

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 IPR2017-00860
Patent 7,552,640 B2

Before THOMAS L. GIANNETTI, BRYAN F. MOORE, and
JASON J. CHUNG, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. BACKGROUND

This Order is being entered to dispose of certain claims and grounds of challenge the parties have agreed to exclude from further consideration in this trial.

The Petition (Paper 1) requested *inter partes* review of claim 1–20 of U.S. Patent No 7,552,640 B2 (Ex. 1001, “the ’640 patent”). In our Institution Decision (Paper 14), we determined that Petitioner had demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the ’640 patent is unpatentable. Paper 14, 2. We therefore instituted *inter partes* review of certain challenged claims. *Id.*

On April 24, 2018, the Supreme Court held that a final written decision under 35 U.S.C. § 318(a) must decide the patentability of all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018). We modified our Institution Decision to institute trial on all of the challenged claims and all of the grounds presented in the Petition. *See id.* Specifically, we modified our Institution Decision to include the following additional grounds:

Claim(s)	Basis	References
3, 12	§ 102(b)	Lam
5, 7, 14, 16	§ 103(a)	Lam and Assanelli
3, 5, 7, 12, 14, 16	§ 103(a)	Assanelli and Lam

Paper 36. An Oral Hearing in this case was held on May 17, 2018. The Hearing Transcript (“Tr.”) is included in the record as Paper 38. At the

hearing, the Board and the parties reached agreement on the disposition of certain claims and grounds.

II. CLAIMS 3 AND 12

In its Response to the Petition (Paper 18), Patent Owner stated: “Patent Owner advises the Board that it will now disclaim Claims 3 and 12 of the ‘640 patent.” Paper 18, 11. At the oral argument this statement was discussed with the parties. *See* Tr. 1:3–5:2; 6:4–8; 60:6–10. Patent Owner confirmed its intention to disclaim claims 3 and 12. *Id.* at 6:6–8. After initially requesting that the Patent Owner file a request for adverse judgment on those claims, the Board later concluded that Patent Owner’s representations at the hearing and in its Response were sufficient: “We will enter an order on that issue. You have made the representation on the record. I think that will be sufficient.” Tr. 60:8–10.

III. ADDITIONAL GROUNDS

At the oral hearing, the parties agreed to limit the case to the grounds on which the Board initially instituted the proceeding. Tr. 5:3–6:2. After the agreement was reached, the Board stated it would follow up with an order. *Id.* at 6:1–4.

IV. ORDER

In view of the foregoing, it is:

ORDERED that, pursuant to 28 C.F.R. § 42.73 (b), adverse judgment is entered as to claims 3 and 12 of the ‘640 patent;

FURTHER ORDERED that pursuant to 37 C.F.R. § 42.72, trial is terminated as to all grounds not included in the trial in the Institution Decision;

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

Claim(s)	Basis	References
9, 11, 18, 20	§ 102(b)	Assanelli
5, 7, 9, 11, 14, 16, 18, 20	§ 103(a)	Kiefer and Assanelli
9,11,18, 20	§ 103(a)	Lam and Assanelli

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