

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2025-00075

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

**PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING
PETITIONS¹**

¹ Petitioner is filing a substantively identical document in IPR2025-00074.

I. Introduction

Petitioner is concurrently filing petitions for *inter partes* review of U.S. Patent No. 9,679,289 (“the ’289 patent”) in IPR2025-00075 (“the 0075 IPR”) and IPR2025-00074 (“the 0074 IPR”). In the 0075 IPR, Petitioner seeks to join *Google LLC v. Proxense, LLC*, IPR2024-00783 (“the Google IPR”). In the 0074 IPR, Petitioner files a petition that is substantively identical to the petition in *Microsoft Corp. v. Proxense, LLC*, IPR2024-00407 (“the Microsoft 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 0074 IPR and the 0075 IPR are meritorious and justified. Should 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 0075 IPR and grant its Motion for Joinder of the Google IPR if the Board institutes that proceeding;

otherwise, Petitioner requests that the Board institute Petitioner’s petition in the 0074 IPR.

III. Background and Related Proceedings

On January 16, 2024, Microsoft filed a petition (“the Microsoft Petition”) to challenge the validity of the ’289 patent in the Microsoft IPR. On April 29, 2024, Proxense, LLC (the “Patent Owner”) filed its patent owner’s preliminary response in the Microsoft IPR. On July 22, 2024, the Board granted institution of the Microsoft IPR.

Separately, on April 19, 2024, Google filed a petition for review of the ’289 patent (“the Google Petition”) in the Google IPR. The Patent Owner filed its preliminary response in the Google IPR on August 20, 2024, setting a deadline for the Board to issue an institution decision of November 20, 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 0075 IPR and the 0074 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.

IPR2025-00075 Petition (substantively identical to the Google Petition)			
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	1-6, 8-11, and 14-19	103	Dua, Giobbi157

2	1-6, 8-11, and 14-19	103	Dua, Giobbi157, Kotola
3	1-7, 10-11, and 14-19	103	Buer
4	4, 8-10, 12, 13, 17, and 20	103	Buer, Giobbi157
5	4	103	Buer, Nishikawa

IPR2025-00074 Petition (substantively identical to the Microsoft Petition)			
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1A	1-20	103	Giobbi-157 in view of Giobbi-139
1B	1-20	103	Giobbi-157 in view of Giobbi-139 and Dua
2A	1-8, 10-11, and 14-19	103	Broadcom
2B	1-20	103	Broadcom in view of Giobbi-157

As shown in the above tables, Petitioner’s petition in the 0075 IPR challenges the claims of the ’289 patent based on significantly different invalidity grounds than its petition in the 0074 IPR.

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 files a petition in the 0074 IPR that is substantively identical to the petition in 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 the Google IPR, and because the 0074 IPR is substantively identical to the Microsoft IPR. As such, 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 '289 patent, Petitioner requests that the Board institute Petitioner's petition in the 0075 IPR and grant its motion to join the Google IPR; otherwise, the Petitioner requests that the Board institute Petitioner's petition in the 0074 IPR.

Date: November 4, 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 by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

Patent Law Works/Proxense
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Additionally, a courtesy copy of the IPR and all supporting exhibits were emailed to 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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