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Paper No. 11
Date: April 5, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

LITL, LLC,
Patent Owner.

IPR2021-01011
Patent 8,577,957 B2

Before MICHELLE N. ANKENBRAND, GARTH D. BAER, and BRIAN D. RANGE, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

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

INTRODUCTION

Microsoft Corp. ("Petitioner") filed a Request for Rehearing of our decision denying institution of *inter partes* review. Paper 10 ("Req. Reh'g"). In its Rehearing Request, Petitioner asserts that, rather than denying institution, we should have entered adverse judgment against Patent Owner LiTL LLC ("Patent Owner") given Patent Owner's disclaimer of all challenged claims. Req. Reh'g 1. For the reasons provided below, we *deny* Petitioner's Request.

ANALYSIS

A request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." 37 C.F.R. § 42.71(d). The party challenging a decision bears the burden of showing the decision should be modified. *Id*.

Petitioner raises two arguments in asserting that we should have entered adverse judgment against Patent Owner. First, Petitioner asserts that we should have entered adverse judgment in light of 37 C.F.R. § 42.73(b), which specifies that "[a] party may request judgment against itself" and that "[a]ctions construed to be a request for adverse judgment include . . . [d]isclaimer of the involved . . . . patent." Req. Reh'g 3–4. Second, Petitioner asserts that in the past, "the Board entered adverse judgment against patent owners that filed statutory disclaimers before institution," and that the Federal Circuit has affirmed such judgments. *Id*. at 2 (citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 15 F.3d 1345, 1350 (Fed. Cir. 2018); *Google LLC v. Seven Networks, LLC*, No. IPR2018-01118, 2019 WL 171672, at *1 (PTAB Jan. 11, 2019); *Glob. Tel*Link Corp. v. Howlink*

Glob., LLC, No. IPR2014-00696, 2014 WL 4090281, at *2 (PTAB Aug. 15, 2014); *Hospira, Inc. v. Janssen Pharms., Inc.*, No. IPR2013-500365, 2013 WL 6514083, at *1 (PTAB Oct. 24, 2013)).

We disagree with Petitioner's arguments. Even if correct, Petitioner's arguments at most establish that entering adverse judgment for pre-institution statutory disclaimers is permissible. Nothing in Rule 42.73(b) or the cited case law indicates that failing to do so is error. To the contrary, our precedential decision in *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (hereafter "*GE v. UT*") did as we have done here—i.e., denied institution without entering adverse judgement.

As we noted in our decision denying institution, "[u]nder our rules, '[n]o inter partes review will be instituted based on disclaimed claims.'" Paper 9, 1 (quoting 37 C.F.R. § 42.107(e)). Petitioner suggests we may enter adverse judgment and still comply with Rule 42.107(e)'s prohibition on institution for disclaimed claims, as well as our precedential decision in *GE v. UT*. *See* Req. Reh'g 8–9. We decline to address either of those issues at this time. Instead, we determine that denying institution without entering adverse judgment is the appropriate means for disposing of this case.

ORDER

Accordingly, it is:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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