

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-01486

U.S. Patent No. 8,352,730

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00775**

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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. 8,352,730 (“’730 Patent”) (IPR2024-01486 “the 1486 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 *Microsoft Corp. v. Proxense, LLC*, IPR2024-00775 (“the Microsoft IPR”).¹ The 1486 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Microsoft IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Microsoft 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 Microsoft IPR while efficiently resolving the question of the ’730 Patent’s validity in a single proceeding.

¹ Microsoft Corporation has filed a Conditional Motion for Joinder of *Google LLC v. Proxense, LLC*, IPR2024-00232 (“the Google IPR”) challenging the ’730 Patent. See *Microsoft Corporation v. Proxense, LLC*, IPR2024-01326, Paper 2.

II. STATEMENT OF MATERIAL FACTS

1. On April 19, 2024, Microsoft Corp. filed a petition for *inter partes* review in IPR2024-00775 (“the Microsoft Petition”) requesting cancellation of claims 1-17 of the ’730 Patent.

2. The Patent Owner filed its preliminary response in the Microsoft IPR on August 21, 2024, setting a deadline for the Board to issue an institution decision of November 21, 2024. IPR2024-00775, Paper 8 (Aug. 21, 2024); 35 U.S.C. § 315(b).

3. Contemporaneously with this Motion, Petitioner filed the 1486 Petition for *Inter Partes* Review requesting cancellation of claims 1-17 of the ’730 Patent, which is substantively identical to the Microsoft Petition.

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 before, and thus within one month of, any institution decision by the Board in the Microsoft IPR, the deadline for which is November 21, 2024. 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 1486 Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Microsoft 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 Microsoft IPR is appropriate because the 1486 Petition involves the same patent, challenges the same claims, relies on the same expert

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