

Filed on behalf of: Times Fiber Communications, Inc.

Entered: August 4, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PPC BROADBAND, INC.,  
Petitioner,  
v.

TIMES FIBER COMMUNICATIONS, INC.,  
Patent Owner.

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Case IPR2022-00831  
Patent 10,589,957

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**PATENT OWNER'S  
PRELIMINARY RESPONSE**

**Patent Owner's Exhibit List**

<b>Ex.</b>	<b>Description</b>
2001	Patent Assignment
2002	Disclaimer in Patent Under 37 C.F.R. 1.21(a), filed July 22, 2022, in U.S. Patent No. 10,589,957

**I. Introduction**

Petitioner PPC Broadband Inc. (“Petitioner”) challenges the validity of claims 9-19 of U.S. Patent No. 10,589,957 (the “’957 patent”). Patent Owner Times Fiber Communications, Inc. (“Patent Owner”) hereby respectfully submits this Preliminary Response to the Petition.

**II. Patent Owner's Statutory Disclaimer under 37 C.F.R. § 1.321(a)**

While Patent Owner disagrees with Petitioner's unpatentability contentions, Patent Owner has disclaimed each of challenged claims 9-19 under 35 U.S.C. § 253. This statutory disclaimer was effected in compliance with 37 C.F.R. § 1.321(a) by submission of an appropriate Form PTO/SB/43 (Disclaimer in Patent under 37 C.F.R. § 1.321(a)) on July 22, 2022, a copy of which is attached as Exhibit 2002, 003.

The present statutory disclaimer does not constitute an admission or acquiescence by Patent Owner with regard to the Petition. This pre-institution disclaimer of all challenged claims should not be construed as a request for an adverse judgment.

Binding Board precedent precludes institution of a review proceeding where all challenged claims are disclaimed pre-institution. *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 at 2-3 (July 6, 2017) (precedential) (“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' and '[n]o *inter partes* review will be instituted based on disclaimed claims.'). A disclaimer under 35 U.S.C. § 253(a) is "considered as part of the original patent." *Id.* As such, disclaimed claims are treated as if they never existed, and the Board cannot exercise jurisdiction over disclaimed claims at the pre-institution stage. *Pfizer, Inc. v. UniQure Biopharma B.V.*, IPR2020-00388, Paper 52 at 3 (Mar. 25, 2021) (citing 37 C.F.R. § 42.107(e)); *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01248, Paper 7 at 2 n.1, 9–10 (Feb. 7, 2019)); *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998); *Gen. Elec. Co. v. United Techs.*, IPR2017-00491, Paper 9 at 2–3 (precedential); *Rekor Sys. Inc. v. Vigilant Sols., LLC*, IPR2020-01584, Paper 9 at 5–6 (Dec. 23, 2020); *Am. Honda Motor Co., Inc. v. Intell. Ventures II LLC*, IPR2018-00350, Paper 12 at 4–5 (June 21, 2018).

Here, Patent Owner disagrees with Petitioner's unpatentability arguments set forth in the Petition and makes the present disclaimer without prejudice to Patent Owner's ability to rebut such arguments, including characterizing and distinguishing the references cited in the Petition, in any forum. Nevertheless, in the interest of judicial and economic efficiency, Patent Owner filed a statutory disclaimer under 35 U.S.C. § 253, which is attached as Exhibit 2002. Accordingly, the Board should deny the Petition consistent with the Board's binding precedent.

### III. Conclusion

All challenged claims of the '957 patent have been disclaimed. Because “[n]o *inter partes* review will be instituted based on disclaimed claims” (37 C.F.R. § 42.107(e)), Patent Owner respectfully submits that institution of a trial as to the challenged claims of the '957 patent would be improper and requests that the Petition not be instituted.

Respectfully submitted,

Dated: August 4, 2022

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**CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24**

I hereby certify that this Patent Owner's Preliminary Response complies with the word count limitation of 37 C.F.R. § 42.24(b)(1) because the Patent Owner's Preliminary Response contains 498 words, calculated by Microsoft Word's word-count feature, excluding the cover page, signature block, and the parts of the Patent Owner's Preliminary Response exempted by 37 C.F.R. § 42.24(b).

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 4th day of August, 2022, a true and correct copy of the foregoing **Patent Owner's Preliminary Response and Exhibit 2002** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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