

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORPORATION,
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

IPR2018-01165
Patent 7,524,087 B1

Before BARBARA A. BENOIT, SCOTT C. MOORE, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

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

Nichia Corporation (“Petitioner”) challenged the patentability of claims 1–19 of U.S. Patent No. 7,524,087 B1 (Ex. 1001, “the ’087 patent” or “the challenged patent”), owned by Document Security Systems, Inc. (“Patent Owner”). Paper 1 (“Petition”). We instituted review and in due course determined the Petitioner had shown by a preponderance of the evidence that claims 1 and 6–8 were unpatentable but had not shown that claims 2–5 and 9–19 were unpatentable. Paper 28 (“Final Written Decision” or “Final Dec.”) 2, 90; *see also* Paper 11 (“Institution Decision” or “Inst. Dec.”), 65. Subsequently, we denied Petitioner’s request for rehearing seeking reconsideration of the Final Written Decision. Paper 30, 2.

Petitioner appealed, and Patent Owner cross-appealed, our Final Written Decision to the United States Court of Appeals for the Federal Circuit. Papers 31, 32. The court issued its decision affirming our findings as to all claims except claims 15–19. *Nichia Corp. v. Document Sec. Sys., Inc.*, Nos. 2020-2261, 2020-2287, 2022 WL 1218036, at *1 (Fed. Cir. Apr. 26, 2022). Specifically, the court reversed our determination that Petitioner had not shown independent claim 15 to be unpatentable and remanded for further proceedings regarding dependent claims 16–19. *Id.* On June 14, 2022, the court issued the formal mandate. Paper 33.

On June 23, 2022, Patent Owner statutorily disclaimed claims 16–19 of the ’087 patent. Thus, claims 16–19 are no longer part of this proceeding and no issues remain for us to consider on remand. *See Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Labs., Inc.*, 933 F.3d 1367, 1373 (Fed. Cir. 2019) (noting that disclaiming claims effectively eliminates those claims from the patent as though the disclaimed claims had never existed (internal quotations and citations omitted)); *see also Asetek Danmark A/S v. CoolIT Sys., Inc.*, IPR2020-00747, Paper 42 at 6 (PTAB Sept. 30, 2021) (determining that a

statutory disclaimer removed a disclaimed claim from an *inter partes* review proceeding); *cf.* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”).

Moreover, under 37 § C.F.R. 42.73(b), a “party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include . . . disclaimer of a claim such that the party has no remaining claim in the trial.” The only claims before us on remand have been disclaimed. Accordingly, we construe Patent Owner’s disclaimer to be a request for adverse judgment as to those claims which remain before us, which we now grant.

ORDER

For the foregoing reasons, it is hereby:

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner as to claims 16–19; and
FURTHER ORDERED that this proceeding is terminated.

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