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Paper 9
Entered: July 6, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION
AND MTU AERO ENGINES AG,
Patent Owner.

Case IPR2017-00491
Patent 8,517,668 B1

Before HYUN J. JUNG, MITCHELL G. WEATHERLY, and GEORGE R. HOSKINS, *Administrative Patent Judges.*

WEATHERLY, *Administrative Patent Judge*.

DECISION
Not Instituting *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. §§ 42.4, 42.108

I. INTRODUCTION

A. BACKGROUND

General Electric Company ("GE") filed a petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–17 of U.S. Patent No. 8,517,668 B1 (Ex. 1001, "the '668 patent"). 35 U.S.C. § 311. United Technologies

Corporation and MTU Aero Engines AG (collectively "Patent Owner") timely filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); 37 C.F.R. § 42.108.

For the reasons described below, we decline to institute an *inter partes* review of any claims.

B. RELATED PROCEEDINGS

The parties indicate that the '668 patent is related to a patent that was at issue in Case IPR2016-00857, in which institution of *inter partes* review was denied. Pet. 1; Prelim. Resp. 1; Paper 4, 1. The parties also indicate that the '668 patent is not involved in litigation. Pet. 2; Paper 4, 2.

II. ANALYSIS

Patent Owner states that it "strongly disagree[s] with Petitioner's unpatentability contentions." Prelim. Resp. 1. Nevertheless, United Technologies Corporation and MTU Aero Engines AG and MTU Aero Engines AG have each filed a statutory disclaimer of claims 1–17 of the '668 patent. Ex. 2001 (for United Technologies Corporation and MTU Aero Engines AG); Ex. 2002 (for MTU Aero Engines AG).

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" and "[n]o *inter partes* review will be instituted based on disclaimed claims." 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. 35 U.S.C. § 253(a). 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;
>
> (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 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) and that no further action is required in the Office).

Based on our review of Exhibits 2001 and 2002 and Office public records, we conclude that a disclaimer of claims 1–17 of the '668 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of April 12, 2017. Ex. 2001; Ex. 2002. Because all claims challenged by GE have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted in this proceeding. 37 C.F.R. § 42.107(e).

III. ORDER

For the reasons given, it is ORDERED that no *inter partes* review is instituted for any claim challenged by GE.

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