

## Contingent Statement Doesn't Unequivocally Abandon Defense of Challenged Claims

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The Director of the US Patent & Trademark Office (PTO) initiated a *sua sponte* review of the Patent Trial & Appeal Board's (Board) adverse judgments in multiple related *inter partes* review (IPR) proceedings. The PTO Director ultimately ordered that the judgments be vacated and remanded for further consideration. *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01124; -01125; -01126; -01129 (Dec. 21, 2022) (Vidal, Dir.)

Apple filed six petitions for IPR, all of which were instituted and assigned to the same panel of Administrative Patent Judges. After institution, Zipit filed responses to two of the IPRs, but not the other four companion IPRs. The Board held a hearing in the two IPRs for which Zipit filed responses. At the end of the hearing, Zipit's counsel was asked with reference to the four companion IPRs whether Zipit was "not contesting if a final written decision or adverse judgment was entered with respect to those IPRs." The counsel responded, "correct . . . if the board determines that [Apple has] met their burden of proof with respect to those claims Zipit hasn't filed any opposition." Based on this exchange, the Board determined that Zipit abandoned the contests and entered adverse judgments.

The PTO Director initiated review under the interim process for Director review §§ 13, 22, which allows *sua sponte* Director review, explaining that notice would be given to parties of the proceedings if such a review was initiated. Upon review, the PTO Director did not consider the counsel's statements to be an "unequivocal abandonment of the contest of these proceedings." In an IPR, a petitioner has the "burden of proving a proposition of unpatentability by a preponderance of the evidence" and the "burden from the onset to show with particularity why the patent it challenges is unpatentable." The PTO Director's interpretation of Zipit's statements was that "non-opposition was contingent on the Board determining that [Apple] met its burden of proving by a preponderance of the evidence that the challenged claims are unpatentable."

The PTO Director thus vacated the Board's adverse judgments and remanded the proceedings to the panel to issue either an order clarifying whether Zipit indeed abandoned the contest or a final written decision addressing the patentability of the challenged claims.

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