

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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APPLE INC,

Petitioner,

v.

PROXENSE, LLC

Patent Owner

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

IPR Case No. 2024-01485

**PATENT OWNER PRELIMINARY RESPONSE**

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## **I. INTRODUCTION**

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107, Patent Owner Proxense, LLC (“Patent Owner” or “Proxense”) submits the following Preliminary Response to the Petition for *Inter Partes* Review of claims 1-29 of U.S. Patent No. 8,886,954 B2 (“the 954 Patent”) filed by Apple Inc. (“Petitioner” or “Apple”).

## **II. DISCRETIONARY DENIAL IS WARRANTED UNDER 35 U.S.C. § 314(a)**

Apple filed a Petition for *inter partes* review of claims 1-29 of the 954 Patent (Paper 1) and a Motion for Joinder (“Motion”) (Paper 3) to join Microsoft’s instituted proceeding in IPR2024-00846 (“Microsoft IPR”) and a Notice Ranking Petitions (“Notice”) (Paper 4). Apple acknowledges that it previously filed a petition, which was granted, for *inter partes* review of claims 1-7, 10, 12-19, and 22-27 of the 954 Patent in IPR2024-01334 (“1334 IPR”), which was granted and joined with IPR2024-00233 (“233 IPR”). Furthermore, “Petitioner ranks the 1334 IPR first.” Paper 4, at 1. Per its ranking, Petitioner states that “[s]hould the Board decide to institute only a single petition and grant only a single motion for joinder against the ’730 patent, Petitioner requests that the Board institute Petitioner’s petition in the 1333 IPR and grant its motion to join the Google IPR.” *Id.*, at 4. The Board should exercise its discretion under 35 U.S.C. § 314(a) to deny Petitioner’s request for institution with respect to Apple’s second petition.

“[O]ne petition should be sufficient to challenge the claims of a patent in most situations.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019, at 59. While Apple’s previous petition in the 1334 IPR relied on different prior art combinations, Apple has not made any showing that the prior art combinations could not have been presented in a single Petition. Furthermore, Apple has not claimed it was unaware of the different prior art combinations at the time of the filing of the 1334 IPR. Nor could Apple make such a showing as IPR2024-00846 to which apple attempts to joined was filed four months prior to 1334 IPR.

Furthermore, though this Petition challenges dependent claims 8, 9, 11, 20, 21, 28 and 29 of the 954 Patent, which were not challenged in the 1334 IPR, Patent Owner has not asserted those claims against Apple in the current co-pending litigation. *See* Apple Exhibit 1032, at 43. Thus, the only difference between the petitions is a challenge to dependent claims not at issue.

Additionally, there is no dispute about the priority date regarding either combination of references. Patent Owner has not denied that either combination of references constitutes prior art.

Finally, Patent Owner notes that Microsoft's petition and accompanying motion to join the 1334 IPR in IPR2024-01327 were denied. *See Microsoft Corp. v. Proxense LLC*, IPR2024-01327, Paper 10. Apple has presented no reason why it should receive different treatment than Microsoft. While Apple may have initially been an "understudy" in the 1334 IPR, Apple is now the sole Petitioner in the proceeding.

Apple ranked the 1334 IPR first, which was instituted, and offers no credible reasons why multiple proceedings are necessary. Accordingly, the Board should exercise its discretion under 35 U.S.C. § 314(a) and deny Apple's second petition.

### **III. CONCLUSION**

In view of the foregoing, Apple's second petition for *inter partes* review of the 954 Patent should be denied.

Dated: January 27, 2025

Respectfully submitted by,

/s/ David L. Hecht

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**CERTIFICATION UNDER 37 C.F.R. § 42.24**

Under the provisions of 37 C.F.R. § 42.24, the undersigned hereby certifies that the word count for the forgoing Patent Owner Response (excluding the table of contents, table of authorities, certificate of service, certificate of word count, or listing of exhibits) total 547 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: January 27, 2025

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**CERTIFICATION OF SERVICE UNDER 37 C.F.R. § 42.6(e)**

The undersigned certifies service pursuant to 37 C.F.R. § 42.6(e) on the petitioner by emailing a copy of this Patent Owner Preliminary Response and supporting materials at the correspondence address of record for the Petitioner listed below:

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