

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

McAFEE, INC.,
Petitioner,

v.

CAP CO., LTD.,
Patent Owner.

Case IPR2016-00211
Patent RE44,249 E

Before DONNA M. PRAISS, PATRICK M. BOUCHER, and J. JOHN LEE,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

JUDGMENT
37 C.F.R. § 42.73(b)

On November 18, 2015, McAfee, Inc. (“Petitioner”) filed a Petition (Paper 1) requesting *inter partes* review of claims 16–23 and 28–36 (“the challenged claims”) of U.S. Patent No. RE44,249 E (Ex. 1001, “the ’249 patent”). An *inter partes* review of all challenged claims was instituted on April 20, 2016. Paper 8. CAP Co., Ltd. (“Patent Owner”) filed a Motion to Amend (Paper 15, “Mot. Amend”) requesting cancellation of all challenged claims, and Petitioner filed a response (Paper 17, “Resp. Mot. Amend”).

In its Motion to Amend, Patent Owner moves to cancel all challenged claims under 35 U.S.C. § 316 and 37 C.F.R. § 42.121, and further states it “chooses not to contest the instituted claims, and therefore has canceled all instituted claims.” Mot. Amend. 1. Although the title of the Motion is “Conditional Motion to Amend,” Patent Owner does not mention any contingency on which its Motion is conditioned. Petitioner does not oppose Patent Owner’s Motion. Resp. Mot. Amend. 1.

An action constituting cancellation or disclaimer of claims such that no claims remain in the trial is construed as a request for adverse judgment. 37 C.F.R. § 42.73(b)(2). Thus, we construe Patent Owner’s Motion to Amend as such a request, and grant the request.

ORDER

It is

ORDERED that Patent Owner’s request for adverse judgment is *granted*;

FURTHER ORDERED that claims 16–23 and 28–36 of the ’249 patent shall be *canceled*; and

FURTHER ORDERED that final judgment is entered against Patent Owner with respect to all challenged claims in this proceeding.

PETITIONER:

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