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Paper 9
Date: October 24, 2022

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.

IPR2022-00831
Patent 10,589,957 B2

Before BART A. GERSTENBLITH, GEORGE R. HOSKINS, and FRANCES L. IPPOLITO, *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)

[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. BACKGROUND

On April 21, 2022, PPC Broadband, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of U.S. Patent No. 10,589,957 B2 ("the '957 patent"), claims 9–19. *See* Pet. 1, 5.

On July 22, 2022, Times Fiber Communications, Inc. ("Patent Owner") filed a Statutory Disclaimer of claims 9–19. *See* Ex. 2002. On August 4, 2022, Patent Owner filed a Preliminary Response (Paper 8, "Prelim. Resp.") opposing institution of review, based on the Statutory Disclaimer.

For the following reasons, on behalf of the Director (*see* 37 C.F.R. § 42.4(a)), we *deny* the petitioned *inter partes* review.

II. ANALYSIS

When a patent owner properly records a disclaimer of all patent claims challenged in a petition, no *inter partes* review is instituted. *See Gen. Elec. Co. v. United Techs. Co.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential); *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 9–19 of the '957 patent on July 22, 2022. The record reflects 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 Daniel R. Gibson, a registered patent attorney representing 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 '957 patent, and identifies claims 9–19 as being disclaimed. *See* Ex. 2002, 3. The evidence also reflects payment of the required fee. *See id.* at 1, 4–5.

Patent Owner has met the requirements for an effective disclaimer of all challenged claims under 35 U.S.C. § 253 and 37 C.F.R. § 1.321(a). Thus, institution of the petitioned *inter partes* review is denied.

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that institution of the petitioned *inter partes* review is *denied*.

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