

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESTO, INC. a/k/a TESTO NORTH AMERICA, AND
TESTO SE & CO. KGaA,
Petitioner,

v.

PARKER INTANGIBLES LLC,
Patent Owner.

IPR2023-00691
Patent 10,739,051 B2

Before JEREMY M. PLENZLER, JAMES A. TARTAL, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *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. INTRODUCTION

A. Background and Summary

Testo, Inc. a/k/a Testo North America, and Testo SE & Co. KGaA (“Petitioner”) filed a petition (“Petition” or “Pet.”) to institute an *inter partes* review of claims 1, 10, 15, 20, and 21 (the “challenged claims”) of U.S. Patent No. 10,739,051 B2 (Ex. 1001, “the ’051 patent”). Parker Intangibles LLC (“Patent Owner”) timely filed a Preliminary Response that includes Exhibit 2001, a copy of a disclaimer under 37 C.F.R. § 1.321(a) filed by Patent Owner that disclaims all of the challenged claims. Paper 7 (“Preliminary Response” or “Prelim. Resp.”).

For the reasons described below, based on the information presented, we do not institute an *inter partes* review of any of the challenged claims.

B. Real Parties in Interest

Testo, Inc. a/k/a Testo North America, Testo SE & Co. KGaA, Parker Intangibles LLC, and Parker-Hannifin Corporation are the real parties in interest. Pet. 14; Paper 4, 2.

C. Related Matters

The parties indicate that the ’051 patent is asserted against Petitioner in *Parker-Hannifin Corp. et al. v. Testo, Inc. et al.*, No. 22-cv-00135 (E.D. Pa.), filed January 12, 2022 (the “Eastern District of Pennsylvania Litigation”). Pet. 14; Paper 4, 2.

Petitioner states that Patent Owner also asserts U.S. Patent No. 10,281,183¹ against Petitioner in the Eastern District of Pennsylvania Litigation. Pet. 14.

II. ANALYSIS

Patent Owner responds to the Petition by filing a statutory disclaimer with the United States Patent and Trademark Office in connection with the '051 patent, disclaiming the asserted claims of the '051 patent pursuant to and in compliance with each of 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). Prelim. Resp. 1 (citing Ex. 2001). Patent Owner asserts that institution would be improper because it has disclaimed each and every claim challenged in the Petition. *Id.*

Under 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.” A disclaimer filed under 35 U.S.C. § 253(a) will be “considered as part of the original patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never existed.”). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;

¹ U.S. Patent No. 10,281,183 is challenged in IPR2023-00685, which involves the same Petitioner and Patent Owner as the present matter (i.e., IPR2023-00691).

- (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
- (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*, 162 F.3d at 1382 (holding that a § 253 disclaimer is immediately “recorded” on the date that the Office receives a disclaimer meeting requirements of 37 C.F.R. § 1.321(a) and that no further action is required in the Office). “No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e); *see also General Electric Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9, 3 (PTAB July 6, 2017) (precedential).

Based on our review of Exhibit 2001 and Office public records for the '051 patent, we conclude that a disclaimer of the challenged claims of the '051 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of June 22, 2023. Exhibit 2001, a copy of the filed disclaimer, is signed by Patent Owner's attorney of record, Amir Shenouda. Ex. 2001, 3. Exhibit 2001 also identifies the '051 patent; identifies that all of the challenged claims in the Petition (i.e., claims 1, 10, 15, 20, and 21) are disclaimed; and states that Parker Intangibles, LLC is the owner of 100% of the instant patent by virtue of an assignment recorded at Reel 054371 and Frame 0141.² *Id.*

² The '051 patent was initially assigned to Parker-Hannifin Corporation, and subsequently assigned by Parker-Hannifin Corporation to Parker Intangibles, LLC. Ex. 2001, 6.

Because 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 challenged claims of the '051 patent (i.e., claims 1, 10, 15, 20, and 21), no *inter partes* review is instituted in this proceeding.

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that no *inter partes* review is instituted for any claim challenged by Petitioner.

IPR2023-00691
Patent 10,739,051 B2

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