

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TV MANAGEMENT, INC., D/B/A GPS NORTH AMERICA,
Petitioner,

v.

PERDIEMCO LLC,
Patent Owner.

Case IPR2016-01063
Patent 8,717,166 B2

Before WILLIAM V. SAINDON, CARL M. DeFRANCO, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

JUDGMENT

Patent Owner's Request for Adverse Judgment After Institution of Trial
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

We instituted *inter partes* review of claims 1–10, 13–16, and 19–25 (“the Instituted Claims”) of U.S. Patent No. 8,717,166 B2 (“the ’166 patent”) on November 29, 2016. Paper 20. On March 2, 2017, Patent Owner PerdiemCo LLC (“Patent Owner”) filed its Response, in which Patent Owner stated:

Patent Owner has filed a statutory disclaimer under 37 CFR § 1.321 disclaiming claims 1–10, 13–16, and 19–25 of the ’166 patent. . . . In view of that filing, Patent Owner requests an adverse judgment under 37 CFR § 42.73(b)(2) against Patent Owner for claims 1–10, 13–16, and 19–25 of the ’166 patent.

Accordingly, Patent Owner believes such adverse judgment should be entered and, as there is no remaining claim in this trial, this IPR should be terminated.

Paper 28.

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.”¹ 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 28 and Exhibit 2011. In view of the disclaimer of the Instituted Claims of the ’166 patent, the entry of final judgment adverse to Patent Owner is appropriate.

¹ Patent Owner also stated in its Response that “Patent Owner’s request to file a motion for adverse judgment is therefore forthcoming.” Paper 28. Because our rules permit a request for adverse judgment “at any time,” however, a party need not obtain prior authorization. 35 U.S.C. § 42.73(b).

ORDER

Accordingly, it is hereby

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

FURTHER ORDERED that judgment against Patent Owner PerdiemCo 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);

FURTHER ORDERED that Patent Owner PerdiemCo LLC shall file a notice and copy of this final judgment and decision in the files of pending Patent Application Nos. 14/629,347 and 15/200,592, as well as any other proceeding or action claiming priority to Provisional Patent App. No. 60/752,879; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner PerdiemCo 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.

Case IPR2016-01063
Patent 8,717,166 B2

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