

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESIDEO TECHNOLOGIES, INC. & CENTRAL SECURITY GROUP—
NATIONWIDE, INC.,
Petitioner,

v.

UBIQUITOUS CONNECTIVITY, LP,
Patent Owner.

IPR2021-01355
Patent 10,344,999

Before GEORGIANNA W. BRADEN, ROBERT J. WEINSCHENK, and
KEVIN C. TROCK, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

JUDGMENT

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

I. INTRODUCTION

Resideo Technologies, Inc. and Central Security Group–Nationwide, Inc. (collectively “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–25 (“the challenged claims”) of U.S. Patent No. 10,344,999 (Ex. 1001, “the ’999 patent”). Paper 3 (“Pet.”), 4–5. Ubiquitous Connectivity, LP (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). In conjunction with its Preliminary Response, Patent Owner filed a statutory disclaimer of claims 15–24 pursuant to 37 C.F.R. § 1.321 (a). *See* Ex. 2001.

We did not institute review as to any of the disclaimed claims because “[n]o *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e) (2019). We instituted an *inter partes* review on the remaining challenged claims 1–14 and 25. Paper 12, 42; Paper 19, 2. Subsequently, Patent Owner filed a statutory disclaimer of the remaining challenged claims 1–14 and 25 of the ’999 patent. Ex. 3002. Petitioner filed a Request for Adverse Judgment of all claims 1–25. Paper 24. Patent Owner did not object or respond to Petitioner’s request.

For the reasons stated below, we construe Patent Owner’s statutory disclaimer as a request for adverse judgment under 37 C.F.R. § 42.73(b). Accordingly, we enter adverse judgment against Patent Owner as to disclaimed challenged claims 1–14 and 25 of the ’999 patent. We do not address Petitioner’s request for adverse judgment of claims 15–24 as they are not part of this instituted trial proceeding. Paper 12, 42; Paper 19, 2. *See, e.g., Pfizer, Inc. v. UniQure Biopharma B.V.*, IPR2020-00388, Paper 52 at 3–4 (PTAB Mar. 25, 2021) (stating that, notwithstanding the Federal Circuit’s holding in *Arthrex*, the panel is “mindful of prior precedent holding that disclaimed claims are treated as if they never existed” and that if “the

claims never existed, we cannot have exercised jurisdiction over the disclaimed claims and therefore cannot enter adverse judgment against them”).

II. DISCUSSION

Section 42.2 defines “judgment” to mean “a termination of a proceeding” or “a final written decision by the Board.” 37 C.F.R. § 42.2. Relevant portions of § 42.73 follow (underlining added):

§ 42.73 Judgment.

(a) A judgment, except in the case of a termination, disposes of all issues that were, or by motion reasonably could have been, raised and decided.

(b) *Request for adverse judgment.* A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

- (1) Disclaimer of the involved application or patent;
- (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
- (3) Concession of unpatentability or derivation of the contested subject matter; and
- (4) Abandonment of the contest.

(c) *Recommendation.* The judgment may include a recommendation for further action by an examiner or by the Director.

(d) *Estoppel.*

....

(3) *Patent applicant or owner.* A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent:

(i) A claim that is not patentably distinct from a finally refused or canceled claim; or

(ii) An amendment of a specification or of a drawing that was denied during the trial proceeding, but this provision does

not apply to an application or patent that has a different written description.

Construing Patent Owner's statutory disclaimer of all claims remaining in the trial as a request for adverse judgment and granting the request precludes Patent Owner under the estoppel provision of § 42.73(d)(3)(i) from obtaining in continuing applications or other subsequent proceedings before the Office claims patentably indistinct from the disclaimed claims. *Cf. Ex Parte Aoki*, Appeal No. 2012-010117, 2015 WL 3827164 (PTAB June 15, 2015) (affirming Examiner's final rejection of claims patentably indistinct from claims on which adverse judgment had been entered against applicant in a prior interference proceeding);

Here, Patent Owner has disclaimed all claims in the instituted trial proceeding such that there are no remaining claims at issue in the trial. Thus, we construe Patent Owner's statutory disclaimer of claims 1–14 and 25 of the '999 patent as a request for adverse judgment, and we grant the request for adverse judgment as to the instituted claims.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that adverse judgment is entered against Patent Owner as to claims 1–14 and 25 of the '999 patent; and

FURTHER ORDERED that this proceeding is hereby terminated.

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FOR PETITIONER:

S. Benjamin Pleune
Christopher T.L. Douglas
Lauren N. Griffin
ALSTON & BIRD LLP
ben.pleune@alston.com
christopher.douglas@alston.com
lauren.griffin@alston.com

Peter Flynn
Stephanie L. Schonewald
CHOATE, HALL & STEWART LLP
pflynn@choate.com
IPRalarm.com@choate.com

FOR PATENT OWNER:

Carey Rozier
ROZIER HARDT MCDONOUGH PLLC
matt@rhmttrial.com