Trials@uspto.gov
571-272-7822

Paper No. 11
Entered: May 16, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEAR EARTH AUTONOMY, INC.,
Petitioner,

v.

AURORA FLIGHT SCIENCES CORP.,
Patent Owner.

Case IPR2018-01704
Patent 9,557,742 B2

Before PATRICK R. SCANLON, CARL M. DeFRANCO, and JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

JUDGMENT
Granting Request for Adverse Judgment
37 C.F.R. § 42.73

Petitioner, Near Earth Autonomy, Inc. ("NEA"), filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–4, 6–16, and 19–21 (the "Challenged Claims") of U.S. Patent No. 9,557,742 B2 (Ex. 1001, the "'742 patent"). Pet. 1. We instituted trial on March 28, 2019. Paper 8.

Pursuant to our authorization, Aurora filed an unopposed motion to terminate this proceeding. Paper 10 ("Motion" or "Mot."). Aurora indicates that it filed a statutory disclaimer disclaiming all of the Challenged Claims. Mot. 1; *see also* Ex. 2001 (providing the statutory disclaimer and electronic acknowledgement receipt). Aurora also indicates that it has conferred with NEA, who does not oppose the Motion. Mot. 1.

Exhibit 2001, entitled "Disclaimer in Patent Under 37 CFR 1.321(a)," is Patent Office form PTO/SB/43 and disclaims claims 1–4, 6–16, and 19–21 of the '742 patent, that is, the Challenged Claims. *See* Ex. 2001. Section 253(a) of Title 35 provides that:

> A patentee, . . . may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

A disclaimer of one or more claims of a patent, to be recorded in the Patent Office, must:

> (1) Be signed by the patentee, or an attorney or agent of record;
> (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
> (3) State the present extent of patentee's ownership interest in the patent; and
> (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that § 253 disclaimer is immediately "recorded" on the date that the Office receives a disclaimer meeting requirements of 37 C.F.R. § 1.321(a)).

Based on our review of Exhibit 2001, we conclude that a disclaimer of claims 1–4, 6–16, and 19–21 of the '742 patent has been recorded in the Office in accordance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a).

Our rules provide that "[a] party may request judgment against itself at any time during a proceeding." 37 C.F.R. § 42.73(b). Moreover, certain actions taken by a party, such as the "[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial," can be construed as a request for adverse judgment against that party. *Id.* § 42.73(b)(2). Because Aurora filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming all the Challenged Claims of the '742 patent after trial was instituted, we construe the disclaimer as a request for adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2). Because no claim remains in this trial, we grant the request and terminate this proceeding.

Accordingly, it is:

ORDERED that Patent Owner's disclaimer is construed to be a request for adverse judgment;

FURTHER ORDERED that Patent Owner's request for adverse judgment is *granted* and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1–4, 6–16, and 19–21 of the '742 patent; and

FURTHER ORDERED that this proceeding is hereby terminated.

For PETITIONER:

Mark G. Knedeisen
Michael Haggerson
Patrick J. McElhinny
K&L GATES, LLP
mark.knedeisen@klgates.com
michael.haggerson@klgates.com
patrick.mcelhinny@klgates.com

For PATENT OWNER:

Naveen Modi
Joseph E. Palys
Daniel Zeilberger
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
danielzeilberger@paulhastings.com