

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-01319
Patent 9,679,289 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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Google LLC (“Petitioner”) filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 9,679,289 B1 (“the ’289 patent”) (Paper 1) and a Motion for Joinder (“Motion”) (Paper 3) to join Microsoft’s instituted proceeding in IPR2024-00407 (“the 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 1–20 of the ’289 patent in IPR2024-00783. 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 ’289 patent in IPR2024-00783. *See* IPR2024-00783, Paper 12. That is, we have not declined to institute Petitioner’s Original Petition in IPR2024-00783. *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 IPR2024-00783],” 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 ’289 patent, . . . the Board institute Petitioner’s Original Petition (in IPR2024-00783).” *Id.* Since, as discussed above, the Board has instituted an *inter partes* review of the ’289 patent in IPR2024-00783, 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 1–20 of the '289 patent; and

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

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