UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case IPR2025-00737
U.S. Patent No. 8,585,476 B2

PETITIONER'S SURREPLY IN OPPOSITION TO MOTION TO DISMISS

Patent Owner's post-institution disclaimer of all challenged claims and voluntary abandonment of its defense against each IPR are indisputably "[a]ctions construed to be a request for adverse judgment." 37 C.F.R. § 42.73(b). Patent Owner does not dispute the language of the governing rule and cannot dispute the PTAB and Federal Circuit precedent consistently applying § 42.73(b) to enter adverse judgment after all challenged claims are disclaimed. *See* Opp. at 1-2.

The correct result is not affected by Patent Owner's citation to *Unified Patents Inc. v. Data Scape Ltd.*, IPR2019-01115, Paper 27 (P.T.A.B. July 17, 2020), which was decided without any briefing by the parties. The case is plainly distinguishable. In that case, the Federal Circuit had recently affirmed a district court judgment finding all claims of the challenged patent invalid for failure to claim patent eligible subject matter under 35 U.S.C. § 101. *See id*. Thus, by the time the patent owner filed its disclaimer, the challenged claims had already been invalidated pursuant to a federal court judgment. The patent owner's subsequent disclaimer was thus arguably redundant, and the "Notice" the patent owner filed to alert the PTAB to the Federal Circuit decision did not cite any rule or regulation. *See id*., Paper 26. The petitioner did not file any response. The Board entered an order dismissing the IPR petition, citing the Federal Circuit affirmance and terminating the IPR "[u]nder these circumstances." *Id*., Paper 27. The order did not cite 37 C.F.R. § 42.73(b). *Id*.

Here, by contrast, no court judgment has invalidated any challenged claim, and Patent Owner voluntarily abandoned the defense of its claims after institution,

making entry of adverse judgment appropriate under § 42.73(b). Under "the regulatory standard" imposed by § 42.73(b), "we construe a disclaimer of all claims involved in a trial as a request for adverse judgment." *Unified Patents Inc. v. Arsus, LLC*, IPR2020-00948, Paper 18, at 2 (P.T.A.B. Jan. 27, 2021), *aff'd*, *Arsus, LLC v. Unified Patents, LLC*, No. 2021-1648, 2021 WL 5315423 (Fed. Cir. Nov. 16, 2021); *see also Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1349 (Fed. Cir. 2018) (application of § 42.73(b) does not "turn on the patentee's characterization of its own request"); *Advanced Micro Devices, Inc. v. Polaris Innovations Ltd.*, IPR2019-01514, Paper 21, at 2 (P.T.A.B. Jan. 11, 2022) (denying request for rehearing after Board construed "Patent Owner's disclaimer of all challenged claims as a request for adverse judgment" and entered adverse judgment under § 42.73(b)).

Patent Owner cites no decision declining to enter adverse judgment under § 42.73(b) after a post-institution disclaimer of all challenged claims where, as here, the petitioner has requested entry of adverse judgment pursuant to that rule. Furthermore, policy rationales only support applying § 42.73(b) here, contrary to Patent Owner's arguments about an alleged "purpose of avoiding unnecessary burden and expense for the Board and the parties." Reply at 2. Indeed, Patent Owner could have filed disclaimers before institution in each IPR, sparing the Board from the effort of evaluating the substantive merits of the invalidity challenges. But Patent Owner chose to file POPRs arguing that institution should be denied on the merits, causing the Board to invest substantial resources to address those arguments and

prepare hundreds of pages of detailed institution decisions. Now that the Board has rejected Patent Owner's merits arguments and instituted IPR, and Patent Owner has responded by disclaiming the challenged claims, adverse judgment is appropriate pursuant to § 42.73(b). To decide otherwise would conflict with the rule and improperly encourage and incentivize similarly situated patent owners to file substantive POPRs in response to meritorious IPR petitions, only to abandon the proceedings after institution.

The policy of administrative estoppel codified by the regulations further supports entry of adverse judgment. After a patent owner takes "[a]ctions construed to be a request for adverse judgment" (37 C.F.R. § 42.73(b)), it "is precluded from taking action inconsistent with the adverse judgment," including obtaining any claim that is "not patentably distinct" from a canceled claim. 37 C.F.R. § 42.73(d)(3). Without entry of adverse judgment, Patent Owner could improperly avoid the regulatory framework by, for example, pursuing claims that are patentably indistinct from the claims on which the Board instituted IPR.[1] *See Unified Patents*, IPR2020-00948, Paper 18 at 2 n.1 (entering adverse judgment and stating that "Patent Owner is reminded of the applicable estoppel provisions in 37 C.F.R. § 42.73(d)(3)").

For the reasons stated in Petitioner's opposition and herein, the Board should enter an adverse judgment against Patent Owner on all instituted claims.

[1] At least one pending application claims shared priority with at least one patent challenged in these IPRs. *See* App. Ser. No. 19/221,386, filed May 28, 2025.

Dated: December 1, 2025

Respectfully submitted,

COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Avenue NW
Suite 700
Washington, DC 20004
Tel: (650) 843-5001/ Fax: (650) 849-7400

By: / *Heidi L. Keefe* /
Heidi L. Keefe
Reg. No. 40,673
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6, that a complete copy of the attached **PETITIONER'S SURREPLY IN OPPOSITION TO MOTION TO DISMISS** is being served via electronic mail on the 1st day of December 2025, upon Patent Owner by serving Patent Owner's counsel of record in this proceeding as follows:

Peter F. Snell
Brad M. Scheller
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Email: PFSnell@mintz.com; BMScheller@mintz.com,
Meta_Mullen_IPRs@mintz.com

DATED: December 1, 2025

/ *Heidi L. Keefe* /
Heidi L. Keefe
Reg. No. 40,673
COOLEY LLP
1299 Pennsylvania Ave. NW, Suite 700
Washington, D.C. 20004
Tel: (650) 843-5001