

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,
Patent Owner.

IPR2024-00957
Patent 7,454,056 B2

Before KRISTEN L. DROESCH, GEORGE R. HOSKINS, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

JUDGMENT

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

In this matter, Petitioner requested *inter partes* review of claims 1–18 of U.S. Patent No. 7,454,056 B2 (Ex. 1001, “the ’056 patent”). *See* Paper 1 (Petition), 1.

On January 8, 2025, the Board *granted* institution of review as to claims 1–8, 10–16, and 18, but *denied* institution of review as to claims 9 and 17 because those claims were disclaimed by Patent Owner prior to institution. *See* Paper 7 (Decision Granting Institution of *Inter Partes* Review), 1, 38–39; Ex. 2002 (Statutory Disclaimer of claims 9 and 17).

On May 16, 2025, Patent Owner filed a Request for Adverse Judgment against itself under 37 C.F.R. § 42.73(b)(2), with respect to claims 1–18 of the ’056 patent. *See* Paper 14. In support, Patent Owner asserts that it “has no remaining claims in this *inter partes* review” because “[o]n May 7, 2025, Patent Owner filed a statutory disclaimer under 37 C.F.R. § 1.321(a) disclaiming all remaining claims at issue in this proceeding, namely, claims 1–8, 10–16, and 18 of the ’056 [p]atent.” *Id.* at 2 (citing Ex. 2003).

The record before us establishes that Patent Owner statutorily disclaimed claims 1–8, 10–16, and 18 on May 7, 2025. *See* Ex. 2003. That disclaimer: was signed by Cliff Crawford, a registered patent practitioner of record representing Patent Owner; identified claims 1–18 of the ’056 patent as being disclaimed; stated Patent Owner is the 100% owner of the ’056 patent; and was accompanied by the requisite fee. *See id.*; 35 U.S.C. § 253(a) (listing the requirements for a disclaimer to be “recorded” in the Office); *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding § 253 disclaimer is immediately “recorded” on date the

USPTO receives a disclaimer meeting the requirements of 35 C.F.R. § 1.321(a), and no further action is required in the USPTO).

A party may request entry of adverse judgment against itself at any time during an *inter partes* review proceeding. *See* 37 C.F.R. § 42.73(b).

“Actions construed to be a request for adverse judgment include:

(1) Disclaimer of the involved application or patent; [and] (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” *Id.* That is the case here, where Patent Owner has disclaimed claims 1–8, 10–16, and 18, the only claims remaining in the present trial.

Under these circumstances, entry of judgment adverse to the Patent Owner is appropriate as to those claims.

However, adverse judgment is not appropriate as to claims 9 and 17, because review was not instituted as to those claims.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s Request for Adverse Judgment is *granted* as to claims 1–8, 10–16, and 18, but *denied* as to claims 9 and 17; and

FURTHER ORDERED that adverse judgment is entered against Patent Owner with respect to claims 1–8, 10–16, and 18 of the ’056 patent.

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