

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.,
Petitioner,

v.

OPTRONIC SCIENCES LLC,
Patent Owner.

IPR2024-01134
Patent 9,406,733 B2

Before THU A. DANG, BENJAMIND. M. WOOD, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

JUDGMENT

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

I. DISCUSSION

BOE Technology Group Co., LTD. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–5 (the “challenged claims”) of U.S. Patent No. 9,406,733 B2 (Ex. 1001, “the ’733 patent”). Paper 1 (“Petition” or “Pet.”). In response to the Petition, we instituted *inter partes* review of the challenged claims. *See* Paper 14 (“Dec. Inst.”).

After institution, Optronics Sciences, LLC (“Patent Owner”) statutorily disclaimed the entire term of the ’733 patent, leaving no patent and thus no claim remaining in the patent for consideration. *See* Ex. 2005 (“Statutory Disclaimer”). In its Response to the Petition, Patent Owner contends that “this IPR is now moot and should be terminated.” PO Resp. 1.

In its Reply, Petitioner argues that “mere termination is improper,” and that “an adverse judgment should be entered against Patent Owner under 37 C.F.R. § 42.73(b).” Pet. Reply 1. According to Petitioner, treating Patent Owner’s disclaimer as a request for adverse judgment is consistent with § 42.73(b), wherein such “request for termination without adverse judgment would avoid the estoppel provision of [§] 42.73(d)(3), which could prejudice Petitioner.” *Id.* at 2. Petitioner argues that it has incurred significant cost and effort, wherein Patent Owner should not be able to “avoid the resolution of issues presented in the Petition simply by disclaiming the patent without prejudice to Patent Owner’s ability to later pursue patentably indistinct claims or inconsistent positions.” *Id.* at 3.

In its Sur-reply, Patent Owner argues that an entry of adverse judgment “has negative effects that would discourage Patent Owner from making efforts to streamline the issues,” resulting in “increased complexity in litigation, increased constraints on the resources of the Board, and increased costs for the parties to reach a final written decision.” PO Sur-

reply 1–2. Further, Patent Owner contends that it “will not seek any sort of reissue patent that are patentably indistinct from the disclaimed claims.” *Id.* at 3.

We determine that Petitioner has the better position. Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. “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.” 37 C.F.R. § 42.73(b)(2). “The application of the [adverse judgment] rule on its face does not turn on the patentee’s characterization of its own request.” *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1349 (Fed. Cir. 2018).

In this case, Patent Owner’s disclaimer of the entire term of the ’733 patent leaves no claims remaining in the trial. Although Patent Owner argues that entry of adverse judgment “has negative effects that would discourage Patent Owner from making efforts to streamline the issues” (PO Sur-reply 1–2), we deem such argument not a persuasive reason as to why we should not apply § 42.73(b)(2), or why termination is more appropriate. Therefore, pursuant to 37 C.F.R. § 42.73(b)(2), we construe Patent Owner’s disclaimer as a request for adverse judgment, which we grant.

II. ORDER

Accordingly, it is

ORDERED that Patent Owner’s request for termination is *denied*; and

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

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