

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEASPINE HOLDINGS CORPORATION,
Petitioner,

v.

ROGER P. JACKSON, M.D.,
Patent Owner.

IPR2025-00773
Patent 11,399,873 B2

Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and
MARY C. HOFFMAN, *Administrative Patent Judges*.

HOFFMAN, *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

SeaSpine Holdings Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 11,399,873 B2 (Ex. 1001, “the ’873 patent”). Roger P. Jackson, M.D. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

The Preliminary Response indicates that Patent Owner has disclaimed all claims of the ’873 patent. Prelim. Resp. 2. Patent Owner also filed a copy of the disclaimer of claims 1–19. Ex. 2001 (disclaimer). Patent Owner states in the Preliminary Response that the disclaimer should not be interpreted as a request for adverse judgment. Prelim. Resp. 2. Petitioner has not sought to respond to the Preliminary Response, nor otherwise requested that adverse judgment be entered.

As explained below, we deny institution of *inter partes* review without entry of adverse judgment.

II. ANALYSIS

Patent Owner has disclaimed all of the claims of the ’873 patent challenged in the Petition and paid the requisite fee. *See* Ex. 2001; 37 C.F.R. § 1.321 (setting forth requirements for statutory disclaimer). Accordingly, we deny institution of the requested review. 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”); *General Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (denying institution based on pre-institution disclaimer of all challenged claims) (“*General Electric*”).

We also decline to enter adverse judgment. The Federal Circuit has interpreted Rule 42.73(b) as permitting the Board to enter adverse judgment when a patent owner disclaims all challenged claims prior to institution. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir. 2018). But neither *Arthrex* nor Rule 42.73(b) require the entry of adverse judgment. Instead, under these circumstances, the Board has discretion to decide whether or not to enter adverse judgement. *See, e.g., Bestway (USA), Inc. v. Intex Mktg., Ltd.*, PGR2024-00036, Paper 9, 6 (PTAB Oct. 28, 2024) (“*Bestway*”). Based on the facts of this case, we believe that efficient administration weighs against entry of adverse judgment.

Thus, consistent with Rule 42.107(e) and *General Electric*, denial of institution is sufficient to dispose of this matter. *See, e.g., Bestway* at 8; *Samsung Electronics Co., Ltd. v. Oura Health OY*, IPR2024-00929, Paper 8, 3 (PTAB Dec. 9, 2024); *Takeda Vaccines, Inc., v. Valneva Austria GmbH*, IPR2023-00354, Paper 7, 4 (PTAB June 9, 2023); *Microsoft Corp. v. Litl, LLC*, IPR2021-01011, Paper 11, 3 (PTAB Apr. 5, 2022); *Cisco Sys., Inc. v. SecurityProfiling, LLC*, IPR2021-01428, Paper 13, 7 (PTAB Mar. 14, 2021).

III. ORDER

Accordingly, it is hereby:

ORDERED that no *inter partes* review is instituted.

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PETITIONER:

Andrew Lowes
John Emerson
Brooke Parker
HAYNES AND BOONE, LLP
andrew.lowes.ipr@haynesboone.com
russ.emerson.ipr@haynesboone.com
brooke.parker.ipr@haynesboone.com

PATENT OWNER:

James Murphy
Patrick Muffo
POLSINELLI PC
jpmurphy@polsinelli.com
pmuffo@polsinelli.com