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Paper 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIRECTV, LLC, DISH NETWORK L.L.C., and
UNIFIED PATENTS INC.,
Petitioners,

v.

QURIO HOLDINGS, INC.,
Patent Owner.

Cases
IPR2015-02005 (Petitioner DIRECTV, LLC)
IPR2016-00007 (Petitioner DISH NETWORK L.L.C.)
IPR2016-00998 (Petitioner UNIFIED PATENTS INC.)

Patent 7,787,904 B2

Before BARBARA A. BENOIT, KERRY BEGLEY, and
JASON J. CHUNG, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

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

I. BACKGROUND

In *DIRECTV, LLC v. Qurio Holdings, Inc.*, Case IPR2015-02005, Petitioner, DIRECTV, LLC, filed a substitute Petition for *inter partes* review of claims 1–3, 10, 12, and 15–18 of U.S. Patent No. 7,787,904 B2 ("the '904 patent"). Paper 3. Patent Owner, Qurio Holdings, Inc., filed a Preliminary Response. Paper 7. On April 4, 2016, we instituted an *inter partes* review of all of the challenged claims. Paper 9. On May 31, 2016, Patent Owner filed a corrected Request for Adverse Judgment, asking the Board to cancel claims 1–3, 10, 12, and 15–18 of the '904 patent, which constitute all of the claims at issue in IPR2015-02005. Paper 13 ("Request for Adverse Judgment – corrected 2").

In *DISH Network L.L.C. v. Qurio Holdings, Inc.*, Case IPR2016-00007, Petitioner, DISH Network L.L.C., filed a Petition for *inter partes* review of claims 1–4, 7, 10, 12–18, and 20 of the '904 patent. Paper 1. Patent Owner filed a Preliminary Response. Paper 5. On April 4, 2016, we instituted an *inter partes* review of all of the challenged claims. Paper 6. On May 31, 2016, Patent Owner filed a corrected Request for Adverse Judgment, asking the Board to cancel claims 1–4, 7, 10, 12–18, and 20 of the '904 patent, which constitute all of the claims at issue in IPR2016-00007. Paper 10 ("Request for Adverse Judgment – corrected 2").

On May 4, 2016, in *Unified Patents Inc. v. Qurio Holdings, Inc.*, Case IPR2016-00998, Petitioner, Unified Patents Inc., filed a Petition for *inter partes* review of claims 1–3, 10, 12, and 15–18 of the '904 patent. Paper 2. Unified Patents Inc. concurrently filed a Motion for Joinder, requesting "silent party joinder" with the *inter partes* review of the '904 patent in IPR2015-02005. Paper 3.

II. DISCUSSION

A party may request adverse judgment against itself at any time. 37 C.F.R. § 42.73(b). In IPR2015-02005 and IPR2016-00007, Patent Owner requests adverse judgment and the cancellation of all of the claims on which *inter partes* review was instituted. Thus, after the cancellation of the specified claims of the '904 patent, no claims would remain in either *inter partes* review. Under these circumstances, the Requests for Adverse Judgment are appropriate. Therefore, we grant Patent Owner's requests and enter judgment in IPR2015-02005 and IPR2016-00007 against Patent Owner under 37 C.F.R. § 42.73(b).

In IPR2016-00998, the Board has not instituted *inter partes* review. After the cancellation of the requested claims, none of the claims challenged in IPR2016-00998 would remain. Even without an express request from Patent Owner to terminate this proceeding, Patent Owner's request to cancel all of the challenged claims leaves nothing to be decided with regard to patentability of the challenged claims and would have no practical effect. Moreover, under 37 C.F.R. § 42.73(b)(2), cancellation of a claim such that the party has no remaining claim in the trial is to be construed as a request for adverse judgment. Therefore, it is appropriate to dismiss Unified Patents Inc.'s Petition and Motion for Joinder as moot and to enter judgment in IPR2016-00998 against Patent Owner under 37 C.F.R. § 42.73(b). *See also* 37 C.F.R. § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part . . . ."); 37 C.F.R. § 42.71(a) ("The Board . . . may . . . dismiss any petition. . . .").

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for adverse judgment in IPR2015-02005 is granted, and judgment is entered against Patent Owner in IPR2015-02005 under 37 C.F.R. § 42.73(b) with respect to claims 1–3, 10, 12, and 15–18 of the '904 patent;

FURTHER ORDERED that Patent Owner's request for adverse judgment in IPR2016-00007 is granted, and judgment is entered against Patent Owner in IPR2016-00007 under 37 C.F.R. § 42.73(b) with respect to claims 1–4, 7, 10, 12–18, and 20 of the '904 patent;

FURTHER ORDERED that claims 1–4, 7, 10, 12–18, and 20 of U.S. Patent No. 7,787,904 B2 are CANCELLED;

FURTHER ORDERED that Unified Patents Inc.'s Petition (Paper 2) and Motion for Joinder (Paper 3) filed in IPR2016-00998 are dismissed as moot;

FURTHER ORDERED that judgment is entered against Patent Owner in IPR2016-00998 under 37 C.F.R. § 42.73(b) with respect to claims 1–3, 10, 12, and 15–18 of the '904 patent; and

FURTHER ORDERED that a copy of this Decision is to be entered into the file of Cases IPR2015-02005, IPR2016-00007, and IPR2016-00998.

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