

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PPC BROADBAND, INC.,
Petitioner,

v.

TIMES FIBER COMMUNICATIONS, INC.¹,
Patent Owner.

IPR2022-00830
Patent 10,913,632 B2

Before BART A. GERSTENBLITH, GEORGE R. HOSKINS, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *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)

¹ The Petition (Paper 2, cover page) identifies Amphenol Corporation as the Patent Owner. Patent Owner states the Petition “incorrectly identified Patent Owner,” and “Patent Owner identifies itself as ‘Times Fiber Communications, Inc.’” Paper 5 n.1; *see also* Ex. 2001 (recorded assignment of the challenged patent from Amphenol Corporation to Times Fiber Communications, Inc.).

I. INTRODUCTION

A. *Background and Summary*

PPC Broadband Inc. (“Petitioner”) filed a petition for *inter partes* review challenging claims 1–14 and 16–21 of U.S. Patent 10,913,632 B2 (Ex. 1001, “the ’632 Patent”). Paper 2 (“Pet.” or “Petition”). Times Fiber Communications, Inc. (“Patent Owner”) filed a Preliminary Response and a Statutory Disclaimer of claims 1–14 and 16–21 (Ex. 2002). Paper 9 (“Prelim. Resp.”). Patent Owner opposed institution of review based on the Statutory Disclaimer.

Petitioner challenges claims 1–14 and 16–21 as unpatentable under 35 U.S.C. § 103. Pet. 2. In light of Patent Owner’s Statutory Disclaimer, we decline to institute an *inter partes* review.

B. *Real Parties in Interest*

Petitioner represents that PPC Broadband, Inc. and Belden Inc. are the real parties-in-interest. Pet. 93.

Patent Owner represents that Times Fiber Communications, Inc. is the real party-in-interest. Paper 5, 1.

C. *Related Matters*

The ’632 Patent is presently involved in a related district court proceeding: *Times Fiber Communications, Inc. v. PPC Broadband, Inc.*, 1:21-cv-01823-UNA, D. Del. filed on December 27, 2021. Pet. 93; Paper 5, 1. Patent Owner also indicates that patents related to the ’632 Patent are asserted in the referenced district court proceeding. These are: U.S. Patent Nos. 10,941,016; 10,988,342; 11,001,471; and 10,906,771. Paper 5, 1.

D. The '632 Patent

The '632 Patent is directed to a “cable payout apparatus that comprises a bag with a payout opening for dispensing cable, and first and second frames inside the bag.” Ex. 1001, (57). The '632 Patent has 21 claims, three of which are independent. *Id.* at 11:17–13:21.

II. ANALYSIS

As set forth in the Board’s precedential *General Electric* decision, “[u]nder 37 C.F.R. § 42.107(e), ‘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’ and ‘[n]o *inter partes* review will be instituted based on disclaimed claims.’” *Gen. Elec. Co. v. United Techs. Co.*, IPR2017-00491, Paper 9 at 2 (PTAB July 6, 2017) (precedential). “A disclaimer under 35 U.S.C. [§] 253(a) is ‘considered as part of the original patent’ as of the date on which it is ‘recorded’ in the Office.” *Id.* at 2–3 (citing (35 U.S.C. § 253(a))). 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).

Based on our review of Exhibit 2002 and Office public records, we conclude a disclaimer of claims 1–14 and 16–21 of the ’632 Patent, under 35 U.S.C. § 253(a) has been recorded in the Office as of July 28, 2022. Ex. 2002. *Vectra Fitness, Inc.*, 162 F.3d at 1382. The record shows that a completed Form PTO/SB/43 (“DISCLAIMER IN PATENT UNDER 37 CFR 1.321(a)”) was filed and received by the Office on that date. *See* Ex. 2002. The disclaimer form was signed by Lance D’Armico, Secretary for Patent Owner Times Fiber Communications, Inc. *See* Ex. 2002, 3; *see also* Ex. 2001 (recorded assignment of the challenged patent from Amphenol Corporation to Times Fiber Communications, Inc., executed on December 23, 2021). The form identifies Patent Owner as having a “100% Ownership Interest” in the ’632 Patent, and identifies claims 1–14 and 16–21 as being disclaimed. *See* Ex. 2002, 3. The evidence also reflects payment of the required fee. *See id.* at 1, 4–5.

We determine Patent Owner has met the requirements for an effective disclaimer under 35 U.S.C. § 253 and 37 C.F.R. § 1.321(a). In view of this disclaimer, and as consistent with 37 C.F.R. § 42.107(e) and the Board’s precedential *General Electric* decision, we determine a denial of institution is sufficient to dispose of this case. *See Gen. Elec. Co.*, IPR2017-00491, Paper 9. Thus, we decline to institute an *inter partes* review.

III. CONCLUSION

Based on the review of Exhibit 2002 and Office public records, we conclude that a disclaimer of claims 1–14 and 16–21 of the ’632 Patent

under 35 U.S.C. § 253(a) has been recorded in the Office as of July 28, 2022. Ex. 2002. Because all the claims challenged by Petitioner have been disclaimed under 35 U.S.C. § 253(a), no *inter partes* review is instituted in this proceeding. 37 C.F.R. § 42.107(e).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, no *inter partes* review is instituted on claims 1–14 and 16–21.

IPR2022-00830
Patent 10,913,632 B2

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