

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

MONKEYMEDIA, INC.,
Patent Owner.

Case IPR2018-00059
Patent 9,247,226 B2

Before MARC S. HOFF, LYNNE E. PETTIGREW, and
KAMRAN JIVANI, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

JUDGMENT

Granting Patent Owner's Request for Adverse Judgment
37 C.F.R. § 42.73(b)

MONKEYmedia, Inc. ("Patent Owner") has filed, with our prior authorization, a Motion for Adverse Judgment as to claims 1 and 7. Paper 25, 2–3 ("Mot."). For the reasons discussed below, we grant Patent Owner's request.

BACKGROUND

Unified Patents, Inc. (“Petitioner”), filed a Petition requesting *inter partes* review of claims 1–12 of U.S. Patent No. 9,247,226 B2 (Ex. 1001, “the ’226 patent”). Paper 2. On April 16, 2018, we instituted *inter partes* review of claims 1 and 7 on Ground 1 asserted in the Petition (obviousness over Lavalley, Gibson, Strickland, and Cohen), but declined to institute review on Grounds 2 and 3 asserted in the Petition (obviousness of claims 1–10 over Davenport and Efrat, and obviousness of claims 11 and 12 over Davenport, Efrat, and Bartok). Paper 15, 36.

On April 24, 2018, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Subsequent to that decision, Patent Owner filed a statutory disclaimer of claims 1 and 7 pursuant to 37 CFR § 1.321(a). Paper 18; Ex. 2010.

On May 15, 2018, the parties notified the Board by email that they had reached agreement to resolve this *inter partes* review. *See* Mot. 2. Specifically, the parties agreed that Patent Owner would request adverse judgment as to instituted claims 1 and 7, and that the parties would stipulate to a joint withdrawal/waiver of the currently non-instituted grounds and claims, thereby warranting termination of the IPR. *See id.* The Board authorized the parties to file such a joint Motion to Limit the Petition, and authorized Patent Owner to file a Motion for Adverse Judgment as to claims 1 and 7, in a teleconference on May 18, 2018. *See id.* The Board subsequently issued an order confirming that authorization. Paper 20.

On June 5, 2018, upon authorization, the parties filed a Joint Motion to Limit the Petition. Paper 24. Patent Owner filed the instant Motion for Adverse Judgment one day later, on June 6, 2018. Concurrently with this

Decision, we issue an Order granting the parties' Joint Motion to Limit the Petition to remove Grounds 2 and 3 from this *inter partes* review, limiting the review to claims 1 and 7 on Ground 1 asserted in the Petition.

ANALYSIS

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). Patent Owner requests adverse judgment as to claims 1 and 7, challenged in Ground 1 raised in the Petition, and subsequently statutorily disclaimed under 37 C.F.R. § 1.321(a) by Patent Owner. Mot. 2–3. Under the circumstances presented here, we find it is appropriate to grant Patent Owner's request for adverse judgment on the identified claims because doing so will achieve the parties' joint objective of resolving this *inter partes* review.

ORDER

For the reasons discussed above, it is:

ORDERED that Patent Owner's request for adverse judgment (Paper 25) is *granted*, and

FURTHER ORDERED that judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to claims 1 and 7 of the '226 patent, the only claims at issue in this proceeding in light of our Order Granting the Joint Motion to Limit the Petition.

IPR2018-00059
Patent 9,247,226 B2

PETITIONER:

Stuart A. Nelson
W. Karl Renner
Ryan Chowdhury
FISH & RICHARDSON P.C.
snelson@fr.com
axf-ptab@fr.com
rchowdhury@fr.com

Ashraf Fawzy
Jonathan Stroud
UNIFIED PATENTS, INC.
afawzy@unifiedpatents.com
jonathan@unifiedpatents.com

PATENT OWNER:

Jonathan D. Baker
FARNEY DANIELS PC
jbaker@farneydaniels.com