UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

Case IPR2019-00820
Patent 7,937,581 B2

PATENT OWNER MPH TECHNOLOGIES OY'S OPENING BRIEF REGARDING LEGAL EFFECT OF STATUTORY DISCLAIMER PURSUANT TO ORDER RE CONDUCT OF PROCEEDINGS ON REMAND (PAPER NO. 50)

Pursuant to the Board's January 19, 2023, Order, Paper 50, Patent Owner MPH Technologies Oy respectfully submits this opening brief on remand addressing the legal effect of its statutory disclaimer.

I. Case Background and Procedural Posture

Apple filed the underlying petition in this proceeding in March 2019 after MPH filed its district court complaint in September 2018[1]. The Board conducted a full trial and entered a Final Written Decision (FWD) in September 2020. Paper 37, FWD. In the FWD, the Board found that Apple had shown by a preponderance of the evidence that claims 1–3, 5, and 9 of the '581 patent are unpatentable, and that Apple had not shown by a preponderance of the evidence that claims 4 and 6–8 of the '581 patent are unpatentable. *Id.* Apple appealed the Board's decision as to claims 4 and 6–8 of the '581 patent. Paper 38, Pet. Not. Of Appeal.

On September 8, 2022, the Federal Circuit provided a new claim construction of one term, vacated the Board's patentability determination for claim 4 of the '581 patent based on that term, and affirmed the Board's patentability determination that

[1] The district court litigation has been stayed pending resolution of the IPR proceedings since April 2019. *MPH Techs. Oy v. Apple Inc.*, Case No. 18-cv-05935-PJH (N.D. Cal.), Dkt. 49. MPH recently filed an unopposed motion to lift the stay, which the district court granted on February 1, 2023. *Id.* at Dkt. 77.

Apple failed to meet its burdens as to claims 6-8 of the '581 patent due to a deficiency in Apple's petition that was *not* related to any claim construction argument made by the parties before the Board or the Federal Circuit. Paper 39, Fed. Cir. decision; *Apple Inc. v. MPH Techs. Oy*, 2022 WL 4103286 (Fed. Cir. Sept. 8, 2022).[2]

During the Federal Circuit appeal, MPH statutorily disclaimed claim 4 of the '581 patent. This disclaimer took place on October 13, 2022, *before* the Federal Circuit issued its mandate to the Board on October 18, 2022. Paper 48 (Mandate); Ex. 3003 (Statutory Disclaimer); Ex. 2010 (complete '581 patent USPTO disclaimer filings dated October 13, 2022). Notably, MPH did not request judgment against itself. Thus, the only remaining task for the Board in this proceeding is to issue a certificate confirming claims 6-8 of the '581 patent pursuant to the Federal Circuit's mandate.

II. MPH Did Not Request Adverse Judgment, and No Adverse Judgment Should be Entered on Claim 4 of the '581 Patent

The Board should decline to enter an adverse judgment as to disclaimed claim 4 of the '581 patent for the reasons set forth below.

[2] The Federal Circuit consolidated the appeals from this case and IPR2019-00819, so its decision addressed both the '581 and '810 patents.

First, MPH's statutory disclaimer of claim 4 of the '581 patent cannot be construed as a request for adverse judgment because it did not occur "during a proceeding" at the Board as required by 37 C.F.R. § 42.73(b). Rather, it occurred during the Federal Circuit appeal and *before* the Federal Circuit issued its mandate and returned jurisdiction to the Board. *See* 37 C.F.R. § 42.2 ("Proceeding means a trial or preliminary proceeding"). In particular, after the Federal Circuit's September 8, 2022 decision, but before the Federal Circuit issued its mandate to the Board on October 18, 2022, MPH statutorily disclaimed claim 4 of the '581 patent on October 13, 2022. Paper 48 (Mandate); Ex. 3003 (Statutory Disclaimer); Ex. 2010 (*'581 patent USPTO disclaimer filings). So, MPH's disclaimer of claim 4 of the '581 patent did not occur "during a proceeding" as required under 37 C.F.R. § 42.73(b).

The non-precedential case cited by Apple during the November 18, 2022 panel conference is not to the contrary. Ex. 1024, Tr. of 2022-11-18 Hearing, p. 22; *Apple Inc. v. Corephotonics Ltd.*, No. IPR2018-01146, 2022 WL 440984, at *1-2 (PTAB Feb. 11, 2022). In *Corephotonics*, the claims at issue were disclaimed three months *after* the Federal Circuit issued its mandate and passed jurisdiction back to the Board, 2022 WL 440984, at *1-2, unlike in the present case where disclaimer occurred *before* the Federal Circuit issued its mandate and passed jurisdiction back to the Board.

Second, MPH's disclaimer of claim 4 of the '581 patent did not result in "no

remaining claim in the trial" as required for adverse judgment under § 42.73(b)(2). In particular, '581 patent claims 6-8 remain in the remanded proceeding until the Director issues an IPR certificate confirming their patentability under 35 U.S.C. § 318(b). *See also* 37 CFR § 42.80. So, 37 C.F.R. § 42.73(b)(2) does not apply.

Third, during the November 18, 2022 panel conference, Apple erroneously suggested that an adverse judgment could be entered even when only *some* of the remaining claims are disclaimed, because that would somehow be a "concession of unpatentability [] of the contested subject matter" under § 42.73(b)(3). Ex. 1024, Tr. of 2022-11-18 Hearing, pp. 8, 10, 14-15. However, "the contested subject matter" refers to the entirety of the contested subject matter, not just part, and MPH indisputably did not disclaim all of the contested claims of the '581 patent.

More importantly, a disclaimer of a claim is not a "concession" of unpatentability. *Gilead Sciences Inc. v. U.S.*, 2020 WL 582380, at *21 n.31 (PTAB Feb. 5, 2020) (supporting patent owner's position that "statutorily dismissed claims are not admissions of unpatentability"). Instead, such claims should be treated as though they never existed as the Federal Circuit has long held. *Vectra Fitness, Inc. v. TNWK Corp.,* 162 F.3d 1379, 1383 (Fed. Cir. 1998); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) ("the patent is viewed as though the disclaimed claims had never existed in the patent."). Indeed, in notifying the Board of the statutory disclaimer, MPH expressly stated that "Patent Owner is not admitting

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