

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP.,
Petitioner

v.

FUTURE LINK SYSTEMS, LLC,
Patent Owner.

IPR2022-01071
Patent 8,099,614 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
AARON W. MOORE *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)

I. BACKGROUND

On June 8, 2022, Realtek Semiconductor Corporation (“Petitioner”) filed a Petition seeking an *inter partes* review of all claims (1–19) of U.S. Patent No. 8,099,614B2 (“the ’614 patent”). *See* Paper 1, 1.

On September 22, 2022, Future Link Systems, LLC (“Patent Owner”) filed a Preliminary Response stating that it had “filed a disclaimer under 35 U.S.C. § 253 dedicating all claims of the ’614 Patent to the public” and that, accordingly, “no trial should be instituted on the Petition.” Paper 6, 1.

Patent Owner filed a copy of the referenced disclaimer as Exhibit 2001, and the Office’s records show that it was received and acknowledged on September 9, 2022.

On December 8, 2022, the panel advised Patent Owner that the Exhibit 2001 disclaimer was ineffective because the power of attorney for the attorney who signed it had been rejected for failure to include the statement required by 37 CFR 3.73(c), meaning that the disclaimer was not “signed by the patentee, or an attorney or agent of record,” as required 37 CFR 1.321(a).

On December 9, 2022, Patent Owner filed a new disclaimer of claims 1–19, dated that day, along with a copy of the previously rejected power of attorney accompanied by a 37 CFR 3.73(c) statement. A copy of the new disclaimer is entered in this proceeding as Exhibit 3001.

II. ANALYSIS

The Board will not institute an *inter partes* review when a Patent Owner has disclaimed all claims challenged in the Petition. *See* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”); *General Electric Co. v. United Techs. Co. et al.*, IPR2017-00491,

Paper 9 (PTAB July 6, 2017) (precedential); *see also* 35 U.S.C. § 253(a) (providing that a patentee may disclaim); 37 CFR § 1.321(a) (requirements for disclaimer).

Our review of the record shows that Patent Owner has now filed a disclaimer meeting the requirements of § 1.321(a) and that all of the challenged claims have therefore been disclaimed. For that reason, the Petition is *denied* and we do not institute an *inter partes* review.

III. ORDER

It is ORDERED that no *inter partes* review is instituted in this proceeding.

PETITIONER:

Christopher J. Higgins
Jeffrey Johnson
ORRICK, HERRINGTON & SUTCLIFFE, LLP
OCHPTABDocket@orrick.com
chiggins@orrick.com
3J6PTABDocket@orrick.com
P52PTABDocket@orrick.com
realtek-fls_ohs@orrick.com

PATENT OWNER:

Reza Mirzaie
James Milkey
RUSS, AUGUST & KABAT
rmirzaie@raklaw.com
jmilkey@raklaw.com