

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

UNIFIED PATENTS INC.,  
Petitioner,

v.

SILVER STATE INTELLECTUAL TECHNOLOGIES, INC.,  
Patent Owner.

---

Case IPR2017-01198  
Patent 8,538,498 B2

---

Before JOHN F. HORVATH, JOHN A. HUDALLA, and  
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

JUDGMENT  
37 C.F.R. § 42.73

Petitioner Unified Patents Inc. requested an *inter partes* review of claims 1–24 (the “challenged claims”) of U.S. Patent No. 8,538,498 B2 (“the ’498 patent”). Paper 1 (“Petition” or “Pet.”). Patent Owner Silver State Intellectual Technologies, Inc. filed a Preliminary Response. Paper 5. We instituted review of all challenged claims. Paper 6, 33. An oral hearing in this trial is scheduled for June 12, 2018. Paper 13.

On June 5, 2018, Patent Owner submitted a notice informing us that it had filed a statutory disclaimer of claims 1–24 of the ’498 patent, which are all of the challenged claims and all of the claims in the patent. Paper 14, 2; *see also* Ex. 2003. In the notice, Patent Owner expressed its understanding “that the Board will construe the Disclaimer as a request for adverse judgment.” *Id.*

Our rules provide: “A party may request judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b). Moreover, certain actions taken by a party, such as the “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial” can be construed as a request for adverse judgment against that party. *Id.* § 42.73(b)(2). Pursuant to 37 C.F.R. § 42.73(b)(2), we construe Patent Owner’s disclaimer of claims 1–24 as a request for adverse judgment because the disclaimer leaves Patent Owner with no remaining claim in this trial. *See* Ex. 2003.

Accordingly, on the record before us, we enter adverse judgment against Patent Owner pursuant to 37 C.F.R. § 42.73(b) and terminate the trial pursuant to 37 C.F.R. § 42.72.

ORDER

It is, therefore,

ORDERED that Patent Owner's disclaimer is construed to be a request for adverse judgment;

FURTHER ORDERED that adverse judgment is entered against Patent Owner;

FURTHER ORDERED that the oral hearing in this matter set for June 12, 2018 is cancelled as moot; and

FURTHER ORDERED that this proceeding is hereby *terminated*.

IPR2017-01198  
Patent 8,538,498 B2

FOR PETITIONER:

Ashraf A. Fawzy  
Jonathan Stroud  
UNIFIED PATENTS INC.  
afawzy@unifiedpatents.com  
jonathan@unifiedpatents.com

PATENT OWNER:

Glen L. Nuttall  
Daniel M. Cavanagh  
KLEIN, O'NEILL & SINGH, LLP  
gnuttall@koslaw.com  
dcavanagh@koslaw.com