

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PARHELION, INC.,  
Petitioner,

v.

STREAMLIGHT, INC.,  
Patent Owner.

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PGR2020-00062  
Patent 10,378,702

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Before LYNNE E. PETTIGREW, WESLEY B. DERRICK, and  
MELISSA A. HAAPALA, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment Prior to Institution of Trial  
*37 C.F.R. § 42.73(b)*

Petitioner, Parhelion, Inc., filed a Petition for Post Grant Review of claims 1, 2, 5, 6, 8, 10–12, 15, 16, 18, 20–24, 26–28, and 31 of U.S. Patent No. 10,378,702 B2 (“the ’702 patent”). Paper 1 (“Pet.”).

On August 13, 2020, following authorization by the Board, Patent Owner, Streamlight, Inc., filed an “Unopposed Request for Entry of Adverse Judgment Under 37 C.F.R. § 42.73(b)(2).” Paper 5 (“Request”). Patent Owner represents that “Petitioner . . . does not oppose [Patent Owner’s] request for [adverse] judgement.” *Id.* Patent Owner cites “business considerations,” and “requests judgment against itself under 37 C.F.R. § 42.73(b)(2), and asks that the Board cancel claims 1, 2, 5, 6, 8, 10, 11, 12, 15, 16, 18, 20, 21, 22, 23, 24, 26, 27, 28, and 31 of the ’702 Patent.” *Id.*

Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Cancellation or disclaimer of one or more claims such that the patent owner has no remaining claim in the trial suffices as a request for adverse judgment. 37 C.F.R. § 42.73(b)(2). The Board is permitted to enter adverse judgment at any time in a proceeding, including prior to an institution decision. *Cf. Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir. 2018) (“37 C.F.R. § 42.73(b) permits the Board to enter an adverse judgment when a patent owner cancels all claims at issue after an IPR petition has been filed, but before an institution decision.”).

As claims 1, 2, 5, 6, 8, 10–12, 15, 16, 18, 20–24, 26–28, and 31 of the ’702 patent are the only claims challenged in this case, and Patent Owner requests their cancellation, Patent Owner will have no remaining claims in this case upon the requested cancellation. Under the circumstances of this case, we determine that the grant of Patent Owner’s Unopposed Request for

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Adverse Judgment is appropriate. Thus, we grant the request for adverse judgment pursuant to 37 C.F.R. § 42.73(b).

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner pursuant to 37 C.F.R. § 42.73;

FURTHER ORDERED that claims 1, 2, 5, 6, 8, 10–12, 15, 16, 18, 20–24, 26–28, and 31 of the '702 patent are cancelled; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner is precluded from taking any action inconsistent with this judgment, including obtaining any patent claim that is not patentably distinct from a cancelled claim in this proceeding.

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