

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CATERPILLAR INC.,
Petitioner,

v.

ESCO CORPORATION,
Patent Owner.

Case IPR2015-00409
Patent 8,689,472 B2

Before PHILLIP J. KAUFFMAN, SCOTT A. DANIELS, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

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

BACKGROUND

The Petition seeks *inter partes* review of claims 1–20 of U.S. Patent 8,689,472 B2 (Ex. 1001, “the ’472 patent”). Paper 2. Patent Owner filed a preliminary response. Paper 7. We granted the Petition and instituted *inter partes* review of claim 14. Paper 9. Petitioner requested rehearing. Paper 12. Patent Owner filed an opposition (Paper 13) and Petitioner filed a reply (Paper 14). We declined to modify our decision. Paper 16.

Patent Owner filed a notice seeking to “disclaim” claim 14 so that no patent would remain at issue in the proceeding and judgment could be entered. Paper 17. The Board held a conference call and indicated its preference for the disposition of claim 14 to be handled via the filing with the Office of a statutory disclaimer pursuant to 35 U.S.C. § 253 and 37 C.F.R. § 1.321. Paper 18. Patent Owner subsequently filed a notice indicating that it had disclaimed claim 14 pursuant to 35 U.S.C. § 253. Paper 19, Ex. 2053.

DISCUSSION

Under 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include disclaimer of a claim such that the party has no remaining claim in the trial. *See* 37 C.F.R. § 42.73(b)(2). Claim 14 of the ’472 patent is the only claim for which trial was instituted; Patent Owner has disclaimed claim 14, and consequently, Patent Owner has no remaining claim in this *inter partes* review. Under these circumstances, the entry of judgment adverse to the Patent Owner and termination of these proceedings is appropriate.

CONCLUSION AND ORDER

It is, therefore,

ORDERED that adverse judgment against the Patent Owner is entered and this proceeding is terminated under 37 C.F.R. § 42.73(b); and

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

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