

From: [Trials](#)
To: [Kestle, Sydney](#); [Rehan Safiullah](#); [Trials](#)
Cc: [Zac Harrington](#); [Larry Thompson](#); [Matt Antonelli](#); [Arner, Erika](#); [Lu, Jia](#); [Yang, Christina Ji-Hye](#)
Subject: RE: IPR2023-01386 & IPR2023-01386 | Statutory Disclaimer Filing
Date: Thursday, August 22, 2024 4:14:18 PM
Attachments: [image001.png](#)
[shield-advisory.png](#)
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Counsel, The record of these *inter partes* reviews does not include evidence about the alleged filing of statutory disclaimer of the challenged claims by Patent Owner. We ask Patent Owner to file a paper in each proceeding to confirm the alleged statutory disclaimer of the challenged claims, if the challenged claims in fact have been statutorily disclaimed by Patent Owner, and to include a copy of the statutory disclaimer as filed in the Office, as a Patent Owner exhibit. Petitioner, in its Reply, may provide a copy of Patent Owner's statutory disclaimer, as a Petitioner exhibit, if Patent Owner has not filed it by the time of submission of Petitioner's Reply.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
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From: Kestle, Sydney <Sydney.Kestle@finnegan.com>
Sent: Wednesday, August 21, 2024 3:11 PM
To: Rehan Safiullah <rehan@ahtlawfirm.com>; Trials <Trials@USPTO.GOV>
Cc: Zac Harrington <zac@ahtlawfirm.com>; Larry Thompson <larry@ahtlawfirm.com>; Matt Antonelli <matt@ahtlawfirm.com>; Arner, Erika <erika.arnner@finnegan.com>; Lu, Jia <Jia.Lu@finnegan.com>; Yang, Christina Ji-Hye <Christina.Yang@finnegan.com>
Subject: RE: IPR2023-01386 & IPR2023-01386 | Statutory Disclaimer Filing

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Honorable Board,

In anticipation of Petitioner's impending August 23, 2024, reply deadline, Petitioner seeks the Board's guidance regarding Patent Owner's disclaimer of all challenged claims in IPR2023-01386 (US Patent 6,904,405) and IPR2023-01387 (US Patent 8,204,737). In view of Patent Owner's disclaimer, Petitioner understands that the Board will enter adverse judgment. See 37 C.F.R. § 42.73(b); *Unified Patents, LLC v. Arsus, LLC*, IPR2020-00948, Paper 18, at 2 (PTAB Jan. 27, 2021) (entering an adverse judgment against the patent owner who disclaimed all challenged claims, holding: "[W]e construe a disclaimer of all claims involved in a trial as a request for adverse judgment. 37 C.F.R. § 42.73(b)."), *aff'd*, No. 2021-1648, 2021 WL 5315423 (Fed. Cir. Nov. 16,

2021). In the event the Board would prefer Petitioner file a reply requesting such adverse judgment and submitting Patent Owner's statutory disclaimers, it would be happy to do so. Thank you in advance for your time and consideration.

Best regards,
Sydney Kestle
Counsel for Petitioner

Sydney Kestle
Partner

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From: Rehan Safiullah <rehan@ahtlawfirm.com>

Sent: Monday, June 3, 2024 2:30 PM

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Subject: IPR2023-01386 & IPR2023-01386 | Statutory Disclaimer Filing

IPR2023-01386,
Patent 6,904,405
IPR2023-01387
Patent 8,204,737

To the Patent Trial and Appeal Board:

Patent Owner has filed statutory disclaimers in U.S. Patent Nos. 6,904,405 and 8,204,737, disclaiming all of the challenged claims in IPR2023-01386 and IPR2023-01387, respectively. The statutory disclaimers filed on May 30, 2024 are attached. Thus, there are no remaining claims in either trial.

Thank you,

Rehan M. Safiullah (Reg. No. 63,506)
Counsel for Patent Owner

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