

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

WEST VIEW RESEARCH, LLC,
Patent Owner.

Case IPR2016-00146
Patent 8,719,038 B1

Before MICHAEL R. ZECHER, KEVIN W. CHERRY, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

JUDGMENT
FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

I. BACKGROUND

On November 17, 2015, Petitioner, Volkswagen Group of America, Inc. (“Volkswagen”), filed a Petition requesting an *inter partes* review of claims 1, 4, 5, 12, 16, 22, 54, and 66 of U.S. Patent No. 8,719,038 B1 (Ex. 1001, “the ’038 patent”). Paper 2. Patent Owner, West View Research LLC (“West View”), filed a Preliminary Response. Paper 6. Patent Owner also filed a Statutory Disclaimer disclaiming claims 1, 4, 16, and 22 of the ’038 patent. Prelim. Resp. 21; Ex. 2007. On May 13, 2016, we instituted an *inter partes* review as to the remaining challenged claims of the ’038 patent—claims 5, 12, 54, and 66. Paper 8.

On February 9, 2016, West View filed a Request for Adverse Judgment pursuant to 37 C.F.R. § 42.73(b). Paper 21 (“Mot.”). West View requests that we cancel the remaining challenged claims of the ’038 patent—claims 5, 12, 54, and 66, the only claims we instituted trial on—and, as a consequence, enter adverse judgment against West View in this trial. Mot. 1. For the reasons discussed below, we *grant* West View’s Request for Adverse Judgment.

II. DISCUSSION

A party may request entry of adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Actions construed to be a request for adverse judgment include, among other things, cancellation or disclaimer of a claim such that the party has no remaining claim in the trial. 37 C.F.R. § 42.73(b)(2). West View has requested that we cancel claims 5, 12, 54, and 66, which are all of the remaining challenged claims involved in

this trial. Given that West View has no remaining claims in this trial, entry of adverse judgment against West View and cancellation of all of the challenged claims of the '038 patent is appropriate.

III. ORDER

In consideration of the foregoing, it is
ORDERED that West View's Request for Adverse Judgement is
GRANTED;

ORDERED that adverse judgment is entered against West View with respect to claims 5, 12, 54, and 66 of the '038 patent;

FURTHER ORDERED that claims 5, 12, 54, and 66 of the '038 patent are cancelled¹; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

¹ See 37 C.F.R. § 42.80 (indicating that after the Board issues a final written decision in an *inter partes* patent review proceeding, the Office will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable).

IPR2016-00146
Patent 8,719,038 B1

For PETITIONER:

Michael J. Lennon
Clifford A. Ulrich
Kenyon & Kenyon LLP
mlennon@kenyon.com
culrich@kenyon.com

For PATENT OWNER:

Peter J. Gutierrez, III
Mark Wang
Gazdzinski & Associates, PC
docket@gazpat.com