

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HALLIBURTON ENERGY SERVICES, INC.,  
Petitioner,

v.

SCHLUMBERGER TECHNOLOGY CORPORATION,  
Patent Owner.

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Case IPR2017-01777  
Patent 8,167,043 B2

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Before PATRICK R. SCANLON, JEREMY M. PLENZLER, and  
JAMES J. MAYBERRY, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On November 2, 2017, Schlumberger Technology Corp. (“Patent Owner”) filed Exhibit 2001 (“Disclaimer in Patent Under 37 CFR 1.321(a),” hereafter “Disclaimer”) with its Preliminary Response (Paper 6). The Preliminary Response contends that the Disclaimer would render this proceeding moot and requests no *inter partes* review be instituted. Paper 6, 1.

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 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; (3) state the present extent of patentee’s ownership interest in the patent; and (4) be accompanied by the relevant fee. 37 C.F.R. § 1.321(a).

The presently filed Disclaimer does not appear to be signed by an attorney of record and does not appear to be owned by Schlumberger Technology Corp. In particular, according to Office records, Customer # 27452 includes the attorneys of record for the patent at issue, U.S. Patent No. 8,167,043 (“the ’043 patent”). The Disclaimer is signed by Mr. Jeremy P. Welch, and neither his name nor his registration number is associated with Customer # 27452. Also, the Disclaimer represents that the extent of patentee’s ownership interest in the patent is recorded at “reel/frame 017144/0120.” However, according to Office records, the assignment referenced in the Disclaimer is only for U.S. Patent No. 7,380,600 (“the ’600 patent”). The ’043 patent issued from a division of an application, from

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which the '600 patent issued. These issues with the Disclaimer were raised and addressed in related Case IPR2017-01568.

### ORDER

In view of the arguments in the Preliminary Response, it is

ORDERED that Patent Owner file, using its next exhibit number and within five (5) business days of the entry date of this Order, a Disclaimer in Patent Under 37 C.F.R. § 1.321(a) that addresses the issues identified above in order to avoid a Decision on Institution.

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