UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01486

U.S. Patent No. 8,352,730

MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00775

TABLE OF CONTENTS

I. STATEMENT OF THE PRECISE RELIEF REQUESTED 1

II. STATEMENT OF MATERIAL FACTS 2

III. STATEMENT OF THE PRECISE RELIEF REQUESTED 2

A. LEGAL STANDARD 2

B. PETITIONER'S MOTION FOR JOINDER IS TIMELY 3

C. EACH FACTOR WEIGHS IN FAVOR OF JOINDER 3

1. Joinder is Appropriate 3

2. Petitioner Proposes No New Grounds of Unpatentability 4

3. Joinder Will Not Unduly Burden or Negatively Impact the Microsoft IPR Trial Schedule 4

4. Procedures to Simplify Briefing and Discovery 5

IV. *GENERAL PLASTIC* IS INAPPLICABLE 7

V. CONCLUSION 11

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple Inc. ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,352,730 ("'730 Patent") (IPR2024-01486 "the 1486 Petition") filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Microsoft Corp. v. Proxense, LLC*, IPR2024-00775 ("the Microsoft IPR").[1] The 1486 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Microsoft IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Microsoft does not oppose Petitioner's request for joinder.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Microsoft IPR while efficiently resolving the question of the '730 Patent's validity in a single proceeding.

---

[1] Microsoft Corporation has filed a Conditional Motion for Joinder of *Google LLC v. Proxense, LLC*, IPR2024-00232 ("the Google IPR") challenging the '730 Patent. *See Microsoft Corporation v. Proxense, LLC*, IPR2024-01326, Paper 2.

II. STATEMENT OF MATERIAL FACTS

1. On April 19, 2024, Microsoft Corp. filed a petition for *inter partes* review in IPR2024-00775 ("the Microsoft Petition") requesting cancellation of claims 1-17 of the '730 Patent.

2. 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. IPR2024-00775, Paper 8 (Aug. 21, 2024); 35 U.S.C. § 315(b).

3. Contemporaneously with this Motion, Petitioner filed the 1486 Petition for *Inter Partes* Review requesting cancellation of claims 1-17 of the '730 Patent, which is substantively identical to the Microsoft Petition.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted inter partes review proceeding. See 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery

may be simplified. *Kyocera Corporation v. Softview LLC,* IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed before, and thus within one month of, any institution decision by the Board in the Microsoft IPR, the deadline for which is November 21, 2024. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the 1486 Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Microsoft Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an "understudy" role. *See Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 6; (granting IPR where petitioners requested an "understudy" role); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder is Appropriate

Joinder with the Microsoft IPR is appropriate because the 1486 Petition involves the same patent, challenges the same claims, relies on the same expert

declaration, and is based on the same grounds and combinations of prior art submitted in the Microsoft Petition. *Id.* The 1486 Petition is substantively identical to the Microsoft Petition, containing only minor differences related to only other issues associated with a different party filing the petition. The 1486 Petition presents no changes to the facts, citations, evidence, or arguments related to patentability presented in the Microsoft Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Microsoft IPR so that the Board can efficiently resolve all grounds in both the 1486 Petition and Microsoft Petition in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The 1486 Petition presents the same grounds of unpatentability as the Microsoft Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact the Microsoft IPR Trial Schedule

Because the 1486 Petition is substantively identical to the Microsoft Petition, with the same grounds challenging the same claims as instituted by the Board, there are no new substantive issues for Patent Owner to address. Due to the same issues being presented in the 1486 Petition and the Microsoft Petition, Patent Owner will not be required to present any additional responses or arguments. *See* IPR2015-01353, Decision Instituting IPR, Motion for Joinder, Paper 11 at 6 (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or

discovery from Patent Owner beyond that already required in [the original IPR].”); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Microsoft Petition are identical to the issues presented in the 1486 Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Microsoft Petition. Also, because the 1486 Petition relies on the same expert and an identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Microsoft IPR does not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule was necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present 1486 Petition with the Microsoft IPR.

4. Procedures to Simplify Briefing and Discovery

The Microsoft Petition and 1486 Petition present substantively identical grounds of rejection, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an “understudy” role, as described by the Board:

“(a) ***all*** filings by [Petitioner] in the joined proceeding be consolidated

> with [the filings of the petitioner in the Microsoft IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Microsoft IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Microsoft] IPR, or introduce any argument or discovery not already introduced by [the petitioner in the Microsoft IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Microsoft IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Microsoft IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Microsoft IPR]."

Noven Pharmaceuticals, Inc. et al. v. Novartis AG et al., IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015) (emphasis in original). Petitioner will assume the primary role only if Microsoft ceases to participate in the Microsoft IPR.

By Petitioner accepting an "understudy" role, Patent Owner and Petitioner can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See* IPR2015-01353, Decision Instituting IPR, Paper 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners

agreed to an "understudy" role.); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 6-7.

Accordingly, joinder should be permitted. *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration."); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 4-5.

IV. *GENERAL PLASTIC* IS INAPPLICABLE

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. In the current motion, Petitioner merely seeks to join Microsoft's petition and does not present any new grounds. Petitioner also filed a petition against the '730 Patent in IPR2024-01333 ("the 1333 IPR"), seeking to join the Google IPR (IPR2024-00232). 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"). Furthermore, the Patent Owner did not even argue that the *General Plastic* factors warranted exercising the Board's discretion to deny the instituted challenges from the Microsoft IPR that Petitioner now seeks to join. *See generally* IPR2024-00775, Paper 8.

In the event the Board does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present IPR. *General Plastic* at 16.

Regarding the first factor, Petitioner has only filed another joinder petition against the '730 Patent (the 1333 IPR) for which Petitioner has agreed to an understudy role. This factor weighs in favor of institution because 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).

The second factor is whether at the time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second petition. This factor is neutral, if not inapplicable, in the *General Plastic* analysis. Here, the Microsoft Petition and the 1486 Petition share the same prior art because the 1486 Petition is a "copycat" of the Microsoft Petition. Because Petitioner is merely seeking to join in an understudy role, the factor is neutral, at best, in determining whether to institute.

The third factor is whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition. Because this is a Motion for Joinder requesting an understudy role, Petitioner is submitting a substantively identical petition and has not added to, or changed, any of the substantive arguments from the Microsoft Petition. Moreover, because the present 1486 Petition is submitted as a joinder and Petitioner will serve an understudy role, the 1486 Petition is not an attempt to harass the Patent Owner or otherwise engage in serial, tactical filings. Thus, this factor weighs against denial of joinder/institution.

The fourth factor is the length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and filing of the second petition, and the fifth factor is whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent. In the context of a joinder motion where Petitioner will be taking an understudy role, these factors are inapplicable.

The sixth factor is the finite resources of the Board. Allowing Petitioner's joinder motion where it will serve in an understudy role will not impact the Board's resources beyond those resources the Board dedicates to the instant joinder motion.

The seventh factor is the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review. As noted above, joining Petitioner should not impact the schedule. Accordingly, this factor weighs in favor of institution.

An eighth factor identified by the Board in *Shenzhen* is the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent. *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.,* IPR2018-00898, Paper 9 at 7, 13-14 (PTAB Oct. 1, 2018) (noting "the purpose of proposed Factor 8 is to discourage tactical filing of petitions over time by parties that faced the same threat at the same time" such that earlier petitions are filed as "test case(s)" to gain

"tactical advantage"). Petitioner is not similarly situated as the petitioner for the Microsoft IPR. The petitioner for the Microsoft IPR was sued on the '730 Patent in a case filed on May 2, 2023. The Petitioner here was sued on the '730 Patent over ten months later, in a case filed on March 18, 2024. Furthermore, because the 1486 Petition does not introduce any new grounds of unpatentability and will effectively merge into a single proceeding with the Microsoft IPR, no tactical advantage is gained here.

Thus, none of the *General Plastic* factors weighs against institution and joinder in this situation.

V. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the 1486 Petition for *Inter Partes* Review of U.S. Patent No8,352,730 and then grant joinder with the Microsoft IPR2024-00775 proceeding.

Date: October 16, 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

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Motion for Joinder has been served via Federal Express, postage prepaid, to Patent Owner, by serving the correspondence address of record for the '730 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

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