

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

**PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING
PETITIONS¹**

¹ Petitioner is filing a substantively identical document in IPR2024-01398.

I. Introduction

Petitioner is concurrently filing petitions for *inter partes* review of U.S. Patent No. 8,646,042 (“the ’042 patent”) in IPR2024-01398 (“the 1398 IPR”) and IPR2024-01399 (“the 1399 IPR”). In the 1398 IPR, Petitioner seeks to join *Microsoft Corp. v. Proxense, LLC*, IPR2024-00573 (“the Microsoft IPR”). In the 1399 IPR, Petitioner seeks to join *Google LLC v. Proxense, LLC*, IPR2024-00782 (“the Google IPR”).

Since Petitioner has two concurrent petitions challenging the validity of the same patent, Petitioner hereby provides: (1) “a ranking of the petitions in the order in which it wishes the Board to consider the merits” and (2) “a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.” Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), 60.

II. Ranking of Petitions

Petitioner believes that the petitions submitted in both the 1398 IPR and the 1399 IPR are meritorious and justified. Should the Board decide to institute only a single petition and grant only a single motion for joinder against the ’042 patent, Petitioner requests that the Board institute Petitioner’s petition in the 1399 IPR and grant its Motion for Joinder of the Google IPR if the Board institutes that proceeding; otherwise, Petitioner requests that the Board institute Petitioner’s petition in the 1398 IPR.

III. Background and Related Proceedings

On February 15, 2024, Microsoft filed a petition for review of the '042 patent (“the Microsoft Petition”) in the Microsoft IPR. On June 10, 2024, Proxense, LLC (the “Patent Owner”) filed its patent owner’s preliminary response in the Microsoft IPR. On August 13, 2024, the Board granted institution of the Microsoft IPR.

Separately, on April 19, 2024, Google filed a petition (“the Google Petition”) to challenge the validity of the '042 patent in the Google IPR. The Patent Owner filed its preliminary response in the Google IPR on August 20, 2024, setting a deadline for the Board to issue an institution decision of November 20, 2024. 35 U.S.C. § 315(b).

IV. Material Differences Support Instituting Multiple Petitions

Material differences exist between the Microsoft Petition and the Google Petition. As such, Petitioner’s petitions in the 1398 IPR and the 1399 IPR are likewise materially different. For example, and as illustrated in the tables below, the two petitions raise different invalidity grounds relying on different prior art combinations, and raise different arguments.

IPR2024-01398 Petition (substantively identical to the Microsoft Petition)			
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	1, 5, 6, 8–11, 13, 14	103	Giobbi '157, Giobbi '139
2	1, 5, 6, 8–11, 13, 14	103	Giobbi '157, Giobbi '139, Dua

3	10, 11, 13, 14	103	Broadcom ²
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IPR2024-01399 Petition (substantively identical to the Google Petition)			
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	10	103	Dua
2	10	103	Dua, Kotola
3	1, 3-6, 8-15, and 17	103	Buer ²
4	2	103	Buer, Lee
5	12	103	Buer, Nishikawa
6	3 and 18-20	103	Buer, Hoffmann

As shown in the above tables, Petitioner’s petition in the 1398 IPR challenges different claims of the ’042 patent based on significantly different invalidity grounds than its petition in the 1399 IPR.

V. *General Plastics* Is Not Applicable

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. The Board has applied the *General Plastic* framework to the joinder petition of a petitioner that previously filed its own petition. *Apple Inc. v. Uniloc 2017 LLC*,

² Buer and Broadcom are the same EP 1536306 reference.

IPR2020-00854, Paper 9 (PTAB Oct. 28. 2020) (precedential); *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential).

Petitioner respectfully submits that application of the *General Plastic* analysis is inapplicable here. Petitioner has not previously filed its own petition. Instead, Petitioner merely seeks to join an IPR—the Google IPR if the Board institutes, or otherwise the Microsoft IPR—that is already pending, 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.

VI. Conclusion

Should the Board decide to institute only a single petition and grant only a single motion for joinder against the ’042 patent, Petitioner requests that the Board institute Petitioner’s petition in the 1399 IPR and grant its motion to join the Google IPR if the Board institutes that proceeding; otherwise, the Petitioner requests that the Board institute Petitioner’s petition in the 1398 IPR.

Date: September 12, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS 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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and, by email, upon counsel of record for the Patent Owner in the litigation before the United States District Court for the Western District of Texas:

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