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Paper 15
Entered: January 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLACK TECHNOLOGIES, LLC,
Petitioner,

v.

GINEGAR LLC,
Patent Owner.

IPR2022-00541 (Patent 9,367,521 B2)
IPR2022-00542 (Patent 9,760,865 B2)[1]

Before HYUN J. JUNG, MONICA S. ULLAGADDI, and MICHAEL T. CYGAN, *Administrative Patent Judges.*

JUNG, *Administrative Patent Judge.*

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

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[1] We exercise our discretion to issue one Order to be entered in each proceeding.

We instituted *inter partes* reviews of claims 1 and 2 of U.S. Patent No. 9,367,521 B2 ("the '521 patent") and claims 1–16 of U.S. Patent No. 9,760,865 B2 ("the '865 patent") in the above-captioned proceedings. IPR2022-00541, Paper 9; IPR2022-00542, Paper 8. Ginegar LLC ("Patent Owner") filed a Request for Adverse Judgment Under 37 C.F.R. § 42.73(b) in each proceeding because, in related litigation, "the Northern District of California issued an order finding that the claims of U.S. Patent No. 9,367,521 were not drawn to patent-eligible subject matter under 35 U.S.C. § 101," and Patent Owner states that it did not appeal that decision thereby making the decision final. IPR2022-00541, Paper 13, 2 (citing *Ginegar LLC v. Slack Techs., Inc.*, No. 22-cv-00044-WHO, 2022 U.S. Dist. LEXIS 102516 (N.D. Cal. June 8, 2022)).

Patent Owner also states that the same court found that "certain claims of U.S. Patent No. 9,760,865 were not drawn to patent-eligible subject matter under 35 U.S.C. § 101." IPR2022-00542, Paper 14, 2 (citing *Ginegar LLC v. Slack Techs., Inc.*, No. 22-cv-00044-WHO, 2022 U.S. Dist. LEXIS 102516 (N.D. Cal. June 8, 2022) and *Ginegar LLC v. Slack Techs., Inc.*, No. 22-cv-00044-WHO, 2022 U.S. Dist. LEXIS 186021 (N.D. Cal. Oct. 11, 2022)). Patent Owner further states that it did not appeal those decisions, thus making them final. *Id.* Patent Owner represents that it submitted a disclaimer for the remaining claims of the '865 patent. *Id.* (citing Ex. 2002); Ex. 2002 (disclaiming claims 2–7, 9, 11–16).

A party may request adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Having reviewed Patent Owner's requests and the cited decisions and exhibit, we determine that

entry of judgment against the Patent Owner with respect to claims 1 and 2 of the '521 patent and claims 1–16 of the '865 patent is appropriate.

ORDER

Accordingly, it is:

ORDERED that judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1 and 2 of U.S. Patent No. 9,367,521 B2 and claims 1–16 of U.S. Patent No. 9,760,865 B2;

FURTHER ORDERED that claims 1 and 2 of U.S. Patent No. 9,367,521 B2 and claims 1–16 of U.S. Patent No. 9,760,865 B2 are cancelled; and

FURTHER ORDERED that this Order constitutes a final written decision under 35 U.S.C. § 318(a) for each of the captioned proceedings.

IPR2022-00541 (Patent 9,367,521 B2)
IPR2022-00542 (Patent 9,760,865 B2)

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