

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADVANCED MICRO DEVICES, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LIMITED,
Patent Owner.

IPR2019-01514
Patent 6,728,144 B2

Before JAMESON LEE, CHRISTA P. ZADO, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

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

I. DISCUSSION

On March 2, 2020, we instituted an *inter partes* review of claims 1–7 of U.S. Patent No. 6,728,144 B2 (“the ’144 patent”). Paper 11. On May 11, 2020, Polaris Innovations Limited (“Patent Owner”) filed a statutory disclaimer of claims 1–7 of the ’144 patent, thereby disclaiming all of the claims challenged in this proceeding. Ex. 2001. On May 18, 2020, the panel and counsel for the parties, Advanced Micro Devices, Inc. (“Petitioner”) and Patent Owner, held a conference call to discuss Patent Owner’s statutory disclaimer. Patent Owner seeks authorization to file a motion to terminate the proceeding under 37 C.F.R. § 42.72 as moot in light of the disclaimer. Petitioner opposes termination of this proceeding as moot, and submits the disclaimer should be treated as a request for entry of adverse judgement pursuant to 37 C.F.R. § 42.73(b). Section 42.73(b) provides “[a] party may request adverse judgment against itself at any time during a proceeding” and “[a]ctions construed to be a request for adverse judgement include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b). We ordered Patent Owner to show cause why the Board should not enter adverse judgement against Patent Owner pursuant to § 42.73(b). Paper 14. Patent Owner filed its Response to Order to Show Cause and Request to Terminate Proceeding as Moot. Paper 17 (“Response”). Petitioner then filed its Reply in Opposition to Patent Owner’s Response to Order to Show Cause and Request to Construe Disclaimer as a Request for Adverse Judgment and Terminate the Proceeding. Paper 18 (“Reply”).¹

¹ We ordered Patent Owner to show cause why we should not enter adverse judgment and authorized Petitioner to respond, but our order did not

For the foregoing reasons, we enter adverse judgment against Patent Owner pursuant to § 42.73(b) and terminate this proceeding.

Section 47.73(b) provides “[a] party may request adverse judgment against itself at any time during a proceeding” and “[a]ctions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that a party has no remaining claim in the trial.” 37 C.F.R.

§ 42.73(b). Here, Patent Owner has disclaimed all of the claims of the ’144 patent, such that no claims remain in this proceeding. Therefore, under § 42.73(b), adverse judgment is appropriate. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1349 (Fed. Cir. 2018) (“[Section 42.73(b) gives the Board authority to construe a patent owner’s actions as a request for an adverse judgment.”).

Patent Owner argues, nonetheless, that the Board should not enter adverse judgment. Response 1. Patent Owner advances the following arguments in support of its position that adverse judgment should not be entered: 1) 37 C.F.R. §§ 42.73(b)(1)–(2) are inconsistent with the right to disclaim patent claims under 35 U.S.C. § 253, arguing that under *Guinn v. Kopf*, 96 F.3d 1419 (Fed. Cir. 1996), claims disclaimed under § 253 are treated as though they never existed; 2) 37 C.F.R. §§ 42.73(b)(1)–(2) is inconsistent with 35 U.S.C. § 311(b), arguing that § 311(b) limits the scope of *inter partes* review to “claims of the patent,” but that disclaimed claims are not, and never were, “claims of the patent”; 3) 37 C.F.R. § 42.73(d)(1)

authorize Patent Owner to file a motion requesting termination of this proceeding as moot or authorize Petitioner to file a motion requesting entry for adverse judgment and termination of this proceeding. Paper 14; 37 C.F.R. 42.20(a)–(b). In entering judgment, we do not consider the parties’ unauthorized requests.

amounts to patent owner estoppel, which is substantive and therefore, under 35 U.S.C. § 2(b)(2), beyond the Patent Office's rulemaking authority; and 4) the Board should exercise its discretion and vacate and terminate this proceeding as moot. *Id.* at 1–5.

Petitioner responds that: 1) the Board has consistently entered adverse judgments under 37 C.F.R. § 42.73(b) in response to similar disclaimers, arguing Patent Owner's voluntary dismissal of all claims is significant; 2) *Guinn* supports entry of adverse judgment, arguing *Guinn* rejected the argument that judgment against a disclaiming party was inconsistent with statutory disclaimer; 3) entry of adverse entry is consistent with public policy, arguing that in *Rembrandt Wireless Techs. v. Samsung Elecs. Co.*, 853 F.3d 1370 (Fed. Cir. 2017), the court criticized the same arguments made by Patent Owner here and cited a number of cases in which a court recognized the existence of claims despite invocation of disclaimer; 4) entry of adverse judgment protects the public from Patent Owner later attempting to seek reissue and regain subject matter surrendered through disclaimer; and 4) entry of adverse judgment in this case is within the scope of the Board's authority, arguing that here Petitioner seeks judgment under 37 C.F.R. § 42.73(b)(2), not estoppel under 37 C.F.R. § 42.73(d)(1), and therefore whether the Board has proper authority under 37 C.F.R. § 42.73(d)(1) is irrelevant to the issue presented here. Reply 1–5.

Having reviewed the papers presented by the parties, we determine entry of adverse judgement pursuant to 37 C.F.R. § 42.73(b) is appropriate. Here, Patent Owner has disclaimed all of the claims of the '144 patent, such that no claims remain in this proceeding. We agree with Petitioner that *Guinn* and 35 U.S.C. § 253 do not preclude entry of adverse judgment. As

argued by Petitioner, in both *Guinn* and *Rembrandt* the court recognized the existence of claims despite the invocation of disclaimer. In *Guinn*—a case involving an interference proceeding before the Board—the Federal Circuit held the Board “had the authority and the responsibility” to resolve the interference proceeding and render judgment against the patent owner as a result of his disclaimer of the only claim in the proceeding. *Guinn*, 96 F.3d at 1422. In *Rembrandt*—a case in which a patent owner sought to avoid the effects of its failure to mark products by disclaiming claims—the Federal Circuit clarified that although disclaimer had been held to relinquish the rights of the patent owner disclaiming the claims, the Federal Circuit never held that patent owner disclaimer relinquished the rights of the public. *Rembrandt*, 853 F.3d at 1383–1384. We also agree with Petitioner that the issue of patent owner estoppel under 37 C.F.R. § 42.73(d)(1) is not before us. Thus, whether 37 C.F.R. § 42.73(d)(1) is a valid rule does not bear on the question of whether adverse judgment should be entered under § 42.73(b)(2).

II. ORDER

Accordingly, it is

ORDERED that adverse judgement is hereby entered against Patent Owner pursuant to 37 C.F.R. § 42.73(b) with respect to claims 1–7 of U.S. Patent No. 6,728,144; and

FURTHER ORDERED that this proceeding is *terminated*.

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