

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP.,
Petitioner,

v.

FUTURE LINK SYSTEMS, LLC,
Patent Owner.

IPR2022-00688
Patent 7,917,680 B2

Before KARL D. EASTHOM, KEVIN C. TROCK, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)
Dismissing as Moot Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. *Background*

Realtek Semiconductor Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.” or “Petition”) to institute an *inter partes* review of claims 3–6 and 15–20 (“the challenged claims”) of U.S. Patent No. 7,917,680 B2 (Ex. 1001,

“the ’680 patent”). Petitioner also filed a Motion for Joinder (Paper 3) with *Qualcomm, Inc. v. Future Link Systems, Inc.*, IPR2021-01396 (“the Qualcomm IPR”). Future Link Systems, LLC (“Patent Owner”) did not file a preliminary response or respond to the Motion for Joinder. On September 9, 2022, counsel for Patent Owner emailed the Board (see Ex. 3001) to inform us that Patent Owner had filed a statutory disclaimer of the challenged claims (see Ex. 3002).

For the reasons discussed below we do institute an *inter partes* review as to the challenged claims. We also dismiss as moot Petitioner’s Motion for Joinder.

B. Real Party-in-Interest

Petitioner identifies itself as the only real party-in-interest. Pet. 3. Patent Owner identifies itself as the only real party-in-interest. Paper 8, 1.

C. Related Matters

Our docketing database informs us of the ’680 patent being (or having been) challenged in the following *inter partes* review proceedings of the Board: (1) *Intel Corp. v. Future Link Sys., LLC*, IPR2016-01401 (terminated by settlement after institution); (2) *Realtek Semiconductor Corp. v. Future Link Sys., LLC*, IPR2021-01182 (instituted Jan. 7, 2022, as to claims 1, 2, and 7–14); (3) *Qualcomm, Inc. v. Future Link Sys., LLC*, IPR2021-01396 (“the Qualcomm IPR”) (terminated by settlement after institution); and (4) *Apple Inc. v. Future Link Sys., LLC*, IPR2022-00209 (terminated by settlement prior to institution decision).

Petitioner informs us of the ’680 patent being challenged in the above proceedings (2)–(4) and also in the following district court proceedings: (5) *Future Link Sys., LLC v. Realtek Semiconductor Corp.*, No. 6:21-cv-00363 (W.D. Tex.) (the “underlying litigation”); (6) *Future Link Sys., LLC v.*

Amlogic Holdings, Ltd., No. 1:21-cv-00634 (D. Del.); (7) *Future Link Sys., LLC v. Apple Inc.*, No. 6:21-cv-00263 (W.D. Tex.); (8) *Future Link Sys., LLC v. Broadcom Inc.*, 6:21-cv-00264 (W.D. Tex.); (9) *Future Link Sys., LLC v. Qualcomm, Inc.*, 6:21-cv-00265 (W.D. Tex.) (the “parallel proceeding”); and (10) *Intel Corp. v. Future Link Sys., LLC*, No. 1:14-cv-00377 (D. Del.). Pet. 3–4.

Patent Owner informs us of the ’680 patent being challenged in the above proceeding (2). Paper 8, 1.

Petitioner notes that the instant Petition is its second petition filed against the ’680 patent. Pet. 1. Petitioner explains that the instant Petition was necessitated because Patent Owner asserted additional claims against Petitioner in the underlying litigation after the filing of the first petition in IPR2021-01182. *Id.*

II. ANALYSIS

A. Statutory Disclaimer

Under 37 C.F.R. § 42.107(e), 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.” Under 35 U.S.C. § 253(a), a statutory disclaimer “shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent.” A disclaimer filed under 35 U.S.C. § 253(a) will be “considered as part of the original patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never

existed.”). For a disclaimer to be “recorded” in the Office, the document filed by a 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*, 162 F.3d at 1382 (holding that a § 253 disclaimer is immediately “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). “No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e); *see also General Electric Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9, 3 (PTAB July 6, 2017) (precedential).

Based on our review of Exhibit 3002, which was obtained from Office public records, we conclude that a disclaimer of claims 3–6 and 15–20 of the ’680 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of September 9, 2022. *See* Ex. 3002. The disclaimer is signed by Patent Owner’s attorney of record, Michael L. Bartholomew. *Id.* at 1. The disclaimer also identifies the ’680 patent; identifies that claims 3–6 and 15–20 are disclaimed; and states that Future Link Systems is the owner of the ’680 patent by virtue of an assignment recorded at Reel 032399 and Frame 0965. *Id.* A fee worksheet and receipt for the requisite fee also accompany the disclaimer. *Id.* at 3–6.

Because Patent Owner has filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) that disclaims all of the challenged claims in this case—namely, claims 3–6 and 15–20—we will not institute *inter partes* review.¹ 37 C.F.R. § 42.107(e); *see also General Electric*, IPR2017-00491, Paper 9, at 3.

B. Motion for Joinder

Petitioner moves for joinder (*see* Paper 3) with the Qualcomm IPR, but we will not be instituting *inter partes* review based on the Petition. In addition, the Qualcomm IPR has now been terminated based on a settlement. *See* IPR2021-01396, Paper 11. Accordingly, we *dismiss as moot* Petitioner’s Motion for Joinder.

III. CONCLUSION

For the foregoing reasons, we do not institute an *inter partes* review of claims 3–6 and 15–20 of the ’680 patent.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied as to claims 3–6 and 15–20 of the ’680 patent, and no *inter partes* review is instituted; and

FURTHER ORDERED that Petitioner’s Motion for Joinder is *dismissed as moot*.

¹ We note that the statutory disclaimer appears to have no impact on the pending *inter partes* review in IPR2021-01182, which challenges claims 1, 2, and 7–14 of the ’680 patent.

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