

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOREALIS AG,
Petitioner,

v.

BERRY PLASTICS CORPORATION,
Patent Owner.

Case IPR2016-00564
Patent 8,883,280 B2

Before SALLY C. MEDLEY, SHERIDAN K. SNEDDEN, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.107(e), 42.108

I. INTRODUCTION

Borealis AG (“Petitioner”)¹ filed a Petition for *inter partes* review of claims 1, 15–36, 40, 42, 43, 54–61, 63, and 64 (“the challenged claims”) of U.S. Patent No. 8,883,280 B2 (Ex. 1001, “the ’280 patent”). Paper 1 (“Pet.”). Berry Plastics Corporation (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

A. *Related Proceedings*

Petitioner also has challenged certain claims of the ’280 patent in *Borealis AG v. Berry Plastics Corp.*, Case IPR2016-00235 (“the 235 IPR”). Pet. 59; Paper 5, 2. Patent Owner disclaimed each of the claims challenged in the 235 IPR, and no trial was instituted. *See* Case IPR2016-00235 (PTAB Mar. 24, 2016) (Paper 11).

B. *The ’280 Patent*

The ’280 patent, titled “Polymeric Material for an Insulated Container,” relates to a formulation which can be used to form a container, the formulation including a polymeric material, a nucleating agent, a blowing agent, and a surface active agent. Ex. 1001, at [54], Abstract. Given the procedural posture of this proceeding, we need not discuss further the substance of the patent or the Petition.

II. ANALYSIS

Pursuant to 35 U.S.C. § 253(a), a patentee may “make disclaimer of any complete claim Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as

¹ In addition to Borealis AG, the Petition also identifies Borealis Polyolefine GmbH and Borealis Compounds, Inc. as real-parties-in-interest. Pet. 59.

part of the original patent.” In its Preliminary Response, Patent Owner indicates that it has disclaimed each of the challenged claims under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a). Prelim. Resp. 2. In particular, claims 1–14, 36–42, 44–48, 51–54, 61, 62, 65, and 66 of the ’280 patent previously were disclaimed in response to the petition in the 235 IPR, via statutory disclaimers filed on March 9, 2016 and March 22, 2016. *See* Prelim. Resp. 2; Ex. 2101; Ex. 2102. Claims 15–35, 43, 55–60, 63, and 64 have been disclaimed via a statutory disclaimer filed on May 23, 2016. *See* Prelim. Resp. 2; Ex. 2103.

Further, 37 C.F.R. § 42.107(e) provides that, in response to a petition, 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.” Accordingly, because Patent Owner has disclaimed each of the challenged claims—namely, claims 1, 15–36, 40, 42, 43, 54–61, 63, and 64—*inter partes* review will not be instituted based on those claims.

III. CONCLUSION

For the foregoing reasons, we do not institute an *inter partes* review of U.S. Patent No. 8,883,280 B2.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), no *inter partes* review of U.S. Patent No. 8,883,280 B2 is instituted.

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