

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC., TELECOMMUNICATION
SYSTEMS, INC., ERICSSON INC., AND
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

TRACBEAM, LLC,
Patent Owner.

Case IPR2015-01708
Patent 7,525,484 B2

Before KEVIN F. TURNER, DAVID C. MCKONE, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

JUDGMENT

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

I. BACKGROUND

T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson (collectively, “Petitioner”) filed a Petition (Paper 1) to institute an *inter partes* review of claims 1, 2, 6, 24, 25, 51, 71, and 72 of U.S. Patent No. 7,525,484 B2 (Ex. 1002, “the ’484 patent”). TracBeam, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6). The parties reached agreement to remove claims 2, 6, 24, 71, and 72 from the proceeding; we accepted that agreement and limited this proceeding to claims 1, 25, and 51. Papers 7–9. Subsequently, we instituted an *inter partes* review of claims 1 and 51 of the ’484 patent, but not claim 25. Paper 10.

On August 19, 2016, in its Patent Owner Response (Paper 14), Patent Owner notified the Board that it had filed a statutory disclaimer under 37 C.F.R. § 1.321(a) of claim 51 of the ’484 patent. *See* Ex. 2005 (statutory disclaimer). On October 31, 2016, Patent Owner notified the Board that it had filed a further statutory disclaimer of claim 1 of the ’484 patent, which constitutes the only remaining claim at issue in this *inter partes* review. Paper 17. Patent Owner also filed a copy of the disclaimer, as well as an electronic acknowledgement receipt of the filing, as Appendices to the Notice. *Id.*

II. DISCUSSION

A party may request adverse judgment against itself at any time. *See* 37 C.F.R. § 42.73(b). Here, Patent Owner requests adverse judgment because no claims remain in the trial after Patent Owner’s disclaimer of all the claims at issue in this proceeding. *See* 37 C.F.R. § 42.73(b)(2). We

IPR2015-01708
Patent 7,525,484 B2

grant Patent Owner's request and enter judgment against Patent Owner under 37 C.F.R. § 42.73(b). Our prior Order granting Petitioner's request for oral hearing is hereby *dismissed* as moot. *See* Paper 16.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for adverse judgment is *granted*, and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b);

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

FURTHER ORDERED that the previously granted oral hearing in this proceeding is *dismissed* as moot.

IPR2015-01708
Patent 7,525,484 B2

FOR PETITIONER:

Brian W. Oaks
Douglas M. Kubehl
Chad C. Walters
Ross G. Culpepper
BAKER BOTTS LLP
brian.oaks@bakerbotts.com
doug.kubehl@bakerbotts.com
chad.walters@bakerbotts.com
ross.culpepper@bakerbotts.com

FOR PATENT OWNER:

Sean A. Luner
DOVEL AND LUNER, LLP
sean@dovellaw.com

Steven C. Sereboff
SOCAL IP LAW GROUP LLP
ssereboff@socalip.com