

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioners,

v.

PROXENSE, LLC,

Patent Owner

IPR2025-00074

U.S. Patent No. 9,679,289 B1

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 (“Proxense”) submits the following Preliminary Response to the Petition for *Inter Partes* Review of claims 1-20 of U.S. Patent No. 9,679,289 B1 (“the 289 Patent”) filed by Petitioner Apple Inc. (“Petitioner” or “Apple”).

II. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(A) IS WARRANTED

Petitioner has filed two petitions challenging the validity of the 289 Patent, one of which has already been instituted. The first petition, filed in IPR2025-00075, was a copy of the petition filed in *Google, LLC v. Proxense, LLC*, IPR2024-00783. *Apple Inc. v. Proxense, LLC*, IPR2025-00075, Paper 2, at 2 (“Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1-20 of the ’289 Patent, which is substantively identical to the Google IPR.”). Petitioner then filed a Motion for Joinder in IPR2025-00075 to have the proceedings joined with *Google, LLC v. Proxense, LLC*, IPR2024-00783. *Id.* Petitioner’s Petition and Motion for Joinder were granted. *See* IPR2025-00075, Paper 7. On February 5, 2025, IPR2024-00783 was terminated with respect to Google, leaving Petitioner as the only petitioner remaining in the case.

Petitioner’s second petition, at issue here, is a copy of the petition filed by Microsoft in *Microsoft Corp. v. Proxense, LLC*, IPR2024-00407. Paper 3 (“In the 00074 IPR, Petitioner files a petition that is substantively identical to the petition in *Microsoft Corp. v. Proxense, LLC*, IPR2024-00407 (‘the Microsoft IPR’)”). Petitioner, however, has not filed a motion for joinder with respect to IPR2024-00407.

In its ranking of petitions, Petitioner states “[s]hould the Board decide to institute only a single petition and grant only a single motion for joinder against the ’289 patent, Petitioner requests that the Board institute Petitioner’s petition in the 00075 IPR and grant its Motion for Joinder of the Google IPR if the Board institutes that proceeding.” Paper 3, at 1.

Petitioner acknowledges that it “has two concurrent petitions challenging the validity of the same patent.” Paper 3, at 1. Although Petitioner provides a ranking of the petitions in the order in which it wishes the Board to consider the merits and a succinct explanation of the differences (*id.*), Petitioner requests that “should the Board decide to institute only a single petition against the ’289 patent, . . . the Board institute Petitioner’s petition in the 00075 IPR and grant its Motion for Joinder of the Google IPR.” *Id.* Since, the Board has instituted *inter partes* review of the ’289 patent in IPR2025-00075, the Board should deny the Petition in the current IPR.

Moreover, the Board should follow the precedent set in *Google LLC v. Proxense, LLC*, IPR2024-01319, Paper 7 (Denying Institution). In IPR2024-01319, after filing the petition in IPR2024-00783, Google filed a copycat petition with a request to join IPR2024-00407 (i.e., the very same IPR Apple has copied). *Id.* Like Apple, Google requested that “[s]hould the Board decide to institute only a single petition against the ’289 patent, . . . the Board institute Petitioner’s Original Petition (in IPR2024-00783).” *Id.* Having instituted *inter partes* review of the 289 Patent in IPR2024-00783, the Board denied Google’s Petition. *Id.*

As noted above, Petitioner’s motion for joinder with respect to IPR2024-00783 was granted and then the proceedings were terminated with respect to Google. Accordingly, Petitioner has stepped into Google’s shoes and thus Petitioner’s copycat petition should receive the same treatment as Google’s and be denied.

III. CONCLUSION

In view of the foregoing, the Board should exercise its discretion under 35 U.S.C. § 314(a) and deny the present Petition.

Dated: February 26, 2025

Respectfully submitted by,

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CERTIFICATION OF WORD COUNT UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner Preliminary Response (excluding the table of contents, certificate of service, word count, or listing of exhibits) total 587 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

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

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that the Patent Owner Response was served on February 26, 2025, by e-mailing copies to the following e-mail addresses provided by Petitioners in their Petition:

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