

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FCA US LLC,
Petitioner,

v.

JACOBS VEHICLE SYSTEMS, INC.,
Patent Owner.

Case IPR2015-01234
Patent No. 6,883,492 B2

Before MEREDITH C. PETRAVICK, BENJAMIN D. M. WOOD, and
RICHARD E. RICE, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

DECISION

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

INTRODUCTION

On May 20, 2015, FCA US LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 38–42, 44, and 45 (“the challenged Claims”) of U.S. Patent No. 6,883,492 B2 (Ex. 1001, “the ’492 Patent”). In the Petition, Petitioner provided notice of

co-pending Reissue Application No. 14/260,250, relating to the '492 Patent. Pet. 46.

On September 2, 2015, Jacobs Vehicle Systems, Inc. ("Patent Owner") filed a Preliminary Response (Paper 8, "Prelim. Resp."). In its Preliminary Response, Patent Owner provided notice that challenged claim 38 of the '492 Patent had been disclaimed pursuant to 37 C.F.R. § 1.321(a); Patent Owner also set forth reasons why no *inter partes* review should be instituted as to the other challenged claims. *See* Prelim. Resp. 1.

On October 5, 2015, Patent Owner sent an email to the Board providing notice that the remainder of the challenged claims had been disclaimed. Patent Owner further stated: "As no *inter partes* review will be instituted based on disclaimed claims, there is no longer any claim requiring resolution by the Board in this proceeding. 37 C.F.R. § 42.107(e)."

On October 6, the Board, by email, authorized Patent Owner to file a motion for adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2) based on the statutory disclaimers. Patent Owner responded by email to the Board stating that Patent Owner "[did] not intend to file a motion for adverse judgment," but rather "assume[d] that the [Petition] will eventually be denied, as the Board no longer has jurisdiction." This email was the first in a series of emails from the parties to the Board in which Petitioner sought adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2) and Patent Owner sought denial of the Petition pursuant to 37 C.F.R. §§ 42.107(e) and 42.108.

DISCUSSION

We have jurisdiction to consider the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect

to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

We determine that Patent Owner has filed statutory disclaimers under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), disclaiming all of challenged claims 38–42, 44, and 45 of the ’492 Patent. Ex. 3001.

Accordingly, no *inter partes* review will be instituted based on the challenged claims. See 37 C.F.R. § 42.107(e).

We further determine that Patent Owner’s statutory disclaimers, which were filed prior to institution of a trial in this case, should not be construed as a request for adverse judgment. Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a proceeding” and “[a]ctions construed to be a request for adverse judgment include . . . (2) [c]ancellation or disclaimer of a claim *such that the party has no remaining claim in the trial*” (emphasis added). The term “trial” in 37 C.F.R. § 42.73(b)(2) means “a contested case instituted by the Board based upon a petition.” See 37 C.F.R. § 42.2. Nothing in 37 C.F.R. § 42.73(b)(2) requires us to construe Patent Owner’s statutory disclaimers as a request for adverse judgment prior to institution of a trial.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Petition for an *inter partes* review of claims 38–42, 44, and 45 of the ’492 Patent is *denied*, and no *inter partes* review will be instituted pursuant to 35 U.S.C. § 314 as to any claim of the ’492 Patent on any of the grounds of unpatentability alleged by Petitioner in the Petition.

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