

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEASPINE HOLDINGS CORPORATION,

Petitioner,

v.

ROGER P. JACKSON, M.D.,

Patent Owner.

Case No. IPR2025-00773

Patent No. 11,399,873

**PATENT OWNER PRELIMINARY RESPONSE TO
INTER PARTES REVIEW PETITION**

LIST OF EXHIBITS

Exhibit No.	Description
2001	Statutory disclaimer of claims 1-19 of the '873 Patent with electronic filing and payment receipts (filed January 16, 2024)

I. INTRODUCTION

SeaSpine Holdings Corporation (“Petitioner”) filed an *inter partes* review petition (the “Petition”) challenging claims 1-19 of U.S. Patent No. 11,399,873 (the ’873 Patent) on March 26, 2025.

Patent Owner disagrees with the arguments and conclusions in the Petition filed against the ’873 Patent. However, Patent Owner has filed a statutorily disclaimer for all claims of the ’873 Patent mooted the instant IPR petition in part to avoid the expenditure of additional time and money. *See* Exhibit 2001.

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) (“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: July 18, 2025

Respectfully submitted:

/James P. Murphy/

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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 313 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: July 18, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the Patent Owner's Preliminary Response and all exhibits were served on January 18, 2024, via email directed to the following email addresses of record:

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