

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

OURARING INC.,
Patent Owner.

PGR2024-00031
Patent 11,868,179 B2

Before NEIL T. POWELL, ELIZABETH M. ROESEL, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

ROESEL, *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

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Petitioner”) filed a petition requesting post-grant review of claims 1–16 of the ’179 patent. Paper 3 (“Petition”). Ouraring, Inc. (“Patent Owner”) elected to waive its preliminary response. Paper 7.

Patent Owner subsequently filed a Notice of Statutory Disclaimer of Challenged Claims, along with a copy of its disclaimer of claims 1–16. Paper 8 (“Notice”); Ex. 2001 (disclaimer). Patent Owner states in its Notice that the disclaimer should not be interpreted as a request for adverse judgment. Paper 8, 1 (citing *Bestway (USA), Inc. v. Intex Mktg., Ltd.*, PGR2024-00036, Paper 9, 8 (Oct. 28, 2024) (“*Bestway*”). Petitioner has not sought to respond to the Notice, nor otherwise requested that adverse judgment be entered.

As explained below, we deny institution of post-grant review without entry of adverse judgment.

II. ANALYSIS

Patent Owner has disclaimed all of the claims of the ’179 patent challenged in the Petition and paid the requisite fee. *See* Ex. 2001; 37 CFR § 1.321 (setting forth requirements for statutory disclaimer). Accordingly, we deny institution of the requested review. 37 C.F.R. § 42.207(e) (“No post-grant 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* or 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* at 6.

Based on the facts of this case, we believe that efficient administration weighs against entry of adverse judgment. Thus, consistent with Rule 42.207(e) and *General Electric*, denial of institution is sufficient to dispose of this matter. *See, e.g., Bestway* at 8; *Takeda Vaccines, Inc., v. Valneva Austria GmbH*, IPR2023-00354, Paper 7, 4 (June 9, 2023); *Microsoft Corp. v. Litl, LLC*, IPR2021-01011, Paper 11, 3 (Apr. 5, 2022); *Cisco Sys., Inc. v. SecurityProfiling, LLC*, IPR2021-01428, Paper 13, 7 (Mar. 14, 2021) (determining on similar facts that denial of institution without entry of adverse judgment was appropriate).

III. ORDER

Accordingly, it is hereby:

ORDERED that no post-grant review is instituted.

PGR2024-00031
Patent 11,868,179 B2

For PETITIONER:

William M. Fink
John Kappos
Benjamin M. Haber
Marc Pensabene
Mark Liang
Sorin G. Zaharia
O'MELVENY & MYERS LLP
tfink@omm.com
jkappos@omm.com
bhaber@omm.com
mpensabene@omm.com
mliang@omm.com
szaharia@omm.com

For PATENT OWNER:

Jasjit S. Vidwan
Christopher S. Schultz
ARENTFOX SCHIFF LLP
jasjit.vidwan@afslaw.com
christopher.schultz@afslaw.com