EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FITBIT, INC.,

Petitioner

v.

PHILIPS NORTH AMERICA LLC,
Patent Owner

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Case Nos. IPR2020-00782

U.S. Patent No. 6,976,958

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**PATENT OWNER PRELIMINARY RESPONSE
UNDER 35 U.S.C. § 313 AND 37 C.F.R. § 42.107**

EXHIBITS

Exhibit No.	Description
2001	Disclaimer of Claims 15-17 of U.S. Patent No. 6,976,958 Under 37 CFR § 1.321(a)

IPR2020-00782   Patent Owner Preliminary Response

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107, Patent Owner Philips North America LLC ("Patent Owner") submits this Patent Owner Preliminary Response to the Petition of Fitbit, Inc. ("Fitbit") (IPR2020-00782) challenging claims 15-17 of U.S. Patent No. 6,976,958 ("the '958 patent").

Patent Owner has filed a statutory disclaimer with the United States Patent and Trademark Office, disclaiming claims 15-17 of the '958 patent pursuant to 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). Ex. 2001. These are the only claims challenged in the Petitions. Thus, the Petitions are now moot and the Board should deny institution of further proceedings.

When a patent owner files a statutory disclaimer with its preliminary response, "no *inter partes* review will be instituted based on disclaimed claims." 37 C.F.R. § 42.107(e). Significantly, when claims in a patent are properly disclaimed, such claims are "treated as though [] [they] never existed." *HTC Corp. v. Lemaire Illumination Tech. LLC*, IPR2019-00091, Paper 7 at 1 (PTAB Apr. 10, 2019) (citing *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1983 (Fed. Cir. 1998)).

The Board routinely denies institution of *inter partes* review under 37 C.F.R. § 47.107(e) when the patent owner has disclaimed each of the challenged claims. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-01574, Paper 9 (PTAB Jan. 15, 2020); *Am. Honda Motor Co., Inc. v. Intellectual Ventures II LLC*, IPR2018-

1

IPR2020-00782   Patent Owner Preliminary Response

00350, Paper 12 (PTAB June 21, 2018); *Facebook, Inc. v. Skky LLC*, IPR2017-

00641, Paper 9 (PTAB Jul. 13, 2017); *Borealis AG v. Berry Plastics Corp.*,

IPR2016-00235, Paper 11 at 3 (PTAB Mar. 24, 2016); *RPX Corp. v. Cedatech*

Holdings, LLC, IPR2015-00736, Paper 8 at 2 (PTAB Aug. 13, 2015).

Here, Patent Owner has disclaimed each and every claim challenged in the

Petitions, in accordance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a).

Because the Board treats these claims as though they never existed, the Petitions

are accordingly moot and no longer provide any basis for institution. Further,

institution would be an inefficient use of resources.

For these reasons, the Board should deny institution of the Petitions.

Date: August 10, 2020   Respectfully submitted,

                                         /George C. Beck/
                                         George C. Beck
                                         Registration No. 38,072
                                         Counsel for Patent Owner

2

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