

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESHPOINT QUALITY ASSURANCE LTD.,
Petitioner,

v.

JP LABORATORIES INC.,
Patent Owner.

Case IPR2017-00538
Patent 8,343,437 B2

Before JO-ANNE M. KOKOSKI, JEFFREY W. ABRAHAM, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*

ABRAHAM, *Administrative Patent Judge*

JUDGMENT AND FINAL WRITTEN DECISION
Granting Request for Adverse Judgment After Institution of Trial
35 U.S.C. 318(a); 37 C.F.R. 42.73(b)

Freshpoint Quality Assurance, Ltd. (“Petitioner”) filed a Petition seeking an *inter partes* review of claims 1, 16, 24, 28, 34, 40, 55, 67, 76, 82–89, 91, 92, 94, 95, 100, 113, and 118 (“challenged claims”) of U.S. Patent No. 8,343,437 B2 (Ex. 1001, “the ’437 patent”).¹ Paper 1 (“Pet.”). JP Laboratories Inc. (“Patent Owner”) did not file a Patent Owner Preliminary Response to the Petition. We granted Petitioner’s request to institute an *inter partes* review of the challenged claims, and trial was instituted on July 12, 2017. Paper 8.

Patent Owner did not file a Patent Owner Response, and on October 19, 2017, during a conference call held between counsel for the parties and Judges Abraham, Kokoski, and Ankenbrand, counsel for Patent Owner indicated that Patent Owner intended to abandon the contest. During the conference call, Petitioner requested that the Board conduct an oral hearing and issue a Final Written Decision on the merits despite Patent Owner’s intention to abandon the contest.

After the call, Patent Owner filed a Request for Adverse Judgment Under 37 C.F.R. §42.73(b)(4). Paper 10. In its Request, Patent Owner states that it “hereby serves notice of its intent to abandon the contest of IPR2017-00538 in favor of prosecuting three continuation applications This action is taken in favor of, and without prejudice to, Patent Owner defending its interest in and otherwise pursuing the related proceedings.” *Id.* at 1.

Pettioner believes that Patent Owner’s continuing applications contain one or more claims that are not patentably distinct from any claim cancelled

¹ The ’437 patent expired as a result of Patent Owner’s failure to pay the first maintenance fee on January 1, 2017.

due to the adverse judgement requested in this case and, therefore, contends that Patent Owner's statements are contrary to the estoppel provisions of 37 C.F.R. § 42.73(d)(3). In view of this, Petitioner requests that the Board explain the impact of the estoppel provisions of 37 C.F.R. §42.73(d)(3) in any order terminating this proceeding and inform the examiners in each of Patent Owner's continuing applications of any such order.

Under 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include abandonment of the contest. 37 C.F.R. § 42.73(b)(4). Having reviewed Patent Owner's Request, we determine that entry of judgment against Patent Owner with respect to the challenged claims of the '437 patent is appropriate. We, therefore, grant the Request. Because no challenged claim remains in the trial, there is no need for an oral hearing. Accordingly, we terminate the proceeding. 37 C.F.R. § 42.72.

We have not reviewed Patent Owner's continuing applications and, therefore, have not considered substantively Petitioner's assertion that these applications contain one or more claims that are not patentably distinct from any claim cancelled due to the adverse judgement requested in this case. Nevertheless, we remind Patent Owner that, pursuant to 37 C.F.R. § 42.73(d)(3), "[a] patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent . . . [a] claim that is not patentably distinct from a finally refused or canceled claim." Additionally, we note that, under 37 C.F.R. § 1.56, "[e]ach individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which

includes a duty to disclose to the Office all information known to that individual to be material to patentability.”

As to Petitioner’s desire to have the examiners in each of Patent Owner’s continuing applications informed of this Judgment, we direct Petitioner to the USPTO’s Post Grant Outcomes Pilot program. Information regarding that pilot program is available at the following website:

<https://www.uspto.gov/patent/initiatives/post-grant-outcomes-pilot>. We encourage Petitioner to visit that website and/or contact PostGrantOutcomes@uspto.gov for more information.

ORDER

Accordingly, it is hereby:

ORDERED that Patent Owner’s Request for Adverse Judgment Under 37 C.F.R. § 42.73(b)(4) for abandonment of the contest with respect to claims 1, 16, 24, 28, 34, 40, 55, 67, 76, 82–89, 91, 92, 94, 95, 100, 113, and 118 of U.S. Patent No. 8,343,437 B2 is GRANTED;

FURTHER ORDERED that judgment is entered herein under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1, 16, 24, 28, 34, 40, 55, 67, 76, 82–89, 91, 92, 94, 95, 100, 113, and 118 of U.S. Patent No. 8,343,437 B2; and

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

Case IPR2017-00538

Patent 8,343,437 B2

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