

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.

IPR2024-01448
Patent 11,737,372 B2

Before JUSTIN T. ARBES, SHEILA F. McSHANE, and
JOHN D. HAMANN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)

I. INTRODUCTION

A. Background and Summary

Petitioner Western Digital Technologies, Inc. filed a Petition (Paper 1) requesting *inter partes* review of claims 1–8 of U.S. Patent No. 11,737,372 B2 (Ex. 1015, “the ’372 patent”) pursuant to 35 U.S.C. § 311(a). Patent Owner Godo Kaisha IP Bridge 1 filed a Preliminary Response (Paper 8,

“Prelim. Resp.”) pursuant to 35 U.S.C. § 313. Pursuant to our authorization provided by email, Petitioner filed a Preliminary Reply (Paper 9, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-Reply (Paper 10, “Prelim. Sur-Reply”). For the reasons that follow, we do not institute an *inter partes* review.

B. Related Matters

The parties indicate that the ’372 patent is the subject of *Godo Kaisha IP Bridge 1 v. Western Digital Technologies, Inc.*, No. 24-cv-06555 (N.D. Cal.) (transferred from D. Del.), and *Godo Kaisha IP Bridge 1 v. Seagate Technology LLC*, No. 24-cv-03691 (D. Minn.) (transferred from D. Del.). See Paper 4, 2; Paper 5, 1. Petitioner filed petitions challenging patents related to the ’372 patent in IPR2024-01384, IPR2024-01385, IPR2024-01386, IPR2024-01447, IPR2024-01449, IPR2024-01493, IPR2024-01494, and IPR2025-00701.

II. ANALYSIS

Patent Owner argues that the Petition should be denied under 37 C.F.R. § 42.107(e) because Patent Owner filed a statutory disclaimer (Ex. 2017) “disclaiming claims 1–8 of the ’372 patent under 35 U.S.C. § 253(a) and in compliance with 37 C.F.R. § 1.321(a), using the form approved for such submissions by the Office and accompanied by the appropriate fee.” Prelim. Resp. 1–2.

Petitioner responds that we should enter adverse judgment against Patent Owner under 37 C.F.R. § 42.73(b) because Patent Owner “has [nine] other patents in this family sharing the same specification” as the ’372 patent and this would ensure that Patent Owner “does not avoid trial now and then

seek to recapture the disclaimed claim scope later” during “reexamination, reissue, or motions to amend” in the related proceedings. Prelim. Reply 1–2. According to Petitioner, we have authority to enter adverse judgment under *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir. 2018), where the Court held that “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.” Prelim. Reply 1.

Patent Owner disputes whether we have authority to enter adverse judgment, as disclaimed claims are treated as if they never existed and the Court in *Arthrex* only addressed whether “the Board’s interpretation [of 37 C.F.R. § 42.73(b)] is consistent with the language of the regulation” and expressly declined to “reach the questions of whether the regulation is authorized by the statute or whether, if so, it was properly promulgated.” *See Arthrex*, 880 F.3d at 1350–51; Prelim. Sur-Reply 1–2. Regardless, though, Patent Owner argues that we should deny institution and not enter adverse judgment based on the Board’s precedential decision in *General Electric Company v. United Technologies Corporation*, IPR2017-00491, Paper 9 at 2–3 (PTAB July 6, 2017) (designated precedential on Sept. 9, 2019). Prelim. Sur-Reply 2–3.

Under 37 C.F.R. § 42.107(e), a “patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent,” and “[n]o *inter partes* review will be instituted based on disclaimed claims.” Based on our review of Exhibit 2017 and Office public records, we conclude that a disclaimer of claims 1–8 of the ’372 patent under 35 U.S.C. § 253(a) was recorded in the Office as of January 21, 2025. Because all claims challenged

by Petitioner have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), we deny institution of an *inter partes* review and do not enter adverse judgment against Patent Owner. *See* 37 C.F.R.

§ 42.107(e); *General Electric*, Paper 9 at 2–3. Numerous other Board decisions subsequent to *General Electric* being made precedential have followed this approach in similar circumstances, and Petitioner points to no authority to the contrary. *See* Prelim. Reply 1–3; *Samsung Elecs. Co., Ltd. v. Ouraring, Inc.*, IPR2024-01079, Paper 9 (PTAB Jan. 7, 2025) (denying institution based on statutory disclaimer and declining to enter adverse judgment); *Select Sires Inc. v. ABS Global, Inc.*, PGR2022-00019, Paper 10 (PTAB June 28, 2022) (same), Paper 13 (PTAB Oct. 25, 2022) (same); *Kymera Therapeutics, Inc. v. Dana-Farber Cancer Inst., Inc.*, PGR2021-00115, Paper 13 (PTAB Mar. 2, 2022) (same); *Google LLC v. Jenam Tech LLC*, PGR2021-00082, Paper 8 (PTAB Nov. 17, 2021) (same); *General Elec. Co. v. United Techs. Corp.*, IPR2019-01489, Paper 11 (PTAB Dec. 10, 2019) (same).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and no *inter partes* review is instituted.

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FOR PETITIONER:

Michelle E. Armond
Douglas R. Wilson
Joseph Li
Monica Arnold
Yue Han
ARMOND WILSON LLP
michelle.armond@armondwilson.com
doug.wilson@armondwilson.com
josepher.li@armondwilson.com
monica.arnold@armondwilson.com
amy.han@armondwilson.com

FOR PATENT OWNER:

Gerald B. Hrycyszyn
Jie Xiang
Thomas A. Franklin
WOLF GREENFIELD & SACKS, P.C.
ghrycyszyn-ptab@wolfgreenfield.com
jxiang-ptab@wolfgreenfield.com
tfranklin-ptab@wolfgreenfield.com