UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01485

U.S. Patent No. 8,886,954

PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS[1]

[1] Petitioner is filing a substantively identical document in IPR2024-01334.

I. Introduction

Petitioner is filing a petition for *inter partes* review of U.S. Patent No. 8,886,954 ("the '954 patent") in IPR2024-01485 ("the 1485 IPR") and has already filed a petition for *inter partes* review of the '954 patent in IPR2024-01334 ("the 1334 IPR"). In the 1485 IPR, Petitioner seeks to join *Microsoft Corp. v. Proxense, LLC*, IPR2024-00846 ("the Microsoft IPR"). In the 1334 IPR, Petitioner seeks to join *Google LLC v. Proxense, LLC*, IPR2024-00233 ("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 1334 IPR and the 1485 IPR are meritorious and justified. The Board has granted Petitioner's Motion for Joinder of the Google IPR and instituted Petitioner's petition in the 1334 IPR. IPR2024-01334, Paper 8. Petitioner requests that the Board institute Petitioner's petition in the 1485 IPR. Petitioner ranks the 1334 IPR first, and the 1485 IPR second.

III. Background and Related Proceedings

On January 17, 2024, Google filed a petition for review of the ’954 patent (“the Google Petition”) in the Google IPR. On April 29, 2024, Proxense, LLC (the “Patent Owner”) filed its patent owner’s preliminary response in the Google IPR. On July 24, 2024, the Board granted institution of the Google IPR.

Separately, on April 26, 2024, Microsoft filed a petition (“the Microsoft Petition”) to challenge the validity of the ’954 patent in the Microsoft IPR. The Patent Owner filed its preliminary response in the Microsoft IPR on August 21, 2024, setting a deadline for the Board to issue an institution decision of November 21, 2024. 35 U.S.C. § 315(b).

IV. Material Differences Support Instituting Multiple Petitions

Material differences exist between the Google Petition and the Microsoft Petition. As such, Petitioner’s petitions in the 1334 IPR and the 1485 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.

IPR2024-01334 Petition (substantively identical to the Google Petition)			
Ground	**Claim(s) Challenged**	**35 U.S.C. §**	**Reference(s)**
1	1, 2, 4-7, 10, 12, 13, 15, 16, 18, 19, 22-27	103	Ludtke
2	3, 14, 17	103	Ludtke and Kon

IPR2024-01485 Petition (substantively identical to the Microsoft Petition)			
Ground	**Claim(s) Challenged**	**35 U.S.C. §**	**Reference(s)**
1	1, 2, 4, 5, 7-13, 15, 16, 18-24, 26-29	103	Burger
2	3, 14, 17	103	Burger and Robinson
3	6, 25		Burger and Orsini

As shown in the above tables, Petitioner's petition in the 1334 IPR challenges different claims of the '954 patent based on significantly different invalidity grounds than its petition in the 1485 IPR. Furthermore, the 1485 IPR challenges additional claims not challenged in the 1334 IPR—i.e., claims 8, 9, 11, 20, 21, 28, and 29 of the '954 patent.

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.

Petitioner respectfully submits that application of the *General Plastic* analysis is inapplicable here. Petitioner merely seeks to join the Google IPR and the Microsoft IPR, both of which are already pending. As such, Petitioner respectfully submits that *General Plastic* does not apply in this circumstance because Petitioner

would be taking an understudy role in both the Microsoft IPR and the Google IPR, 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. 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 petition previously filed a non-instituted IPR, stating the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditure of resources").

VI. Conclusion

Should the Board decide to institute only a single petition and grant only a single motion for joinder against the '954 patent, Petitioner requests that the Board institute Petitioner's petition in the 1334 IPR and grant its motion to join the Google IPR; otherwise, the Petitioner requests that the Board institute Petitioner's petition in the 1485 IPR.

Date: October 16, 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 '954 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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