

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS SOLUTIONS, INC.,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING LLC,
Patent Owner.

Case IPR2019-01222
Patent 8,929,442 B2

Before GEORGIANNA W. BRADEN, GREGG I. ANDERSON, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

JUDGMENT
37 C.F.R. § 42.73

Petitioner Arris Solutions, Inc. requested an *inter partes* review of claims 1–15 (the “challenged claims”) of U.S. Patent No. 8,929,442 B2 (“the ’442 patent”). Paper 1 (“Petition” or “Pet.”). Patent Owner Realtime Adaptive Streaming, LLC did not file a preliminary response. *See* Paper 7, 1. We instituted review of all challenged claims. *Id.* at 29. An oral hearing in this trial was scheduled for October 13, 2020. Paper 22, 1.

After the close of business on October 8, 2020, the parties jointly emailed the Board stating that Patent Owner had statutorily disclaimed all the challenged claims. Ex. 3001. The parties “agree[d] the hearing next week should be taken off calendar” and Petitioner “request[ed] that adverse judgment be entered in this case.” *Id.*

We held a conference call with the parties the next day, on October 9, 2020, to discuss the matters raised in the parties’ October 8 email. Ex. 3002. We informed counsel for both parties during the call that if they were to forego the October 13 oral hearing, the Board likely would not be able to schedule a future oral hearing in this proceeding. The parties maintained their request to cancel and so we cancelled the October 13 oral hearing.

With respect to Petitioner’s request for judgement based on the statutory disclaimer, Patent Owner confirmed that it did not oppose Petitioner’s request as described in the parties’ October 8 email. Accordingly, we authorized Patent Owner to file a notice of statutory disclaimer and Petitioner to file a motion for judgment. On October 12, 2020, Patent Owner and Petitioner filed the authorized papers. Papers 26 (notice of disclaimer), 27 (request for judgment).

Our rules provide: “A party may request judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b). Here, Patent Owner

does not request expressly adverse judgement against itself. Rather, Petitioner requests entry of judgement against Patent Owner. Paper 27. Patent Owner, however, does not oppose Petitioner's request. *See infra*. 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).

Pursuant to 37 C.F.R. § 42.73(b)(2), we construe Patent Owner's disclaimer of claims 1–15 of the '442 patent as a request for adverse judgment because the disclaimer leaves Patent Owner with no remaining claim in this trial. Paper 26. Patent Owner's non-opposition to Petitioner's request for judgment accords with our view of the statutory disclaimer. Accordingly, on the record before us, we enter adverse judgment against Patent Owner pursuant to 37 C.F.R. § 42.73(b) and terminate the trial pursuant to 37 C.F.R. § 42.72.

ORDER

It is, therefore,

ORDERED that Patent Owner's statutory disclaimer of claims 1–15 of the '442 patent (Paper 26) is construed as a request for adverse judgment;

FURTHER ORDERED that Petitioner's request for judgment (Paper 27) is *granted* and judgment adverse to Patent Owner is entered; and

FURTHER ORDERED that this proceeding is hereby *terminated*.

IPR2019-01222
Patent 8,929,442 B2

For PETITIONER:

Brian Oaks
Jennifer Nall
Andrew Wilson
BAKER BOTTS LLP
brian.oaks@bakerbotts.com
jennifer.nall@bakerbotts.com
andrew.wilson@bakerbotts.com

Carol Ansley
ARRIS SOLUTIONS, INC.
carol.ansley@arris.com

For PATENT OWNER:

Philip Wang
C. Jay Chung
Kent Shum
Reza Mirzaie
Neil Rubin
RUSS AUGUST & KABAT
pwang@raklaw.com
jchung@raklaw.com
kshum@raklaw.com
rmirzaie@raklaw.com
nrubin@raklaw.com