

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLAREEDGE TECHNOLOGIES LTD.,
Petitioner,

v.

SMA SOLAR TECHNOLOGY, AG.,
Patent Owner.

IPR2020-00964
Patent 8,779,630 B2

Before THU A. DANG, JONI Y. CHANG, and SCOTT B. HOWARD,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

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

BACKGROUND

In response to a Petition (Paper 2, “Pet.”) filed by Solaredge Technologies LTD (“Petitioner”), on January 11, 2021, the Board instituted *inter partes* review of claims 1–23 (the “challenged claims”) of U.S. Patent No. 8,779,630 B2 (“the ’630 patent”). Paper 8 (“Dec. Inst.”).

On April 5, 2021, SMA Solar Technology AG (“Patent Owner”) filed a statutory disclaimer (Ex. 2002, “Disclaimer”) with the United States Patent and Trademark Office pursuant to 37 C.F.R. § 1.321(a), disclaiming claims 1–23 of the ’630 patent. On the same day, Patent Owner filed a Response (Paper 10 (“PO Resp.”)), pointing out that “Patent Owner filed a statutory disclaimer,” and thus, Patent Owner contends that, “as there is no remaining claim in this trial, this *inter partes* review should be terminated.” *Id.* at 4.

In turn, Petitioner filed its Reply to Patent Owner’s Response. Paper 11 (“Pet. Reply”). In the Reply, Petitioner contends that “termination is not the proper result following Patent Owner’s disclaimer.” *Id.* at 1. In particular, according to Petitioner, “the rules provide that the Board should construe Patent Owner’s disclaimer to be a request for adverse judgment, and enter a Final Written Decision to that effect.” *Id.* (citing 37 C.F.R. § 42.73(b)).

In its Sur-reply, Patent Owner submits that “there are no remaining issues or controversy in this proceeding.” Paper 12, 4.

DISCUSSION

Actions construed as a request for adverse judgment 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). Here, Patent Owner has disclaimed claims 1–23 of the ’630 patent under 35 U.S.C. § 253 according to the procedures set forth in 37 C.F.R. § 1.321(a). *See* Ex. 2002, 1. We agree with Petitioner that 37 C.F.R. § 42.73(b) provides that the Board should construe Patent Owner’s statutory disclaimer to be a request that the Board enter adverse judgment against it with respect to claims 1–23, the only claims at issue, in this trial. Pet. Reply 1; *see also Unified Patents, LLC v. Arsus, LLC*, IPR2020-00948, Paper 18 at 2 (PTAB Jan. 27, 2021) (construing statutory disclaimer of all challenged claims as request for adverse judgment), *aff’d* Case No. 2021-1648, 2021 WL 5315423 (Fed. Cir. Nov. 16, 2021)..

Having reviewed the Disclaimer, Patent Owner’s Response, Petitioner’s Reply, and Patent Owner’s Sur-reply, we determine that entry of judgment against Patent Owner with respect to claims 1–23 of the ’630 patent is appropriate.

ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1–23 of the ’630 patent; and

FURTHER ORDERED that this proceeding is terminated.

IPR2020-00964
Patent 8,779,630 B2

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