Filed on behalf of TRACBEAM, LLC

By: Sean Luner
     DOVEL & LUNER, LLP
     201 Santa Monica Blvd, Suite 600
     Santa Monica, CA 90401
     Telephone (310) 656-7066
     sean@dovel.com

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. IPR2015-01711
Patent 7,525,484 B2

_____

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

Table of Authorities

Cases

Exhibit List

Exhibit No.	Description
2001	Narrowing Agreement
2002	Disclaimer in Patent Under 37 CFR 1.321(a) – Patent No. 7,525,484 B2

Claim 27 of the '484 patent is challenged in this *Inter Partes* Review. This claim is no longer asserted in the co-pending district court litigation against any of the Petitioners or any other parties. Patent Owner maintains claim 27 was and is patentable and non-obvious. However, Patent Owner wishes to avoid the time and expense of defending this no-longer asserted claim in this proceeding, particularly since its limited resources are needed to prosecute the co-pending litigation as it nears trial. Patent Owner has therefore filed a disclaimer with the Patent Office pursuant to 37 CFR 1.321(a), disclaiming the sole challenged claim in this proceeding. Ex. 2002.

The effect of the disclaimer is that claim 27 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 <u>as though the disclaimed claims had never existed in the patent</u>" (emphasis added)). As a result, this proceeding is now moot—the Board need not and cannot determine whether a claim that is treated as having never existed is or is not patentable. Accordingly, Patent Owner

anticipates seeking permission to file a motion to terminate this proceeding, to the

extent such a motion is necessary.

Respectfully submitted,

Date: August 19, 2016   By: */Sean Luner/*

Sean Luner, Esq.
Registration No. 36,588
DOVEL & LUNER, LLP.
201 Santa Monica Blvd, Suite 600
Santa Monica, CA 90401
Main Telephone (310) 656-7066
sean@dovel.com
Counsel for Patent Owner

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.

fastcase
Smarter legal research.