

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIMFROST AS

Petitioner

v.

AKER BIOMARINE ANTARCTIC AS

Patent Owner

Case: IPR2018-01178

U.S. Patent No. 9,375,453

**PETITIONER'S FIFTH UPDATED SUBMISSION OF
MANDATORY NOTICE INFORMATION**

Petitioner Rimfrost AS provides the following updated Mandatory Notice pursuant to 37 C.F.R. § 42.8. On January 13, 2020, the Board issued its Final Written Decision in IPR 2018-01178 (Paper 34), holding claims 1-32 of U.S. Patent No. 9,375,453 unpatentable (“1178-FWD”). Patent Owner had until February 12, 2020 to file a Request for Rehearing of the 1178-FWD - Patent Owner did not file a Request for Rehearing. Thereafter, Patent Owner had until March 16, 2020 to file a Notice of Appeal of the 1178-FWD with the U.S. Court of Appeals for the Federal Circuit – Patent Owner did not file a Notice of Appeal. Therefore, Patent Owner is precluded from taking any further action with respect to the 1178-FWD, which after March 16, 2020 must be considered final.

As Patent Owner is precluded from taking any further action with respect to the 1178-FWD, which found claims 1-32 of U.S. Patent No. 9,375,453 unpatentable, pursuant to 35 U.S.C. ¶ 318 (b), Petitioner respectfully requests that a certificate cancelling claims 1-32 of U.S. Patent No. 9,375,453 be issued and published.

Petitioner further updates the Board, in connection with a related *inter partes* review, IPR 2018-01179, which addressed the remaining claims of U.S. Patent No. 9,375,453. On January 13, 2020, the Board issued its Final Written Decision in IPR 2018-01179 (Paper 34), holding claims 33-61 of U.S. Patent No. 9,375,453

unpatentable (“1179-FWD”). Patent Owner did not file (i) a Request for Rehearing of the 1179-FWD, or (ii) a Notice of Appeal of the 1179-FWD to the Federal Circuit, and the time for both has lapsed. Therefore, Patent Owner is precluded from taking any further action with respect to the 1179-FWD and Petitioner is contemporaneously filing a Mandatory Notice Update in IPR2018-01179 requesting that the remaining claims of U.S. Patent No. 9,375,453 be cancelled.

RELATED MATTERS.

Finally, Petitioner is providing notice regarding the status of two other patents owned by Patent Owner that are related to U.S. Patent No. 9,375,453 (all three patents claim priority to and are continuations of the same parent patent). These two other patents, which were the subject of IPR2017-00745 and IPR2017-00746, were cancelled by Inter Partes Certificates US 9,078,905 K1 and US 9,028,877 K1, respectively.

On October 3, 2019, the Federal Circuit, in a consolidated decision, affirmed the Board’s Final Written Decisions in related IPR2017-00745 and IPR2017-00746 finding all claims of Patent Owner’s U.S. Patent Nos. 9,078,905 B2 and 9,028,877 B2 unpatentable. *Aker Biomarine Antarctic AS v. Rimfrost AS*, 786 Fed. Appx.

251 (Fed. Cir. 2019). The Federal Circuit's Mandate issued on November 12, 2020.

On March 11, 2020, Inter Partes Review Certificate US 9,078,905 KI was issued cancelling all claims of U.S. Patent No. 9,078,905. On March 12, 2020, Inter Partes Review Certificate US 9,028,877 KI was issued cancelling all claims of U.S. Patent No. 9,028,877.

Dated: June 4, 2019

Respectfully submitted,

By: /Michael I. Chakansky/

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First Back-Up Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on this the 4th day of June, 2020, the foregoing PETITIONER'S FIFTH UPDATED SUBMISSION OF MANDATORY NOTICE INFORMATION was served in its entirety on the following counsel of record by electronic service by email at the email addresses as set forth below in accordance with the consent set forth in Patent Owner's Mandatory Notices Pursuant to 37 C.F.R. § 42.8 (Paper No. 4, p. 2).

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