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Paper 8
Entered: October 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PROXSENSE LLC,
Patent Owner.

IPR2024-01398
Patent 8,646,042 B1

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

MCKONE, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
Granting Motion for Joinder
35 U.S.C. § 314; 35 U.S.C. § 315(c)

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I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1, 5, 6, 8–11, 13, and 14 of U.S. Patent No. 8,646,042 B1 (Ex. 1001, "the '042 patent"). Additionally, Petitioner filed a Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) to Related *Inter Partes* Review IPR2024-00573. Paper 3 ("Joinder Mot."). In an October 1, 2024, teleconference among the panel and counsel for Petitioner, Patent Owner, and counsel for Microsoft Corp. (the petitioner in the IPR2024-00573 ("the Microsoft IPR")), Patent Owner represented that it did not oppose Petitioner's Joinder Motion and that we should proceed to join Petitioner as a party to the Microsoft IPR. Paper 7, 4.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2016); 37 C.F.R. § 42.4(a) (2019). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons explained below, we institute an *inter partes* review of the '042 patent. We also join Petitioner as a party to IPR2024-00573.

II. INSTITUTION OF INTER PARTES REVIEW

A. Evidence

Petitioner relies on the references listed below.

Name	Reference	Date	Exhibit No.
Giobbi-157	US 2007/0245157 A1	Pub. Oct. 18, 2007 (filed May 5, 2007)	1005

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Name	Reference	Date	Exhibit No.
Giobbi-139	US 2004/0255139 A1	Pub. Dec. 6, 2004 (filed May 17, 2004)	1006
Dua	US 9,042,819 B2	May 26, 2015 (filed Sept. 30, 2014)	1007
Broadcom	EP 1,536,306 A1	Pub. June 1, 2005 (filed Sept. 30, 2004)	1008

Petitioner also relies on the Declaration of Patrick Traynor, Ph.D. (Ex. 1003).

B. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 1):

Reference(s)	35 U.S.C. §	Claim(s) Challenged
Giobbi-157, Giobbi-139	§ 103(a)[1]	1, 5, 6, 8–11, 13, 14
Giobbi-157, Giobbi-139, Dua	§ 103(a)	1, 5, 6, 8–11, 13, 14
Broadcom	§ 103(a)	10, 11, 13, 14

C. Institution of Inter Partes Review

This Petition is substantially identical to the petition in the Microsoft IPR, challenging the same patent and claims, based on the same grounds of unpatentability, and relying upon the same evidence (including the same prior art combinations supported by the same expert declaration). According to Petitioner, "the 1398 Petition involves the same patent, challenges the

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. § 103. Because the '042 patent has an effective filing date before the effective date of the relevant provision of the AIA, we cite to the pre-AIA version of § 103.

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same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Microsoft Petition." Joinder Mot. 3; *accord id.* at 5 ("The Microsoft Petition and 1398 Petition present substantively identical grounds of rejection, including the same art combinations against the same claims.").

Petitioner undertakes, if the Petition and Joinder Motion are granted, to assume an "understudy" role, and will not take an active role in the *inter partes* review proceeding unless the petitioner in the Microsoft IPR ceases to participate in the instituted IPR. *Id.* at 5–6 (citing *Noven Pharmaceuticals, Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015)). Petitioner represents that it "can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner." *Id.* at 6. Thus, Petitioner argues, "[t]hese steps will minimize any potential complications or delay that potentially may result by joinder." *Id.*

In view of these representations by Petitioner and Patent Owner's statement that it does not oppose joinder, and having reviewed the Petition, we determine that, under the current circumstances, it is appropriate to exercise our discretion to institute *inter partes* review of the challenged claims based upon the same grounds authorized and for the same reasons discussed in the Microsoft DI (Microsoft IPR, Paper 11). Petitioner has shown a reasonable likelihood that it would prevail with respect to each of the claims challenged in the Petition for the same reasons given in the Microsoft DI considering the same issues.

III. PETITIONER'S JOINDER MOTION

As noted above, Petitioner requests joinder of this proceeding with the Microsoft IPR. Joinder Mot. 1.

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Joinder in *inter partes* review proceedings is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

"To join a party to an instituted [inter partes review (IPR)], the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). "First, the statute requires that the Director (or the Board acting through a delegation of authority) . . . determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* "Second, to effect joinder, § 315(c) requires the Director to exercise h[er] discretion to decide whether to 'join as a party' the joinder applicant." *Id.*

As the moving party, Petitioner bears the burden of proving that it is entitled to joinder. *See* 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

A motion for joinder must be filed "no later than one month after the institution date of any inter partes review for which joinder is requested." 37 C.F.R. § 42.122(b). Petitioner argues that the Joinder Motion is timely because it was filed within one month of the August 13, 2024, Microsoft DI. Joinder Mot. 3.

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