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Paper 8
Date: May 5, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WIZ, INC.,
Petitioner,

v.

ORCA SECURITY LTD.,
Patent Owner.

IPR2025-00092
Patent 11,516,231 B2

Before MICHAEL R. ZECHER, GARTH D. BAER, and LISA A. MURRAY, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Wiz, Inc. ("Wiz"), filed a Petition requesting an *inter partes* review ("IPR") of claims 1–19 ("the challenged claims") of U.S. Patent No. 11,516,231 B2 (Ex. 1001, "the '231 patent"). Paper 2 ("Pet."). Patent Owner, Orca Security Ltd. ("Orca"), filed a Preliminary Response (Paper 6 ("Prelim. Resp.")), along with a statutory disclaimer that only disclaimed "the entire term of the above-identified patent," but did not disclaim any of the challenged claims (Ex. 2001). After informing Orca that the Board retains jurisdiction over an expired patent and its disclaimer did not achieve the intended effect of foreclosing IPR, Orca promptly filed another statutory disclaimer that disclaims all the challenged claims of the '231 patent. Ex. 2002.

In accordance with the rules governing an IPR, no trial will be instituted based on disclaimed claims. *See* 37 C.F.R. § 42.107(e). Accordingly, we *deny* Wiz's Petition.

II. ANALYSIS

Orca contends that "the Petition is moot" and an "IPR cannot be instituted" because a statutory disclaimer was filed with the U.S. Patent and Trademark Office ("USPTO") disclaiming all the challenged claims of the '231 patent. Prelim. Resp. 1; *see also* Ex. 2002 (Disclaimer in a Patent Under 37 C.F.R. § 1.321(a), filed Apr. 24, 2025).

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" and, if the statutory disclaimer is filed properly, "[n]o [IPR] will be instituted based on disclaimed claims." A statutory disclaimer is "considered as part of the

original patent" as of the date on which it is "recorded" in the USPTO. 35 U.S.C. § 253(a). "A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent." *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996); *see also Raytheon Techs. Corp. v. General Elec. Co.*, 993 F.3d 1374, n.4 (Fed. Cir. 2021) ("Disclaimed claims are treated as if they never existed.")

For a disclaimer to be "recorded" in the USPTO, the document filed by the patent owner must include the following:

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

37 C.F.R. § 1.321(a). "[N]othing in the statutes or regulations requires any action by the [USPTO] for a disclaimer to be 'recorded.'" *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998).

Based on our review of Exhibit 2002 and the USPTO's public records, we conclude that a disclaimer of the challenged claims of the '231 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of April 24, 2025. Ex. 2002. Because we cannot institute an IPR based on disclaimed claims and all of the challenged claims of the '231 patent have been disclaimed, no trial will be instituted. *See Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential)

(Decision Denying Institution) (denying institution under 37 C.F.R. § 42.107(e) based on a statutory disclaimer filed pre-institution).

III. ORDER

In consideration of the foregoing, it is ORDERED that the Petition is *denied* and no trial is instituted.

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