

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

IXI MOBILE (R&D) LTD.,
Patent Owner.

Case IPR2016-01669
Patent 7,552,124 B2

Before BRYAN F. MOORE, TREVOR M. JEFFERSON, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

JUDGMENT

Termination of the Proceeding and Lifting of
Stay of Reexamination Control No. 90/013,988
35 U.S.C. § 318(a), 37 C.F.R. §§ 42.73, and 42.122(a)

I. INTRODUCTION

Petitioner, Google Inc., filed a Petition for *inter partes* review of claims 1–10 of U.S. Patent No. 7,552,124 B2 (Ex. 1001, “the ’124 patent”). Paper 1. On March 8, 2017, the Board instituted trial to review the patentability of claims 1–5. Paper 9.

On November 9, 2017, Patent Owner filed a Request for Adverse Judgement. Paper 23.

II. DISCUSSION

A. Adverse Judgment

A party may request adverse judgment against itself at any time. 37 C.F.R. § 42.73(b). In its Request for Adverse Judgment, Patent Owner states that it “hereby abandons the contest pursuant to 37 C.F.R. § 42.73(b)(4) and requests cancellation of the instituted claims.” Paper 23. There is no pending motion to amend claims. Petitioner has entered no objection to the Request for Adverse Judgment. Under these circumstances, we determine that entry of judgment against Patent Owner with respect to claims 1–5 of the ’124 patent is appropriate.

B. Reexamination Stay

On October 12, 2017, we entered an Order (Paper 21) staying Reexamination Control No. 90/013,988 (’988 Reexam), which involves claims of the ’124 patent not at issue in this *inter partes* review. In that order, we denied a request to terminate the ’988 Reexam noting “[t]his decision not to terminate the Reexam may be revisited at a later date.” Paper 21, 6.

We determine in this proceeding that claims 1–5 of the ’124 patent are unpatentable due to a request for adverse judgment. As noted in the Order, the reexamination is based on the same prior art presented in this proceeding but involves existing claims (claims 6–10) and several added claims (claims 11–71) that are not involved in this proceeding. Paper 21, 3, 6. Under the circumstances, we determine that the stay of the ’988 Reexam should be lifted and the ’988 Reexam will not be terminated.

III. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1–5 of the ’124 patent. Claims 1–5 are unpatentable and shall be cancelled¹;

FURTHER ORDERED that the stay of Reexamination Control No. 90/013,988 is hereby lifted; and

FURTHER ORDERED that all time periods in Reexamination Control No. 90/013,988 are restarted.

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

IPR2016-01669
Patent 7,552,124 B2

PETITIONER:

Naveen Modi
Joseph E. Palys
Daniel Zeilberger
Arvind Jairam
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
danielzeilberger@paulhastings.com
arvindjairam@paulhastings.com

PATENT OWNER:

Andy H. Chan
Charles F. Koch
Griffin Mesmer
Andrew W. Schultz
PEPPER HAMILTON LLP
chana@pepperlaw.com
koche@pepperlaw.com
mesmerg@pepperlaw.com
schultza@pepperlaw.com