

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ULTRATEC, INC.,
Petitioner,

v.

SORENSEN IP HOLDINGS,
Patent Owner.

Case IPR2017-01394
Patent 9,336,689 B2

Before SALLY C. MEDLEY, STACEY G. WHITE, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

JUDGMENT
Request for Adverse Judgment
37 C.F.R. § 42.73(b)

On May 9, 2017, Petitioner Ultratec, Inc. (“Ultratec”) filed a Petition (“Pet.”) to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 9,336,689 B2 (Ex. 1003, “the ’689 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 1. Patent Owner Sorenson IP Holdings (“Sorenson”) filed a Preliminary Response (“Prelim. Resp.”) to the Petition on September 6, 2017. Paper 6. On November 30, 2017, we instituted trial as to claims 1–20, Paper 7, and on Dec. 11, 2017, we scheduled an oral hearing for August 13, 2018, Paper 9. Sorenson has not filed a Patent Owner Response, and Ultratec has not filed a Reply.

On February 16, 2018, Sorenson filed a Notice Regarding Filing of Disclaimer, notifying us that a Disclaimer (Ex. 2006) was filed in connection with the ’689 patent, disclaiming all claims (claims 1–20) of the ’689 patent. Paper 10, 1. Sorenson explicitly requests adverse judgment against itself pursuant to 37 C.F.R. § 42.73(b)(2) and termination of the *inter partes* review. Paper 10, 1.

Under 35 U.S.C. § 253(a), a patentee may disclaim its whole interest or any sectional interest in any patent claim. When a party in an *inter partes* review disclaims all the claims at issue in the proceeding, we construe the disclaimer as a request for adverse judgment. 37 C.F.R. 42.73(b)(1)–(2).

Because Sorenson has explicitly requested adverse judgment against itself, and has statutorily disclaimed all claims in the ’689 patent, Sorenson’s request for adverse judgment is *granted*.

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Accordingly, it is hereby:

ORDERED that judgment is herein entered against Sorenson with respect to claims 1–20 of the '689 patent;

FURTHER ORDERED that the instant proceeding is terminated;

FURTHER ORDERED that claims 1–20 of the '689 patent are herein *cancelled*; and

FURTHER ORDERED that all scheduled Due Dates (Paper 8) are *vacated* and the hearing scheduled for August 13, 2018 is *cancelled*.

PETITIONER:

Michael Jaskolski
Louis A. Klapp
Nikia L. Gray
QUARLES & BRADY LLP
michael.jaskolski@quarles.com
louis.klapp@quarles.com
nikia.gray@quarles.com

PATENT OWNER:

Ruben H. Munoz
John Wittenzellner
AKIN GUMP STRAUSS HAUER & FELD LLP
rmunoz@akingump.com
jwittenzellner@akingump.com