Trials@uspto.gov
571-272-7822

Paper No. 12
Entered: June 21, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-00350
Patent 7,067,944 B2

Before KRISTEN L. DROESCH, JOHN A. HUDALLA, and AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

A. Background

On December 22, 2017, American Honda Motor Co., Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 3, 9, and 11 ("the challenged claims") of U.S. Patent No. 7,067,944 B2 (Ex. 1001, "the '944 patent"). Paper 2 ("Pet."). Intellectual Ventures II LLC ("Patent Owner") filed a Preliminary Response. Paper 5 ("Prelim. Resp."). With our authorization, *see* Paper 7, Petitioner filed a Reply to Patent Owner's Preliminary Response, addressing Patent Owner's argument regarding the applicability to this proceeding of *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (precedential), slip op. at 15–19. Paper 8 ("Reply"); *see also* Prelim. Resp. 12–22. Subsequently, Patent Owner filed a notice regarding disclaimer of the challenged claims. Paper 10.

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314. *See also* 37 C.F.R § 42.4(a) ("The Board institutes the trial on behalf of the Director.").

For the reasons that follow, we do not institute an *inter partes* review of any challenged claim of the '944 patent.

B. Related Proceedings

The parties identify the following matters related to the '944 patent (Pet. 3; Paper 4, 1–2):

Intellectual Ventures II LLC v. Toyota Motor Corporation et al, No. 1:17-cv-00300 (D. Del.);

Intellectual Ventures II LLC v. Aisin Seiki Co., Ltd. et al., No. 1:17-cv-00295 (D. Del.);

Intellectual Ventures II LLC v. Honda Motor Co., Ltd. et al., No. 1:17-cv-00294 (D. Del.);

Intellectual Ventures II LLC v. Bayerische Motoren Werke AG et al., No. 1:17-cv-0296 (D. Del.);

Intellectual Ventures II LLC v. Aisin Seiki Co., Ltd. et al., No. 1:17-cv-13551 (E.D. Mich.);

Intellectual Ventures II LLC v. Honda Motor Co., Ltd. et al., No. 2:17-cv-07680 (C.D. Cal.);

Intellectual Ventures II LLC v. Toyota Motor Corp. et al., No. 2:17-cv-07681 (C.D. Cal.);

Intellectual Ventures II v. Bayerische Motoren Werke AG, BMW of North America, LLC, BMW Manufacturing Co., LLC., No. 2:17-cv-08870 (D. N.J.);

In the Matter of Certain Thermoplastic-Encapsulated Electric Motors, Components Thereof, and Products and Vehicles Containing Same, 337-TA-1052 (USITC);

In the Matter of Certain Thermoplastic-Encapsulated Electric Motors, Components Thereof, and Products and Vehicles Containing Same, 337-TA-1073 (USITC); and

In the Matter of Certain Thermoplastic-Encapsulated Electric Motors, Components Thereof, and Products and Vehicles Containing Same II, 337-TA-3243 (USITC).

The '944 patent is also the subject of the following pending *inter partes* review proceedings: IPR2017-01498, IPR2017-01536,[1] and IPR2017-01836. Pet. 3; Paper 4, 1–2.

II. ANALYSIS

Patent Owner states that "it has statutorily disclaimed all previously challenged claims, as shown by the disclaimer filed as Exhibits 2013 and 2014. Because all previously challenged claims have been disclaimed, the Board should not institute this IPR." Paper 10, 2 (citing 35 U.S.C. § 318(a); 37 C.F.R. §§ 42.72, 42.107(e)). Exhibits 2013 and 2014, each titled "Disclaimer in Patent Under 37 CFR 1.321(a)," purport to disclaim claim 9 and claims 3, 10, and 11 of the '944 patent, respectively. *See* Exs. 2013 and 2014. Petitioner has not challenged the disclaimers in any manner.

Under 37 C.F.R. § 42.107(e), "[t]he patent owner may file a statutory disclaimer under 35 U.S.C. [§] 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims." A disclaimer under 35 U.S.C. § 253(a) shall be recorded in the Office, and is "considered as part of the original patent." *See* 35 U.S.C. § 253(a).

The disclaimer, to be recorded in the Office, must:

> (1) Be signed by the patentee, or an attorney or agent of record;
>
> (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
>
> (3) State the present extent of patentee's ownership interest in the patent; and

[1] IPR2018-00441 has been joined with this proceeding. *See* IPR2017-01536, Paper 24.

> (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that § 253 disclaimer is immediately "recorded" on date that Office receives disclaimer meeting requirements of 37 C.F.R. § 1.321(a)).

Based on our review of Exhibits 2013 and 2014 and Office public records (i.e., the USPTO Patent Assignment database and the USPTO Patent Application Information Retrieval database), we conclude that a disclaimer of claims 3 and 9–11 of the '944 patent has been recorded in the Office under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). Because Petitioner challenged claims 3, 9, and 11 of the '944 patent, and Patent Owner filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming all the claims challenged by Petitioner, no *inter partes* review is instituted in this proceeding. 37 C.F.R. § 42.107(e).

III. CONCLUSION

For the foregoing reasons, we do not institute an *inter partes* review of claims 3, 9, or 11 of the '944 patent.

IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

PETITIONER:

John Caracappa
jcaracap@steptoe.com

James Nuttall
jnuttall@steptoe.com

Robert Kappers
rkappers@steptoe.com

PATENT OWNER:

John R. King
2jrk@knobbe.com

Ted M. Cannon
2tmc@knobbe.com

Bridget Smith
2bzs@knobbe.com

Tim Seeley
tims@intven.com

James Hietala
jhietala@intven.com