

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 REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF AUTHORITIES

Federal Cases

<i>Facebook, Inc. v. Windy City Innovations, LLC</i> , 973 F.3d 1321 (Fed. Cir. 2020)	1-3
<i>Uniloc 2017 LLC v. Facebook Inc.</i> , 989 F.3d 1018 (Fed. Cir. 2012).....	3

Other Authorities

Consolidated Trial Practice Guide “CTPG,” 59	1
<i>Microsoft Corp. v. Proxense, LLC</i> , IPR2024-1327, Paper 10 (P.T.A.B. Nov. 20, 2024)	3
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PETITIONER’S UPDATED LIST OF EXHIBITS

MSC-1001	U.S. Patent No. 8,886,954 to John J. Giobbi (“the ‘954 Patent”)
MSC-1002	Excerpts from the Prosecution History of the ‘954 Patent (“the ‘954 Prosecution History”)
MSC-1003	Declaration and Curriculum Vitae of Dr. Patrick Traynor
MSC-1004	Complaint, <i>Proxense, LLC v Microsoft Corporation</i> , 6:23-cv-00319, W.D. Tex., filed April 28, 2023
MSC-1005	US Patent Application Publication No. 2005/0050367 (“Burger”)
MSC-1006	US Patent Application Publication No. 2003/0177102 (“Robinson”)
MSC-1007	Institution Decision, <i>Samsung Electronics America, Inc. v. Proxense, LLC</i> , IPR2021-01444, Paper 11 (PTAB Feb. 28, 2022)
MSC-1008	Definition of “transaction,” Merriam-Websters Collegiate Dictionary, 10 th Ed., 1999
MSC-1009	Google Pixel Serial Number Guide, HomeServe webpage, https://www.homeserve.com/en-us/customers/find-serial-number-device-type/google/
MSC-1010	US Patent No. 8,977,860 (“Barrus”)
MSC-1011	US Patent No. 7,681,050 (“Blom”)
MSC-1012	US Patent No. 10,755,300 (“Goodhart”)
MSC-1013	US Patent Application Publication No. 2009/0070219 (“D’Angelo”)
MSC-1014	US Patent No. 10,929,869 (“Rosenberg”)
MSC-1015	RESERVED
MSC-1016	Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)

MSC-1017	Microsoft’s Opening Brief in support of its Motion to Dismiss for Failure to State a Claim, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., filed July 10, 2023
MSC-1018	Microsoft’s Reply in support of its Motion to Dismiss for Failure to State a Claim, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., filed August 10, 2023
MSC-1019	Order Canceling Markman Hearing, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., Jan. 9, 2024
MSC-1020	RESERVED
MSC-1021	US Patent Application Publication No. 2004/0049687 (“Orsini”)
MSC-1022	Ex-Parte Re-examination Request of ‘905 patent; Re-examination application number 90/015,053
MSC-1023	Motion to Transfer, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., Aug. 21, 2023
MSC-1024	Motion to Stay pending resolution of the Motion to Transfer, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., Mar. 8, 2024
MSC-1025	Order Granting Motion to Stay pending resolution of the Motion to Transfer, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., Mar. 26, 2024
MSC-1026	“How to find the serial number on TP-Link devices,” https://www.tp-link.com/us/support/faq/503/ (last visited April 15, 2024)
MSC-1027	Order Denying Motion to Transfer, Proxense, LLC v Microsoft Corporation, 6:23-cv-00319, W.D. Tex., April 18, 2024
MSC-1028	US Patent Application Publication No. 2002/0147658 (“Kwan”)
MSC-1029	US Patent Application Publication No. 2002/0143634 (“Kumar”)
EX-1030-1031	RESERVED

EX-1032	Complaint, <i>Proxense, LLC v Apple Inc.</i> , 6:24-cv-00143, W.D. Tex., filed March 18, 2024
EX-1033	<i>Proxense, LLC v. Microsoft Corp.</i> , Case No. 6:23-cv-00319, Dkt. No. 66, Claim Construction Order (W.D. Tex. May 24, 2024)
EX-1034	<i>Proxense, LLC v. Google LLC</i> , Case No. 6:23-cv-00320, Dkt. No. 59, Claim Construction Order (W.D. Tex. Jan. 13, 2024)
EX-1035	Docket Sheet for <i>Proxense, LLC v. Apple Inc.</i> , Case No. 6-24-cv-00143 (W.D. Tex) (pulled October 14, 2024)
EX-1036	Scheduling Order in <i>Proxense, LLC v. Apple Inc.</i> , Case No. 6-24-cv-00143 (W.D. Tex)
EX-1037	Applications Related to the 954 Patent
EX-1038	Email from Proxense Counsel dated October 22, 2024

Institution¹ is warranted here because the 1485 Petition (“this Petition”) presents the same grounds for unpatentability instituted in IPR2024-846 (“Microsoft IPR”) and will assure the most timely, cost-effective, and efficient resolution of the ’954 Patent’s patentability without burdening or prejudicing Proxense, allaying any concerns of filing multiple petitions (Consolidated Trial Practice Guide “CTPG,” 59). Proxense does not dispute these points. Proxense’s arguments that the Board should exercise its discretion and deny “Apple’s” second petition (POPR, 1) because Petitioner was joined to IPR2024-233 (“the Google IPR”) are unsupported by the facts and the law. Thus, the Board should institute this Petition.

First, Proxense provides no challenge to the grounds of this Petition. Thus, the Board should institute it for the same reasons it instituted the Microsoft IPR.

Second, Proxense’s argument that “Apple has not made any showing that the prior art combinations could not have been presented in a single Petition” (POPR, 1) ignores the law and facts. By requesting joinder, Apple could not have introduced additional grounds in this Petition. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1336-37 (Fed. Cir. 2020). If Apple had combined grounds in a single Petition, both the Board and Proxense would have had to expend additional

¹ This Reply addresses institution only because Proxense has “no objection to Apple joining . . . IPR2024-00846” and did not file an opposition to Apple’s Motion for Joinder. EX-1038, 1.

resources addressing grounds in an Apple IPR that could not have been joined to any proceeding. Further, such a combination is not feasible. As demonstrated by Apple’s analysis (Ranking Document, Paper 4), its two petitions raise significantly different invalidity challenges, and only this Petition challenges claims 8, 9, 11, 20, 21, 28 and 29. Paper 4, 2-3. These different petitions require 13,957 (this Petition) and 12,771 (1334 Petition) words, respectively, and cannot be practicably combined.

Proxense’s argument that claims 8, 9, 11, 20, 21, 28 and 29 are not asserted and, therefore, “not at issue” (POPR, 2) is incorrect and misleading. These claims are at issue because they are challenged here, and their inclusion creates a material difference with the 1334 Petition. Paper 4, 2-3. Rather than “clearly proffer[ing]” a stipulation to take these claims out of dispute (CTPG, 61), Proxense argues that these claims are not at issue because they are not asserted in the *current* co-pending litigation. Tellingly, Proxense would not agree to sign a covenant not to sue Apple on these claims. POPR, 2. Thus, Proxense’s litigation tactics result in claims 8, 9, 11, 20, 21, 28 and 29 remaining “at issue” and the *current* co-pending litigation is of no consequence. This weighs against the Board discretionarily denying institution as only this proceeding will resolve that dispute.

Proxense’s argument that Apple should be treated like Microsoft (POPR, 2) ignores why the Board denied Microsoft’s joinder and that it and Apple are not similarly situated. Rather than determine the propriety of joinder, the Board

procedurally denied joinder because “the condition on which [Microsoft]’s Petition and Motion for Joinder is based ha[d] not come to pass.” IPR2024-1327, Paper 10, 2. No such condition exists here. In addition to Apple’s different request, Microsoft and Apple are differently situated because Microsoft was sued 10 months earlier than Apple and Microsoft chose to file its own petition challenging all of the ’954 Patent claims. Moreover, Apple is not precluded from joining the Microsoft IPR merely because it was previously joined to the Google IPR. *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1022 (Fed. Cir. 2012). Indeed, in another IPR against Proxense, the Board instituted a second, joinder petition noting the “representations by [Apple] and [Proxense]’s statement that it does not oppose joinder.” IPR2024-1399, Paper 8, 4-5. The Board should institute this Petition because these same representations and lack of opposition exist here. Proxense’s argument that Apple is no longer an understudy in the Google IPR (POPR, 2) is a red herring that ignores that Petitioner’s substantive briefing has concluded and, as a joinder party, Apple cannot challenge claims 8, 9, 11, 20, 21, 28 and 29 or add any new grounds. *Facebook*, 973 F.3d at 1336-37.

Third, Proxense will not be prejudiced by institution of the 1486 Petition, and does not make this argument. Thus, the Board should institute this Petition to resolve the parties dispute in a manner that conserves resources and prevents additional costs to the parties.

Date: February 10, 2025

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

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Reply to Patent Owner Preliminary Response has been served by email on the Patent Owner at the correspondence address of record for the Patent Owner:

David L Hecht (Reg. No. 61,618)
Hecht Partners LLP
125 Park Avenue, 25th Floor
New York, NY 10017
Tel: 212-851-6821
dhecht@hechtpartners.com E:
proxense@hechtpartners.com

James Zak (Reg. No. 60,190)
Hecht Partners LLP
125 Park Avenue, 25th Floor
New York, NY 10017
Tel: 212-851-6821
jzak@hechtpartners.com

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