

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.,
Petitioner,

v.

SECURITYPROFILING, LLC,
Patent Owner.

Case IPR2017-02191
Patent 8,266,699 B2

Before BRIAN J. McNAMARA, GREGG I. ANDERSON, and
MINN CHUNG, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

JUDGMENT

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

I. INTRODUCTION

On September 27, 2017, Trend Micro, Inc. (“Petitioner”) filed a Petition challenging claim 7 of U.S. Patent No. 8,266,699 B2 (“the ’699 patent”). Paper 1, 14. On January 12, 2018, SecurityProfiling, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6. On April 10, 2018, we entered an Institution Decision initiating trial. Paper 7. An oral hearing was scheduled for January 16, 2019. Paper 8, 6.

On July 12, 2018, the parties conducted a telephone conference with the Board. Patent Owner represented that it intended to disclaim claim 7 of the ’699 patent, the only claim challenged here. *See* 35 U.S.C. § 253; 37 C.F.R. § 1.321(a). The parties had conferred prior to the call and Petitioner represented it had no objection to proceeding in this manner. In our Order dated July 13, 2018, Patent Owner was advised that it should file a disclaimer and then request adverse judgment. *See* 37 C.F.R. § 42.73(b). Paper 16, 2.

On September 5, 2018, Patent Owner filed a Request for Adverse Judgment (“Request,” Paper 17). In the Request, Patent Owner represented that on September 4, 2018, it “filed with the U.S. Patent and Trademark Office a statutory disclaimer under 37 C.F.R. 1.321(a) of Claim 7 of U.S. Patent No. 8,266,699, the only claim in issue in this proceeding.” Paper 17. In view of the cancellation of the sole claim in the trial, Patent Owner requested that the Board enter a final adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2). *Id.*

II. DISCUSSION

The Board’s rule regarding requests for adverse judgment provides as follows:

A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

- (1) Disclaimer of the involved application or patent;
- (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
- (3) Concession of unpatentability or derivation of the contested subject matter; and
- (4) Abandonment of the contest.

37 C.F.R. § 42.73(b). Patent Owner has disclaimed the only claim subject to this proceeding, as per 37 C.F.R. § 42.73(b)(2) above. Given the disclaimer, there is no reason to have a trial and adverse judgment is appropriate.

III. ORDER

Accordingly, it is

ORDERED that Patent Owner's Request for Adverse Judgment under 37 C.F.R. § 42.73(b) with respect to claim 7 of U.S. Patent No. 8,266,699 B2 is *granted*; and

FURTHER ORDERED that this proceeding is hereby terminated.

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