

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,
Patent Owner.

Case IPR2017-01097
Patent 8,572,943 B1

Before HYUN J. JUNG, SCOTT A. DANIELS, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

JUDGMENT AND FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

In this matter, General Electric Company (“Petitioner”) initially requested *inter partes* review of claims 1–5, 8–13, and 15–20 of U.S. Patent No. 8,572,943 B1 (“the ’943 patent”). Paper 1. United Technologies Corporation (“Patent Owner”) filed a Preliminary Response (Paper 6). The Board granted the Petition, instituting on all challenged claims. Paper 7.

IPR2017-01097
Patent 8,572,943 B1

On February 16, 2018, Patent Owner filed a Patent Owner's Response. Paper 13 ("Response" or "PO Resp."). The Response notified the Board of Patent Owner's filing of a Disclaimer under 37 C.F.R. § 1.321(a), disclaiming claims 1–5, 8–13 and 15–20 of the '943 patent. PO Resp. 1. Patent Owner has filed a copy of the Disclaimer. Ex. 2019. The Response concludes that, due to the disclaimer, "this IPR should be terminated." PO Resp. 1. On March 22, 2018, Petitioner filed a Reply to the Response. Paper 14 ("Reply"). According to Petitioner, 37 C.F.R. § 42.73(b) "provide[s] that the Board should construe Patent Owner's disclaimer as a request for adverse judgment," rather than a request for termination under 37 C.F.R. § 42.72. Reply 1–2. A party may request entry of adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). "Actions construed to be a request for adverse judgment include . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial." *Id.* § 42.73(b)(2). That is the case here, where Patent Owner has disclaimed claims 1–5, 8–13, and 15–20, all the claims challenged in the present trial. Under these circumstances, entry of judgment adverse to the Patent Owner is appropriate.

ORDER

In view of the foregoing, it is:

ORDERED that, to the extent Patent Owner is requesting termination instead of adverse judgment, the request is denied;

FURTHER ORDERED that adverse judgment against Patent Owner in this proceeding is entered under 37 C.F.R. § 42.73(b)(2); and

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a).

IPR2017-01097
Patent 8,572,943 B1
For PETITIONER:

WEIL, GOTSHAL & MANGES LLP

Anish R. Desai
Brian E. Ferguson
Christopher Pepe
anish.desai@weil.com
brian.ferguson@weil.com
christopher.pepe@weil.com
GE.WGM.Service@weil.com

For PATENT OWNER:

FISH & RICHARDSON P.C.
W. Karl Renner
Timothy W. Riffe
David L. Holt
IPR43498-0011IP2@fr.com
PTABInbound@fr.com