

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AURIS HEALTH, INC.,
Petitioner,

v.

INTUITIVE SURGICAL OPERATIONS, INC.,
Patent Owner.

IPR2019-01532
Patent 6,491,701 B2

Before ULRIKE W. JENKS, TINA E. HULSE, and JAMES A. WORTH,
Administrative Patent Judges.

HULSE, *Administrative Patent Judge.*

JUDGMENT

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

Auris Health, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 7, 8, 11, 16, and 25 of U.S. Patent No. 6,491,701 B2 (Ex. 1001, “the ’701 patent”). Paper 1. Intuitive Surgical Operations, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition, including a disclaimer of claim 25. Paper 8, 1; Ex. 2001. On March 4, 2020, we instituted an *inter partes* review of claims 1, 7, 8, 11, and 16 of the ’701 patent, but not disclaimed claim 25. Paper 9, 17.

On April 1, 2020, Patent Owner filed its Patent Owner Response. Paper 11 (“PO Resp.”). In its Response, Patent Owner states claims 1, 7, 8, 11, and 16 are now expired and are no longer being asserted in the co-pending district court litigation. *Id.* at 1. Patent Owner states that it has filed a statutory disclaimer of claims 1, 7, 8, 11, and 16 with the Office, along with the necessary fees. *Id.*; Ex. 2002. Accordingly, Patent Owner asserts “as there is no remaining claim in this trial, this *inter partes* review should be terminated.” PO Resp. 1.

Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Cancellation or disclaimer of one or more claims such that the patent owner has no remaining claim in the trial is construed to be a request for adverse judgment. 37 C.F.R. § 42.73(b)(2).

Here, although Patent Owner does not expressly request adverse judgment in its Response (*see* PO Resp. 1), Patent Owner has disclaimed all claims of the ’701 patent on which a trial was instituted such that it has no remaining claim in the trial. In light of the disclaimer, we construe Patent Owner’s Response as a request for adverse judgment and grant Patent Owner’s request.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request for adverse judgment under 37 C.F.R. § 42.73(b) is *granted*; and

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 1, 7, 8, 11, and 16 of the '701 patent.

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