

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

McWANE, INC.
Petitioner

v.

TOM W. WAUGH
Patent Owner

Case IPR2014-00777
Patent 8,567,155

Submitted via Patent Review Processing System (PRPS)

**PATENT OWNER AND PETITIONER'S JOINT REQUEST
FOR ADVERSE JUDGMENT AGAINST PATENT
OWNER UNDER 37 C.F.R. §42.73(b)(3)**

Pursuant to 37 C.F.R. § 42.73(b)(3), Patent Owner Tom W. Waugh (“Patent Owner”) and Petitioner McWane, Inc. (“Petitioner”) jointly request that the Patent Trial and Appeal Board (“PTAB”) enter an adverse judgment in this *Inter Partes* Review against the Patent Owner. The request for entry of adverse judgment is made in light of the following:

- (i) Patent Owner desires the issuance of a U.S. Reissue Patent (“Reissue Patent”) from U.S. Reissue Application No. 14/272,076 (“’076 Application”);
- (ii) original Claims 1-9 of U.S. Patent 8,567,155 (“’155 patent”), which are the subject of this *Inter Partes* Review, have been canceled from the ’076 Application;
- (iii) the claims remaining in the ’076 Application have been allowed and the Patent Owner has paid the issue fee for the ’076 Application;
- (iv) Patent Owner concedes the unpatentability of claims 1-9 of the ’155 patent under 37 C.F.R. § 42.73(b)(3);
- (v) Patent Owner and Petitioner desire the entry of adverse judgment consistent with Patent Owner’s concession of the unpatentability of claims 1-9 of the ’155 patent;

- (vi) Patent Owner agrees that the estoppel provisions of 37 C.F.R. § 42.73(d)(3) shall apply with respect to claims 1-9 of the '155 patent according to the adverse judgment entered by the PTAB;
- (vii) Petitioner does not concede that the claims in the forthcoming Reissue Patent are patentable and reserves the right to challenge the validity of the claims in the forthcoming Reissue Patent by any means;
- (viii) the intent of the parties is that both entry of an adverse judgment in this *Inter Partes* Review and issuance of the forthcoming Reissue Patent will occur on the day that the Reissue Patent issues;
- (ix) to facilitate entry of the adverse judgment contemporaneously with the issuance of the Reissue Patent, Patent Owner agrees to immediately notify the PTAB of any issue notification received in the '076 Application; and
- (x) Patent Owner agrees not to contest the PTAB's entry of adverse judgment in this *Inter Partes* Review and agrees not to contest the PTAB's authority to enter the adverse judgment requested herein.

Respectfully submitted,

Dated: November 25, 2014

By: /John C. Eisenhart/

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By: /Jason P. Cooper/

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Certificate of Service

This joint request is being filed by the Petitioner on behalf of both parties. Accordingly, pursuant to 37 C.F.R. §§ 42.6(e) and 42.8, the undersigned hereby certifies that the foregoing **Joint Request for Adverse Judgment Against Patent Owner** was served electronically, via e-mail on November 25, 2014, in its entirety on the following:

Attn: Joseph A. Rhoa, Esq. and
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Dated: November 25, 2014

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