Google requests that its motions for joinder be held in abeyance until, and only if, its earlier-filed petitions are denied. Google also indicated that its earlier-filed petitions take precedence over its joinder petitions. *See, e.g.*, IPR2024-01318, Paper 4 (Petitioner's Supplemental Paper and Notice Ranking Petitions), 1.[4]

Microsoft explained that it filed its joinder petitions and motions for joinder conditionally. Microsoft requests that the Board grant its motions for joinder if, and only if, the Board denies institution of its earlier-filed petitions. *See, e.g.*, IPR2024-01326, Paper 2 (Petitioner's Conditional Motion for Joinder), 1.[5]

Patent Owner stated that it does not oppose joinder in the Apple joinder proceedings[6] and agreed that we should proceed to grant those motions. We infer from this that Patent Owner will not file preliminary responses in the Apple joinder proceedings.

Patent Owner has concerns with Google's motions for joinder because the parties have exchanged expert reports in the parallel district court

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[4] Google filed similar statements in IPR2024-01319 and IPR2024-01320.
[5] Microsoft filed similar statements in IPR2024-01327 and IPR2024-01328.
[6] We do not yet address Apple's Joinder Motion in IPR2024-01399, as we have not determined yet whether to institute a trial in the proceeding Apple seeks to join, IPR2024-00782.

litigation and a trial is scheduled to occur in February 2025. Patent Owner stated that a trial is scheduled for May 2025 in the parallel district court litigation involving Microsoft. Patent Owner and Google agreed to meet and confer to discuss whether they can resolve any opposition Patent Owner might have to Google's motions for joinder.

Microsoft and Patent Owner also agreed to meet and confer to discuss whether they can resolve any opposition Patent Owner might have to Microsoft's motions for joinder.

Patent Owner represented that it intends to file requests for adverse judgment in the proceedings challenging U.S. Patent No. 9,298,905 B1. We informed the parties that we will address any such requests once Patent Owner files them. We requested that the parties provide us a with a status update on each of the above-listed proceedings and meet and confer to attempt to resolve any disputes.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties provide the Board with a status update summary of each of the above-listed proceedings via email to Trials@uspto.gov no later than October 8, 2024.

IPR2024-00405 (Pat. 10,073,960 B1); IPR2024-00407 (Pat. 9,679,289 B1); IPR2024-00573 (Pat. 8,646,042 B1); IPR2024-01326 (Pat. 8,352,730 B2); IPR2024-01327 (Pat. 8,886,954 B1); IPR2024-01328 (Pat. 9,298,905 B1)

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