

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

JENAM TECH LLC,  
Patent Owner.

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PGR2021-00082  
Patent 10,742,774 B1

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Before DANIEL J. GALLIGAN, SCOTT B. HOWARD, and  
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

DECISION

Denying Institution of Post-Grant Review  
Due to Disclaimer of All Challenged Claims  
*35 U.S.C. § 324; 37 C.F.R. § 42.207(e)*

## I. INTRODUCTION

Google LLC (“Petitioner”) filed a petition to institute a post-grant review of claim 1 of U.S. Patent No. 10,742,774 B1 (Ex. 1001, “the ’774 patent”). Paper 1 (“Pet.”). Jenam Tech LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

For the reasons discussed below, we do not institute a post-grant review.

## II. DISCUSSION

Patent Owner argues that we should deny the Petition because, concurrent with the filing of its Preliminary Response, Patent Owner filed a statutory disclaimer, disclaiming the only claim at issue in this proceeding. Prelim. Resp. 1.<sup>1</sup> *See* Ex. 2003 (Disclaimer in Patent under 37 CFR 1.321(a), Form PTO/SB/43 (07-09), filed Sept. 7, 2021).

Under 37 C.F.R. § 42.207(e), “[t]he 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 post-grant review will be instituted based on disclaimed claims.” A disclaimer is “considered as part of the original patent” as of the date on which it is

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<sup>1</sup> In its Preliminary Response, Patent Owner also argues that the disclaimer of claim 1 should not be considered a request for adverse judgment. Prelim. Resp. 7 (citing *General Elec. Co. v. United Techs. Corp.*, Case IPR2017-00491, Paper 9 (July 6, 2017) (designated precedential on Sept. 9, 2019)). In an email to the Board, Petitioner requested additional briefing on this issue. Ex. 3001. In a conference call with the Board, Petitioner argued that the Board should enter adverse judgment in this case, citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018). Patent Owner opposed Petitioner’s request. Because nothing in *Arthrex* compels entry of an adverse judgment in this case, we determine that no further briefing on the adverse-judgment issue is necessary.

“recorded” in the Office. 35 U.S.C. § 253(a). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;
  - (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
  - (3) State the present extent of patentee’s ownership interest in the patent; and
  - (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).
- 37 C.F.R. § 1.321(a). “[N]othing in the statutes or regulations requires any action by the [Patent Office] for a disclaimer to be ‘recorded.’” *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998).

From our review of Exhibit 2003 and the Office’s public records, we conclude that a disclaimer of claim 1 of the ’774 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of September 7, 2021. Ex. 2003. Because the Board cannot institute trial on disclaimed claims and the sole challenged claim has been disclaimed here, no post-grant review will be instituted.

### III. ORDER

It is ORDERED that the Petition is *denied*.

PGR2021-00082  
Patent 10,742,774 B1

FOR PETITIONER:

Naveen Modi  
Joseph E. Palys  
Quadeer A. Ahmed  
Jason Heidemann  
PAUL HASTINGS LLP  
PH-Google-Jenam-PGR@paulhastings.com

FOR PATENT OWNER:

Timothy Devlin  
DEVLIN LAW FIRM LLC  
tdevlin@devlinlawfirm.com