

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01125
Patent 7,292,870 B2

Before TREVOR M. JEFFERSON, NEIL T. POWELL, and
JOHN D. HAMANN, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

JUDGMENT

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

Petitioner filed a Petition (Paper 3) requesting an inter partes review of claims 2–4, 11–14, 22, 23, and 31–33 of U.S. Patent No. 7,292,870 B2 (“the ’870 patent,” Ex. 1001). Patent Owner did not file a Preliminary Response. We instituted *inter partes* review and issued a Scheduling Order on December 21, 2021. Papers 8, 9. Pursuant to the Scheduling Order, Patent Owner was to file a response to the petition or a motion to amend the patent by March 15, 2022. Paper 9, 11 (Due Date 1). According to the record in this case, Patent Owner did neither. Additionally, the Scheduling Order instructed Patent Owner to arrange for a conference call with the Board if Patent Owner elected to not file a response to the petition. *Id.* Patent Owner did not arrange for such a conference call. Before us now is Petitioner’s Reply (Paper 10), requesting “issuance of an FWD invalidating the Challenged Claims” in the pending proceeding. Paper 10, 2.

Pursuant to our rules, “[a]ctions construed to be a request for adverse judgment include . . . [a]bandonment of the contest.” 37 C.F.R. § 42.73(b)(4). In the present proceeding and three related proceedings, Patent Owner failed to file responses to the Petition, which is consistent with abandonment of the contest. In two closely related proceedings, IPR2021-01130 and IPR2021-01131, however, Patent Owner filed substantive response papers and an oral hearing was held. *See* IPR2021-01130 Paper 10; IPR2021-01131 Paper 10. At the conclusion of the oral hearing in IPR2021-01130 and IPR2021-01131, Patent Owner stated on the record that they are not contesting a final written decision or adverse judgment in the related cases that Patent Owner did not file a response. IPR2021-01130 Paper 29, 64:3–64:20 (stating that Patent Owner is not contesting adverse judgment “if the Board determines [Petitioner] met their burden of proof

with respect to those claims [where Patent Owner] hasn't filed any opposition"). In the same oral hearing, Petitioner stated that although Petitioner "continue[s] to seek entry of a final written decision . . . [they] actually think there is precedent for entering . . . adverse judgment." *Id.* at 65:4–18. Thus, Petitioner stated "adverse judgment would be appropriate here under the circumstances." *Id.*

In light of Patent Owner's and Petitioner's statements on the record in the related proceedings and Patent Owner's stated lack of opposition to Petitioner's unpatentability grounds in this instituted proceeding and request for final judgment, we treat Petitioner's request for a final written decision (Paper 10) and Patent Owner's abandonment of the contest as requests for adverse judgment under 37 C.F.R. § 42.73(b). Under the circumstances of this case, we find that adverse judgment is appropriate.

ORDER

Accordingly, it is

ORDERED that adverse judgment shall be entered against Patent Owner as to claims 2–4, 11–14, 22, 23, and 31–33 of the '870 patent under 37 C.F.R. § 42.73(b);

FURTHER ORDERED that claims 2–4, 11–14, 22, 23, and 31–33 of the '870 patent are determined to be unpatentable; and

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a).

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