

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL INC.,
Petitioner,

v.

DSM IP ASSETS B.V.,
Patent Owner.

IPR2020-01558
Patent 10,557,690 B2

Before ZHENYU YANG, JON B. TORNQUIST, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

JUDGMENT

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

Honeywell International Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 23 and 24 of U.S. Patent No. 10,557,690 B2 (Ex. 1001, “the ’690 patent”). Paper 1. DSM IP Assets B.V. (“Patent Owner”) declined to file a Preliminary Response to the Petition.

On March 24, 2021, we instituted an *inter partes* review as to all challenged claims, that is, claims 23 and 24. Paper 6. On that same day, we also issued a Scheduling Order setting forth due dates for the parties to take action. Paper 7. The Scheduling Order states that “[i]f Patent Owner elects not to file a response, Patent Owner must arrange a conference call with the parties and the Board.” *Id.* at 8.

On June 8, 2021, Patent Owner contacted the Board requesting a call with the parties and the Board and informing the Board that Patent Owner does not intend to file a response to the Petition challenging claims 23 and 24. A conference call with the Board and the Parties was held on June 9, 2021. During the call, the Board authorized Patent Owner to file a motion for adverse judgment after confirming it would not be opposed; Patent Owner then filed, also on June 9, 2021, the authorized “Unopposed Motion for Adverse Judgment.” Paper 8 (“Motion”).

In its Motion, Patent Owner “requests that an adverse judgment be issued as to challenged claims 23–24, and that this proceeding be terminated.” *Id.* Patent Owner further sets forth, as noted above, that the Motion is not opposed and was filed with the Board’s authorization. *Id.*

Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a proceeding.” As permitted by this Rule, Patent Owner has explicitly asked the Board to enter adverse judgment as to challenged claims 23 and 24. Paper 8. Claims 23 and 24 are the only claims at issue in this proceeding. *See* Paper 6, 2, 27.

Having reviewed Patent Owner's Motion requesting adverse judgment, we determine that entry of judgment against Patent Owner cancelling claims 23 and 24 of the '690 patent is appropriate. Thus, we grant the Motion requesting adverse judgment pursuant to 37 C.F.R. § 42.73(b). This constitutes a final written decision pursuant to 35 U.S.C. § 318(a) cancelling claims 23 and 24 of the '690 patent.

ORDER

Accordingly, it is:

ORDERED that adverse judgment is entered against Patent Owner pursuant to 37 C.F.R. § 42.73;

FURTHER ORDERED that claims 23 and 24 of the '690 patent are cancelled;

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a);

FURTHER ORDERED that Patent Owner shall file a notice and copy of this judgment in the files of any proceeding or action involving the '690 patent; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner is precluded from taking any action inconsistent with this judgment, including obtaining any patent claim that is not patentably distinct from a cancelled claim in this proceeding.

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