

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 IPR2015-01681
Case IPR2015-01687
Patent 7,764,231 B1¹

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

TURNER, *Administrative Patent Judge*.

JUDGMENT

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

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

I. BACKGROUND

T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson (collectively, “Petitioner”) filed Petitions (Paper 1, both proceedings) to institute *inter partes* reviews of claims 25, 26, 36, and 82 of U.S. Patent No. 7,764,231 B1 (Ex. 1001, “the ’231 Patent”), in the IPR2015-01681 proceeding (“’1681 proceeding”), and claims 17, 20, 25, and 26 of the ’231 Patent, in the IPR2015-01687 proceeding (“’1687 proceeding”). TracBeam, LLC (“Patent Owner”) filed Preliminary Responses (Papers 8 and 6, ’1681 & ’1687 proceedings, respectively). The parties reached agreement to remove claims 26 and 36 from the proceedings; we accepted those agreements and limited these proceedings to claims 17, 20, 25, and 82. Papers 12 and 10, ’1681 & ’1687 proceedings, respectively. Subsequently, we instituted an *inter partes* review of claims 25 and 82 of the ’231 Patent in the ’1681 proceeding, and instituted an *inter partes* review of claims 20 and 25 of the ’231 Patent in the ’1687 proceeding. *Id.*

On October 31, 2016, Patent Owner notified the Board that it had filed statutory disclaimers under 37 C.F.R. § 1.321(a) of claims 20, 25, and 82 of the ’231 Patent, which constitute all of the claims at issue in these *inter partes* reviews. Papers 20 and 18, ’1681 & ’1687 proceedings, respectively. Patent Owner also filed copies of the disclaimers, as well as electronic acknowledgement receipts of their filings, as Appendicies to those Notices. *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 these proceedings. *See* 37 C.F.R. § 42.73(b)(2). We *grant* Patent Owner's requests and enter judgment against Patent Owner under 37 C.F.R. § 42.73(b) in both proceedings. Our prior Order granting Petitioner's request for oral hearing is hereby *dismissed* as moot. *See* Papers 19 and 17, '1681 & '1687 proceedings, respectively.

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) with respect to claims 20, 25, and 82 of the '231 Patent;

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

FURTHER ORDERED that the previously granted oral hearings in these proceedings are *dismissed* as moot.

IPR2015-01681; IPR2015-01687
Patent 7,764,231 B1

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