

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,
Petitioner,

v.

XY, LLC,
Patent Owner.

Case IPR2017-02184
Patent 7,208,265 B1

Before GRACE KARAFFA OBERMANN, SUSAN L. C. MITCHELL, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

JUDGMENT AND FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. §§ 42.72; 42.73(b)

BACKGROUND

Petitioner filed a Petition requesting inter partes review of claims 1–4, 8–20, 22, and 26–28 of U.S. Patent No. 7,208,265 B1 (“the ’265 patent”). Paper 1. The Board granted the Petition and instituted review of all challenged claims. Paper 10. On July 6, 2018, Patent Owner submitted a notification alerting the Board of the filing of a Disclaimer directed to claims 1–4, 8–20, 22, and 26–28 of the ’265 patent (that is, all claims challenged in this proceeding). Paper 20. Patent Owner concurrently filed a copy of the Disclaimer submitted to the Office pursuant to 35 U.S.C. § 253(a). Ex. 2002 (copy of Disclaimer filed July 6, 2018, including Electronic Acknowledgement Receipt).

In the notification, Patent Owner requests entry of adverse judgment against itself pursuant to 37 C.F.R. § 42.73(b)(2). Paper 20. Patent Owner also requests termination of the trial. *Id.*

DISCUSSION

A party may request entry of adverse judgment against itself at any time during a proceeding. *See* 37 C.F.R. § 42.73(b). Here, Patent Owner disclaims all challenged claims; therefore, no claim remains at issue in this trial. Paper 20; Ex. 2002. Patent Owner “requests adverse judgment against itself.” Paper 20. Accordingly, entry of judgment adverse to Patent Owner is appropriate.

Patent Owner, however, also requests termination of the trial. *Id.* Termination may be appropriate, for example, “where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a).” 37 C.F.R. § 42.72. Patent Owner advances no information supporting termination and that result is not appropriate given the particular facts and circumstances presented in the notification. Paper 20 (requesting termination but providing no

argument or evidence supporting that result). Specifically, in view of the Disclaimer and Patent Owner's express request for entry of adverse judgment against itself (Paper 20; Ex. 2002), the appropriate outcome is entry of a final judgment adverse to Patent Owner. *See, e.g., Delphix Corp. v. Actifio, Inc.*, Case IPR2015-01689 (P.T.A.B. June 1, 2016) (non-precedential), Paper 15 (entering final judgment against Patent Owner in response to a disclaimer of all challenged claims).

CONCLUSION

In view of the Disclaimer (Ex. 2002), and Patent Owner's express request for entry of adverse judgment against itself (Paper 20), we *grant* the request for entry of judgment adverse to Patent Owner. We *deny* the request for termination.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for entry of adverse judgment is *granted*;

FURTHER ORDERED that adverse judgment hereby is entered against Patent Owner pursuant to 37 C.F.R. § 42.73(b)(2);

FURTHER ORDERED that Patent Owner's request for termination of the trial is *denied* pursuant to 37 C.F.R. § 42.72;

FURTHER ORDERED that this constitutes a final written decision under 35 U.S.C. § 318(a); and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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