

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioners,

v.

UNIFI SCIENTIFIC BATTERIES, LLC,
Patent Owner.

Cases IPR2013-00213 and IPR2013-00236
Patent 6,791,298 B2

Before MICHAEL R. ZECHER, JUSTIN T. ARBES, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

JUDGMENT
Request for Adverse Judgment
37 C.F.R. § 42.73(b)

Petitioner Texas Instruments Incorporated filed a petition in Case IPR2013-00213 seeking *inter partes* review of U.S. Patent No. 6,791,298 B2 (“the ’298 patent”). IPR2013-00213, Paper 1. On September 25, 2013, we instituted an *inter partes* review of claims 1 and 4-18 of the ’298 patent on one ground of unpatentability. IPR2013-00213, Paper 12.

Petitioner Samsung Electronics Co., Ltd. also filed a petition in Case IPR2013-00236 seeking *inter partes* review of the ’298 patent. IPR2013-00236, Paper 1. On September 25, 2013, we instituted an *inter partes* review of claims 1, 4-10, 13, 14, 17, and 18 of the ’298 patent on three grounds of unpatentability. IPR2013-00236, Paper 10. Claims 2, 3, and 19-29 of the ’298 patent are not involved in either review.

On June 11, 2014, Patent Owner Unifi Scientific Batteries, LLC filed in each proceeding a “Notice Regarding Filing of Disclaimer in Patent Under 37 C.F.R. § 1.321(a) and Request for Adverse Judgment.” See IPR2013-00213, Paper 38; IPR2013-00236, Paper 47. Patent Owner states in each paper that it filed a disclaimer of claims 1 and 4-18 of the ’298 patent and now “requests adverse judgment against itself with respect to claims 1 and 4-18.” Patent Owner filed a copy of the disclaimer in each proceeding. See IPR2013-00213, Ex. 2036; IPR2013-00236, Ex. 2040.

Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Cancellation or disclaimer of one or more claims, such that the patent owner has no remaining claim in the trial, is construed to be a request for adverse judgment. 37 C.F.R. § 42.73(b)(2). Patent Owner has disclaimed all of the claims of the ’298 patent on which a trial was instituted in the instant proceedings, such that after the disclaimer, it will have no remaining claim in either trial.

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In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request for adverse judgment under 37 C.F.R. § 42.73(b) in each proceeding is *granted*; and

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 1 and 4-18 of the '298 patent.

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