

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETSCOUT SYSTEMS, INC.,
Petitioner,

v.

LONGHORN HD LLC,
Patent Owner.

IPR2021-01555
Patent 6,954,790 B2

Before KARL D. EASTHOM, GARTH D. BAER, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.107(e)

I. INTRODUCTION

A. Background and Summary

On October 6, 2021, NetScout Systems, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–4 and 7 of U.S. Patent No. 6,954,790 B2 (Ex. 1001, the “’790 patent”). Paper 1 (“Pet.”). On January 25, 2022, Longhorn HD LLC (“Patent Owner”) filed a Preliminary Response (Paper 6 (“Prelim. Resp.”)) and a statutory disclaimer (Ex. 2001).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons set forth below, we decline to institute an *inter partes* review of any claims challenged in the ’790 patent.

B. Real Parties in Interest

Petitioner identifies itself as the real party-in-interest. Pet. 65. Patent Owner names itself as the real party-in-interest. Paper 5, 1.

C. Related Matters

The parties identify, as matters involving or related to the ’790 patent, *Longhorn HD LLC v. Juniper Networks, Inc.*, 2-21-cv-00099 (E.D. Tex.). Pet. 65; Paper 5, 1. Patent Owner also identifies *Longhorn HD LLC v. Fortinet Inc.*, No. 2:19-cv-00124 (E.D. Tex.); *Longhorn HD LLC v. Lanner Electronics Inc.*, No. 2:20-cv-00260 (E.D. Tex.); *Longhorn HD LLC v. Mitel Software Technologies Ltd.*, No. 2:20-cv-00350 (E.D. Tex.); *Longhorn HD LLC v. Palo Alto Networks, Inc.*, No. 2:20-cv-00259 (E.D. Tex.); *Longhorn HD LLC v. Sophos Limited*, No. 2:20-cv-00261 (E.D. Tex.); and *Longhorn HD LLC v. Trend Micro Inc.*, No. 2:20-cv-00348 (E.D. Tex.) as related matters. Paper 5, 1.

D. The ’790 Patent

The ’790 Patent is directed to “[a] network-based mobile workgroup system.” Ex. 1001, code (57). More particularly, the ’790 patent “describes a network-based mobile workgroup system that provides secure communication to and within an overlaid workgroup network while applying mobility management for the workgroup members.” *Id.* at 1:6–11. The ’790

patent has 101 claims, of which claim 1 is the sole independent claim. *Id.* at 20:60–28:28.

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–4 and 7 are unpatentable on the following ground:

Claims) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–4, 7	103	Akhtar ² , Schneider ³

(Pet. 5). Petitioner also relies on the Declaration of Dr. Wenke Lee (Ex. 1003) in support of its arguments.

II. ANALYSIS

Patent Owner disputes the grounds advanced against claims 1–4 and 7 in the Petition. Prelim. Resp. 1–4. However, Patent Owner has filed a statutory disclaimer of claims 1–4 and 7 in the ’790 patent. *Id.* at 1; Ex. 2001. Petitioner has not challenged the disclaimer in any manner.

According to our rules, a “patent owner may file a statutory disclaimer under 35 U.S.C. [§] 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e) (2019).

A disclaimer under 35 U.S.C. § 253(a) is “considered as part of the original patent” as of the date on which it is “recorded” in the Office.

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the ’790 patent’s effective filing date predates the AIA’s amendments to § 103, this decision refers to the pre-AIA version of § 103.

² US 6,769,000 B1, issued July 27, 2004 (Ex. 1004, “Akhtar”).

³ US 6,408,336, issued June 18, 2002 (Ex. 1005, “Schneider”).

35 U.S.C. § 253(a). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner “must:”

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee’s ownership interest in the patent; and

(4) Be accompanied by the fee set forth in 37 C.F.R. § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that a § 253 disclaimer is “recorded” on the date that the Office receives a disclaimer meeting the requirements of 37 C.F.R. § 1.321(a), and that no further action is required in the Office for a disclaimer to be “recorded”).

Here, Patent Owner filed a statutory disclaimer of claims 1–4 and 7 of the ’790 patent. Ex. 2001. Based on our review of Exhibit 2001 and Office public records, we conclude that a disclaimer of claims 1–4 and 7 of the ’790 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of January 17, 2022. Ex. 2001; *see also* Prelim. Resp. 1 (“[O]n January 17, 2022, Patent Owner filed a statutory disclaimer disclaiming the Challenged Claims pursuant to 37 C.F.R. §§ 1.321(a) and 42.107(c).”).

Because all challenged claims 1–4 and 7 have been disclaimed under 35 U.S.C. § 253(a), in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted. 37 C.F.R. § 42.107(e); *General Electric Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (declining to institute *inter partes* review when all challenged claims were disclaimed under 35 U.S.C. § 253(a)).

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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