

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SECURUS TECHNOLOGIES, INC.,
Petitioner,

v.

GLOBAL TEL*LINK CORPORATION,
Patent Owner.

Case IPR2016-01446
Patent 7,333,798 B1

Before KEVIN F. TURNER, BARBARA A. BENOIT, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ORDER
Termination of the Proceeding
37 C.F.R. §§ 42.73, 42.107(e)

Securus Technologies, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–5 of U.S. Patent No. 7,333,798 B1 (Ex. 1001, “the ’798 patent”). Global Tel*Link Corporation (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.” Paper 6) requesting cancellation of the challenged claims under 35 U.S.C. § 253(s) and in compliance with 37 C.F.R. § 1.321(a). Patent Owner states that the “present Statutory Disclaimer does not constitute an admission or acquiescence by Patent Owner with regard to the Petition.” Prelim. Resp. 1. Contemporaneously with the filing of the Preliminary Response, Patent Owner filed a copy of its Statutory Disclaimer. Ex. 2001 (the “Disclaimer”).

Under 35 U.S.C. § 253(a), a patentee may disclaim any claim. This applies to the extent of a patentee’s ownership interest in the claim, whether of the whole or any sectional interest therein. *Id.* Under 37 C.F.R. § 42.107(e), a Patent Owner can file a Preliminary Response that includes a statutory disclaimer under 35 U.S.C. § 253(a). Rule 107(e) states that no *inter partes* review will be instituted based on disclaimed claims. Inasmuch as Patent Owner has disclaimed each and every claim for which *inter partes* review is sought by Petitioner, no claim remains to be adjudicated in this proceeding.

Under 37 C.F.R. § 42.73(b), a party may request an adverse judgment at any time during a proceeding. Disclaimer of claims, such that a party has no remaining claim in the proceeding, is deemed a request for entry of adverse judgment. 37 C.F.R. § 42.73 (b)(1) & (2). Accordingly, we construe Patent Owner’s statutory disclaimer of all of the challenged claims in the ’798 patent as a request for adverse judgment.

ORDER

For the reasons set forth above, it is:

ORDERED that judgment is herein entered against Patent Owner with respect to claims 1–5 of the '798 patent on the basis that such claims have been disclaimed.

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