

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
Petitioner,

v.

BELDEN INC.,
Patent Owner.

Case No. IPR2023-01058
Patent 10,832,833 B2

PATENT OWNER PRELIMINARY RESPONSE

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EXHIBIT LIST

EXHIBIT	DESCRIPTION
EX-1001	U.S. Patent No. 10,832,833 (“’833 Patent”)
EX-2001	DISCLAIMER IN PATENT UNDER 37 C.F.R. § 1.321(A)”) for U.S. Patent No. 10,832,833
EX-2002	Recorded Assignment for U.S. Patent No. 10,832,833

I. INTRODUCTION

Patent Owner respectfully submits this Preliminary Response to the Petition for *Inter Partes* Review (“IPR”) of claims 1-8 and 48-50 (the “Challenged Claims”) of U.S. Patent No. 10,832,833 B2 (“’833 Patent”) (EX-1001).

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 the Challenged Claims under 35 U.S.C. § 253. When a patent owner properly records a disclaimer of all patent claims challenged in a petition, binding Board precedent and rules preclude institution of IPR. *See Gen. Elec. Co. v. United Techs. Co.*, IPR2017-00491, Paper 9 (July 6, 2017) (precedential); *see also* 37 C.F.R. § 42.107(e) (“The 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.”).

For a statutory disclaimer to be recorded in the Office, the disclaimer 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. . . . ;
- (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 Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379,

1382 (Fed. Cir. 1998) (holding § 253 disclaimer is immediately “recorded” on the date the USPTO receives a disclaimer meeting the requirements of § 1.321(a), and no further action is required in the USPTO).

Patent Owner complied with 37 C.F.R. § 1.321(a) by submission of Form PTO/SB/43 (“DISCLAIMER IN PATENT UNDER 37 C.F.R. § 1.321(A)”) on September 18, 2023, a copy of which is attached as EX-2001. The disclaimer form identifies the ’833 Patent and all of the Challenged Claims (1-8 and 48-50). EX-2001, 3. The disclaimer was signed by Christopher W. Day, Vice President (Legal), Assistant General Counsel, and Chief Intellectual Property Counsel for Patent Owner Belden Inc. *See* EX-2001, 3; *see also* EX-2002 (recorded assignment of the ’833 Patent to Belden Inc., executed on October 20, 2014 and recorded at Reel 050527/Frame 0001 on September 27, 2019).¹ The disclaimer form identifies Patent Owner has having a “100% ownership interest” in the ’833 Patent. EX-2001, 3. Finally, Patent Owner paid the required fee set forth in 37 C.F.R. § 1.20(d). *See* EX-

¹ The assignment from the named inventors of the ’833 Patent to Belden Inc. was made at the time of the filing of Provisional Application No. 61/894,728 to which the ’833 Patent claims priority (EX-1001 Cover (60)) and effectively assigns all subsequent patent applications and patents, including the ’833 Patent, to Belden Inc. EX-2002, 3.

2001, 5-6. Accordingly, Patent Owner has met the requirements for an effective disclaimer of all Challenged Claims under 35 U.S.C. § 253 and 37 C.F.R. §1.321(a).

The present statutory disclaimer is not an admission or acquiescence by Patent Owner with regard to the Petition, and should not and cannot be construed as a request for an adverse judgment. 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 in any forum. Nevertheless, in the interest of judicial and economic efficiency, Patent Owner has filed an effective statutory disclaimer under 35 U.S.C. § 253. Accordingly, the Board should deny institution consistent with the Board's binding precedent.

III. CONCLUSION

All Challenged Claims of the '833 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 '833 Patent would be improper and requests that the Board deny institution.

Date: September 20, 2023

Respectfully submitted,

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CERTIFICATION OF COMPLIANCE WITH WORD COUNT

The undersigned hereby certifies that the foregoing Patent Owner Preliminary Response complies with the requirements of 37 C.F.R. § 42.24 and contains less than 14,000 words (693 words), excluding those contained in the following: Table of Contents, Table of Authorities, Grounds of Standing, Mandatory Notices, Certification of Compliance with Word Count, Certificate of Service, and the Exhibit List.

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PATENT OWNER PRELIMINARY RESPONSE** was served pursuant to 37 C.F.R. § 42.6(e) via electronic mail on September 20, 2023, on the following:

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