

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 REQUESTING ACCEPTANCE OF SUBMISSION

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I. INTRODUCTION

Apple Inc. (“Petitioner”) respectfully submits this Motion Requesting Acceptance of Submission following its service of its Petition for *Inter Partes* Review of U.S. Patent No. 8,646,042 (“’042 Patent”) (IPR2024-01399 “the 1399 Petition”), related papers, and exhibits (“Documents”) on counsel for Patent Owner on September 12, 2024. Petitioner was unable to submit these documents via P-TACTs on September 12, 2024 and thus served these documents on Patent Owner in accordance with the Patent Office’s guidance for alternative filings.¹ Petitioner requests acceptance of these Documents and accordance of a September 12, 2024 filing date for the same.

II. STATEMENT OF MATERIAL FACTS

1. On September 12, 2024, Petitioner attempted to file a Petition and supporting exhibits, Motion for Joinder, Power of Attorney, and a Supplemental Paper and Notice of Ranking Petitions through P-TACTS for IPR2024-01399.

2. When attempting to file, P-TACTS did not provide any of Petitioner’s counsel with the option to pay via the deposit account of Petitioner’s counsel. Petitioner counsel’s had verified before, and confirmed after, that sufficient funds exist in Deposit Account Number 04-1679 to cover the cost of this filing.

¹ See <https://www.uspto.gov/patents/apply/filing-online/filing-documents-during-outage>.

3. Because Petitioner could not file via P-TACTS, Petitioner effected the alternative filing method as directed by Patent Office guidance and notified the Patent Office that it had done the same. *See* Attachment A; <https://www.uspto.gov/patents/apply/filing-online/filing-documents-during-outage>. Included in this notification to the Patent Office, Petitioner authorized the Patent Office to charge Deposit Account Number 04-1679.

4. On September 13, 2024, Petitioner successfully uploaded to P-TACTS all documents served on Patent Owner on September 12, 2024. Petitioner also verified the required fees for this proceeding were paid.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority to “determine a proper course of conduct in a proceeding for any situation not specifically covered by [regulation].” 37 C.F.R. § 42.5(b). It further has the authority, if Petitioner’s actions are deemed to be “late,” to “excuse[] [an action] on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3).

B. The Board Should Accept Petitioner’s Submission

The Board should accept Petitioner’s submission of the Documents as filed on September 12, 2024. In accordance with Patent Office guidance for alternative

filings,² Petitioner served the Documents counsel for Patent Owner on September 12, 2024, including both in litigation and in other proceedings challenging the '042 Patent. *See* Attachment A; IPR2024-00573; IPR2024-00782. Further, Petitioner's notification to the Patent Office provided the information required for an alternative filing, including the authorization to charge the deposit account of Petitioner's counsel. *See* Attachment A. Thus, Petitioner met all requirements for being afforded a filing date of September 12, 2024 for IPR2024-01399.

Further, Patent Owner is not prejudiced by affording a filing date of September 12, 2024 to Petitioner's submission. First, Petitioner's Petition is a "copycat" of IPR2024-00782. Thus, Patent Owner has already seen and responded to the substantive arguments contained therein. Second, Patent Owner's counsel of record in both the related litigation and in pending IPRs challenging the '042 Patent were served these Documents on September 12, 2024. Finally, the Board has previously authorized the acceptance of Patent Owner's filings in another pending IPRs challenging the '042 Patent that were not timely filed. *See* IPR2024-00573, Paper 9. Patent Owner is not prejudice by affording Petitioner's Documents a filing date of September 12, 2024.

² <https://www.uspto.gov/patents/apply/filing-online/filing-documents-during-outage>.

The Board should accept Petitioner's request that its submission of its Documents be afforded a filing date of September 12, 2024 as Petitioner's submission meets all alternative filing requirements to be afforded this filing date and Patent Owner is not prejudiced by affording these Documents a filing date of September 12, 2024.

IV. CONCLUSION

Petitioner respectfully requests that the Board afford a filing date of September 12, 2024 for IPR2024-001399.

Date: September 13, 2024

Respectfully submitted,

DUANE MORRIS LLP

BY: /Philip W. Woo/
Philip W. Woo
USPTO Reg. No. 39,880
Duane Morris LLP
260 Homer Avenue #202
Palo Alto, CA 94301

ATTORNEY FOR PETITIONER

ATTACHMENT A

From: Belnap, Paul H.
Sent: Thursday, September 12, 2024 11:40 PM
To: Trials@uspto.gov; dhecht@hechtpartners.com; jzak@hechtpartners.com; proxense@hechtpartners.com; bmelton@susmangodfrey.com
Cc: Woo, Philip; Squire, Monté T.; Bartow, D. Stuart; Belnap, Paul H.; Veliz, Jareth
Subject: Notification of Alternative Filing for IPR2024-01399
Attachments: _042 Pat IPR POA [executed].PDF

To the Honorable Members of the Board,

Petitioner writes to provide notification of the alternative filing of the above referenced proceeding due to the inability to file the Petition, Motion for Joinder, Petitioner's Supplemental Paper and Notice of Ranking Petitions, POA, and supporting exhibits in the above referenced proceeding.

These documents have been served by email on Patent Owner's counsel of record in the related litigation and from earlier filed, but still pending, IPRs involving the same patent challenged by the above referenced petitions, specifically:

David L Hecht (dhecht@hechtpartners.com)
James Zak (jjak@hechtpartners.com)
proxense@hechtpartners.com
Brian D. Melton (bmelton@susmangodfrey.com)

Additionally, Petitioner provides the following information to the Board:

POC: Paul H. Belnap, Reg. No. 73,106
Email: phbelnap@duanemorris.com
Phone: 202-776-7879
Patent Challenged: 8,646,042
Application No. of Patent Challenged: 13/445,825
Number of claims challenged: 18 Claims
Type of trial proceeding: IPR
Power of attorney has been signed by Petitioner (please see attached)
Deposit account authorization: The USPTO is authorized to charge Deposit Account Number 04-1679 in association with the above referenced proceeding.

Respectfully,



Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the MOTION REQUESTING ACCEPTANCE OF SUBMISSION has been served via Federal Express, postage prepaid, to Patent Owner, by serving the correspondence address of record for the '042 Patent:

89194 - Patent Law Works/Proxense
Greg Sueoka
4516 South 700 East, Suite 290
Salt Lake City, UT
UNITED STATES

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:

Brian D. Melton
Susman Godfrey, LLP
1000 Louisiana St.
Suite 5100
Houston, TX 77002
Email: bmelton@susmangodfrey.com

Date: September 13, 2024

BY: /Philip W. Woo/
Philip W. Woo, Reg. No. 39,880
Duane Morris LLP
260 Homer Avenue #202
Palo Alto, CA 94301
P: (650) 847 4145
F: (650) 644 0150
pwwoo@duanemorris.com

ATTORNEY FOR PETITIONER