

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEC CORPORATION, NOKIA CORPORATION, and
ALCATEL SUBMARINE NETWORKS,
Petitioner,

v.

NEPTUNE SUBSEA IP LIMITED,
Patent Owner.

IPR2018-01160
Patent 8,406,637 B2

Before BARBARA A. BENOIT, GREGG I. ANDERSON, and
JASON W. MELVIN, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, NEC Corporation, Nokia Corporation, and Alcatel Submarine Networks (“Petitioner”)¹ filed a Petition (“Pet.,” Paper 4) pursuant to 35 U.S.C. §§ 311–19 challenging claims 1–7 and 9–13 (“challenged claims”) of U.S. Patent No. 8,406,637 B2 (“’637 patent,” Ex. 1001). Neptune Subsea IP Limited (“Patent Owner”)² did not file a Preliminary Response. We instituted an *inter partes* review of the ’637 patent on all grounds (“Inst. Dec.,” Paper 8). After institution, Patent Owner filed a Patent Owner Response (“PO Resp.” Paper 11). The Response is limited to requesting termination of this proceeding pursuant to a Disclaimer in Patent Under 37 C.F.R. § 1.321(a) (“Disclaimer,” Ex. 2001). PO Resp. 2.

II. DISCUSSION

Section 42.2 defines “judgment” to mean “a termination of a proceeding” or “a final written decision by the Board.” Section 42.73 is reproduced in part below.

§ 42.73 Judgment.

(a) A judgment, except in the case of a termination, disposes of all issues that were, or by motion reasonably could have been, raised and decided.

(b) Request for adverse judgment. A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

¹ NEC Networks & System Integration Corporation and NEC Corporation of America are additional real parties-in-interest. Pet. 55.

² Neptune Subsea IP Limited is the real party in interest. Paper 6, 1.

- (1) Disclaimer of the involved application or patent;
- (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
- (3) Concession of unpatentability or derivation of the contested subject matter; and
- (4) Abandonment of the contest.

In this proceeding, Patent Owner filed a statutory disclaimer for all the challenged claims of the '637 patent. Ex. 2001. Under § 42.73(b), a “party may request judgment against itself *at any time during a proceeding*,” which in this case is after institution. Therefore, it is appropriate here to construe Patent Owner's statutory disclaimer as a request for adverse judgment under § 42.73(b). 37 C.F.R. § 42.73(b) (“Actions construed to be a request for adverse judgment include: (1) Disclaimer of the involved application or patent; (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial . . .”). There is no dispute that all of the challenged claims are disclaimed in this proceeding. Ex. 2001.

For the foregoing reasons, we construe Patent Owner's statutory disclaimer of claims 1–7 and 9–13 of the '637 patent as a request for adverse judgment, and we grant the request for adverse judgment.

III. ORDER

Accordingly, it is

ORDERED that adverse judgement is entered against Patent Owner as to claims 1–7 and 9–13 of the '637 patent; and

FURTHER ORDERED that this proceeding is hereby terminated.

IPR2018-01160
Patent 8,406,637 B2

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