

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESTO, INC. a/k/a TESTO NORTH AMERICA, AND
TESTO SE & CO. KGaA,
Petitioners, v.

PARKER INTANGIBLES LLC,
Patent Owner.

Case IPR2023-00691
Patent No. 10,739,051

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF AUTHORITIES

Cases

<i>Cisco Sys., Inc. v. SecurityProfiling, LLC</i> , IPR2021-01428 (PTAB Mar. 14, 2021).....	2
<i>Gen. Elec. Co. v. United Techs. Corp.</i> , IPR2017-00491 (PTAB July 6, 2017).....	2
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<i>Vectra Fitness, Inc. v. TNWK Corp.</i> , 162 F.3d 1379 (Fed. Cir. 1998).....	1

Other Authorities

37 C.F.R. § 42.107(e)	2
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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Disclaimer of Claims 1, 10, 15, 20, and 21

Patent Owner Parker Intangibles LLC (“Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review filed by Petitioner seeking review of Claims 1, 10, 15, 20, and 21 of U.S. Patent No. 10,739,051 (EX1001) (“the ’051 Patent”). The ’051 Patent has 25 claims, but the Petition challenged only five of them. Paper 1 (“Pet.”), 14.¹

Patent Owner strongly disagrees with Petitioner’s grounds of unpatentability in the Petition. Nevertheless, institution should be denied for a threshold reason, namely, Patent Owner has disclaimed every claim challenged in the Petition. EX2001, 3 (disclaiming Claims 1, 10, 15, 20, and 21).

“[D]isclaimed claims are treated as if they never existed.” *Pfizer, Inc. v. UniQure Biopharma B.V.*, IPR2020-00388, 2021 WL 1158151, at *2 (PTAB Mar. 25, 2021) (citing *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998)); see also *Raytheon Techs. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1379 n.4 (Fed. Cir. 2021). As the Board explained in *Pfizer*, “[i]f the claims never existed, we cannot have exercised jurisdiction over the disclaimed claims and therefore cannot enter adverse judgment against them.” 2021 WL 1158151, at *2 (citing *Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Lab., Inc.*, 933 F.3d 1367, 1374-75 (Fed. Cir.

¹ There is no pending U.S. continuation application that claims priority to any application underlying the ’051 Patent.

2019)).

Because Patent Owner has disclaimed each claim challenged in the Petition (Claims 1, 10, 15, 20, and 21) and “[n]o *inter partes* review will be instituted based on disclaimed claims,” 37 C.F.R. § 42.107(e), Patent Owner requests that the Board deny institution. *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, 2017 WL 2891110, at *1 (PTAB July 6, 2017) (precedential) (denying institution); *see also Cisco Sys., Inc. v. SecurityProfiling, LLC*, IPR2021-01428, 2021 WL 7711197, at *2-3 (PTAB Mar. 14, 2021) (same); *Microsoft Corp. v. LiTL LLC*, IPR2021-01011, Paper 9, at 2 (PTAB Nov. 29, 2021) (same).

Dated: June 26, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

The undersigned certifies pursuant to 37 C.F.R. § 42.24 that the foregoing Patent Owner's Preliminary Response, excluding any table of contents, mandatory notices under 37 C.F.R. § 42.8, certificates of service or compliance, or appendix of exhibits, contains 405 words according to the word-processing program used to prepare this document (Microsoft Word).

/James L. Lovsin/
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Counsel for Patent Owner
Parker Intangibles LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on June 26, 2023 the foregoing Patent Owner's Preliminary Response is being served electronically by agreement of the parties, by email to the following counsel of record.

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