

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,
Patent Owner.

IPR2019-01489
Patent 9,920,653 B2

Before HYUN J. JUNG, GEORGE R. HOSKINS, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)

I. BACKGROUND

On August 12, 2019, General Electric Company (“Petitioner”) filed a Petition (Paper 1, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 9,920,653 B2 (“the ’653 patent”). *See* Pet. 14–15. Those are all of the claims of the ’653 patent. *See* Ex. 1001, 6:23–8:31.

On November 25, 2019, United Technologies Corporation (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). The Preliminary Response states “Patent Owner strongly disagrees with Petitioner’s unpatentability contentions, but institution should be denied” because “Patent Owner has disclaimed every claim challenged by the Petition.” Prelim. Resp. 1 (citing Ex. 2001; 37 C.F.R. § 42.107(e); *Gen. Elec. Co. v. United Techs. Co.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (hereafter “*GE v. UT*”)).

II. ANALYSIS

Pursuant to the precedential Board decision in *GE v. UT*, when a Patent Owner properly records a disclaimer of all claims challenged in a Petition, no *inter partes* review is instituted. *See also* 37 C.F.R. § 42.107(e) (“The 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.”).

For a disclaimer to be recorded in the Office, the disclaimer 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. . . . ;

- (3) State the present extent of patentee's ownership interest in the patent; and
- (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 § 253 disclaimer is immediately “recorded” on the date the USPTO receives a disclaimer meeting the requirements of § 1.321(a), and no further action is required in the USPTO).

We conclude the record presently before us establishes Patent Owner disclaimed claims 1–20 of the '653 patent on November 25, 2019. The record reflects that a completed Form PTO/SB/43 (“DISCLAIMER IN PATENT UNDER 37 CFR 1.321(a)”) was filed on that date, as part of the prosecution history file of the '653 patent. *See* Exhibit 2001. The disclaimer form was signed by Troy S. Prince, a registered patent attorney and the Chief Intellectual Property Counsel of the Pratt & Whitney Division of Patent Owner. *See id.* The form identifies Patent Owner as the assignee of the '653 patent; identifies claims 1–20 as being disclaimed; and reflects payment of the requisite fee. *See id.* Thus, Patent Owner's filing of Exhibit 2001 in the prosecution history file of the '653 patent on November 25, 2019 appears to have met the requirements for an effective disclaimer.

In an email inquiry dated December 3, 2019, Petitioner's counsel requested authorization to file a motion for adverse judgment pursuant to 37 C.F.R. § 42.73(b). We deny that request. Our rules provide: “No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e). Furthermore, the precedential decision in *GE v. UT*, *supra*, denied institution, and did not enter adverse judgment against the patent

owner, where all challenged claims were disclaimed prior to institution of trial. Based on these authorities, we determine that a denial of institution, and not an adverse judgment against Patent Owner, is the appropriate vehicle for disposing of this case.

For the foregoing reasons, we deny institution of *inter partes* review in this proceeding.

III. ORDER

It is ORDERED that no *inter partes* review is instituted in this proceeding.

PETITIONER:

Brian Ferguson
Anish Desai
Christopher Pepe
WEIL, GOTSHAL & MANGES LLP
Brian.Ferguson@weil.com
Anish.Desai@weil.com
Christopher.Pepe@weil.com
GE.WGM.Service@weil.com

PATENT OWNER:

Jeffrey C. Totten
Benjamin A. Saidman
Trenton A. Ward
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
jeffrey.totten@finnegan.com
benjamin.saidman@finnegan.com
trenton.ward@finnegan.com
UTC-IPR@finnegan.com