

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

OPUS KSD INC.,  
Petitioner,

v.

INCISIVE SURGICAL INC.,  
Patent Owner.

---

Case IPR2017-01438  
Patent 8,821,517 B2

---

Before FRANCES L. IPPOLITO, JAMES A. WORTH, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

Dismissing Motion to Deem Facts Admitted  
*37 C.F.R. § 42.23*

## I. INTRODUCTION

On May 15, 2017, Petitioner, Opus KSD, filed a Petition requesting *inter partes* review of claims 1–8 of U.S. Patent No. 8,821,517 B2 (“the ’517 patent”). Paper 1 (“Pet.”). Patent Owner, Incisive Surgical Inc., filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With its Preliminary Response, Patent Owner filed a copy of a statutory disclaimer disclaiming challenged claims 1–8 of the ’517 patent. Ex. 2001.

After authorization, Petitioner filed a Reply to the Preliminary Response, requesting that we treat Patent Owner’s statutory disclaimer as a request for adverse judgment, or, alternatively institute *inter partes* review over the challenged claims based on the grounds of unpatentability presented in the Petition. Paper 9 (“Reply”). Patent Owner filed an authorized Sur-reply to Petitioner’s Reply responding to Petitioner’s request for entry of adverse judgment. Paper 10 (“Sur-reply”).

Additionally, after authorization, Petitioner filed a Motion to Deem Facts Admitted directed to certain “Statements of Facts” presented in its Petition, (Paper 8 (“Mot.”)); Patent Owner filed an Opposition to Petitioner’s Motion (Paper 11); and Petitioner filed a Reply to Patent Owner’s Opposition (Paper 13).

We have reviewed the parties submissions and, for the reasons discussed below, we deny the Petition for *inter partes* review. Further, because the Petition is denied, and no *inter partes* review is instituted, we also dismiss as moot Petitioner’s Motion to Deem Facts Admitted.

## II. RELATED PROCEEDINGS

Patent Owner represents that U.S. Patent No. 9,713,472 (“the ’472 patent”) and U.S. Patent Application No. 15/630,461 (“the ’461 application”) are continuations of the ’517 patent. Prelim. Resp. 3.

### III. DENYING INSTITUTION OF INTER PARTES REVIEW

#### A. *Petitioner's Contentions*

In its Reply, Petitioner asserts that Patent Owner's disclaimer of all claims of the '517 patent should be treated as a request for adverse judgment under 37 C.F.R. 42.73(b)(1). Reply 1. According to Petitioner, disclaimer of all claims in the '517 patent is essentially a disclaimer of the *patent*. *Id.* at 1–2. Further, Petitioner argues that per Rule 42.73(b), a party may request adverse judgment against itself at any time during a “proceeding,” and that Rule 42.73(b)(1), unlike Rule 42.73(b)(2), is not limited to the “trial.” *Id.* at 2.

Petitioner further argues that Patent Owner's “undisclosed claim copying, the hardship to Petitioner, and the policy interest in finality and repose” are equitable considerations in favor of entering adverse judgment. Reply 1–3. Petitioner further contends that Patent Owner copied Petitioner's claims verbatim and did not notify the Office during the prosecution of the '517 patent of claim copying and priority issues. *Id.* at 3. Petitioner adds that “Incisive's strategy, left unchecked, invites Incisive to thwart IPR review by filing successive disclaimers and continuation applications, at Petitioner's and the public's potential cost.” *Id.* at 4. In this regard, Petitioner relies on *Smith & Nephew, Inc. v. Arthrex, Inc.*, Case IPR2016–00917, slip op. at 8 (PTAB Sept. 21, 2016) (Paper 12) (“*Arthrex*”), where the panel stated that “treating the disclaimer as a request for adverse judgment is in keeping with ‘the policies of finality and repose embodied in the doctrines of res judicata and collateral estoppel.’” *Id.* at 3.

Alternatively, Petitioner urges us to institute trial and asserts that we should accept the claims “lack support, are not entitled to priority and are invalid over the ’889 Publication.” Reply 1, 4.

*B. Patent Owner’s Contentions*

In its Preliminary Response, Patent Owner argues that institution would be improper under 37 C.F.R. § 42.107(e) (“No post-grant review will be instituted based on disclaimed claims”) because all claims of the ’517 patent have been disclaimed. Prelim. Resp. 4–5. Patent Owner asserts that its statutory disclaimer of the challenged claims should not be construed as a request for adverse judgment under 37 C.F.R. § 42.73(b), citing *FCA US LLC v. Jacobs Vehicle Systems, Inc.*, Case IPR2015–01234, slip op. at 3 (PTAB Oct. 23, 2015) (Paper 9) (“FCA”) (denying institution based on Patent Owner’s statutory disclaimer filed before institution) and *RPX Corp. v. Cedatech Holdings LLC*, Case IPR2015–00736, slip op. at 4 (PTAB Oct. 13, 2015) (Paper 11) (“RPX”), for the proposition that because trial has not been instituted, 37 C.F.R. § 42.73(b)(2) does not apply. Prelim. Resp. 5–6.

Further, in its Sur-reply, Patent Owner contends that “[b]ecause claims disclaimed by filing a statutory disclaimer during the preliminary proceeding never existed as of the Decision to Institute, there is no statutory or regulatory basis for instituting a trial. 37 C.F.R. §42.107(e).” Sur-reply 2. *See also id.* at 1 (citing *Guinn v. Kopf*, 96 F. 3d 1419 (Fed. Cir. 1996)). Patent Owner adds that there is no statutory or regulatory authority for the Board to apply patentee estoppel to disclaimed claims or to grant equitable relief. *Id.* at 3–4. Moreover, Patent Owner disputes Petitioner’s allegations that Patent Owner copied Petitioner’s claims. *Id.* at 4–5; *see* Ex. 2001,6.

*C. Analysis*

*1. Rule 42.73(b)(1)–(4)*

Initially, we note that none of the Board decisions cited by the parties have been designated as precedential, and, thus, none of those decisions are binding in the instant proceeding. *See* PTAB Standard Operating Procedure 2 (Rev. 9), available at <http://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/resources>. That being said, we have considered those opinions to the extent they offer guidance on the issue before us in this proceeding. Moreover, we note that, in its analysis, the *RPX* panel considered whether the patent owner’s pre-institution statutory disclaimer satisfied any of the four actions listed in 37 C.F.R. § 42.73(b)(1)–(4). We begin with the same inquiry.

Rule 42.73(b) provides that 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).

Here, Patent Owner has disclaimed the *claims* of the ’517 patent per 35 U.S.C. § 253(a) and filed the disclaimer form under 37 C.F.R. § 1.321(a) stating “I hereby disclaim the following complete *claims* in the above identified patent: Claims 1, 2, 3, 4, 5, 6, 7, and 8.” Ex. 2001, 7 (emphasis added). In doing so, Patent Owner has explicitly disclaimed *claims* of the ’517 patent, which we determine makes Rule 42.73(b)(1) inapplicable.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.