

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAKADU R&D PTY LTD. AND KAKADU SOFTWARE PTY LTD.,
Petitioner,

v.

INTOPIX S.A.,
Patent Owner.

IPR2021-00411
Patent No. 9,332,258

**PATENT OWNER PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107**

LIST OF EXHIBITS

Exhibit No.	Description
2001	Disclaimer of Claims 1–16 in U.S. Patent No. 9,332,258 Under 37 C.F.R. § 1.321(a), Filed in Reissue Application Serial No. 16/950,863.

Pursuant to 37 C.F.R. § 42.107, Patent Owner INTOPIX S.A. (“Patent Owner”) submits this Patent Owner Preliminary Response to the Petition (IPR2021-00411) challenging claims 1–16 of U.S. Patent No. 9,332,258 (“the ’258 Patent”). *See, e.g.*, Petition at 1.

Patent Owner has filed a statutory disclaimer with the United States Patent and Trademark Office, in connection with reissue application Serial No. 16/950,863, disclaiming claims 1–16 of the ’258 Patent pursuant to and in compliance with each of 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). *See Ex. 2001*. These claims are the only claims challenged in the Petition. *See, e.g.*, Petition at 1. Thus, the Petition is now moot and the Board should deny institution of further proceedings.

37 C.F.R. § 42.107(e) provides: “[t]he 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.” 37 C.F.R. § 42.107(e). Indeed, the Board routinely denies institution of *inter partes* review under 37 C.F.R. § 47.107(e) when the patent owner has disclaimed each of the challenged claims. *See, e.g., Matsing, Inc. v. CommScope Techs. LLC*, IPR2020-01326, Paper 6 (P.T.A.B. January 8, 2021) (denying petition and not instituting IPR when all challenged claims were disclaimed under 35 U.S.C. § 253(a)); *Fitbit, Inc. v. Philips North*

America LLC, IPR2020-00782, Paper 7 (P.T.A.B. October 30, 2020) (same);
Garmin Int'l, Inc. v. Philips North America LLC, IPR2020-00909, Paper 9
(P.T.A.B. October 30, 2020) (same); *General Electric Co. v. United Techs. Corp.*,
IPR2017-00491, Paper 9 (P.T.A.B. July 6, 2017) (precedential) (same).

Here, Patent Owner has disclaimed each and every claim challenged in the
Petition, pursuant to and in compliance with each of 35 U.S.C. § 253(a) and 37
C.F.R. § 1.321(a). Because the Board treats these disclaimed claims as though they
never existed in the first instance, the instant Petition is accordingly moot and no
longer provides any basis for institution. 37 C.F.R. § 42.107(e). Accordingly, as
was done in *Matsing*, the Board should issue a decision under 35 U.S.C. § 314 and
37 C.F.R. 42.107(e), ordering “that the Petition is *denied* and no *inter partes*
review is instituted.” IPR2020-01326, Paper 6; *see also* IPR2020-00782, Paper 7;
IPR2020-00909, Paper 9; IPR2017-00491, Paper 9.

Respectfully submitted,

Dated: April 26, 2021

/Timothy J. May/
Timothy J. May, Reg. No. 41,538
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Lead Counsel for Patent Owner
INTOPIX S.A.

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing **Patent Owner Preliminary Response Pursuant to 37 C.F.R. § 42.107** contains 456 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: April 26, 2021

/Timothy J. May/
Timothy J. May, Reg. No. 41,538

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