

Filed on behalf of TRACBEAM, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC,
Patent Owner

Case No. IPR2015-01713
Patent 8,032,153

PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120

Table of Authorities

Cases

<i>Genetics Inst., LLC v. Novartis Vaccines and Diagnostics, Inc.</i> , 655 F.3d 1291 (Fed. Cir. 2011).....	1
<i>Guinn v. Kopf</i> , 96 F.3d 1419 (Fed. Cir. 1996).....	1

Exhibit List

<u>Exhibit No.</u>	<u>Description</u>
2001	Narrowing Agreement
2002	Disclaimer in Patent Under 37 CFR 1.321(a) – Patent No. 8,032,153

Claims 1, 3, and 15 of the ‘153 patent are challenged in this *Inter Partes* Review. These claims are no longer asserted in the co-pending district court litigation against any of the Petitioners or any other parties. Patent Owner maintains that each of these claims was and is patentable and non-obvious. However, Patent Owner wishes to avoid the time and expense of further defending these claims in this proceeding, particularly since its limited resources are needed to prosecute the co-pending litigation as it nears trial. Patent Owner has therefore filed a disclaimer with the Patent Office pursuant to 37 CFR 1.321(a), disclaiming each challenged claim in this proceeding. Ex. 2002.

The effect of the disclaimer is that claims 1, 3, and 15 of the ‘153 patent are treated as if they had never existed. *Genetics Inst., LLC v. Novartis Vaccines and Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) (“upon entry of a disclaimer under § 253, we treat the patent as though the disclaimed claim(s) had never existed” (internal quotations omitted)); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) (“A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent” (emphasis added)). As a result, this proceeding is now moot—the Board need not and cannot determine whether claims that are treated as having never existed are or are not patentable.

Accordingly, Patent Owner anticipates seeking permission to file a motion to terminate this proceeding, to the extent such a motion is necessary.

Respectfully submitted,

Date: August 19, 2016

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Certificate of Filing and Service

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.102** together with **EXHIBIT 2002** are being filed via PTAB E2E and served by electronic mail this 19th day of August 2016 on counsel for Petitioners as follows:

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