

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

NATIONAL OILWELL VARCO, L.P.,  
Petitioner,

v.

TECHNICAL INDUSTRIES, INC.,  
Patent Owner.

---

Case IPR2017-00699  
Patent 7,401,518 B2

---

Before BRYAN F. MOORE, MINN CHUNG, and  
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

JUDGMENT AND ORDER  
*Granting Motion for Partial Adverse Judgment and*  
*Granting Joint Motion to Limit the Petition*  
*37 C.F.R. §§ 42.72, 42.73(b)*

Petitioner, National Oilwell Varco, L.P., filed a Corrected Petition to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 7,401,518 B2 (“the ’518 patent”). Paper 5. Patent Owner, Technical Industries, Inc., filed a Preliminary Response, in which it averred that “Patent Owner will disclaim Claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17 and 19, leaving Claims 4, 6, 9, 11, 14, 16, 18 and 20 at issue in this matter.” Paper 9, 10.

On July 28, 2017, we instituted an *inter partes* review of all challenged claims on all grounds asserted, and explained that

[b]ecause we are not aware that Patent Owner has in fact disclaimed claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17, and 19 of the ’518 patent, we address Petitioner’s unpatentability contentions with regard to those claims in this Decision. Should Patent Owner proceed to disclaim claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17, and 19, we will address such disclaimer at that time.

Paper 16, 11.

On November 30, 2017, Patent Owner filed a Patent Owner Response to the Petition, in which it again represented that “Patent Owner will disclaim claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17 and 19, leaving only 4, 6, 9, 11, 14, 16, 18 and 20 of the ’518 patent at issue in this matter.” Paper 21, 1–2.

On April 5, 2018, pursuant to our authorization, Patent Owner filed an unopposed Request for Adverse Judgment, disclaiming and canceling claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17 and 19 of the ’518 patent. Paper 44.

On April 30, 2018, in light of the Supreme Court’s decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018) and the Guidance on the

Impact of *SAS* on AIA Trial Proceedings issued by the USPTO,<sup>1</sup> we modified our Decision on Institution to institute trial on every challenged claim as to each ground asserted in the Petition. Paper 47, 2. On July 6, 2018, pursuant to our authorization, the parties filed a Joint Motion to Limit the Petition to the originally instituted grounds. Paper 48.

Rule 42.73(b) permits a party to “request judgment against itself at any time during a proceeding.” 37 C.F.R. § 42.73(b). Under the circumstances presented here, we find it is appropriate to grant Patent Owner’s request for adverse judgment on claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17, and 19, because doing so will significantly simplify the issues to be addressed at trial.

In addition, limiting the Petition in the manner jointly requested by the parties serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b); *see also Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision). Accordingly, we likewise find it is appropriate to grant the parties’ Joint Motion to Limit the Petition.

---

<sup>1</sup> Available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

As a result of this Order, only the following claims and grounds remain in trial:

Claims	Basis	Reference(s)
6, 11, 16, 20	§ 102(b)	Assanelli
4, 6, 9, 11, 14, 16, 18, 20	§ 103(a)	Kiefer and Assanelli
6, 20	§ 103(a)	Lam and Assanelli

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Request for [Partial] Adverse Judgment (Paper 44) is *granted*, and judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17, and 19 of U.S. Patent No. 7,401,518 B2;

FURTHER ORDERED that claims 1–3, 5, 7, 8, 10, 12, 13, 15, 17, and 19 of U.S. Patent No. 7,401,518 B2 are CANCELED;

FURTHER ORDERED that the Joint Motion to Limit the Petition (Paper 48) is *granted*;

FURTHER ORDERED that pursuant to 37 C.F.R. § 42.72, trial is terminated as to all grounds not originally included in the trial in the Decision on Institution (Paper 16); and

FURTHER ORDERED that only the following claims and grounds remain in the trial:

Claims	Basis	Reference(s)
6, 11, 16, 20	§ 102(b)	Assanelli
4, 6, 9, 11, 14, 16, 18, 20	§ 103(a)	Kiefer and Assanelli
6, 20	§ 103(a)	Lam and Assanelli

IPR2017-00699  
Patent 7,401,518 B2

PETITIONER:

Robert M. Bowick, Jr.  
Bradford T. Laney  
RALEY & BOWICK, L.L.P.  
[rbowick@raleypowick.com](mailto:rbowick@raleypowick.com)  
[blaney@raleypowick.com](mailto:blaney@raleypowick.com)

PATENT OWNER:

Ted M. Anthony  
BABINEAUX, POCHÉ, ANTHONY & SLAVICH, L.L.C.  
[tanthony@bpasfirm.com](mailto:tanthony@bpasfirm.com)

Joseph L. Lemoine, Jr.  
LEMOINE & ASSOCIATES, LLC  
[joe@lemoine.com](mailto:joe@lemoine.com)