

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

PROXSENSE LLC,
Patent Owner.

IPR2024-00776¹
IPR2024-01328
Patent 9,298,905 B1

Before THU A. DANG, KEVIN F. TURNER, and DAVID C. McKONE,
Administrative Patent Judges.

TURNER, *Administrative Patent Judge.*

JUDGMENT

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

¹ This Decision addresses multiple requests for adverse judgment in the related *inter partes* reviews listed. Therefore, we issue one Decision to be filed in both cases. The parties, however, are not authorized to use this style of filing in subsequent papers.

Microsoft Corporation filed two Petitions on August 20, 2024: a first, requesting *inter partes* review of claims 1, 3–7 and 9, 10, 12, 13, and 15–18 of U.S. Patent No. 9,298,905 B1 (“the ’905 Patent”) (Paper 2, IPR2024-00776); and a second requesting *inter partes* review of claims 1, 3–7, 9, 10, and 12–18 of the ’905 Patent (Paper 3, IPR2024-01328). Proxense, LLC (“Patent Owner”) filed a Patent Owner’s Preliminary Response (Paper 8) in the first proceeding. No Decision on Institution has been made in either proceeding.

On November 6, 2024, Patent Owner filed a Request for Adverse Judgment in each proceeding, indicating to the Board that it had filed a statutory disclaimer under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) of all claims at issue in each *inter partes* review proceeding, “thereby redering the proceedings moot.” Paper 9, 2, IPR2024-00776. Paper 8, 2, IPR2024-01328. Copies of the disclaimer, as well as electronic acknowledgement receipt of its filing, were also filed in each proceeding. Ex. 2009, IPR2024-00776; Ex. 2001, IPR2024-01328.

A party may request adverse judgment against itself at any time. 37 C.F.R. § 42.73(b). Here, Patent Owner requests adverse judgment in each proceeding because no claims remain in the trial after Patent Owner’s disclaimer of all the claims at issue in this proceedings. *See* 37 C.F.R. § 42.73(b)(2). We *grant* Patent Owner’s requests and enter judgment against Patent Owner under 37 C.F.R. § 42.73(b) in both proceedings.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for adverse judgment is *granted*, and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1, 3–7, 9, 10, and 12–18 of U.S. Patent No. 9,298,905 B1.

IPR2024-00776, IPR2024-01328
Patent 9,298,905 B1

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