UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01399

U.S. Patent No. 8,646,042

MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00782

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple Inc. ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,646,042 ("'042 Patent") (IPR2024-01399 "the 1399 Petition") filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Google LLC. v. Proxense, LLC*, IPR2024-00782 ("the Google IPR"). The 1399 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Google IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Google does not oppose Petitioner's request for joinder.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Google IPR while efficiently resolving the question of the '042 Patent's validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On April 19, 2024, Google LLC filed a petition for *inter partes* review (IPR2024-00782) requesting cancellation of claims 1-6, 8-15, and 17-20 of the '042 Patent.

2. On August 20, 2024, Patent Owner filed its preliminary response, setting a deadline for the Board to issue an institution decision of November 20, 2024. 35 U.S.C.§ 315(b); IPR2024-00782, Paper 5.

3. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1-6, 8-15, and 17-20 of the '042 Patent, which is substantively identical to the Google IPR.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted inter partes review proceeding. See 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corporation v. Softview LLC,* IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed before any institution decision has been made in the Google IPR. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the 1399 Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Google IPR Petition. Further, joinder will have minimal, if any, impact on any forthcoming trial schedule, as all issues are substantively identical and Petitioner will accept an "understudy" role. *See Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 6; (granting IPR where petitioners requested an "understudy" role); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder is Appropriate

Joinder with the Google IPR is appropriate because the 1399 Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Google IPR Petition. *Id.* The 1399 Petition is substantively identical to the Google IPR Petition, containing only minor differences related to only other issues associated with a different party filing a petition. The 1399 Petition presents no changes to the facts, citations, evidence, or arguments related to patentability presented in the Google IPR Petition. Because these proceedings are substantively

identical, good cause exists for joining this proceeding with the Google IPR so that the Board can efficiently resolve all grounds in both the 1399 Petition and Google IPR Petition in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The 1399 Petition presents the same grounds of unpatentability as the Google IPR Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact Any Forthcoming Google IPR Trial Schedule

Because the 1399 Petition is substantively identical to the Google IPR Petition, with the same grounds challenging the same claims as instituted by the Board, there are no new substantive issues for Patent Owner to address. Due to the same issues being presented in the 1399 Petition and the Google IPR Petition, Patent Owner will not be required to present any additional responses or arguments. *See* IPR2015-01353, Decision Instituting IPR, Motion for Joinder, Paper 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]."); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Google IPR Petition are identical to the issues presented in the 1399 Petition. 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. Also, because the 1399 Petition relies on the same expert and an identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Google IPR does not unduly burden or negatively impact any forthcoming trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule was necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present 1399 Petition with the Google IPR.

4. Procedures to Simplify Briefing and Discovery

The Google IPR Petition and 1399 Petition present substantively identical grounds of unpatentability, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an "understudy" role, as described by the Board:

> "(a) ***all*** filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Google IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Google IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Google] IPR, or introduce any argument or discovery not already introduced by [the petitioner in the Google IPR]; (c) [Petitioner] shall be bound by any agreement

> between [Patent Owner] and [the petitioner in the Google IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Google IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Google IPR]."

Noven Pharmaceuticals, Inc. et al. v. Novartis AG et al., IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015) (emphasis in original). Petitioner will assume the primary role only if Google ceases to participate in the Google IPR.

By 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. These steps will minimize any potential complications or delay that potentially may result by joinder. *See* IPR2015-01353, Decision Instituting IPR, Paper 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.); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 6-7.

Accordingly, joinder should be permitted. *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 5-6 (granting institution of IPR and 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."); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 4-5.

IV. *GENERAL PLASTIC* IS INAPPLICABLE

In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board "recognize[d] the potential for abuse of the review process by repeated attacks on patents." IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential). In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. Petitioner respectfully submits that application of the *General Plastic* analysis is inapplicable here. In the current motion, Petitioner merely seeks to join Google's petition and does not present any new grounds. As such, Petitioner respectfully submits that *General Plastic* does not apply in this circumstance because Petitioner would be taking an understudy role and the Board's finite resources would not be impacted. Moreover, a joinder petition in these circumstances is not the type of serial petition to which *General Plastic* applies, especially as Petitioner has not previously filed an IPR against the '042 Patent. The PTAB has previously stated that a joinder petition "effectively neutralizes" a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-

instituted IPR, stating joinder petitioner's joinder motion agreeing to a passive understudy role "effectively neutraliz[es] the *General Plastic* factors"); *see also Celltrion, Inc. v. Genentech, Inc.,* IPR2018-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditure of resources"). Furthermore, Patent Owner did not argue, that the *General Plastic* factors warranted exercising the Board's discretion to deny the challenges from the Google IPR that Petitioner now seeks to join. IPR2024-00782, Paper 5.

In the event the Board does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present IPR. *General Plastic* at 16.

Regarding the first factor, Petitioner has not previously filed a petition against the '042 Patent. This factor weighs in favor of institution.

The second factor is whether at the time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second petition. This factor is neutral, if not inapplicable, in the *General Plastic* analysis. Here, Google's petition and 1399 Petition share the same prior art because the 1399 Petition is a "copycat" of Google's petition. Because Petitioner is merely seeking to join in an understudy role, the factor is neutral, at best, in determining whether to institute.

The third factor is whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition. Because this is a Motion for Joinder requesting an understudy role, Petitioner is submitting a substantively identical petition and has not added to, or changed, any of the substantive arguments from the Google petition. Moreover, because the present Petition is submitted as a joinder and Petitioner will serve an understudy role, the Petition is not an attempt to harass the Patent Owner or otherwise engage in serial, tactical filings. Thus, this factor weighs against denial of joinder/institution.

The fourth factor is the length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and filing of the second petition, and the fifth factor is whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent. In the context of a joinder motion where Petitioner will be taking an understudy role, these factors are inapplicable.

The sixth factor is the finite resources of the Board. Allowing Petitioner's joinder motion where it will serve in an understudy role will not impact the Board's resources beyond those resources the Board dedicates to the instant joinder motion.

The seventh factor is the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review. As noted above, joining Petitioner should not impact any forthcoming schedule. Accordingly, this factor weighs in favor of institution.

An eighth factor identified by the Board in *Shenzhen* is the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent. *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.,* IPR2018-00898, Paper 9 at 7, 13-14 (PTAB Oct. 1, 2018) (noting "the purpose of proposed Factor 8 is to discourage tactical filing of petitions over time by parties that faced the same threat at the same time" such that earlier petitions are filed as "test case(s)" to gain "tactical advantage"). Petitioner is not similarly situated as the petitioner for the Google IPR. The petitioner for the Google IPR was sued on the '042 Patent in a case filed on May 2, 2023. The Petitioner here was sued on the '042 Patent over ten months later, in a case filed on March 18, 2024. Furthermore, because the 1399 Petition does not introduce any new grounds of unpatentability and will effectively merge into a single proceeding with Google's IPR, no tactical advantage is gained here.

Thus, none of the *General Plastic* factors weighs against institution and joinder in this situation.

V. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the 1399 Petition for *Inter Partes* Review of U.S. Patent No. 8,646,042 and then grant joinder with the Google IPR2024-00782 proceeding.

Date: September 12, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Motion for Joinder has been served via Federal Express, postage prepaid, to Patent Owner, by serving the correspondence address of record for the ’042 Patent:

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