

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION,
Petitioner,

v.

DIGITAL AUDIO ENCODING SYSTEMS, LLC,
Patent Owner.

Case IPR2017-00208
Case IPR2017-00209
Case IPR2017-00212
Patent 7,490,037 B2¹

Before MICHAEL J. FITZPATRICK, STACEY G. WHITE, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order employs a joint caption, as it is being entered in each of the identified proceedings. The parties may not use a joint caption unless authorized.

IPR2017-00208
IPR2017-00209
IPR2017-00212
Patent 7,490,037 B2

Petitioner, RPX Corporation, filed Petitions to institute *inter partes* reviews of some or all of the thirty-two claims of U.S. Patent No. 7,490,037 B2 (“the ’037 patent”). Paper 1.² Thereafter, but before any decision whether to institute any of the petitioned-for reviews was rendered, Patent Owner, Digital Audio Encoding Systems, LLC, filed unopposed Requests for Adverse Judgment pursuant to 37 C.F.R. § 42.73(b). Paper 5.

Pursuant to our instruction, a Board staff member sent an email to the parties stating:

The panel notes that Patent Owner has filed in each of the above-identified cases a Request for Adverse Judgment in which Patent Owner seeks cancellation of all claims of U.S. Patent No. 7,490,037 (“the ’037 patent”). As no trial has been instituted in any of these cases, the panel requests Patent Owner to file with the Patent and Trademark Office a statutory disclaimer as to all claims of the ’037 patent under 35 U.S.C. § 253(a). See 37 C.F.R. § 42.107(e) (“The 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. No *inter partes* review will be instituted based on disclaimed claims.”). The panel also requests that a copy of the disclaimer be filed in each of the above-identified cases.

Jan. 9, 2017, email from trials@uspto.gov to counsel for both parties.

On January 24, 2017, we conducted a conference call with respective counsel for the parties to discuss the status of any statutory disclaimer, as no copy of the same had been filed in any of these proceedings. During the call, Patent Owner indicated its intent to file a statutory disclaimer and

² Citations are provided to IPR2017-00208 only, but they are exemplary with respect to all three proceedings.

IPR2017-00208
IPR2017-00209
IPR2017-00212
Patent 7,490,037 B2

copies of the same in each proceeding as quickly as possible. Petitioner stated that, even if all the claims of the '037 patent are statutorily disclaimed (and they now have been—*see* Paper 6), Patent Owner's Requests for Adverse Judgment still should be granted. Petitioner revealed that it wants adverse judgment because it would estop Patent Owner "from taking action inconsistent with the adverse judgment." *See* 37 C.F.R. § 42.73(d)(3).

Prior to our deciding whether to grant or deny the Requests for Adverse Judgment, the parties will have the opportunity to brief whether we have the power to enter adverse judgment in these proceedings, where no instituted review of the patent exists.

The Board frequently employs, as we do here, the term "proceeding" to describe a petitioned-for but not instituted *inter partes* review. And, we are cognizant that 37 C.F.R. § 42.73 states that "[a] party may request judgment against itself at any time during a proceeding" and that § 42.2 states that "*Proceeding* means a trial or preliminary proceeding." Any brief filed pursuant to this Order should not merely point this out. Rather, such a brief should elaborate as to why the definition set forth in § 42.2 applies in § 42.73. *See Intellectual Ventures II LLC v. JPMorgan Chase & Co.*, 781 F.3d 1372, 1378 (Fed. Cir. 2015) ("The PTO's own regulations are inconsistent on [the meaning of proceeding]."). Such a brief should also identify the statutory source of our power to enter adverse judgment when no review is instituted.

IPR2017-00208
IPR2017-00209
IPR2017-00212
Patent 7,490,037 B2

Accordingly, it is

ORDERED that each party may file one brief, not exceeding five pages, directed to whether we have the power to enter adverse judgment in these proceedings; and

FURTHER ORDERED that any such briefs are due no later than February 9, 2017.

IPR2017-00208
IPR2017-00209
IPR2017-00212
Patent 7,490,037 B2

For Petitioner:

Elisabeth Hunt
Ehunt-ptab@wolfgreenfield.com

Richard Giunta
Rgiunta-ptab@wolfgreenfield.com

Randy Pritzker
rpritzker@wolfgreenfield.com

For Patent Owner:

Timothy Devlin
tdevlin@devlinlawfirm.com