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Paper 20 IPR2015-00677

Paper 17 IPR2015-00678

Entered: December 4, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRYKER CORPORATION,
Petitioner,

v.

KARL STORZ ENDOSCOPY-AMERICA, INC.,
Patent Owner.

Case IPR2015-00677
Case IPR2015-00678¹
Patent 8,069,420 B2

Before BRYAN F. MOORE and BARRY L. GROSSMAN,
Administrative Patent Judges.

GROSSMAN, *Administrative Patent Judge.*

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

¹ We use this caption to indicate that this Judgment applies to, and is entered in, both cases. The parties are not authorized to use this caption.

I. INTRODUCTION

Stryker Corporation (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–4, 6, 7, 9, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–55, 57, 68, 72–74, 76, 77, and 79–83 of U.S. Patent No. 8,069,420 B2 (“the ’420 patent”). Paper 2² (“Pet.”). Karl Storz Endoscopy-America, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We instituted an *inter partes* review of claims 1, 2, 4, 6, 7, 9, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–55, 57, 68, 73, 76, 77, 79, 80, 82, and 83. Paper 15 (“Dec. on Instit.”). We did not institute an *inter partes* review on challenged claims 3 and 81. *Id.* Patent Owner did not file a Patent Owner Response.

Patent Owner filed a Notice Regarding Filing of Disclaimer of a Claim in a Patent Under 37 C.F.R. § 1.321(a) informing the Board that a disclaimer was filed in the ’420 patent disclaiming claims 1, 2, 4, 6, 7, 9, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–55, 57, 68, 73, 76, 77, 79, 80, 82, and 83 of the ’420 patent, which include all of the claims on which *inter partes* review was instituted. Paper 18 (“Notice of Disclaimer”). A copy of the disclaimer was filed as Exhibit 2007.

The Notice of Disclaimer included a request for adverse judgment under 37 C.F.R. § 42.73(b)(2) with respect to claims 1, 2, 4, 6, 7, 9, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–55, 57, 68, 73, 76, 77, 79, 80, 82, and 83 of the ’420 patent, which are all the claims on which *inter partes* review was instituted. Notice of Disclaimer, 1 (“Patent Owner hereby requests judgment against itself under 37 C.F.R. § 42.73(b)(2)”).

² All citations are to the record in IPR2015-00677. Similar documents also have been filed in IPR2015-00678.

II. DISCUSSION

A party may request entry of adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). 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 claims on which trial was instituted in this *inter partes* review, such that there are no remaining claims in the trial, and has expressly requested entry of adverse judgment. Notice of Disclaimer, 1.

III. ORDER

For the reasons given, it is:

ORDERED that adverse judgment is entered against claims 1, 2, 4, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–53, 57, 68, 73, 76, 77, 79, 80, 82, and 83 of the '420 patent; and

FURTHER ORDERED that IPR2015-00677 and IPR2015-00678 are hereby terminated.

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