

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MCWANE, INC.,  
Petitioner,

v.

TOM W. WAUGH,  
Patent Owner.

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Case IPR2014-00777  
Patent 8,567,155 B2

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Before FRANCISCO C. PRATS, MICHAEL J. FITZPATRICK, and  
BRIAN P. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

JUDGMENT  
Termination of the Proceeding  
*37 C.F.R. § 42.73(b)*

## BACKGROUND

On October 24, 2014, we instituted *inter partes* review of claims 1-9 of U.S. Patent No. 8,567,155 B2 (“the ’251 patent”). Paper 8. On October 28, 2014, Patent Owner filed a Supplemental Amendment in co-pending reissue patent application 14/272,076 (hereafter, “the Reissue Application”) in which Patent Owner, *inter alia*, cancelled claims 1-9 of the ’255 patent. Ex. 2001. Several new claims remain pending in the Reissue Application. *Id.* at 2-3.

On November 18, 2014, we convened an Initial Conference call among counsel for Petitioner and Patent Owner, and Judges Prats, Fitzpatrick, and Murphy. The parties and the Board discussed the posture of this *inter partes* review proceeding and the procedure to be followed in view of Patent Owner’s Supplemental Amendment filed in the Reissue Application. At the request of the Board, counsel for Petitioner and Patent Owner agreed to confer in an effort to propose a form of adverse judgment in this trial proceeding. The adverse judgment discussed would take effect immediately upon issuance of a reissue patent from the Reissue Application (hereafter, “the Reissue Patent”), in order not to prejudice the issuance of Patent Owner’s remaining claims. Accordingly, on November 25, 2014, Patent Owner and Petitioner filed a Joint Request for Adverse Judgment Against Patent Owner under 37 C.F.R. § 42.73(b)(3) (hereafter, “Joint Request”). Paper 12 (“Jnt. Req.”).

## DISCUSSION

A party may request entry of adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Grounds for an adverse judgment include a “concession of unpatentability” by Patent Owner pursuant to 37 C.F.R. § 42.73(b)(3). The Joint Request acknowledges Patent Owner’s desire for the

issuance of the Reissue Patent and Patent Owner's concession of the unpatentability of claims 1-9 of the '251 patent. Jnt. Req. 1. The Joint Request further represents that the claims remaining in the Reissue Application have been allowed and the issue fee has been paid. *Id.* Patent Owner and Petitioner, therefore, desire entry of adverse judgment consistent with Patent Owner's concession of the unpatentability of claims 1-9 of the '251 patent, and "the intent of the parties is that both entry of an adverse judgment in this *Inter Partes* Review and issuance of the forthcoming Reissue Patent will occur on the day that the Reissue Patent issues." *Id.* at 2. On January 8, 2015, Patent Owner filed a Notice of Filing Exhibit and entered the Issue Notification for Reissue Application No. 14/272,076 ("the Reissue Notification") received from the United States Patent and Trademark Office as an exhibit. Paper 13; Ex. 2002. The Reissue Notification provides a date of January 13, 2015 for issuance of the Reissue Patent. *Id.*

Accordingly, in reliance on all of the representations made by Patent Owner and Petitioner in the Joint Request, and in view of the Reissue Notification, we conclude that Patent Owner has conceded the unpatentability of claims 1-9 of the '255 patent effective immediately upon issuance of the Reissue Patent. Under the particular circumstances of this proceeding, the Joint Request for entry of adverse judgment against Patent Owner is appropriate.

#### ORDER

For the reasons given above, it is

ORDERED that the Joint Request for Adverse Judgment Against Patent Owner under 37 C.F.R. § 42.73(b)(3) with respect to claims 1-9 of U.S. Patent No. 8,567,155 B2 is GRANTED;

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ORDERED that this adverse judgment against Patent Owner is effective immediately upon issuance of the Reissue Patent from U.S. Reissue Application No. 14/272,076, and,

ORDERED that judgment is entered against Patent Owner with respect to claims 1-9 of U.S. Patent No. 8,567,155 B2.

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