

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Facebook, Inc.,
Petitioner

v.

ZKey Investments, LLC.,
Patent Owner.

Case IPR2017-01278
Patent 6,820,204 B1

Before ROBERT J. WEINSCHENK, MINN CHUNG,
and CHRISTA P. ZADO, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

JUDGMENT
Granting Request for Adverse Judgment
37 C.F.R. § 42.73(b)

In the Petition, Facebook, Inc. (“Petitioner”) requested *inter partes* review of claims 1–5, 8–11, 16, and 17 of U.S. Patent No. 6, 820, 204 B1 (“the ’204 patent”). Paper 2, 1. On October 30, 2017, we instituted *inter partes* review of some, but not all, claims challenged by Petitioner regarding the ’204 patent. Paper 9. In particular, we instituted *inter partes* review of claims 1–3, and 16 of the ’204 patent, but we did not institute review of claims 4, 5, 8–11, and 17. *Id.* at 30–31. On January 22, 2017, ZKey Investments, LLC (“Patent Owner”) filed a Motion to Amend [Claims] Pursuant to 37 C.F.R. § 42.121 in which Patent Owner sought to cancel claims 1–3 and 16. Paper 19. Patent Owner also filed a Request for Adverse Judgment as to Instituted Claims 1–3 and 16, on January 24, 2017. Paper 21. On February 16, 2018, Petitioner filed a Statement of Non-Opposition to [Patent Owner’s] Motion to Amend. Paper 22. On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018). Subsequent to the *SAS* decision, we instituted on all remaining challenges raised in the Petition, on May 8, 2018. Paper 23. On May 16, 2018, Patent Owner filed a Motion to Amend [Claims] Pursuant to 37 C.F.R. § 42.121 (Paper 24) seeking cancellation of claims 1–5, 8–11, 16, and 17 and an Amended Request for Adverse Judgment as to Instituted Claims 1–5, 8–11, 16, and 17 (Paper 25). Patent Owner, therefore, has requested cancellation and adverse judgment as to all claims challenged in the Petition and upon which *inter partes* review has been instituted.

A party may request adverse judgment against itself at any time.
37 C.F.R. § 42.73(b). Patent Owner requests cancelation of all claims

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challenged in the Petition and upon which we instituted *inter partes* review, after which no claims would remain at issue in this proceeding. Under the circumstances presented here, we determine that it is appropriate to grant Patent Owner's requests to cancel the challenged claims and enter adverse judgment. 37 C.F.R. § 42.73(b).

ORDER

Accordingly, it is:

ORDERED that claims 1–5, 8–11, 16, and 17 of the '204 patent are *canceled*;

FURTHER ORDERED that Patent Owner's request for adverse judgment with respect to claims 1–5, 8–11, 16, and 17 of the '204 patent is *granted*, and adverse judgment is entered against Patent Owner in this proceeding pursuant to 37 C.F.R. § 42.73(b).

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