

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

PROXENSE, LLC
Patent Owner.

Inter Partes Review No.: IPR2025-00600

MOTION TO TERMINATE *INTER PARTES* REVIEW

I. INTRODUCTION

The Board authorized Petitioner Apple Inc. (“Apple”) to file a motion to dismiss its IPR petition and terminate IPR2025-00600 regarding U.S. Patent No. 10,698,989 (“the ’989 patent”) on June 2, 2025. Apple now so moves. The ’989 patent was challenged in the *Ex Parte* Reexamination App. No. 90/015,054 (“the ’054 Reexam”) requested by Samsung Electronics. On March 20, 2025, in the ’054 Reexam, the Office issued an Ex Parte Reexamination Certificate cancelling all claims (claims 1-9) of the ’989 patent. Apple requests the Board to dismiss this IPR petition and terminate IPR2025-00600 in view of the cancellation of all claims of the ’989 patent in the ’054 Reexam and to preserve the Board’s and parties’ resources.

II. BACKGROUND AND PROCEDURAL HISTORY

Apple filed the Petition on March 18, 2025. At the time, the ’989 patent was also being challenged in the ’054 Reexam. As of the filing date of the Petition, all challenged claims of the ’989 patent had been rejected in the ’054 Reexam but the reexamination proceeding was not final. Petition, at 7, 84. In an attempt to obviate the necessity of filing this petition, “Petitioner requested that Patent Owner grant a covenant not to sue for the ’989 Patent,” which “Patent Owner refused.” *Id.*

After filing the Petition, Apple reached out to Patent Owner’s counsel in the related litigation—*Proxense, LLC v. Apple Inc.*, No. 6:24-cv-00143 (W.D. Tex.

Mar. 18, 2024)—regarding IPR2025-00600. Litigation counsel indicated that it had not been retained to represent Patent Owner in IPR2025-00600. As of the date of this Motion, no counsel has appeared on behalf of Patent Owner in IPR2025-00600.

On March 20, 2025, in the '054 Reexam, the Office issued an Ex Parte Reexamination Certificate cancelling all claims (claims 1-9) of the '989 patent. Apple updated its Mandatory Notices on May 22, 2025 to apprise the Board of the reexamination certificate. On May 23, 2025, Apple requested permission from the Board to file a motion to dismiss the Petition and terminate IPR2025-00600. On May 30, 2025, Patent Owner's litigation counsel indicated to the Board that it had not been retained for IPR2025-00600. On June 2, 2025, the Board granted Apple's request.

III. ARGUMENT

Good cause exists to dismiss Apple's IPR petition and terminate IPR2025-00600. Termination would preserve the Board's and the parties' resources, and would expeditiously resolve Apple's request, furthering the purpose of IPR challenges. 37 C.F.R. § 42.1(b). IPR2025-00600 is in its preliminary stage as the Board has not yet reached the merits and issued a decision on institution. Proxense would not be prejudiced by termination.

The Board “may terminate a trial without rendering a final written decision, where appropriate.” 37 C.F.R. § 42.72. The Rules governing IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). In determining whether a termination request is “appropriate,” the Board has looked primarily to the stage of the proceedings when a request is made, and has repeatedly granted pre-institution termination. *See, e.g.*, IPR2014-00905, Paper 7 at 1 (Aug. 26, 2014) (granting unopposed motion to terminate stating that a “decision on the Petition . . . has not yet been rendered. Under these circumstances, we determine that it is appropriate . . . to terminate this proceeding without rendering a final written decision” (emphasis added)).

The Board should grant Apple’s unopposed motion. This proceeding is in its preliminary stage and termination is proper. Such termination would further the purpose of the rules by justly and expeditiously resolving this dispute without subjecting the Board and the parties to unnecessary expense involved in taking IPR2025-00600 through trial. Indeed, the fact that no counsel has appeared for Patent Owner in this proceeding is telling. The parties will incur substantial expense in preparing and presenting expert declarants for deposition, submitting substantive briefs and motions, and presenting at an oral hearing. The Board will also have to expend substantial resources if it were to decline to terminate IPR2025-00600. It will likely be requested to address various procedural issues

(such as how to proceed without counsel for Patent Owner), preside over an oral hearing, and draft a substantive decision on institution and a final written decision on the merits. All of these resources can be spared by terminating IPR2025-00600. Termination will reduce the overall burden of this dispute on the Board, which is already significant given that there are six other already-instituted trials.

Termination is also a just resolution. Proxense will not be prejudiced by this Board terminating IPR2025-00600, because all claims of the '989 patent have already been cancelled in the '054 Reexam. Furthermore, Proxense will reap the benefit of preserving its own resources.

IV. CONCLUSION

The Board should dismiss the IPR petition and terminate IPR2025-00600.

Respectfully submitted,

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Dated: June 24, 2025

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the June 24, 2025, a complete and entire copy of this Motion to Terminate *Inter Partes* Review of U.S. Patent No. 10,698,989 was served via Federal Express, postage prepaid, to Patent Owner, by serving the correspondence address of record for the '989 Patent:

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and upon counsel of record for the Patent Owner in the litigation before the United States District Court for the Western District of Texas, by e-mail:

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Date: June 24, 2025