

Filed on behalf of Patent Owner by:

Paper No. ____

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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

Patent No. 11,737,372

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY IN
SUPPORT OF ITS PETITION**

LISTING OF EXHIBITS

Exhibit	Description
2001	RESERVED
2002	RESERVED
2003	RESERVED
2004	RESERVED
2005	RESERVED
2006	RESERVED
2007	RESERVED
2008	RESERVED
2009	RESERVED
2010	RESERVED
2011	RESERVED
2012	RESERVED
2013	RESERVED
2014	RESERVED
2015	RESERVED
2016	RESERVED
2017	Statutory Disclaimer Under 37 C.F.R. § 1.321(a)

The Board should deny institution without entering adverse judgment because (1) the Board has no authority to enter adverse judgment on these facts; (2) even if the panel believes that the Board has the authority, a precedential Board decision and the weight of the Board’s decisions show a clear policy directive to not enter adverse judgment on these facts; and (3) Petitioner’s assertion that there is a risk of Patent Owner recapturing the disclaimed claim scope is false.

No Authority—“[d]isclaimed claims are treated as if they never existed.” *Raytheon Tech. v. General Electric*, 993 F.3d 1374, 1379 n.4 (Fed. Cir. 2021). Thus, the Federal Circuit held that a district court “lacked authority to disinter the already disclaimed claims and declare them invalid. Accordingly, we vacate the court’s judgment concerning the disclaimed claims.” *Sanofi-Aventis v. Dr. Reddy’s Labs.*, 933 F.3d 1367, 1374-75 (Fed. Cir. 2019). As a Board panel has recognized, “[i]f the claims never existed, we cannot have exercised jurisdiction over the disclaimed claims and therefore cannot enter adverse judgment against them.” *Pfizer v. UniQure*, IPR2020-00388, Paper 52 at 4 (PTAB March 25, 2021).

Petitioner says *Arthrex* supports the Board’s authority to enter adverse judgment here. Reply, 1. Not so. In *Arthrex*, the patent owner waived “any argument that [Rule 42.73(b) authorizing adverse judgment on claims disclaimed *pre*-institution is] not authorized by the statute,” 880 F.3d 1345, 1349 (Fed. Cir. 2018), so the Court did “not decide whether the PTO had authority to adopt this

regulation.” *Id. Arthrex* only addressed whether “the Board’s interpretation of [Rule 42.73(b)] is consistent with the text of that regulation.” *Id.* at 1351. Had the Board’s authority to adopt a rule authorizing adverse judgment on claims disclaimed pre-institution been presented, two judges suggested the outcome would have been different. *Id.* at 1351 (Judge O’Malley “question[ed] the Board’s authority to issue adverse judgments prior to institution” and stated “it is unclear to me why the Board would have the authority to take any other action [*e.g.*, enter adverse judgment]—particularly prior to institution—with respect to disclaimed claims.”); *id.* at 1353 (Judge Newman stated: “Adverse judgment against disclaimed claims without institution of trial is not available by statute, and is contrary to [37 C.F.R. § 42.107(e)].”).

Board Policy—even if the panel believes that entry of adverse judgment is authorized, it is not compelled and would be against Board policy. After the Board panel entered adverse judgment in the case at issue in *Arthrex*, the Board made precedential *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9, 7-8 (PTAB July 6, 2017) (precedential) (denying institution without entering adverse judgment where all claims were disclaimed pre-institution). In a subsequent case, the Board denied a request for adverse judgement because “the precedential decision in [*GE*], denied institution, and did not enter adverse judgment” where all challenged claims were disclaimed pre-institution. *Gen. Elec. v. United Techs.*,

IPR2019-01489, Paper 11 at 3–4 (PTAB Dec. 10, 2019) (“a denial of institution, and not an adverse judgment against Patent Owner, is the appropriate vehicle for disposing of this case.”). Post-*Arthrex* panels routinely come out the same way. *See e.g., Samsung Elecs. v. Ouraring*, IPR2024-01079, Paper No. 9 (PTAB Jan. 7, 2025); *Bestway v. Intex Marketing*, PGR2024-00036, Paper No. 9 (PTAB Oct. 28, 2024); *Celltrion v. Regeneron*, PGR2021-00117, Paper No. 16 (PTAB March 15, 2022); *Opus KSD v. Incisive Surgical*, IPR2017-01438, Paper 14 at 7-8 (PTAB Nov. 15, 2017) (permitting pre-institution disclaimers without adverse judgement “encourages ...the efficient resolution of disputes early in the proceeding and the conservation of limited Board resources.”).

Petitioner relies on *Arthrex* and a single PTAB case that issued shortly thereafter, but ignores the ***precedential*** *GE* case and the vast majority of Board decisions that declined to enter adverse judgement when all challenged claims were disclaimed pre-institution. POPR, 1-2, EX2017.

No Recapture – unlike the underlying facts in *Arthrex*, there is no continuation pending here. Petitioner’s assertion that Patent Owner could “recapture the disclaimed claim scope” (Reply, 1) in other issued patents “through reexamination, reissue, or motions to amend in [IPRs]” (*id.*, 2) is false because those proceedings authorize only narrowing amendments and every other patent in the family has limitations absent from the disclaimed claims.

Respectfully submitted,

Date: February 27, 2025

/Gerald B. Hrycyszyn/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on February 27, 2025, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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Date: February 27, 2025

/Dara Del Rosario/
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