

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

THL HOLDING COMPANY, LLC,
Patent Owner.

IPR2024-00400
Patent 11,350,246 B2

Before CHRISTOPHER M. KAISER, SHEILA F. McSHANE, and
ELIZABETH J. REAGAN, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER TO SHOW CAUSE
37 C.F.R. § 42.5(a)

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 20–27 (“the challenged claims”) of U.S. Patent No 11,350,246 B2 (Ex. 1001, “the ’246 patent”). THL Holding Company, LLC (“Patent Owner”) did not file a Preliminary Response. We determined that the information presented in the Petition established a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims, and, accordingly, we instituted an *inter partes* review. Paper 7 (“Dec.”). Following our decision on institution, Patent Owner filed a disclaimer of claims 20–27, followed a day later by a Request for Rehearing. Paper 9 (“Req. Reh’g”); Ex. 2001.

II. DISCUSSION

Patent Owner requests rehearing of our decision instituting review. Req. Reh’g 1–6. The Request for Rehearing is based on Patent Owner’s statutory disclaimer of claims 20–27 of the ’246 patent. *Id.* at 3 (citing Ex. 2001).

“A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include . . . disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b)(2). Here, the only claims in the trial are claims 20–27, all of which have been disclaimed. Dec. 26; Ex. 2001, 3. Accordingly, we construe Patent Owner’s disclaimer as a request for adverse judgment that would moot the Request for Rehearing.

Upon the occurrence of an action that is construed as a request for adverse judgment (as opposed to the filing of a clear request for adverse judgment), our typical procedure is to enter an order to show cause why

adverse judgment should not be entered. *See Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01124, Paper 14, 4 (PTAB Dec. 21, 2022) (precedential). Accordingly, we enter such an order here. To the extent Patent Owner does not intend for the disclaimer of claims 20–27 to be treated as a request for adverse judgment, it should file a paper explaining why we should not enter adverse judgment. Alternatively, Patent Owner may clarify that adverse judgment should be entered. In either case, we hold Patent Owner’s Request for Rehearing in abeyance until the adverse-judgment issue is resolved.

III. ORDER

It is hereby

ORDERED that Patent Owner is authorized to file a paper, not later than one week after the entry of this order, either requesting the entry of adverse judgment or showing cause why adverse judgment should not be entered; and

FURTHER ORDERED that Patent Owner’s Request for Rehearing is held in abeyance until such time as the adverse-judgment issue is resolved.

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FOR PETITIONER:

Jennifer C. Bailey
Callie A. Pendergrass
Christina Canino
ERISE IP, P.A.
PTAB@eriseip.com

FOR PATENT OWNER:

John S. LeRoy
Frank A. Angileri
Marc Lorelli
BROOKS KUSHMAN P.C.
THLC0104IPR2@brookskushman.com