

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 9,332,258 B2

Before DEBRA K. STEPHENS, KALYAN K. DESHPANDE, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION

Not Instituting *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. §§ 42.4, 42.108

I. INTRODUCTION

A. Background

Kakadu R&D Pty Ltd. and Kakadu Software Pty Ltd. (collectively, “Petitioner”) filed a petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–16 of U.S. Patent No. 9,332,258 B2 (Ex. 1001, “the ’258 patent”). INTOPIX S.A. (“Patent Owner”) timely filed a Preliminary Response that includes Exhibit 2001, a copy of a disclaimer under 37 C.F.R. § 1.321(a) filed by Patent Owner that disclaims all of the claims in the ’258 patent. Paper 6 (“Prelim. Resp.”); Ex. 2001 (copy of disclaimer).

For the reasons described below, based on the information presented, we do not institute an *inter partes* review of any claims.

B. Related Proceedings

The parties indicate that the ’258 patent is not involved in any current litigation. Pet. 95; Paper 4, 1–2.

II. ANALYSIS

According to Patent Owner, “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).” Prelim. Resp. 1 (citing Ex. 2001). Patent Owner asserts that, because Patent Owner has disclaimed each and every claim challenged in the Petition, “the instant Petition is accordingly moot and no longer provides any basis for institution.” *Id.* at 2 (citing 37 C.F.R. § 42.107(e)).

Under 37 C.F.R. § 42.107(e), “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.” A disclaimer filed

under 35 U.S.C. § 253(a) will be “considered as part of the original patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a); *see also 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.”). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee’s ownership interest in the patent; and

(4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra*, 162 F.3d at 1382 (holding that a § 253 disclaimer is immediately “recorded” on the date that the Office receives a disclaimer meeting requirements of 37 C.F.R. § 1.321(a) and that no further action is required in the Office). A disclaimer filed during the prosecution of a reissue application, where the disclaimer disclaims one or more claims of the underlying patent sought to be reissued, will nonetheless be “recorded” in the Office so long as the above-listed requirements are satisfied. Finally, “[n]o *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e); *see also General Electric Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9, 3 (PTAB July 6, 2017) (precedential).

Based on our review of Exhibit 2001 and Office public records (that is, the USPTO Patent Application Information Retrieval (PAIR) database containing the image file wrappers and other information for both the '258 patent and its reissue application 16/950,863), we conclude that a disclaimer of claims 1–16 of the '258 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of April 26, 2021. As Patent Owner indicates, the disclaimer was filed by Patent Owner during the prosecution of reissue application 16/950,863, a reissue application seeking reissue of the underlying '258 patent. Prelim. Resp. 1. The disclaimer was filed in both the '258 patent file history and the 16/950,863 reissue application. Exhibit 2001, a copy of the filed disclaimer, is signed by Gaël Rouvroy, CEO of INTOPIX S.A. Ex. 2001, 1. Exhibit 2001 also identifies the '258 patent; identifies that all of the claims at issue in the Petition, claims 1–16, are disclaimed; and states that “INTOPIX S.A. is the owner of 100% of the instant patent by virtue of an assignment recorded at Reel 038007 and Frame 0318.” *Id.* Lastly, the image file wrapper in PAIR for the 16/950,863 reissue application includes a fee worksheet and receipt for the requisite fee filed with the disclaimer on April 26, 2021. *See* Ex. 3001.

Because Patent Owner filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming all the claims of the '258 patent, no *inter partes* review is instituted in this proceeding.

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that no *inter partes* review is instituted for any claim challenged by Petitioner.

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