

Filed on behalf of Western Digital Technologies, Inc.

By: Michelle E. Armond

Douglas R. Wilson

Joseph Li

Monica Arnold

Yue Han

ARMOND WILSON LLP

4685 MacArthur Court, Suite 390

Newport Beach, CA 92660

Telephone: (949) 932-0778

Email: ipr@armondwilson.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case No. IPR2024-01448
U.S. Patent No. 11,737,372

PETITIONER'S PRELIMINARY REPLY

(Authorized by Email on 2/14/2025)

In response to the Petition, IP Bridge disclaimed all claims 1–8 of the '372 Patent. EX2017. Western Digital requested this reply after IP Bridge repeatedly refused to agree not to seek patent claims of the same or similar scope in its other patents. IP Bridge has 9 other patents in this family sharing the same specification. To date, IP Bridge has asserted eight of the patents in this family against Western Digital. EX1067. Adverse judgment under 37 C.F.R. § 42.73(b) will ensure that IP Bridge does not avoid trial now and then seek to recapture the disclaimed claim scope later.

The Board plainly has authority to enter adverse judgment here: “37 C.F.R. § 42.73(b) permits the Board to enter an adverse judgment when a patent owner cancels all claims at issue after an IPR petition has been filed, but before an institution decision.” *Arthrex v. Smith & Nephew*, 880 F.3d 1345, 1350 (Fed. Cir. 2018). Entering adverse judgment triggers estoppel, ensuring IP Bridge cannot seek any “claim that is not patentably distinct from a finally refused or canceled claim” in other proceedings. 37 C.F.R. § 42.73(d)(3)(i). “Construing a statutory disclaimer of all the challenged claims as a request for adverse judgment aligns with the policies underlying the estoppel provision of [PTO] rules.” *Google v. Seven Networks*, IPR2018-01103, 2018 WL 6436742, at *4 (P.T.A.B. Dec. 6, 2018).

IP Bridge professes no current intent to pursue claims of the same or similar scope in future proceedings with another related patent, yet refuses to give its word.

It would be unfair for IP Bridge to duck institution here while keeping its options open as the litigation unfolds. A “termination of this proceeding that does not include an adverse judgment would allow Patent Owner to seek patentably indistinct claims” in the future. *Smith & Nephew v. Arthrex*, IPR2016-00917, Paper 12 at 5 (P.T.A.B. Sept. 21, 2016), *aff’d*, 880 F.3d 1345 (Fed. Cir. 2018).

The disclaimed ’372 Patent is but one member of a 10-patent family all sharing the same specification. EX1019. IP Bridge’s abrupt decision last month to abandon the two remaining patent applications 18/232,576 and 18/642,280 facing prior art rejections in no way bars it from seeking claim amendments in its other issued patents through reexamination, reissue, or motions to amend in pending IPR2024-01384, -01385, -01386, -01447, -01449, -01493, or -01494.

Here, IP Bridge disclaimed claims requiring a tunnel barrier layer with oxygen vacancy defects, e.g., an “MgOx” layer. EX1015 (’372 Patent, claim 1). Its other patents, including those facing IPR petitions, also purport to claim an MgO tunnel barrier layer with oxygen vacancy defects. *E.g.*, EX1001 (’403 Patent, claim 1); EX1011 (’138 Patent, claim 1); EX1013 (’167 Patent, claim 7). Asserting it cannot seek “broadening amendments” is misdirection because limiting claims to the specific ranges of oxygen vacancy defects it disclaimed (*e.g.*, MgOx where “ $0 < x < 1$,” “ $0.9 < x < 1$,” “ $0.98 < x < 1$,” or “ $0.99 < x < 1$ ”) is of course a narrowing amendment. *See* 2/13/2025 Email Requesting Authorization; EX1015 (’372 Patent, claims 1–8).

In any event, IP Bridge’s request for a denial of institution is not dispositive. The application of the Board’s adverse judgment rule “does not turn on the patentee’s characterization of its own request, and such a construction would make no sense” and render the rule “a nullity.” *Arthrex*, 880 F.3d at 1349.

IP Bridge next asserts “that institution of a trial here would be improper” following its disclaimer, Paper 8 at 1, and that the Board has “repeatedly declined to enter adverse judgment in cases like this,” 2/13/2025 Email. In its POPR, IP Bridge cites four pre-*Arthrex* PTAB decisions to support its request for a denial of institution: *Tandus*, *Inguran*, *Borealis*, and *Coolit*. Paper 8 at 1. None of those four cases addressed a request for adverse judgment, and IP Bridge offers nothing explaining why a denial of institution is mandated following *Arthrex*. *See id.* IP Bridge’s refusal to actually commit not to pursue the disclaimed claim scope in the other asserted patents or future Office proceedings underscores the need for adverse judgment here. *See* 2/13/2025 Email.

The Board should hold IP Bridge to its stated intent not to pursue these same claims in its other patents and enter adverse judgment to ensure it.

ARMOND WILSON LLP

Dated: February 24, 2025

By: /Michelle E. Armond/

Michelle E. Armond (Reg. No. 53,954)

Douglas R. Wilson (Reg. No. 54,542)

Joseph Li (Reg. No. 74,998)

Western Digital v. Godo Kaisha IP Bridge
U.S. Patent No. 11,737,372 – IPR2024-01448

Monica Arnold (Reg. No. 77,262)
Yue Han (Reg. No. 80,950)
Attorneys for Western Digital Technologies, Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **PETITIONER’S PRELIMINARY REPLY** is being served electronically on February 24, 2025 to the following counsel for Patent Owner to the following email addresses:

Gerald B. Hrycyszyn
GHrycyszyn-PTAB@wolfgreenfield.com

Jie Xiang
JXiang-PTAB@wolfgreenfield.com

Thomas A. Franklin
TFranklin-PTAB@wolfgreenfield.com

ARMOND WILSON LLP

Dated: February 24, 2025

By: /Michelle E. Armond /
Michelle E. Armond (Reg. No. 53,954)
Douglas R. Wilson (Reg. No. 54,542)
Joseph Li (Reg. No. 74,998)
Monica Arnold (Reg. No. 77,262)
Yue Han (Reg. No. 80,950)
Attorneys for Western Digital Technologies, Inc.