

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-01318
Patent 8,646,042 B1

Before THU A. DANG, DAVID C. McKONE, and
NORMAN H. BEAMER *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

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Patent 8,646,042 B1

Google LLC (“Petitioner”) filed a Petition for *inter partes* review of claims 1, 5, 6, 8–11, 13, and 14 of U.S. Patent No. 8,646,042 B1 (“the ’042 patent”) (Paper 1) and a Motion for Joinder (“Motion”) (Paper 3) to join Microsoft’s instituted proceeding in IPR2024-00573 (“Microsoft IPR”), along with a Notice Ranking Multiple Petitions (“Notice”) (Paper 4). Petitioner also acknowledges that it previously filed a petition (“Original Petition”) for *inter partes* review of claims 1–6, 8–15, and 17–20 of the ’042 patent in IPR2024-00782. Notice 1. Thus, Petitioner “requests that action on this motion be held in abeyance until, and only if, the Board declines to institute Petitioner’s Original Petition.” *Id.*; *see also* Motion 1.

The Board has instituted an *inter partes* review of the ’042 patent in IPR2024-00782. *See* IPR2024-00782, Paper 13. That is, we have not declined to institute Petitioner’s Original Petition in IPR2024-00782. *Id.* Accordingly, the condition on which Petitioner’s Petition and Motion for Joinder is based, i.e., “in abeyance until, and only if, the Board declines to institute [in IPR2024-00782],” has not come to pass. Therefore, we deny the Petition and the Motion for Joinder.

Here, Petitioner acknowledges that it “has two concurrent petitions challenging the validity of the same patent.” Notice 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 ’042 patent, . . . the Board institute Petitioner’s Original Petition (in IPR2024-00782).” *Id.* Since, as discussed above, the Board has instituted an *inter partes* review of the ’042 patent in IPR2024-00782, we deny the Petition and the Motion for Joinder in the current IPR.

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ORDER

In consideration of the foregoing, it is hereby

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is denied as to claims 1, 5, 6, 8–11, 13, and 14 of the '042 patent; and

FURTHER ORDERED that Petitioner's Motion for Joinder (Paper 3) is denied.

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FOR PETITIONER:

Erika Arner
Kara Specht
Cory Bell
Shawn Chang
Safiya Aguilar
Finnegan, Henderson, Farabow, Garrett & Dunner LLP
erika.arners@finnegan.com
kara.specht@finnegan.com
cory.bell@finnegan.com
shawn.chang@finnegan.com
safiya.aguilar@finnegan.com

FOR PATENT OWNER:

David L Hecht
James Zak
Hecht Partners LLP
dhecht@hechtpartners.com
jzak@hechtpartners.com
proxense@hechtpartners.com