

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HALLIBURTON ENERGY SERVICES, INC.,
Petitioner,

v.

SCHLUMBERGER TECHNOLOGY CORP.,
Patent Owner.

Case IPR2017-01568
Patent 8,167,043 B2

Before HYUN J. JUNG, JEREMY M. PLENZLER, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Halliburton Energy Services, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”), requesting institution of an *inter partes* review of claims 1–4, 6, 7, 13, 15, and 25–27 of U.S. Patent No. 8,167,043 B2 (Ex. 1001, “the ’043 patent”). Schlumberger Technology Corp. (“Patent Owner”) filed a Preliminary Response (Paper 10, “Prelim. Resp.”).

For the reasons explained below, we do not institute an *inter partes* review.

A. *Related Proceedings*

The parties indicate that there are no related judicial or administrative proceedings. Pet. 2; Paper 3, 1. The ’043 patent is also the subject of Case IPR2017-01777 and is related to the patent at issue in Case IPR2017-01564. *Id.*

II. ANALYSIS

Patent Owner states that it “rendered this proceeding moot by disclaiming all claims of the ’043 patent on October 20, 2017.” Prelim. Resp. 1 (citing Ex. 2002 (“Disclaimer in Patent Under 37 C.F.R. § 1.321(a)” disclaiming claims 1–27 of the ’043 patent)). In response to an order (Paper 13), Patent Owner filed another Disclaimer in Patent Under 37 C.F.R. § 1.321(a) (Ex. 2003) and confirms that Patent Owner is the assignee of the ’043 patent (Paper 14, 1–2 (citing MPEP § 306; Ex. 2004 (assignment for patent application 11/294,983); Ex. 2004, 3–4 (“Inventors . . . have . . . assigned . . . unto [Schlumberger Technology Corp.] . . . entire right, title and interest . . . to any . . . divisional . . . application which may be filed on said invention, inventions, or improvements in the United States”)); *see also*

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Ex. 1001 (62) (stating that the '043 patent issued from a “[d]ivision of application No. 11/294,983”).

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” once it is “recorded” in the Office. 35 U.S.C. § 253(a).

The disclaimer, to be recorded in the Patent and Trademark Office, 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 the date that the Office receives disclaimer meeting requirements of 37 C.F.R. § 1.321(a)).

Based on our review of Exhibits 2003 and 2004 and Office public records, we conclude that a disclaimer of claims 1–27 of the '043 patent has been recorded in the Office under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). Because Petitioner challenged claims 1–4, 6, 7, 13, 15, and 25–27 of the '043 patent and Patent Owner filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming all the claims challenged by Petitioner, no *inter partes* review is instituted in this proceeding. 37 C.F.R. § 42.107(e).

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III. CONCLUSION

For the foregoing reasons, we do not institute *inter partes* review of claims 1–4, 6, 7, 13, 15, and 25–27 of the '043 patent.

IV. ORDER

Accordingly, it is ORDERED that the Petition is *denied* for the reasons discussed, and no trial is instituted.

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