UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

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Case IPR2019-00820
Patent 7,937,581 B2

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

I. INTRODUCTION

Pursuant to the Board's January 19, 2023, Order, Paper 50, Patent Owner MPH Technologies Oy respectfully submits this responsive brief on remand addressing the legal effect of its statutory disclaimer of claim 4 of the '581 patent.

II. DISCUSSION

Apple's opening brief argues that MPH's statutory disclaimer should be construed as a request for adverse judgment under 37 C.F.R. § 42.73(b), but fails to address the regulation's express requirement that the disclaimer must occur "during a proceeding" at the Board. *See, generally,* Paper 51, Apple's Brief. For purposes of Section 42.73(b), "[p]roceeding means a trial or preliminary proceeding." *See* 37 C.F.R. § 42.2. MPH's disclaimer of claim 4 of the '581 patent admittedly did not occur "during a proceeding"—*i.e.* during a trial or preliminary proceeding—at the Board. Instead, it occurred during the Federal Circuit appeal, that is, after the Board was divested of jurisdiction and before the Federal Circuit released jurisdiction of the remanded case back to the Board.

Specifically, the Board was divested of jurisdiction in the proceeding on November 23, 2020, when Apple filed its Notice of Appeal. Paper 38, Pet. Not. of Appeal; *See* 37 C.F.R. § 41.35(b)(2) ("The jurisdiction of the Board ends when … [t]he Board enters a final decision (*see* § 41.2) and judicial review is sought…"); *Smart Microwave Sensor Gmbh v. Wavetronix LLC*, No. IPR2016-00488, Paper No.

59 at 3. (PTAB Aug. 24, 2017) ("The general rule is that the Board is divested of jurisdiction when either party files a notice of appeal to the Federal Circuit.").

Events that occur *after* the Board is divested of jurisdiction, including during pendency of an appeal to the Federal Circuit, are not "during a proceeding." *Emerson Electric Co. v. SIPCO, LLC,* No. IPR2016-00984, Paper No. 52 at 25-26 (PTAB Jan. 24, 2020) ("[W]e determine that the Certificate [of Correction], which issued after the Final Decision and after Patent Owner filed an appeal to the Federal Circuit, has no impact on the Final Decision in this case because it was not in effect ***during the proceeding***.") (emphasis added). Here, well after Apple filed its Notice of Apple, and before the Federal Circuit issued its mandate returning jurisdiction to the Board on October 18, 2022, MPH statutorily disclaimed claim 4 of the '581 patent on October 13, 2022. Paper 38, Pet. Not. of Appeal; Ex. 3003 (Statutory Disclaimer); Ex. 2010 ('581 patent USPTO disclaimer filings); Paper 48 (Mandate).

Apple does not dispute that MPH's disclaimer was received by the USPTO in proper form and with the fee on October 13, 2022, and, therefore, was recorded and effective as of October 13, 2022. Ex. 3003 (Statutory Disclaimer); Ex. 2010 *('*581 patent USPTO disclaimer filings); *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F. 3d 1379, 1382 (Fed.Cir. 1998) (finding disclaimer recorded and effective when received by the PTO in proper form and with the fee); 35 U.S.C. § 253(a) ("Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and

it shall *thereafter* be considered as part of the original patent…") (emphasis added).

And only after the October 13, 2022 disclaimer did the Federal Circuit's October 18, 2022 Mandate pass jurisdiction back to the Board. Paper 48 (Mandate); PTAB Standard Operating Procedure 9, p. 1 ("The mandate makes the judgment of the Federal Circuit final and releases jurisdiction of the remanded case to the Board."). Thus, MPH's disclaimer of claim 4 of the581 patent occurred during the Federal Circuit appeal, not "during a proceeding" under 37 C.F.R. § 42.73(b), and the Board should deny entry of adverse judgment.

Separately, Apple's opening brief also failed to address that 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). For this independent reason, standing alone, the Board should decline to enter adverse judgment against claim 4. In particular, in its September 8, 2022 opinion, 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, affirmed the Board's patentability determination that Apple failed to meet its burdens as to claims 6-8 of the '581 patent based on deficiencies in Apple's petition, and remanded to the Board for further proceedings. Paper 39, Fed.Cir. decision; *Apple Inc. v. MPH Techs. Oy*, 2022 WL 4103286 (Fed.Cir. Sept. 8, 2022). Thus, 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 C.F.R. § 42.80. For these reasons, "disclaimer of a claim such that the party has no remaining claim in the trial" has not occurred as a result of MPH's disclaimer of claim 4, and the express requirements of 37 C.F.R. § 42.73(b)(2) are not met. The Board should decline to enter adverse judgment against claim 4.

The non-precedential cases Apple cited are materially distinguishable and do not compel entry of adverse judgment. *See* Paper 51, Apple's Brief., p. 2.

In *Apple Inc. v. Corephotonics Ltd.*, the patent owner disclaimed claims three months *after* the Federal Circuit issued its mandate and passed jurisdiction back to the Board, No. IPR2018-01146, 2022 WL 440984, Paper 45, at *1-2 (PTAB Feb. 11, 2022), unlike in the present case where MPH disclaimed claim 4 *before* the Federal Circuit issued its mandate passing jurisdiction back to the Board. Ex. 3003 (Statutory Disclaimer); Ex. 2010 (*'*581 patent USPTO disclaimer filings); Paper 48 (Mandate). Thus, the non-precedential *Corephotonics* decision is inapposite.

Apple's reliance on the non-precedential opinion in *Unified Patents, LLC v. Arsus, LLC* is also misplaced because, there, the patent owner disclaimed *all* of the challenged claims, and did so "during a proceeding," just days after the institution decision. No. IPR2020-00948, Paper 18 at 2 (PTAB Jan. 27, 2021); *See Id.* at Paper 15 (Decision granting Institution) and Paper 17 (Mot. to Dismiss and Disclaimer). Those circumstances are not present here since MPH only disclaimed claim 4, not

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