

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXACTA FRAC ENERGY SERVICES, INC. AND
GRAYHAWK TOOLS INTERNATIONAL, LLC,
Petitioner,

v.

PAUL BERNARD LEE,
Patent Owner.

IPR2020-01425
Patent 9,869,163 B2

Before BART A. GERSTENBLITH, JAMES A. WORTH, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

I. INTRODUCTION

Exacta Frac Energy Services, Inc. and GrayHawk Tools International, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of *inter partes* review of claims 1–6, 8–13, 15–18, and 20–25 (“the Challenged Claims”) of U.S. Patent No. 9,869,163 B2 (Ex. 1001, “the ’163 patent”). Paul Bernard Lee (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). On February 11, 2021, we granted institution of *inter partes* review. Paper 10 (“Inst. Dec.”). On March 1, 2021, Patent Owner filed a Request for Adverse Judgment Under 37 C.F.R. § 42.73(b). Paper 12 (“Request”).

Patent Owner’s Request indicates that “[i]n co-pending reissue application no. 17/099,556, Patent Owner is pursuing substantially narrowed claims that better articulate the novelty and nonobvious of Patent Owner’s invention.” Request 1. Patent Owner states, “[w]ith the understanding that the amended and new claims that Patent Owner is pursuing in the reissue application are patentably distinct from each claim at issue in this [*inter partes* review], Patent Owner hereby requests adverse judgment.” *Id.*

Petitioner does not oppose Patent Owner’s request so long as the challenged claims are cancelled without condition. Ex. 3001 (March 10, 2021, email from Petitioner’s counsel). In particular, Petitioner does not agree with Patent Owner’s statement that the claims of the reissue application are patentably distinct from claims 1–6, 8–13, 15–18, and 20–25 of the ’163 patent. *Id.*

II. DISCUSSION

“A party may request judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b) (2019). Patent Owner has so requested and Petitioner does not oppose. The parties’ sole disagreement, whether the claims sought in the reissue application are patentably distinct from the Challenged Claims, is not a question for us today and we offer no opinion.¹

Accordingly, we grant Patent Owner’s unopposed Request.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner’s Request is *granted* and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1–6, 8–13, 15–18, and 20–25 of the ’163 patent.

¹ See 37 C.F.R. § 42.73(d)(3)(i) (2019) (“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.”).

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