

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION,
Petitioner,

v.

DESTINATION MATERNITY CORPORATION,
Patent Owner.

Case IPR2013-00533¹
Patent RE43,531 E

Before MICHAEL P. TIERNEY, LORA M. GREEN, JONI Y. CHANG,
THOMAS L. GIANNETTI, JENNIFER S. BISK,
MICHAEL J. FITZPATRICK, and MITCHELL G. WEATHERLY,
Administrative Patent Judges.

Opinion for the Board filed by *Administrative Patent Judge* GREEN.

Opinion Dissenting-in-part filed by *Administrative Patent Judge*
FITZPATRICK, in which *Administrative Patent Judges*, BISK and
WEATHERLY, join.

JUDGMENT
Request for Adverse Judgment
37 C.F.R. § 42.73(b)

¹ Case IPR2014-00509 has been joined with this proceeding.

The Board instituted *inter partes* review of claims 1 and 24–29 of U.S. Patent No. RE43,531 E on February 19, 2014. Paper 11, 2. On February 12, 2015, *inter partes* review was instituted on claims 18 and 19 in IPR2014-00509 (“the ’509 IPR”), which proceeding was joined with the instant proceeding. The ’509 IPR, Paper 31, 1. On April 20, 2015, Patent Owner filed a Motion for Adverse Judgment, asking that the Board cancel all claims on which trial was instituted, *i.e.*, claims 1, 18, 19, and 24–29, and enter judgment against Patent Owner. Paper 81, 2.

Under 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Cancellation or disclaimer of one or more claims such that the patent owner has no remaining claim in the trial is construed to be a request for adverse judgment. 37 C.F.R. § 42.73(b)(2). Patent Owner has not only requested cancellation of all claims on which trial was instituted in this *inter partes* review, such that after the cancellation it will have no remaining claim in the trial, but has also expressly requested entry of adverse judgment.

Accordingly, it is hereby

ORDERED that Patent Owner’s Motion for Adverse Judgment is *granted*;

FURTHER ORDERED Patent Owner’s request that claims 1, 18, 19, and 24–29 of U.S. Patent No. RE43,531 E be cancelled is *granted*;

FURTHER ORDERED that IPR2013-00533 and IPR2014-00509 are hereby terminated; and

FURTHER ORDERED that a copy of this Decision be entered into the file of Case IPR2014-00509.

Case IPR2013-00533
Patent No. RE43,531 E

Opinion Dissenting-in-part filed by *Administrative Patent Judge* FITZPATRICK, in which BISK and WEATHERLY, *Administrative Patent Judges*, join.

Claims 18 and 19 would not be before us but for a prior decision granting rehearing, which ultimately resulted in institution of an *inter partes* review of claims 18 and 19 based on a petition filed in IPR2014-00509 and joinder of that *inter partes* review with IPR2014-00533. *See* Papers 29–31 in IPR2014-00509. For the reasons we previously set forth in our dissents from the decisions granting rehearing, institution, and joinder (*i.e.*, Papers 29–31 in IPR2014-00509), claims 18 and 19 are not properly before us.

We respectfully dissent-in-part from the majority opinion *supra*, as it pertains to claims 18 and 19.

Case IPR2013-00533
Patent No. RE43,531 E

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