

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARTHREX, INC. and SMITH & NEPHEW, INC.,
Petitioner,

v.

VITE TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00382
Patent 6,168,598 B1

Before WILLIAM V. SAINDON, BARRY L. GROSSMAN, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER
Denying Request for Adverse Judgment
37 C.F.R. § 42.73

On June 28, 2016, we instituted this *inter partes* review of claims 21, 25–27, 29, 30, 38, and 39 of U.S. Patent No. 6,168,598 B1 (“the ’598 patent”). Paper 7. On October 17, 2016, Patent Owner filed a Request for Adverse Judgment Under 37 C.F.R. § 42.73(b). Paper 10 (“Request”). Patent Owner’s Request notes that the ’598 patent is the subject of an *ex parte* reexamination proceeding, in which “the majority of the original claims at issue in the present proceeding” have been rejected. *Id.* at 1. In the Request, Patent Owner “asks that the Board cancel the only claims remaining in this proceeding (claims 21, 25–27, 29, 30, 38, and 39) and enter adverse judgment against it ***without prejudice to its ability to proceed with the ex parte reexaminations of the patents, including continuing prosecution of the claims currently pending there.***” *Id.* (emphasis added).

The language emphasized above conditions the Request on the adverse judgment being without prejudice to other claims not at issue in this proceeding. The Board has held on similar facts that “[w]e cannot make a determination regarding claims not involved in this *inter partes* review. A request for adverse judgment should not be made with conditions imposed on what effects it should or should not have on other claims.” *Hyundai Motor Co. v. American Vehicular Sciences LLC*, Case IPR2014-00657, slip op. at 2 (PTAB Feb. 9, 2015) (Paper 16).

Accordingly, we deny Patent Owner’s request for adverse judgment, without prejudice to Patent Owner refiling its request without any conditional language that seeks to limit the impact of the entry of adverse judgment.

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For the foregoing reasons, it is:

ORDERED that Patent Owner's request for entry of adverse judgment is *denied*; and

FURTHER ORDERED that Patent Owner may refile its request.

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