

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHOLLA ENERGY LLC and OBM, INC.,
Petitioners,

v.

LANCIUM LLC,
Patent Owner.

IPR2024-00914
Patent 11,016,456 B2

Before KEN B. BARRETT, AMBER L. HAGY, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

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

Cholla Energy LLC and OBM, Inc. (collectively, “Petitioner”) filed a petition requesting *inter partes* review (Paper 3, “Pet.”) of claims 1–10, 12, and 14–30 (“the challenged claims”) of U.S. Patent No. 11,016,456 B2 (Ex. 1001, the “’456 patent”). *See* 35 U.S.C. § 311. Lancium LLC (“Patent Owner”) did not file a Preliminary Response. We instituted review of all challenged claims on November 21, 2024. Paper 7.

On February 13, 2025, with authorization from the Board, Patent Owner filed an unopposed motion for adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2). Paper 9. Patent Owner represents that it “filed a statutory disclaimer under 37 C.F.R. § 1.321(a) of all challenged claims in this IPR – disclaiming claims 1–10, 12, and 14–30 of U.S. Patent 11,016,456.” *Id.* at 1. Patent Owner also represents that “[a] copy of this disclaimer that was filed with the Office, along with the filing receipt and corresponding confirmation of fee payment, is provided as Exhibit 2001.” *Id.*

A patent owner may request judgment against itself “at any time during a proceeding” upon disclaimer of the particular claims at issue such that there is “no remaining claim in the trial.” 37 C.F.R. § 42.73(b)(2). Here, Patent Owner has statutorily disclaimed all of the claims on which trial was instituted; hence, no claims will remain for trial. Paper 9; Exhibit 2001. In view of the disclaimer of the challenged claims of the ’456 patent, the entry of final judgment adverse to Patent Owner is appropriate.

ORDER

Accordingly, it is hereby

ORDERED that Patent Owner Lancium LLC's request for adverse judgment is *granted*;

FURTHER ORDERED that judgment against Patent Owner Lancium LLC, pursuant to 37 C.F.R. § 42.73(b)(2), is *entered*;

FURTHER ORDERED that this decision constitutes a final written decision under 35 U.S.C. § 318(a); and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner Lancium LLC shall not take any action inconsistent with this final judgment and decision, including obtaining in any patent a claim that is not patentably distinct from the statutorily disclaimed claims in this proceeding.

IPR2024-00914
Patent 11,016,456 B2

PETITIONER:

David McCombs
Adam Fowles
HAYNES AND BOONE, LLP
david.mccombs.ipr@haynesboone.com
adam.fowles.ipr@haynesboone.com

Rodney Miller
Preston Heard
James Dority
WOMBLE BOND DICKINSON
Rodney.Miller@wbd-us.com
Preston.Heard@wbd-us.com
James.Dority@wbd-us.com

PATENT OWNER:

Christopher Hoff
Mark Nelson
Adam Kaufmann
Kurt Rohde
BARNES & THORNBURG LLP
chris.hoff@btlaw.com
mnelson@btlaw.com
adam.kaufmann@btlaw.com
kurt.rohde@btlaw.com