

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.,
Petitioner,

v.

THE TRUSTEES OF PURDUE UNIVERSITY,
Patent Owner.

IPR2022-00309
Patent 8,035,112 B1

Before GRACE KARAFFA OBERMANN, JO-ANNE M. KOKOSKI, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

STMicroelectronics, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 6, 7, and 10–12 (“challenged claims”) of U.S. Patent No. 8,035,112 B1 (“the ’112 patent,” Ex. 1001). Paper 2. The Trustees of Purdue University (“Patent Owner”) filed a Preliminary Response. Paper 10. On July 6, 2022, we instituted an *inter partes* review of all challenged claims based on all grounds set forth in the Petition. Paper 14.

On August 5, 2022, with our authorization, Patent Owner filed a Request for Adverse Judgment due to statutory disclaimer of all the claims in the ’112 patent. Paper 17 (citing Ex. 2019). In the statutory disclaimer, Patent Owner asserts that it owns “the entire interest” in, and disclaims claims 1–16 of, the ’112 patent. Ex. 2019, 1.

Rule 42.73(b) permits a party to “request adverse judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b). In addition, “[a]ctions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” *Id.* § 42.73(b)(2). Because Patent Owner disclaimed all claims in the ’112 patent, there are no challenged claims remaining in the proceeding, and we grant Patent Owner’s Request for Adverse Judgment.

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner’s Request for Adverse Judgment (Paper 17) is *granted*; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(b), adverse judgment is entered against Patent Owner with respect to claims 1, 6, 7, and 10–12 of the ’112 patent, and this proceeding is terminated.

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