

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
HONDA OF AMERICA MFG., INC.,
HONDA PATENTS & TECHNOLOGIES NORTH AMERICA, LLC, and
HONDA MOTOR CO., LTD.,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

Case IPR2015-01005
Patent 6,434,486 B1

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

BOUDREAU, *Administrative Patent Judge*.

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

I. BACKGROUND

The Board instituted *inter partes* review of claims 1, 2, 6–9, 13, 14, 21, 22, 26–29, 33, and 34 of U.S. Patent No. 6,434,486 B1 (“the ’486 patent”) on September 18, 2015. Paper 8. On November 11, 2015, Signal IP, Inc. (“Patent Owner”) filed Patent Owner’s Second Updated Mandatory Notices pursuant to 37 C.F.R. § 42.8(a)(2). Paper 11 (“Updated Notices”). In its Updated Notices, Patent Owner indicates that: (1) Reexamination Certificate US 6,434,486 C1 issued on November 6, 2015, cancelling claims 21, 26, and 28 of the ’486 patent and adding new claims 41–77; (2) Patent Owner filed a statutory disclaimer with respect to claims 1, 2, 6–9, 13, 14, 22, 23, 27, 29, 30, 33, 34, and 35 of the ’486 patent on November 10, 2015; and (3) accordingly, there are no claims for which trial was instituted remaining in the ’486 patent. Paper 11, 2.¹

II. DISCUSSION

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Under the Rules, actions construed as a request for entry of adverse judgment include “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b)(2). Here, claims 21, 26, and 28 of the ’486 patent were cancelled in Reexamination Certificate US 6,434,486 C1 (Ex. 2004), and Patent Owner subsequently disclaimed, under 37 C.F.R. § 1.321, claims 1, 2, 6–9, 13, 14, 22, 23, 27, 29, 30, 33, 34, and 35 of the ’486 patent (Ex. 2005).

¹ Patent Owner filed copies of the reexamination certificate and statutory disclaimer referenced in its Updated Notices as Exhibits 2004 and 2005, respectively. Paper 11, 2.

Because Patent Owner disclaimed, *inter alia*, claims 1, 2, 6–9, 13, 14, 22, 27, 29, 33, and 34 of the '486 patent, constituting all of the claims involved in this trial that had not already been cancelled in the reexamination certificate, we construe Patent Owner's statutory disclaimer as a request for entry of adverse judgment.

III. CONCLUSION

Having reviewed Reexamination Certificate US 6,434,486 C1 and Patent Owner's statutory disclaimer with respect to claims 1, 2, 6–9, 13, 14, 22, 23, 27, 29, 30, 33, 34, and 35 of the '486 patent, we determine that entry of judgment against Patent Owner with respect to claims 1, 2, 6–9, 13, 14, 21, 22, 26–29, 33, and 34 of the '486 patent is appropriate.

IV. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1, 2, 6–9, 13, 14, 21, 22, 26–29, 33, and 34 of the '486 patent; and

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

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