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Paper 10
Date: June 30, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
Petitioner,

v.

DALI WIRELESS INC.,
Patent Owner.

IPR2020-01476
Patent 9,847,816 B2

Before MELISSA A. HAAPALA, *Senior Lead Administrative Patent Judge*, and KARL D. EASTHOM and SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

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

CommScope Technologies LLC ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–18 (the "challenged claims") of U.S. Patent No. 9,847,816 B2 (Ex. 1001, the "'816 patent"). Dali Wireless Inc. ("Patent Owner") did not file a preliminary response. The Board instituted trial on the challenged claims. Paper 6 (Decision on Institution).

Thereafter, Patent Owner filed a Response. Paper 8. In its Response, Patent Owner notifies the Board that "prosecution counsel expressly abandoned all claims of [the '816 patent]" and further states "[t]here are no remaining claims at issue in this trial." Response 1 (citing Ex. 2001 ("Submission of Express Abandonment under 37 C.F.R. § 1.138")). During a teleconference on June 16, 2021, Patent Owner's counsel notified the Board that the Office did not consider this a proper submission, so prosecution counsel had subsequently filed a disclaimer with respect to all claims. *See* Ex. 2002 ("Submission of Disclaimer Pursuant to 37 C.F.R. § 1.321(a)") ("Disclamer").

The Board construes an action cancelling or disclaiming claims such that no challenged claims remain in the trial as a request for adverse judgment. 37 C.F.R. § 42.73(b)(2) ("Actions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial."); *see also McAfee, Inc. v. CAP Co., Ltd.*, IPR2016-00211, Paper 19 (PTAB, April 5, 2017) (entering adverse judgment based on motion to amend seeking cancellation of claims remaining in the trial).

During the June 16, 2021 teleconference with the parties, the panel discussed with the parties the applicability of 37 C.F.R. § 42.73(b)(2).

Petitioner argued that adverse judgment under 37 C.F.R. § 42.73(b)(2) is proper because the Motion to Amend seeks to cancel all the remaining claims in the trial. Patent Owner disagreed, arguing that Patent Owner did not request an adverse judgment, did not file a brief on the issue, and that by disclaiming the challenged claims early in the trial process, Patent Owner attempted to promote efficiency and an early resolution so that termination under 37 C.F.R. § 42.72 is proper.

Under 37 C.F.R. § 42.72, "[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a)." In this case, there is no "consolidat[ion] . . . or a joint request under 35 U.S.C. 317(a) or 327(a)."

Petitioner's arguments are more persuasive. Under 37 C.F.R. § 42.73(b)(2), "[a]ctions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial." In this case, the Board instituted trial and Patent Owner filed a Response acknowledging that "[t]here are no remaining claims at issue in this trial." Response 1. Accordingly, we construe Patent Owner's Response and Disclaimer as a request for adverse judgment.

ORDER

Accordingly, it is

ORDERED that Patent Owner's request for adverse judgment is *granted*;

FURTHER ORDERED that final judgment is entered against Patent Owner with respect to claims 1–18.

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