

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner,

v.

PROXSENSE LLC,  
Patent Owner.

---

IPR2024-01485  
Patent 8,886,954 B1

---

Before THU A. DANG, KEVIN F. TURNER, and DAVID C. McKONE,  
*Administrative Patent Judges.*

McKONE, *Administrative Patent Judge.*

DECISION

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

## I. INTRODUCTION

### A. Background and Summary

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–29 of U.S. Patent No. 8,886,954 B1 (Ex. 1001, “the ’954 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 IPR2024-00846. Paper 3 (“Joinder Mot.”). Petitioner also filed a Supplemental Paper and Notice Ranking Petitions. Paper 4 (“Ranking Notice”). Patent Owner filed a Preliminary Response. Paper 8 (Prelim. Resp.). With our authorization, Petitioner filed a Preliminary Reply. Paper 9 (“Prelim. Reply”). Patent Owner declined to file a preliminary sur-reply by our deadline to do so.

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 decline to institute an *inter partes* review of the ’954 patent. We also deny Petitioner’s Joinder Motion.

### B. Related Matters

The parties advise us that the ’954 patent is involved in three district court cases, including *Proxense, LLC v Apple, Inc.*, Case No. 6:24-cv-00143 (W.D. Tex.). Pet. 104; Paper 6, 2. The ’954 patent also has been challenged at the Board in the following *inter partes* review petitions: *Google, LLC v.*

*Proxense, LLC*, IPR2024-00233 (PTAB) (instituted); *Microsoft Corp. v. Proxense, LLC*, IPR2024-00846 (PTAB) (Petitioner’s Joinder Motion seeks to join this trial); *Microsoft Corp. v. Proxense, LLC*, IPR2024-01327 (PTAB) (institution denied); *Apple Inc. v. Proxense, LLC*, IPR2024-01334 (PTAB) (joined to IPR2024-00233). Pet. 104; Paper 6, 2.

*C. Evidence*

Petitioner relies on the references listed below.

Name	Reference	Date	Exhibit No.
Burger	US 2005/0050367 A1	Mar. 3, 2005 (filed Sept. 30, 2004)	1005
Robinson	US 2003/0177102 A1	Sept. 18, 2003	1006
Orsini	US 2004/0049687 A1	Mar. 11, 2004	1021

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

*D. The Asserted Grounds*

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

Reference(s)	35 U.S.C. §	Claim(s) Challenged
Burger	§ 103(a) <sup>1</sup>	1, 2, 4, 5, 7–13, 15, 16, 18–24, 26–29
Burger, Robinson	§ 103(a)	3, 14, 17

---

<sup>1</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the ’954 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.

Reference(s)	35 U.S.C. §	Claim(s) Challenged
Burger, Orsini	§ 103(a)	6, 25

*E. Institution of Inter Partes Review*

Petitioner has filed two petitions challenging the '954 patent, the instant Petition (filed October 16, 2024) and a petition in IPR2024-01334 (filed August 22, 2024). The instant Petition is accompanied by a motion seeking to join Petitioner as a party to IPR2024-00846. Joinder Mot. 1. The Board has already granted the petition in IPR2024-01334 (“’1334 petition”) and joined Petitioner as a party to IPR2024-00233. Ranking Notice 1.

According to PTAB guidance, “[b]ased on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations.” Consolidated Trial Practice Guide (“TPG”) 59 (Nov. 2019), available at <https://go.usa.gov/xpvPF>. “Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner),” the situation we have here, “may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *Id.* Thus, “multiple petitions by a petitioner are not necessary in the vast majority of cases.” *Id.* That said,

the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references. In such cases two petitions by a petitioner may be needed, although this should be rare.

*Id.* In such situations, a petitioner is invited to identify, either in its petition or a separate ranking paper (Petitioner filed the Ranking Notice):

(1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, *why the issues addressed by the differences are material*, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a).

*Id.* at 59–60 (emphasis added). In a separate paper or in the preliminary response (Patent Owner provided a Preliminary Response), the patent owner is permitted to

respond to the petitioner and explain why the Board should not exercise its discretion to institute more than one petition (if it institutes at all). Among other issues, the patent owner should explain whether the differences identified by the petitioner are directed to an issue that is not material or not in dispute. If stating that issues are not material or in dispute, the patent owner should clearly proffer any necessary stipulations. For example, the patent owner may seek to avoid additional petitions by proffering a stipulation that certain claim limitations are not disputed or that certain references qualify as prior art.

*Id.* at 60–61.

In its Ranking Notice, Petitioner requests that we institute both the '1334 petition and the instant Petition, but ranks the '1334 petition first and the instant Petition second. Ranking Notice 1. Thus, if we decide that Petitioner has not provided sufficient justification for instituting two petitions, we should deny the instant Petition, as we have already instituted the '1334 petition.

Petitioner argues that we should institute both petitions because “Petitioner’s petitions in the 1334 IPR and the 1485 IPR are . . . materially different.” Ranking Notice 2. Petitioner shows that the '1334 petition

challenges a subset of the claims of the '954 patent based on the prior art references Ludtke and Kon, while the instant Petition challenges all 29 claims of the '954 patent based on the prior art references Burger, Robinson, and Orsini. *Id.* at 2–3. According to Petitioner, these are “significantly different invalidity grounds.” *Id.* at 3. However, Petitioner does not explain why challenging the same patent with different invalidity grounds, without more, justifies instituting both petitions.

Petitioner also argues that “the 1485 IPR challenges additional claims not challenged in the 1334 IPR—i.e., claims 8, 9, 11, 20, 21, 28, and 29 of the '954 patent.” *Id.* at 3. Each of these claims are dependent claims. Ex. 1001, 10:5–12:51. Petitioner does not explain in its Ranking Notice why the additional claims challenged in the Petition presents a material difference.

One exemplary justification for multiple petitions is “when the patent owner has asserted a large number of claims in litigation.” TPG 59. Petitioner does not argue that it was impractical to challenge in one petition all claims asserted in litigation. Patent Owner argues the contrary, stating that, “though this Petition challenges dependent claims 8, 9, 11, 20, 21, 28 and 29 of the 954 Patent, which were not challenged in the 1334 IPR, Patent Owner has not asserted those claims against [Petitioner] in the current co-pending litigation. . . . Thus, the only difference between the petitions is a challenge to dependent claims not at issue.” Prelim. Resp. 2.

Petitioner argues that Patent Owner did not clearly proffer a stipulation not to assert claims 8, 9, 11, 20, 21, 28, and 29. Prelim. Reply 2. According to Petitioner, Patent Owner’s statement that these claims are not at issue is “incorrect and misleading” because Patent Owner “would not

agree to sign a covenant not to sue [Petitioner] on these claims,” and that “Proxense’s litigation tactics result in claims 8, 9, 11, 20, 21, 28 and 29 remaining ‘at issue’ and the *current* co-pending litigation is of no consequence.” *Id.* In support of this argument, Petitioner cites to the Preliminary Response, at 2. *Id.* The Preliminary Response says nothing about whether Patent Owner would agree to sign a covenant not to sue on these claims. Prelim. Resp. 2. And Petitioner does not meaningfully allege a concern that these claims will be asserted. Thus, Petitioner does not show that the addition of claims 8, 9, 11, 20, 21, 28, and 29 makes the difference between the two petitions material. Moreover, Petitioner could have ranked the instant Petition, which challenges the additional claim, higher, but chose not to for reasons that are not presented here.<sup>2</sup> Petitioner does not persuade us that the additional challenges to claims 8, 9, 11, 20, 21, 28 and 29 in the Petition is material.

As to the other exemplary justification stated in the TPG, “when there is a dispute about priority date requiring arguments under multiple prior art references,” TPG 59, Patent Owner represents that “there is no dispute about the priority date regarding either combination of references,” and that “Patent Owner has not denied that either combination of references constitutes prior art,” Prelim. Resp. 2. Petitioner does not argue that there is any dispute as to priority date justifying two petitions.

---

<sup>2</sup> It is notable that Petitioner does not provide reasons why, should we institute on the instant Petition, the 1334 petition still would be justified. In other words, Petitioner has not explained why the challenges presented in the 1334 petition are materially different from those presented in the instant Petition.

Petitioner argues that it could not have raised both sets of challenges in the instant Petition because issues in the instant Petition could not be joined to the '233 IPR that the '1334 petition sought to join. Prelim. Reply 1–2 (citing *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1336–37 (Fed. Cir. 2020)). We appreciate that Petitioner did not draft either petition in the first instance, and instead chose to copy petitions to facilitate joinder. While it might be the case that Petitioner could not have combined the two petitions and still sought joinder, Petitioner still does not provide a reason why it should be permitted two petitions. Alleging that the challenges presented in the two petitions are materially different, by itself, does not show “why the issues addressed by the differences are material.” TPG 60.

We have considered the reasons for two petitions presented in the Ranking Notice, but find insufficient argument or evidence to show that this is the “rare” case in which two petitions might be needed by Petitioner. Accordingly, consistent with the guidance in the TPG, we exercise our discretion to deny the Petition under 35 U.S.C. § 314(a).

## II. PETITIONER’S JOINDER MOTION

As noted above, Petitioner requests joinder of this proceeding with IPR2024-00846. Joinder Mot. 1. As the moving party, Petitioner bears the burden of proving that it is entitled to joinder. *See* 37 C.F.R. § 42.20(c).

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.* “The statute makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.” *Id.* (citing *Thyrv, Inc. v. Click-to-Call Techs., LP*, 140 S.Ct. 1367, 1377 (2020)).

As we explain above, Petitioner has not shown that we should institute a second Petition by Petitioner challenging the ’954 patent. Instead, we determine that the Petition does not warrant institution. Accordingly, the Joinder Motion fails at the first step, whether the Petition warrants institution, and we need not evaluate further the second step, whether to join Petitioner as a party to IPR2024-00846.

Petitioner’s Joinder Motion is denied.

### III. CONCLUSION

We exercise our discretion to deny the Petition because Petitioner has not shown that we should institute a second petition by Petitioner challenging the '954 patent.

Because the Petition does not warrant institution, we deny Petitioner's Joinder Motion.

### IV. 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 1–29 of the '954 patent;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2024-00846 (Paper 3) is denied.

IPR2024-01485  
Patent 8,886,954 B1

PETITIONER:

Philip Woo  
Monte Squire  
Daryl Bartow  
Paul Belnap  
DUANE MORRIS LLP  
[pwoo@duanemorris.com](mailto:pwoo@duanemorris.com)  
[mtsquire@duanemorris.com](mailto:mtsquire@duanemorris.com)  
[dsbartow@duanemorris.com](mailto:dsbartow@duanemorris.com)  
[phbelnap@duanemorris.com](mailto:phbelnap@duanemorris.com)

PATENT OWNER:

David Hecht  
JAMES ZAK  
HECHT PARTNERS LLP  
[dhecht@hechtpartners.com](mailto:dhecht@hechtpartners.com)  
[zakx0017@umn.edu](mailto:zakx0017@umn.edu)