

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

Case IPR2015-00941
Patent 6,775,601 B2

Before JOSIAH C. COCKS, MITCHELL G. WEATHERLY, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

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

I. BACKGROUND

Petitioner, Mercedes-Benz USA, LLC (“Mercedes”), filed a Petition for *inter partes* review of claims 8–11, 13, 15, and 17 of U.S. Patent 6,775,601 B2 (the “’601 patent”) on March 25, 2015. Paper 1. Patent Owner, Signal IP, Inc. (“Signal IP”), filed a Patent Owner’s Preliminary Response on July 2, 2015. Paper 8. We instituted trial as to claims 8–11, 13, 15, and 17 of the ’601 patent on September 29, 2015. Paper 15. Signal IP subsequently filed a Patent Owner’s Response on December 15, 2015. Paper 18 (“Response” or “PO Resp.”). Mercedes filed a Reply to Signal IP’s Response on March 7, 2016. Paper 20.

In the Response, Signal IP represented that in a concurrent Reexamination of the ’601 patent (Control No. 90/013,385) it filed an amendment seeking to cancel claims 8–11, 13, 15, and 17.¹ On December 28, 2015, Signal IP filed a copy of an *Ex Parte* Reexamination Certificate that issued in connection with the ’601 patent on December 23, 2015. Ex. 2006. That Certificate indicates that claims 8–11, 13, 15, and 17 are cancelled. *Id.* at 1:15. Therefore, every claim subject to this *inter partes* review has been canceled, and no claims remain in this trial.

II. ANALYSIS

As set forth in 37 C.F.R. § 42.73:

(b) *Request for adverse judgment.* A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include: . . .

¹ The Response also indicates that claims of the ’601 patent not involved in this proceeding (i.e., claims 1–7, 12, 14, and 16) have been disclaimed. PO Resp. 3; *see also* Ex. 2005 (“Statutory Disclaimer”).

(2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial.

Pursuant to 37 C.F.R. § 42.73(b), we construe cancellation of all claims involved in this proceeding as a request for adverse judgment. We grant that request and enter judgment against Signal IP under 37 C.F.R. § 42.73.

III. ORDER

Accordingly, it is

ORDERED that judgment is entered under 37 C.F.R. § 42.73 against Signal IP with respect to claims 8–11, 13, 15, and 17 of the '601 patent; and

FURTHER ORDERED that this Order constitutes a Final Written Decision under 35 U.S.C. § 318(a).

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