

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLPAK, INC.,
Petitioner,

v.

MAMBATE USA INC.,
Patent Owner.

IPR2021-00007
Patent D846,728 S

Before GRACE KARAFFA OBERMANN, LYNNE E. PETTIGREW, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

JUDGMENT

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

Petitioner, Cellpak, Inc., filed a Petition for *inter partes* review of the design claim in U.S. Patent No. D846,728 S (Ex. 1001, “the ’728 patent”) on October 1, 2020. Paper 1. On the same day, Petitioner served a copy of the Petition on Patent Owner, Mambate USA Inc., at the correspondence address

of record for the '728 patent, the Law Offices of Steven W. Weinrieb. *See id.* at 25 (Certificate of Service); *see also* Ex. 1001, code (75) (identifying Law Offices of Steven W. Weinrieb as the attorney or firm representing Patent Owner during prosecution of the '728 patent). Under 37 C.F.R. § 42.8(a)(2), Patent Owner was required to file mandatory notices “within 21 days of service of the petition.”¹ Patent Owner did not timely file the requisite mandatory notices and did not file a preliminary response to the Petition.

On March 23, 2021, we entered an Order to Show Cause as to why adverse judgment should not be entered against Patent Owner in view of its failure to file mandatory notices. Paper 4. As explained in the Order to Show Cause, we held a conference call to discuss the issue. *Id.* at 2. Mr. Michael Chen represented Petitioner on the call. *Id.* Mr. Weinrieb participated in the call but stated he was not authorized to speak on behalf of Patent Owner for purposes of the call or to represent Patent Owner in this proceeding. *Id.* Mr. Weinrieb also stated he had forwarded all correspondence regarding this *inter partes* review to Patent Owner. *Id.* No counsel appeared on the call for Patent Owner. *Id.*

The Order to Show Cause explained that under 37 C.F.R. § 42.73(b), “[a] party may request adverse judgment against itself at any time during a proceeding,” and “[a]ctions construed to be a request for adverse judgment include . . . [a]bandonment of the contest.” *Id.* The Order to Show Cause also explained that failure to participate in a proceeding, such as failure to file mandatory notices as required under 37 C.F.R. § 42.8, may be

¹ Mandatory notices must identify real party-in-interest, related matters, lead and back-up counsel, and service information. 37 C.F.R. § 42.8(b).

considered abandonment of the contest and therefore result in adverse judgment under 37 C.F.R. § 42.73(b). *Id.* The Order to Show Cause gave Patent Owner ten calendar days to show cause why adverse judgment should not be entered against it. *Id.* at 3. Patent Owner did not respond to the Order to Show Cause.

On April 21, 2021, we entered a decision instituting an *inter partes* review of the '728 patent. Paper 7. On the same day, we entered an Order providing Patent Owner a final opportunity to file the required mandatory notices. Paper 9. In that Order, we placed Patent Owner on express notice that, if Patent Owner did not file mandatory notices within 30 calendar days, we would determine that Patent Owner has abandoned the contest, and we would construe Patent Owner's abandonment of the contest as a request for adverse judgment in this proceeding under 37 C.F.R. § 42.73(b)(4). *Id.* at 3.

More than 30 calendar days have elapsed since the date the Order was entered, and Patent Owner has not filed mandatory notices. In view of Patent Owner's failure to file mandatory notices within the specified time period, we determine that Patent Owner has abandoned the contest. Pursuant to 37 C.F.R. § 42.73(b)(4), we construe Patent Owner's abandonment of the contest as a request for adverse judgment. Under these circumstances, we determine that entry of judgment against Patent Owner is appropriate.

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Accordingly, it is:

ORDERED that adverse judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b) with respect to the claim of U.S. Patent No. D846,728 S;

FURTHER ORDERED that this proceeding is terminated and all scheduled Due Dates (*see* Paper 8) are vacated; and

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a).

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