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Paper 55
Date: May 11, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

IPR2019-00820
Patent 7,937,581 B2

Before KEVIN C. TROCK, JOHN D. HAMANN, and STACY B. MARGOLIES, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

JUDGMENT
Adverse Judgment on Remand
37 C.F.R. 42.73(b)

I. INTRODUCTION

This case returns on remand from the United States Court of Appeals for the Federal Circuit in *Apple Inc. v. MPH Techs. OY*, Nos. 2021-1355, 2021-1356, 2022 WL 4103286, at *1 (Fed. Cir. Sept. 8, 2022).[1] In our prior Final Written Decision in this proceeding, we determined that by a preponderance of the evidence Apple Inc. ("Petitioner") (i) proved that claims 1–3, 5, and 9 of U.S. Patent No. 7,937,581 B2 (Ex. 1001, "the '581 patent") are unpatentable, and (ii) did not prove that claims 4 and 6–8 are unpatentable. Paper 37 ("FWD"), 68. On Petitioner's appeal, the Federal Circuit held that we erred in our construction of a term, and as a result, vacated our judgment of no unpatentability for claim 4 and remanded to the Board for further proceedings. *Apple*, 2022 WL 4103286, at *4–6, 8. In addition, the Federal Circuit affirmed our "patentability determination that [Petitioner] failed to meet its burden as to claims 6–8 of the '581 patent." *Id.* at *8.

After the Federal Circuit's decision, and five days before the mandate issued, MPH Technologies Oy ("Patent Owner") filed with the Patent Office a statutory disclaimer under 37 C.F.R. § 1.321, which stated that Patent Owner "hereby disclaims and dedicates to the public the entirety of claim 4 of the '581 Patent." Ex. 3003, 1; Paper 48 (Mandate).

A. Related Matters

The parties identify as related matters: (i) *MPH Techs. Oy v. Apple Inc.*, No. 5:18-cv-05935-PJH (N.D. Cal.); (ii) *Apple Inc. v. MPH Techs. Oy*,

[1] The Federal Circuit issued a joint decision, addressing Petitioner's appeal from this proceeding, as well as Petitioner's appeal from *Apple Inc. v. MPH Techs. Oy*, IPR2019-00819. *Apple*, 2022 WL 4103286, at *1. On remand, we issue separate decisions for these cases for purposes of clarity.

IPR2019-00819 (PTAB) (involving related U.S. Patent No. 7,620,810 B2); (iii) *Apple Inc. v. MPH Techs. Oy*, Appeal No. 21-1355 (Fed. Cir.); and (iv) *MPH Techs. Oy v. Apple Inc.*, Appeal No. 21-1390 (Fed. Cir.). Paper 42, 1; Paper 43, 1.

B. Additional Briefing Post-Remand

After the remand, we authorized a simultaneous exchange of additional briefing for the parties to address the legal effect of the statutory disclaimer of claim 4. Paper 50, 6. Pursuant to that authorization, Petitioner filed an Opening Brief Post-Remand (Paper 51, "Pet. Rem. Open."), Patent Owner filed an Opening Brief (Paper 52, "PO Rem. Open."), Petitioner filed a Response Brief Post-Remand (Paper 53, "Pet. Rem. Resp."), and Patent Owner filed a Response Brief (Paper 54, "PO Rem. Resp.").

II. ANALYSIS

The parties dispute the legal effect of Patent Owner's statutory disclaimer of claim 4. Petitioner argues that we should treat Patent Owner's statutory disclaimer of claim 4 as a "request for adverse judgement and enter same." Pet. Rem. Open. 2. Patent Owner disagrees. *See generally* PO Rem. Open.; PO Rem. Resp.

We agree with Petitioner and determine that Patent Owner requested adverse judgment against itself by filing a statutory disclaimer for claim 4. Pet. Rem. Open. 2–3. In particular, "[a]ctions construed to be a request for adverse judgment include . . . disclaimer of a claim such that the party has no remaining claim in the trial." 37 C.F.R. § 42.73(b). Here, claim 4 was the sole remanded claim. *Apple*, 2022 WL 4103286, at *8 (remanding only claim 4 for this proceeding).

We also agree with Petitioner and determine that "claims 6–8 are no longer part of this [*inter partes* review] proceeding, because the Board made a final judgment with regard to these claims and that judgment has not been reversed or vacated." Pet. Rem. Resp. 4 (citing 37 C.F.R. § 42.2); *see also Apple*, 2022 WL 4103286, at *8 (affirming as to claims 6–8); 37 C.F.R. § 42.2 ("A decision is final only if it disposes of all necessary issues with regard to the party seeking judicial review, and does not indicate that further action is required."). As such, claims 6–8 no longer remain "in the trial," within the meaning of 37 C.F.R. § 42.73(b)(2).

Thus, in light of the disclaimer of claim 4, Patent Owner has no remaining claim in the trial. Hence, we view Patent Owner statutorily disclaiming claim 4 as a request for adverse judgment. This is consistent with how other panels have handled this issue. *See Nichia Corp. v. Document Security Systems, Inc.*, IPR2018-01165, Paper 35 at 2–3 (PTAB Nov. 18, 2022); *Auris Health, Inc. v. Intuitive Surgical Operations Inc.*, IPR2019-01547, Paper 31 at 2–4 (PTAB July 22, 2022); *Foundation Medicine, Inc. v. Caris MPI, Inc.*, IPR2019-00166, Paper 65 at 2–3 (PTAB June 15, 2022); *Apple Inc. v. Corephotonics Ltd.*, IPR2018-01146, Paper 45 at 4 (PTAB Feb. 11, 2022).

We find unavailing Patent Owner's argument that "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)." PO Rem. Open. 3–4. Section 318(b) states that if the Board issues "a final written decision . . . and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, [and] confirming any claim of

the patent determined to be patentable." 35 U.S.C. § 318(b). This language does not address when the trial ends, and whether claims on remand remain in the trial. *Id.* Rather, it is directed to when the Director shall issue the certificate. *Id.* Moreover, Patent Owner simply asserts that the language of § 318(b) supports its argument without explaining why. *See* PO Rem. Open. 3–4; PO Rem. Resp. 3–4. Our corresponding Rule substantively has the same language (except for replacing "the Director shall" with "the Office will"), and thus, we view it the same way. *See* 37 C.F.R. § 42.80.

We also find unavailing Patent Owner's argument that the "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)." PO Rem. Open. 3. Rather, we agree with Petitioner that Patent Owner incorrectly conflates the first sentence of § 42.73(b) with the second sentence. Pet. Rem. Resp. 2–3. The first sentence states that "[a] party may request judgment against itself at any time during a proceeding," which relates to when a party may request adverse judgment during a proceeding (i.e., "at any time"). 37 C.F.R. § 42.73(b). The second sentence relates to examples of what should be construed as a request for adverse judgment. *Id.* Notably, the second sentence does not include a temporal requirement. *Id.* Thus, when Patent Owner filed the statutory disclaimer of claim 4 here is immaterial.

We also find unavailing Patent Owner's argument that regardless of whether the requirements of 37 C.F.R. § 42.73(b) are met, that the Rule is permissive and we should decline to enter an adverse judgment because otherwise we "would frustrate the policy of 37 C.F.R. 42.1(b) and the Federal Circuit's mandate." PO Rem. Open. 5. Patent Owner does not

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