

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01334

U.S. Patent No. 8,886,954

**MOTION FOR JOINDER UNDER
35 U.S.C. § 325(c) AND 37 C.F.R. § 42.222(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00233**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple, Inc. (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,886,954 (“’954 Patent”) (IPR2024-01334 “the 1334 Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Google LLC v. Proxense, LLC*, IPR2024-00233 (“the Google IPR”).¹ The 1334 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Google IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Google does not oppose Petitioner’s request for joinder.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Google IPR while efficiently resolving the question of the ’954 Patent’s validity in a single proceeding.

¹ Microsoft Corporation has filed a Conditional Motion for Joinder of the Google IPR. *See Microsoft Corporation v. Proxense, LLC*, IPR2024-01327, Paper 2.

II. STATEMENT OF MATERIAL FACTS

1. On January 17, 2024, Google LLC filed a petition for *inter partes* review (IPR2024-00233) requesting cancellation of claims 1-7, 10, 12-19, and 22-27 of the '954 Patent.

2. On July 24, 2024, the Board instituted *inter partes* review on all challenged claims and grounds. IPR2024-00233, Paper 10 (Jul. 24, 2024).

3. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1-7, 10, 12-19, and 22-27 of the '954 Patent, which is substantively identical to the Google IPR.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. See 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the Decision Granting Institution of *Inter Partes* Review dated July 24, 2024, (Paper 10) of the Google IPR. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the 1334 Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Google Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 6; (granting IPR where petitioners requested an “understudy” role); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder is Appropriate

Joinder with the Google IPR is appropriate because the 1334 Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Google Petition. *Id.* The 1334 Petition is substantively identical to the Google

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