Filed on behalf of TRACBEAM, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC,
Patent Owner

Case No. IPR2015-01708
Patent 7,525,484 B2

PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120

Table of Contents

Table of Authorities

Cases

Updated Exhibit List

Exhibit No.	Description
2001	*The American Heritage Dictionary*, p. 575 (3rd ed., 1994)
2002	*Webster's New World College Dictionary*, p. 996 (4th ed., 2010)
2003	Narrowing Agreement
2004	Memorandum Opinion and Order entered 7/14/16 in *TracBeam LLC v. T-Mobile US, Inc., et al.*, case no 6:14-cv-678 (E.D. Tex.) ("*Markman* Order")
2005	Disclaimer in Patent Under 37 CFR 1.321(a) – Patent No. 7,525,484 B2

I. Introduction.

This *Inter Partes* review is limited to review of claims 1 and 51 of the '484 patent, which are challenged as obvious under 35 U.S.C. § 103 in view of the Loomis-Wortham combination. IPR2015-01708, paper 10 ("Decision"). Patent Owner TracBeam appreciates the guidance provided by the Board in its Decision but respectfully maintains that Petitioners have failed to show that challenged claim 1 is obvious. Patent Owner also maintains that claim 51 was and is patentable. However, to conserve resources in these proceedings and the co-pending litigation, which is nearing trial, Patent Owner has disclaimed claim 51, thereby rendering this proceeding moot as to that claim. Ex. 2005.[1]

[1] The effect of the disclaimer is that claim 51 of the '484 patent is treated as if it had never existed. *Genetics Inst., LLC v. Novartis Vaccines and Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) ("upon entry of a disclaimer under § 253, we treat the patent as though the disclaimed claim(s) had never existed" (internal quotations omitted)); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) ("A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent" (emphasis added)). As a result, this proceeding is now moot—the Board need not and cannot determine whether a claim that is

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