

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

ACCELERATED MEMORY TECH, LLC,
Patent Owner.

IPR2020-00191
Patent 6,513,062 B1

Before JENNIFER S. BISK, LYNNE H. BROWNE, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314, 37 C.F.R. § 42.107(e)

I. INTRODUCTION

A. Background and Summary

On December 3, 2019, Unified Patents Inc. (“Petitioner”) filed a
Petition requesting *inter partes* review of claims 1–7 of U.S. Patent No.
6,513,062 B1 (“the ’062 patent”) (Ex. 1001). Paper 2 (“Pet.”). On February
6, 2020, Accelerated Memory Tech, LLC (“Patent Owner”) filed a Request

for Adverse Judgment, explaining that a disclaimer disclaiming all the challenged claims was filed, and that there are no remaining claims at issue in this proceeding. Paper 7 (“Req.”); *see also* Ex. 2001 (Disclaimer).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons set forth below, we decline to institute an *inter partes* review of any claims challenged in the ’062 patent.

B. Real Parties in Interest

Petitioner identifies itself as the sole real party-in-interest. Pet. 1. Patent Owner identifies itself as the real party-in-interest. Paper 6, 2.

C. Related Matters

The parties identify *Accelerated Memory Tech, LLC v. Hulu, LLC*, Civil Action 1-19-cv-01158 (D. Del.), transferred to *Accelerated Memory Tech, LLC v. Hulu, LLC*, 2-19-cv-08968 (C.D. Cal.), *Accelerated Memory Tech, LLC v. Kemp Technologies, Inc.*, Civil Action 1-19-cv-00939 (D. Del.), *Accelerated Memory Tech, LLC v. F5 Networks, Inc.*, Civil Action 2-19-cv-00183 (W.D. Wa.), *Accelerated Memory Tech, LLC v. Barracuda Networks, Inc.*, Civil Action 2-18-cv-00175 (N.D. Ga.), and *Accelerated Memory Tech, LLC v. Citrix Systems, Inc.*, Civil Action 2-18-cv-00052 (N.D. Ga.) as related matters. Pet. 1; Paper 6, 2.

II. ANALYSIS

A “patent owner may file a statutory disclaimer under 35 U.S.C. [§] 253(a) in compliance with §1.321(a) of this chapter, disclaiming one or

more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e) (2019).

A disclaimer under 35 U.S.C. § 253(a) is “considered as part of the original patent” as of the date on which it is “recorded” in the Office.

35 U.S.C. § 253(a). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee’s ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in 37 C.F.R. § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that a § 253 disclaimer is “recorded” on the date that the Office receives a disclaimer meeting the requirements of 37 C.F.R. § 1.321(a), and that no further action is required in the Office for a disclaimer to be “recorded”).

Here, Patent Owner filed a statutory disclaimer of claims 1–8 of the ’062 patent. Ex. 2001. Based on our review of Exhibit 2001 and Office public records, we conclude that a disclaimer of claims 1–8 of the ’062 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of January 29, 2020. Because all challenged claims 1–7 have been disclaimed under 35 U.S.C. § 253(a), in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted. 37 C.F.R. § 42.107(e); *General Electric Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017)

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(precedential) (declining to institute *inter partes* review when all challenged claims were disclaimed under 35 U.S.C. § 253(a)).

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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