

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2025-00562
Patent 9,049,188 B1

Before THU A. DANG, KEVIN F. TURNER, and DAVID C. McKONE,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A. BACKGROUND

On May 18, 2026, Petitioner e-mailed the Board to request authorization to file a Motion to Strike exhibits submitted by Patent Owner with its Sur-reply. According to Petitioner, Patent Owner opposes such a motion. On May 20, 2026, Judges Thu Dang, Kevin Turner, and David McKone conducted a conference call with counsel for the parties to discuss Petitioner's request and Patent Owner's opposition.

B. DISCUSSION

During the call, Petitioner requested authorization to file a Motion to Strike all exhibits that were filed with Patent Owner's Sur-reply (Paper 13) on April 30, 2026, arguing that the filing was "untimely." Although Petitioner acknowledged that most of the exhibits were previously submitted in related proceedings and are publicly available, Petitioner argued that, in particular, Exhibit 2016, the Declaration of Dr. Markus Jakobsson (herein the "Jakobsson Declaration"), should have been submitted with the Patent Owner's Response, and not with the Sur-reply. Furthermore, Petitioner acknowledged that Patent Owner did not introduce new arguments in its Sur-reply and that Petitioner does not intend to bring a "prejudice" argument in the Motion to Strike.

Patent Owner responded by arguing that the Jakobsson Declaration was cited in the Patent Owner Response, and was intended to be submitted with the Response, wherein omission of the Declaration as an exhibit, along with the Response, was merely a clerical error. Patent Owner contended that these exhibits, including the Jakobsson Declaration, are the same exhibits filed in previous proceedings in the same family of cases, and thus, should be submitted to the record of the current proceeding for the sake of

consistency. Patent Owner pointed out that Petitioner acknowledged that there are no new arguments introduced in the Sur-reply and thus there is no undue prejudice against the Petitioner.

We note that this issue likely could have been resolved by a simple phone call, from either party to the other, long before now (i.e., as soon as a party became suspicious that something was missing from the record), without involvement of the panel. Nevertheless, we are persuaded by Patent Owner's contentions.

Here, the Exhibit List was submitted with the Response on April 30, 2026, listing all of Exhibits 2001–2016, including the Jakobsson Declaration as Exhibit 2016. *See* Paper 11. And Petitioner acknowledged during the call that most of the exhibits are previously filed documents in related proceedings and are publicly available. The Board should be made aware of the previously filed documents pertaining to claim construction in the district court (most of the documents at issue here) and thus should consider such previously filed documents. *See* 37 C.F.R. § 42.100(b).

Further, as Patent Owner pointed out, the Jakobsson Declaration was clearly cited in its Response as “Exhibit 2016.” *See* Paper 11, 46 (“as evidenced by the Declaration of Markus Jakobsson (Exhibit 2016) and detailed above, the specification of the 188 Patent defines a ‘PDK’ and ‘RDC’ to be nothing more than general purpose computers”). And as Petitioner acknowledged during the call, it recognized that the Response references the Jakobsson Declaration, and thus, pointed out in its Reply that no declaration was submitted with the Response (*see* Reply 11 (“The POR refers to a ‘Declaration of Markus Jakobsson’ in support of [Patent Owner]’s arguments . . . However, no such declaration has been submitted into

evidence”). Petitioner further acknowledged that Patent Owner submitted the Jakobsson Declaration with its Sur-reply in response to Petitioner’s Reply, and alleged that there is no new matter introduced and thus there is no prejudice in the Patent Owner’s submission with the Sur-reply. We find that making such cited document part of the record would be beneficial in bringing clarity to the Response, especially in view of Petitioner’s acknowledgement of the lack of meaningful prejudice.

We are mindful of Petitioner’s concern that, with the Exhibits of record, Patent Owner may reference the Jakobsson Declaration during oral arguments, for example, and potentially bring up new matter that could prejudice Petitioner. As discussed during the call, should Petitioner deem that Patent Owner has brought up new matter during oral arguments which would prejudice Petitioner, Petitioner shall bring such matter to the attention of the Board and we will address the matter accordingly.¹

On this record, we deny Petitioner’s request to file a Motion to Strike.

C. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner may not file a Motion to Strike the Exhibits submitted with the Sur-reply.

¹ A procedure for objecting to oral argument demonstratives will be included in our forthcoming oral argument order, and must be followed for such objections.

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