

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. and AUGUST HOME, INC.,  
Petitioner,

v.

MARK W. KILBOURNE,  
Patent Owner.

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Case IPR2019-00233  
Patent 7,373,795 B2

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Before GEORGE R. HOSKINS, RICHARD H. MARSCHALL, and  
JASON W. MELVIN, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceeding*  
37 C.F.R. §§ 42.5 & 42.107(e)

Apple Inc. and August Home, Inc. (collectively, “Petitioner”) have filed a Petition (Paper 3, “Pet.”) to institute an *inter partes* review of claims 11–20 of U.S. Patent No. 7,373,795 B2 (“the ’795 patent”). *See* Pet. 7–8. As pertinent to this Order, the Petition asserts claims 18–20 are unpatentable under 35 U.S.C. § 103 based on two patents and one published patent application. *See id.* at 8, 57–70.

Mark W. Kilbourne (“Patent Owner”), the solely named inventor and the owner of the ’795 patent, has filed a Preliminary Response (Paper 8, “Prelim. Resp.”). Patent Owner’s only response to the Petition’s challenge of unpatentability in relation to claims 18–20 is as follows:

Pursuant to a disclaimer filed prior to the filing of this response, Patentee has disclaimed claims 18–20. *See* Exhibit 2002. As such, this response addresses only independent claim 11 and claims 12–17 (which depend from claim 11). *See* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.[”])[.]

Prelim. Resp. 18.

We have reviewed Exhibit 2002. It is a document captioned “DISCLAIMER OF CLAIMS 18, 19 AND 20 FOR U.S. PATENT No. 7,373,795.” Ex. 2002. The document pertinently states: (a) Patent Owner is “the sole owner of” the ’795 patent; (b) Patent Owner “hereby disclaim[s] claims 18, 19 and 20” of the ’795 patent; and (c) attached is “a USPTO payment form for \$160. to pay the fee for this action.” *Id.* The document bears a typewritten date of February 13, 2019, and Patent Owner’s signature followed by the handwritten date of February 14, 2019. *Id.* The Preliminary Response in this proceeding was filed on February 14, 2019.

However, Exhibit 2002 does not bear any indicia of the document having been filed with the Office in any fashion other than as an Exhibit in

this proceeding. There also is no payment form attached to the document, despite statement (c) in the document. Further, the Office's Public Patent Application Information Retrieval (PAIR) database records relating to the '795 patent do not reflect the filing of the disclaimer provided in Exhibit 2002 as part of the official prosecution history record of the '795 patent.

Based on the foregoing, we conclude Patent Owner has not, in fact, disclaimed claims 18–20, despite having stated it was Patent Owner's intention to have done so "prior to the filing of" the Preliminary Response. *See* Prelim. Resp. 18. Our Rules direct the Patent Owner to "*file* a statutory disclaimer under 35 U.S.C. [§] 253(a) *in compliance with § 1.321(a) of this chapter.*" 37 C.F.R. § 42.107(e) (emphases added). That is, Patent Owner must file the disclaimer as part of the prosecution history record of the '795 patent, for example using the Office's EFS-Web electronic filing system, so that the disclaimer is included in the PAIR database records relating to the '795 patent. This method of filing permits the disclaimer to be reviewed by the appropriate personnel for statutory and regulatory compliance. *Id.*; *see also* MPEP § 1490(IV)(A)–(D) (the Certificates of Correction Branch of the Office, not the Patent Trial and Appeal Board, determines whether a filed statutory disclaimer complies with 35 U.S.C. § 253(a) and with 37 C.F.R. § 1.321, and takes appropriate action).

In consideration of the foregoing, it is hereby:

ORDERED that, on or before April 5, 2019, Patent Owner shall take *one of* the following actions:

- (1) file a statutory disclaimer of claims 18–20 of the '795 patent as part of the prosecution history record of

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the '795 patent, and then file a Paper in the present proceeding attaching the prosecution history filing as an Exhibit thereto; *or*

- (2) file a Paper in the present proceeding indicating that Patent Owner does not desire to disclaim claims 18–20 of the '795 patent; *or*
- (3) confer with Petitioner's counsel to determine when counsel for both parties are available during the week of April 8–12, 2019, to participate in a telephone conference with the Board to discuss the status of claims 18–20 of the '795 patent.

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