

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMVIE, INC. AND ZIMMER BIOMET SPINE, INC.,

Petitioners,

v.

ROGER P. JACKSON,

Patent Owner.

Case No. IPR2023-01430

Patent No. 8,911,479

**PATENT OWNER PRELIMINARY RESPONSE TO
POST-GRANT REVIEW PETITION**

LIST OF EXHIBITS

Exhibit No.	Description
2001	Statutory disclaimer of claims 1-22 of the '479 Patent with electronic filing and payment receipts (filed January 3, 2024)

I. INTRODUCTION

Zimvie, Inc. and Zimmer Biomet Spine, Inc. (“Petitioner”) filed an *inter partes* review petition (the “Petition”) challenging claims 1-22 of U.S. Patent No. 8.911,479 (the ’479 Patent) on September 22, 2023.

Petitioner has filed four concurrent IPR petitions against four different patents assigned to Patent Owner, including the instant proceeding. *See* IPR2023-01430, -01431, -01432, -01433. Patent Owner disagrees with the arguments and conclusions in the instant Petition filed against the ’479 Patent. However, Patent Owner has filed a statutorily disclaimer for all claims of the ’479 Patent mooted the instant IPR petition. *See* Exhibit 2001 at 5. The statutory disclaimer of the claims of the ’479 Patent is solely to streamline the multiple IPR proceedings by focusing on the other three proceedings.¹ This will allow for a more efficient use of the parties’ and Board’s resources.

For the avoidance of any doubt, Patent Owner is not seeking an adverse judgment. In accordance with the Board’s precedence, the Board should deny this IPR petition without issuing an adverse judgment in light of the statutory disclaimer filed prior to institution. *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 at 2–3 (PTAB July 6, 2017) (precedential); *see also* 37 C.F.R. § 42.107(e)

¹ Patent Owner has concurrently filed preliminary responses in the three IPR proceedings demonstrating why the prior art does not render the claims unpatentable.

(“No post-grant review will be instituted based on disclaimed claims.”); 37 C.F.R. § 42.72; Consolidated Trial Practice Guide, November 2019 at 52); *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (a disclaimer meeting the requirements of 37 C.F.R. § 1.321(a) is recorded on the date the Office receives the disclaimer).

As stated by one Board panel in determining dismissal is appropriate over adverse judgement when the challenged claims are disclaimed prior to institution:

The statutory disclaimer was filed before institution. In view of this disclaimer, consistent with 37 C.F.R. § 42.107(e) and the Board’s precedential *General Electric* decision, we determine a denial of institution is sufficient to dispose of this case (*see Gen. Elec. Co.*, IPR2017-00491, Paper 9). Thus, we decline to institute an *inter partes* review.

Cisco Systems, Inc. v. SecurityProfiling, LLC, IPR2021-01428, Paper 13 at 6-7 (PTAB March 14, 2021).

Therefore, the Board should deny the Petition in accordance with 37 C.F.R. § 42.107(e).

Dated: January 3, 2024

Respectfully submitted:

/James P. Murphy/

James P. Murphy (Reg. No. 55,474)

POLSINELLI PC

1000 Louisiana, Suite 6400

Houston, TX 77002

Attorney for Patent Owner

CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the Microsoft Office word count for the foregoing Patent Owner's Preliminary Response Under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, excluding the table of contents, table of authorities, certificate of word count, and certificate of service, totals 363 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: January 3, 2024

/James P. Murphy/
James P. Murphy (Reg. No. 55,474)
POL SINELLI PC
1000 Louisiana, Suite 6400
Houston, TX 77002

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the Patent Owner's Preliminary Response and all exhibits were served on January 3, 2024, via email directed to the following email addresses of record:

Victor P. Jonas
VictorJonasPTAB@FaegreDrinker.com

Joel D. Sayres
Joel.Sayres@FaegreDrinker.com

Keven P. Wagner
Kevin.Wagner@FaegreDrinker.com

Lauren J.F. Barta
Lauren.Barta@FaegreDrinker.com

/Ericka McNeil/
Ericka McNeil
Polsinelli PC
1000 Louisiana Street, 64th Floor
Houston, Texas 77002