

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC. AND DELL TECHNOLOGIES INC.,
Petitioner,

v.

SOFTEX LLC,
Patent Owner.

IPR2024-00564
Patent 8,506,649 B2

Before THU A. DANG, MICHELLE N. WORMMEESTER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

JUDGMENT

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

I. DISCUSSION

Dell Inc. and Dell Technologies Inc. (collectively “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–25 (“the challenged claims”) of U.S. Patent No. 8,506,649 B2 (Ex. 1001, “the ’649 patent”). Paper 2 (“Petition”). Along with the Petition, Petitioner filed a Motion for Joinder to *inter partes* review IPR2023-01185. Paper 3 (“Motion”).

Before institution, Softex LLC (“Patent Owner”) statutorily disclaimed claims 1–25 of the ’649 patent, leaving no claim remaining in the patent for consideration. *See* Ex. 3001 (“Statutory Disclaimer”).

A disclaimer is “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). For a disclaimer to be “recorded” in the Office, the document filed by the 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). “[N]othing in the statutes or regulations requires any action by the [Patent Office] for a disclaimer to be ‘recorded.’” *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998). From our review of Exhibit 3001 and the Office’s public records, we conclude that a disclaimer of claims 1–25 of the ’649 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of February 28, 2024. Ex. 3001.

Our Rules provide that “[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.” 37 C.F.R. § 42.73(b)(2). Patent Owner’s disclaimer of claims 1–25 leaves no claim remaining in the trial. Therefore, pursuant to our Rules, we construe this disclaimer as a request for adverse judgment, which we grant.

II. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b)(2).

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