

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CISCO SYSTEMS, INC.,
Petitioner,

v.

DYNAMIC MESH NETWORKS, INC.
D/B/A MESHDYNAMICS,
Patent Owner.

IPR2025-01303
Patent 11,368,537 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Determination Granting Institution,
and Denying Institution of *Inter Partes* Review

Dynamic Mesh Networks, Inc. d/b/a MeshDynamics (“Patent Owner”) filed a request for Director Review of the Notice granting institution (“Notice,” Paper 11) in the above-captioned case, and Cisco Systems, Inc. (“Petitioner”) filed an authorized response. *See* Paper 12 (“DR Request”); Paper 13 (“DR Response”).

Patent Owner argues that the determination in the Notice should be reversed because, before institution, Patent Owner filed a statutory disclaimer disclaiming each claim and the entire term of the challenged patent. DR Request 3 (citing Ex. 2011 (Notice of Filing a Statutory Disclaimer under 37 C.F.R. § 1.321(a))), 6 (citing 37 C.F.R. § 42.107(e)).

Petitioner takes no position as to Patent Owner’s request for Director Review, but notes that the Office can construe Patent Owner’s request as a motion for adverse judgment under 37 C.F.R. § 42.73(b)(1). *See* DR Response 1.

After considering the parties’ filings, I conclude that the appropriate course of action is to deny institution. Office rules state that “[n]o *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e); *see also* 35 U.S.C. § 253(a) (providing that a patentee may “make disclaimer of any complete claim” in writing with the Office, and such disclaimer “shall thereafter be considered as part of the original patent”); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) (“A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent.”).

Patent Owner filed a statutory disclaimer of the entire term of the challenged patent before the Notice was entered. *See* Ex. 2011. Although

37 C.F.R. § 42.73(b) permits the Office to enter an adverse judgment when a patent owner cancels all claims at issue, denying institution under these circumstances is a more efficient use of the Office's resources. Denying institution also encourages similarly situated patent owners to file a disclaimer *prior to* institution. As such, the appropriate course of action is to vacate the determination in the Notice and deny institution.

Accordingly, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the determination in the Notice granting institution of *inter partes* review (Paper 11) is vacated; and

FURTHER ORDERED that the Petition is denied, and no trial is instituted.

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