

Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

Strategic Use of Disclaimers in PTAB Proceedings

By Patrick T. Muffo

A patentee has several options for responding to a Petition for *Inter Partes* Review (“IPR”) or Covered Business Method (“CBM”) petition. The patent owner can optionally file a Preliminary Response arguing against institution on substantive grounds, or the patent owner can attack the petition procedurally, such as by arguing the petitioner is a real-party in interest to a litigation or is otherwise related to a party served more than a year prior to the petition and the petition is therefore time barred. A third, less frequently used approach, is to file a disclaimer that disclaims the claims that provide a basis for the institution of the IPR or CBM.

37 CFR § 42.107 states “The 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. No *inter partes* review will be instituted based on disclaimed claims.” The patent owner can therefore eliminate claims that present the basis of the PTAB institution, for example, those claims that are of a financial nature and that therefore provide the basis for institution of a CBM petition. The patent owner may also file a disclaimer to eliminate claims that are most likely not novel in light of the prior art and, instead of fighting those claims in the petition, can emerge from the PTAB proceeding with stronger claims intact and without spending resources and time fighting for all of the claims in the IPR petition.

The case of *Securus Technologies, Inc. v. Global Tel*Link Corp.*, Case IPR2016-01115 (Nov. 15, 2016 Decision Denying Institution) involved a disclaimer of all claims of a patent owned by Global Tel*Link. The parties were not in litigation at the time of the petition and, while it was unclear what Global’s motives were, Global disclaimed all claims of the challenged patent rather than fight the IPR. The challenged patent was one patent in a larger family, and after the petition was filed in June 2016, Global filed four new continuation applications claiming priority to the challenged patent.

Although it may seem counterintuitive to disclaim your own patent, disclaimers can provide great strategic benefits and allow the parties to fight the battle in a preferred forum (e.g., district court) or to file continuation applications to obtain more defensible protection. All options should be considered when responding to an IPR petition and sometimes the road less traveled is the best path, given the circumstances.

[Patrick T. Muffo](#) is editor of the Seyfarth PTAB Blog and partner in the firm’s Chicago office. For more information, please contact a member of the [Patent Practice Group](#), your Seyfarth Shaw LLP attorney, or Patrick T. Muffo at pmuffo@seyfarth.com.

www.seyfarth.com

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