

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LSI CORPORATION and AVAGO TECHNOLOGIES U.S., INC,  
Petitioners,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA,  
Patent Owner.

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Case No. IPR2017-01068  
Patent 5,859,601

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**PATENT OWNER'S WAIVER OF PRELIMINARY RESPONSE  
PURSUANT TO 37 C.F.R. § 42.107(b)**

Pursuant to 37 C.F.R. §42.107(b), Patent Owner, Regents of the University of Minnesota (“UMN”), hereby elects to waive its Patent Owner Preliminary Response to the *inter partes* review petition (“Petition”) filed by LSI Corporation and Avago Technologies U.S., Inc. for certain claims of U.S. Patent 5,859,601 (“the ‘601 Patent,” Ex. 1001). The Petition challenged claims 1, 2, 8-10, 12-17 and 21 of the ‘610 Patent. *See* Petition (Paper No. 1) at p. 1.

The Board’s Order of August 19, 2019 in this case ordered that “the deadline for Patent Owner to file a preliminary response in this proceeding will be two (2) months from the expiration of the deadline to file, or the final disposition of, a petition for writ of certiorari in the Supreme Court for *Regents of the University of Minnesota v. LSI Corp.*, Case No. 2018-1599.” Paper No. 28 at 3. The Supreme Court denied UMN’s petition for writ of certiorari on January 13, 2020. Paper No. 30. Thus, this waiver is being filed within the two-month time limit set by the Board in its August 19, 2019 Order.

No adverse inference should be taken by this election. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48764 (August 14, 2012). This election should not be deemed a waiver or admission on the part of UMN of any material presented in the Petition and UMN reserves all rights to submit a Patent Owner Response pursuant to 37 C.F.R. §42.120.

On February 14, 2020, UMN filed with the U.S. Patent and Trademark Office a statutory disclaimer of claims 1-12, 15, 16 and 21 of the '601 Patent under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). A copy of the statutory disclaimer is submitted as Exhibit 2001 in this proceeding. Based on this disclaimer, the '601 Patent is to be treated as though claims 1-12, 15, 16 and 21 never existed. *See Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never existed.”). As a result of the statutory disclaimer of claims 1-12, 15, 16 and 21 and pursuant to 37 C.F.R. § 42.107(e), it is respectfully submitted that the institution decision in this proceeding should be based only on the remaining challenged claims, which are claims 13, 14 and 17 of the '601 Patent.

Dated: February 14, 2020

Respectfully submitted,  
*Regents of the University of Minnesota*

By /Mark G. Knedeisen/  
Patrick J. McElhinny, Reg. No. 46,320  
Mark G. Knedeisen, Reg. No. 42,747  
K&L GATES LLP  
210 Sixth Ave.  
Pittsburgh, PA 15222  
Tel: 412-355-6500 / Fax: 412-355-6501

**CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)**

I certify that on February 14, 2020, I will cause a copy of the foregoing document, including any exhibits or appendices referred to therein, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

Kristopher Reed  
Edward Mayle  
David Sipiora

[kreed@kilpatricktownsend.com](mailto:kreed@kilpatricktownsend.com)  
[tmayle@kilpatricktownsend.com](mailto:tmayle@kilpatricktownsend.com)  
[dsipiora@kilpatricktownsend.com](mailto:dsipiora@kilpatricktownsend.com)

Date: February 14, 2020

/ Mark G. Knedeisen/  
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