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Paper 21
Date: June 30, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
Petitioner,

v.

DALI WIRELESS INC.,
Patent Owner.

IPR2020-01473
Patent 10,080,178 B2

Before MELISSA A. HAAPALA, *Senior Lead Administrative Patent Judge*, and KARL D. EASTHOM and SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

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

CommScope v. Dali Wireless
CommScope Exhibit 1005

CommScope Technologies LLC ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–30 (the "challenged claims") of U.S. Patent No. 10,080,178 B2 (Ex. 1001, the "'178 patent"). Dali Wireless Inc. ("Patent Owner") filed a preliminary response. Paper 9. After supplementary briefing, the Board instituted trial on the challenged claims. Paper 18 (Decision on Institution).

Thereafter, Patent Owner filed a Motion to Amend. Paper 20. In its Motion to Amend, Patent Owner moves to cancel the challenged claims under 35 U.S.C. § 316 and 37 C.F.R. § 42.121, and further states "[t]here are no remaining claims at issue in this trial." Motion to Amend 1.

The Board construes an action cancelling or disclaiming claims such that no challenged claims remain in the trial as a request for adverse judgment. 37 C.F.R. § 42.73(b)(2) ("Actions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial."); *see also McAfee, Inc. v. CAP Co., Ltd.,* IPR2016-00211, Paper 19 (PTAB, April 5, 2017) (entering adverse judgment based on motion to amend seeking cancellation of claims remaining in the trial).

During a teleconference with the parties on June 16, 2021, the panel discussed with the parties the applicability of 37 C.F.R. § 42.73(b)(2). Petitioner argued that adverse judgment under 37 C.F.R. § 42.73(b)(2) is proper because the Motion to Amend seeks to cancel all the remaining claims in the trial. Patent Owner disagreed, arguing that Patent Owner did not request an adverse judgment, did not file a brief on the issue, and that by moving to cancel claims early in the trial process, Patent Owner attempted to

promote efficiency and an early resolution so that termination under 37 C.F.R. § 42.72 is proper.

Under 37 C.F.R. § 42.72, "[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a)." In this case, there is no "consolidat[ion] . . . or a joint request under 35 U.S.C. 317(a) or 327(a)."

Petitioner's arguments are more persuasive. Under 37 C.F.R. § 42.73(b)(2), "[a]ctions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial." In this case, the Board instituted trial and Patent Owner filed a Motion to Amend seeking to cancel all claims remaining in the trial and acknowledging that "[t]here are no remaining claims at issue in this trial." Motion to Amend 1. Accordingly, we construe Patent Owner's Motion to Amend as a request for adverse judgment and grant the request to cancel all remaining claims in the trial.

ORDER

Accordingly, it is

ORDERED that Patent Owner's request for adverse judgment is *granted*;

FURTHER ORDERED that claims 1–30 shall be *cancelled*; and

FURTHER ORDERED that final judgment is entered against Patent Owner with respect to claims 1–30.

PETITIONER:

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