

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC., TELECOMMUNICATION
SYSTEMS, INC., ERICSSON INC., AND
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

TRACBEAM, LLC,
Patent Owner.

Case IPR2015-01712
Patent 7,298,327 B2

Before KEVIN F. TURNER, DAVID C. McKONE, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

I. BACKGROUND

T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson (collectively, “Petitioner”) filed a Petition (Paper 1) to institute an *inter partes* review of claims 1, 2, 3, 5, 17, 18, 28, 44, 60, 61, and 76 of U.S. Patent No. 7,298,327 B2 (Ex. 1004, “the ’327 patent”). TracBeam, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6). The parties reached agreement to remove claims 3, 5, 17, 18, 28, 61, and 76 from the proceeding; we accepted that agreement and limited this proceeding to claims 1, 2, 44, and 60. Papers 7–9. Subsequently, we instituted an *inter partes* review of claim 60 of the ’327 patent, but not claims 1, 2, and 44. Paper 10.

On October 31, 2016, Patent Owner notified the Board that it had filed a statutory disclaimer under 37 C.F.R. § 1.321(a) of claim 60 of the ’327 patent, which constitutes the only remaining claim at issue in this *inter partes* review. Paper 19. Patent Owner also filed a copy of the disclaimer, as well as an electronic acknowledgement receipt of the filing, as Appendices to the Notice. *Id.*

II. DISCUSSION

A party may request adverse judgment against itself at any time. *See* 37 C.F.R. § 42.73(b). Here, Patent Owner requests adverse judgment because no claims remain in the trial after Patent Owner’s disclaimer of all the claims at issue in this proceeding. *See* 37 C.F.R. § 42.73(b)(2). We *grant* Patent Owner’s request and enter judgment against Patent Owner

under 37 C.F.R. § 42.73(b). Our prior Order granting Petitioner's request for oral hearing is hereby *dismissed* as moot. *See* Paper 18.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for adverse judgment is *granted*, and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b);

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

FURTHER ORDERED that the previously granted oral hearings in these proceedings are *dismissed* as moot.

IPR2015-01712
Patent 7,298,327 B2

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