

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

PEBBLE TIDE, LLC,
Patent Owner.

PGR2020-00011
Patent 10,303,411 B2

Before JAMESON LEE, DAVID C. McKONE,
and CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

JUDGMENT
Patent Owner's Request for Adverse Judgment
37 C.F.R. §§ 42.72, 42.73(b)

Unified Patents (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting post-grant review of claims 1–20 of U.S. Patent No. 10,303,411 B2 (Ex. 1001, “the ’411 patent”). Pet. 5. We instituted a post-grant review of claims 1–20 of the ’411 patent. Paper 12. Prior to our Decision, the United States District Court for the District of Delaware ruled that the challenged claims are invalid under 35 U.S.C. § 101. Ex. 1030. After our Decision, on July 23, 2020, the United States Court of Appeals for the Federal Circuit dismissed Patent Owner’s appeal of the Delaware court’s decision. Ex. 1032.

On September 29, 2020, Pebble Tide LLC (“Patent Owner”) filed both a Patent Owner Response (Paper 17, “Resp.”) and a Motion to Amend (Paper 18, “Mot. to Amend”) seeking to substitute claims 21–35 for claims 1–3, 5, 6, 8–11, 13, 14, 16–18, and 20. We expunged Patent Owner’s Response on November 19, 2020. Paper 21. On December 22, 2020, Petitioner filed an Opposition to Patent Owner’s Motion to Amend. (Paper 23, “Opp.”). Petitioner argued, *inter alia*, that Patent Owner’s Motion to Amend should be denied as moot in light of the Delaware court’s decision on the challenged claims and the subsequent dismissal of the Federal Circuit appeal of that decision. *Id.* at 2–4. Oral Argument is scheduled for April 14, 2021. Paper 13, 13.

On April 12, 2021, Patent Owner emailed the Board seeking permission to file a motion for adverse judgment under 37 C.F.R. § 42.73(b). Ex. 3001. Patent Owner seeks adverse judgment “based on mootness, given that this Motion [to Amend] was filed after the Federal Circuit appeal was dismissed. As such, the Board need not reach the merits of this Motion.” *Id.* Patent Owner represented that Petitioner does not oppose. *Id.* Patent Owner

further stated that the parties request that the April 14, 2021, oral argument not be held. *Id.*

The Board responded, by email, that Patent Owner may request judgment against itself at any time during the proceeding, and that the parties should jointly request to cancel the April 14, 2021, oral argument. *Id.*

Patent Owner filed a Motion for Adverse Judgment Under 37 C.F.R. § 42.73(b). (Paper 30, “Mot.”). Specifically, “Patent Owner respectfully requests judgment against itself as to all challenged claims. Patent Owner therefore requests that this proceeding be terminated, given that no case or controversy remains.” *Id.* at 2. Patent Owner cites to Rule 42.73(b)(2), which lists, as an action construed as a request for adverse judgment, “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” *Id.*

“A party may request judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b). “The Board may terminate a trial without rendering a final written decision, where appropriate.” 37 C.F.R. § 42.72. Here, Patent Owner requests judgment against itself because a district court has already determined that the claims challenged in the Petition are invalid and, therefore, there is no case or controversy remaining. Mot. 2; Ex. 3001. Both parties agree that Patent Owner’s Motion to Amend is moot because the Delaware court and the Federal Circuit ruled on the validity of the challenged claims before Patent Owner filed its Motion to Amend. Opp. 2; Ex. 3001. In light of Patent Owner’s Motion for Adverse Judgment and the parties’ agreement on the Motion to Amend, we grant Patent Owner’s Motion for Adverse Judgment, dismiss Patent Owner’s Motion to Amend as moot, and terminate the proceeding.

The parties also filed a Joint Request to Cancel April 14, 2001 Oral Argument. Paper 31. Because the case is terminated, and no party currently seeks oral argument, the April 14, 2021, oral argument is unnecessary and is cancelled.

ORDER

Accordingly, it is

ORDERED that Patent Owner's Request for Adverse Judgment is granted;

FURTHER ORDERED that Patent Owner's Motion to Amend is dismissed as moot;

FURTHER ORDERED that the oral argument scheduled for April 14, 2021, is cancelled; and

FURTHER ORDERED that this proceeding is terminated.

PGR2020-00011
Patent 10,303,411 B2

For PETITIONER:

Jung Hahm
Roshan Mansinghani
UNIFIED PATENTS, LLC
jung@unifiedpatents.com
roshan@unifiedpatents.com

For PATENT OWNER:

Isaac Rabicoff
RABICOFF LAW LLC
isaac@rabilaw.com