

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERIMAGE 3D, INC. and
MASTERIMAGE 3D ASIA, LLC,
Petitioner,

v.

REALD INC.,
Patent Owner.

Case IPR2015-00035
Patent 7,857,455 B2

Before JAMESON LEE, JAMES B. ARPIN, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Authorization
to File a Motion to Terminate
37 C.F.R. § 42.20(b)

I. BACKGROUND

On June 17, 2015, a conference call was held to discuss Petitioner's request for authorization to file a motion to terminate this trial, without a final written decision. Counsel for Petitioner and Patent Owner, respectively, and Administrative Patent Judges Lee, Arpin, and Gerstenblith participated in the call.

Petitioner explained that it sought authorization to file a motion to terminate this trial that would result in a judgment without a final written decision. Petitioner indicated that its motion to terminate would be sought as an adverse judgment, specifically due to Petitioner's abandonment of the contest under 37 C.F.R. § 42.73(b)(4), but that Petitioner sought to avoid the estoppel effects of a final written decision. Petitioner also indicated willingness to include a second proceeding, IPR2015-00876, which involves the same parties and same patent at issue here, in its motion to terminate, thus, seeking to terminate all pending *inter partes* proceedings pertaining to U.S. Patent No. 7,857,455 B2. Petitioner, however, indicated that it was not requesting authorization to file a motion to terminate IPR2015-00876 independent of its request for termination of the instant proceeding.

Patent Owner opposes Petitioner's request for authorization and would oppose Petitioner's motion, if crafted according to Petitioner's request, because Patent Owner (1) desires Petitioner to be bound by any estoppel effects of, at least, 35 U.S.C. § 315(e), and (2) is contemplating filing a motion to amend under 35 U.S.C. § 316(d) in the instant proceeding. Patent Owner would not oppose a separate request by Petitioner for authorization to file a motion to terminate IPR2015-00876.

II. ANALYSIS

“Judgment” is defined as “a final written decision by the Board, or a termination of a proceeding.” 37 C.F.R. § 42.2. Whether a judgment is a final written decision or a termination of a proceeding depends on the circumstances.

A final written decision in the context of an *inter partes* review carries with it, *inter alia*, the estoppel effects provided in 35 U.S.C. § 315(e) and 37 C.F.R. § 42.73(d). Estoppel under these sections, however, does not apply to a termination of trial under § 42.72. A party may request judgment *against itself* at any time during a proceeding (i.e., *adverse* judgment) in accordance with 37 C.F.R. § 42.73(b), including by abandoning the contest under 37 C.F.R. § 42.73(b)(4), and no authorization by the Board for such request is required, unless the party further characterizes the adverse judgment as a *termination*.

Based on representation of counsel for Petitioner during the call, Petitioner is seeking a termination of the proceeding and *not* entry of a final written decision. In this circumstance, it is appropriate simply to refer to and to regard Petitioner’s request as for authorization to file a motion to *terminate* the proceeding, despite the fact that Petitioner also stated its intention to abandon the contest under 37 C.F.R. § 42.73(b)(4) and to request entry of *adverse* judgment.

Section 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision *where appropriate . . .*” 37 C.F.R. § 42.72 (emphasis added). Thus, we consider here whether terminating, without rendering a final written decision, is *appropriate* under the circumstances presented.

The instant proceeding is not in a preliminary stage; we issued a decision instituting *inter partes* review on April 23, 2015. *See* Paper 12. In addition, during the call, Patent Owner indicated that it opposes Petitioner's request for authorization to file a motion to terminate because Patent Owner wants Petitioner to be bound by any estoppel effects of a final written decision. Under the circumstances presented here, we determine that Petitioner's request for authorization to file a motion to terminate is not *appropriate* under § 42.72.

Accordingly, Petitioner's request for authorization to file a motion to terminate, without a final written decision, based on a request for adverse judgment is *denied*.

III. ORDER

It is:

ORDERED that Petitioner's Request for Authorization to File a Motion to Terminate Based on a Request for Adverse Judgment is *denied*.

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