

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.

IPR2023-01430
Patent 8,911,479 B2

Before ULRIKE W. JENKS, SHERIDAN SNEDDEN, and
ZHENYU YANG, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)

I. INTRODUCTION

On September 22, 2023, ZimVie, Inc. and Zimmer Biomet Spine, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting a *inter partes* review of claims 1–22 of U.S. Patent No. 8,911,479 B2 (“the ’479 patent”).¹ Pet. 1. Roger P. Jackson (“Patent Owner”) filed a Patent Owner Preliminary Response (Paper 7, “POPR”) on January 3, 2024.

Patent Owner responds that we should deny institution because it has filed a statutory disclaimer disclaiming all of the claims of the ’479 patent. *See* POPR 2. Patent Owner also filed a copy of the statutory disclaimer in this proceeding. *See* Ex. 2001.

Patent Owner has disclaimed all claims of the ’479 patent and paid the requisite fees. *See* Ex. 2001; *see also* 37 C.F.R. § 1.321 (setting forth requirements for statutory disclaimer). Accordingly, we deny institution of the requested *inter partes* review. *See* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”); *see also* *General Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (denying institution of *inter partes* review under rule 37 C.F.R. § 42.107(e) based on disclaimer) (“*General Electric*”). In the present instance, and consistent with Rule 42.107(e) and the Board’s precedential *General Electric* decision, we determine that a denial of

¹ Petitioner has filed three additional *inter partes* review petitions against three related patents assigned to Patent Owner: IPR2023-01431 (U.S. Patent No. 10,548,641 B2), IPR2023-01432 (U.S. Patent No. 10,898,233 B2), and IPR2023-01433 (U.S. Patent No. 11,129,646 B2). Pet. 1. Petitioner additionally acknowledges that the ’479 patent is subject to a pending lawsuit entitled *Jackson v. ZimVie Inc.*, No. 1:22-cv-00891-RGA (D. Del. Filed June 30, 2022). Pet. 1.

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institution is sufficient to dispose of this case. Because the Board cannot institute trial on disclaimed claims and all the challenged claims have been disclaimed here, no *inter partes* review will be instituted.

II. ORDER

It is therefore:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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