

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OPOWER INC.,
Petitioner,

v.

CLEANTECH BUSINESS SOLUTIONS, LLC,
Patent Owner.

Case CBM2014-00155
Patent 8,489,245 B2

Before KARL D. EASTHOM, TREVOR M. JEFFERSON, and
J. JOHN LEE, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

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

Patent Owner filed a Notice of Related Proceeding requesting an adverse judgment in this proceeding. Paper 28 (“Notice”). The Notice states that Patent Owner filed a statutory disclaimer in an ongoing reissue proceeding (U.S. Pat. App. No. 12/701,390) involving the same patent at issue here (U.S. Patent No. 8,489,245 B2). The Notice also states that Patent Owner “disclaim[s] claims 1-16 of U.S. Patent No. 8,489,245 (the ’245 [p]atent). According to 37 C.F.R. § 42.73(b)(2) . . . this disclaimer constitutes a request for adverse judgment.” Paper 28, 1.

I. BACKGROUND

On January 12, 2015, the Board instituted a review of the patentability of claims 1–16 of the ’245 patent. Paper 10. Patent Owner filed a Response (Paper 19), Petitioner filed a Reply (Paper 20), and the parties requested and appeared at an Oral Hearing on Oct. 8, 2015 (*see* Paper 27 (Record of Oral Hearing)). On November 5, 2015, Patent Owner filed the aforementioned statutory disclaimer in the noted reissue proceeding. *See* Paper 28 (attaching a copy of a “Disclaimer in Patent Under 37 CFR § 1.321(a)”). On November 6, 2015, as indicated above, Patent Owner requested adverse judgment in this proceeding. Paper 28.

II. DISCUSSION

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Actions construed as a request for entry of adverse judgment include “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b)(2). Here, Patent Owner has disclaimed, under 37 C.F.R. § 1.321, claims 1–16, all claims

involved in this trial. Paper 28. The statutory disclaimer constitutes a request for entry of adverse judgment.¹

III. CONCLUSION

Entry of judgment against Patent Owner with respect to claims 1–16 of the '245 patent is appropriate.

IV. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1–16 of the '245 patent; and

FURTHER ORDERED that this Order constitutes a Final Written Decision under 35 U.S.C. § 328(a).

¹ During a telephone conference on November 17, 2015, which included counsel for both parties and the panel, counsel for Petitioner stated he did not object to the request for adverse judgment, but requested that the panel issue with this judgment findings of fact and legal determinations arising from papers of record. Petitioner expressed a concern over a potential for duplicated efforts in ongoing reissue proceedings involving the '245 patent. We exercise our discretion and decline the request to supplement the record. *See* 37 C.F.R. § 42.73(d) (3) (i) (precluding Patent Owner from obtaining claims that are not “patentably distinct from a finally refused or canceled claim”).

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