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Paper No. 11  
Entered: October 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RPX CORPORATION,  
Petitioner,

v.

CEDATECH HOLDINGS, LLC,  
Patent Owner.

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Case IPR2015-00736  
Patent 7,707,591 B2

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Before RAMA G. ELLURU, BART A. GERSTENBLITH, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION  
Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71*

I. INTRODUCTION

RPX Corporation (“Petitioner”) filed a Request for Rehearing (Paper 9, “Req. Reh’g”) of the Decision Denying Institution of *Inter Partes* Review of U.S. Patent No. 7,707,591 (Ex. 1001, “the ’591 patent”) (Paper 8, dated August 13, 2015, “Dec.”). Petitioner requests reconsideration of the

denial of institution and contends that we misapprehended and overlooked 37 C.F.R. § 42.73(b) and prior Board decisions that Petitioner asserts should have compelled us to construe the statutory disclaimer filed by Cedatch Holdings, LLC (“Patent Owner”) as a request for adverse judgment. Req. Reh’g 1. For the reasons stated below, Petitioner’s request is denied.

## II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or reply. 37 C.F.R. § 42.71(d).

## III. DISCUSSION

In our Decision Denying Institution, we determined that trial would not be instituted, in accordance with 37 C.F.R. § 42.107(e), because Patent Owner filed a statutory disclaimer under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a). Dec. 2. Petitioner does not contend that we should have instituted an *inter partes* review; rather, Petitioner contends that we should have considered Patent Owner’s statutory disclaimer as a request for adverse judgment.<sup>1</sup> Req. Reh’g 1.

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<sup>1</sup> Petitioner’s Request for Rehearing reiterates the discussion that occurred during a conference call on July 20, 2015. Req. Reh’g 2. Also, Petitioner

Although we did not discuss 37 C.F.R. § 42.73(b) in our Decision Denying Institution, Petitioner's position regarding its applicability was considered. We take this opportunity to explain, in detail, why we did not designate our Decision Denying Institution as an adverse judgment.

First, we do not agree that the factual circumstances surrounding Patent Owner's disclaimer fall within any of the actions that are to be construed as a request for adverse judgment under 37 C.F.R. § 42.73(b). In particular, § 42.73(b) states:

*Request for adverse judgment.* A party may request adverse judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

- (1) Disclaimer of the involved application or patent;
- (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
- (3) Concession of unpatentability or derivation of the contested subject matter; and
- (4) Abandonment of the contest.

37 C.F.R. § 42.73(b).

Patent Owner did not disclaim the patent, for example by filing a disclaimer under 35 U.S.C. § 253(b); rather, Patent Owner disclaimed *claims* under § 253(a). Thus, subsection (b)(1) is inapplicable.

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indicates correctly that our subsequent Order (Paper 6) placed the burden on Patent Owner to explain why we should not construe Patent Owner's statutory disclaimer as a request for adverse judgment. *Id.* at 1–2. Even though Patent Owner did not take the opportunity to respond to our request, we determined, nonetheless, not to construe Patent Owner's disclaimer as a request for adverse judgment because Patent Owner undertook none of the “[a]ctions construed to be a request for adverse judgment” under 37 C.F.R. § 42.73(b).

Subsection (b)(2), which refers to “disclaimer of a claim *such that the party has no remaining claim in the trial*” (emphasis added), is also inapplicable. Because it includes the phrase “such that the party has no remaining claim in the trial,” it is our view that subsection (b)(2) applies only *after* a trial has been instituted. *See* 37 C.F.R. § 42.2 (“*Trial* means a contested case instituted by the Board based upon a petition. A trial begins with a written decision notifying the petitioner and patent owner of the institution of the trial.”). In the circumstances here, however, trial had not yet been instituted. Thus, subsection (b)(2) does not require that we construe Patent Owner’s disclaimer as a request for adverse judgment.

Additionally, Petitioner does not contend that subsections (b)(3) or (b)(4) apply, and we agree that they do not. Accordingly, the facts presented here do not fall within any of subsections (b)(1)–(4), and Petitioner has not pointed us to anything that requires us to construe Patent Owner’s disclaimer as a request for adverse judgment.

Second, contrary to Petitioner’s argument, our Decision Denying Institution does not depart from prior Board practice. We are aware of at least the following four Board decisions addressing facts analogous to those presented here—a pre-institution statutory disclaimer filed by a patent owner disclaiming each of the claims challenged in the respective petition:

- (1) *Hospira, Inc. v. Janssen Pharms., Inc.*, Case IPR2013-00365  
(PTAB Oct. 24, 2013) (Paper 9);
- (2) *Tandus Flooring, Inc. v. Interface, Inc.*, Case IPR2013-00526  
(PTAB Feb. 14, 2014) (Paper 7);
- (3) *Global Tel\*Link Corp. v. Howlink Global LLC*, Case IPR2014-00696 (Aug. 15, 2014) (Paper 9); and

(4) *CoolIT Systems, Inc. v. Asetek Danmark A/S*, Case IPR2014-01172 (Jan. 29, 2015) (Paper 12).

In *Hospira* and *Global Tel\*Link*, the Board treated the patent owner’s disclaimer as a request for adverse judgment. But in *Tandus Flooring* and *CoolIT Systems*, in contrast, the Board did *not* treat the patent owner’s disclaimer as a request for adverse judgment and, instead, denied institution in accordance with 37 C.F.R. § 42.107(e).

The four Board decisions cited above reflect that although the Board *may* treat a disclaimer such as that filed by Patent Owner as a request for adverse judgment, the Board is not required to do so. In light of the specific language in § 42.73(b) and the decisions cited above, therefore, our Decision Denying Institution was not “based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc.*, 840 F.2d at 1567 (citations omitted).

#### IV. ORDER

Accordingly, it is hereby ORDERED that Petitioner’s Request for Rehearing (Paper 9) is *denied*.

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