

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHIRE DEVELOPMENT LLC,
Petitioner,

v.

LUCERNE BIOSCEINCES, LLC,¹
Patent Owner.

Case IPR2014-00739
Patent 8,318,813 B2

PER CURIAM.

ENTRY OF ADVERSE JUDGMENT
37 C.F.R. § 42.73(b)

On May 18, 2015, we issued an Order to Show Cause Why Adverse Judgment Against Patent Owner Should not be Entered (“Order to Show Cause”). Paper 29. In that Order, Patent Owner was given ten days to show cause why adverse judgment should not be entered against it. *Id.* at 2.

¹ The patent at issue was assigned to Lucerne Biosciences, LLC, and Lucerne Biosciences, LLC is the sole owner of the patent at issue. Paper 17, 2.

After that Order was entered, we received an e-mail from Patent Owner, to which it attached an e-mail it had sent to its counsel of record at that time, Mr. Joseph Lucci, stating that Mr. Lucci was not authorized to represent it in any matter, and that Patent Owner was represented by new counsel. Paper 30, 2. Patent Owner argued further in the e-mail that the patent at issue is “patentable and valid.” *Id.* at 1; Ex. 3001.

In response, we noted that an e-mail is not an official communication, 37 C.F.R. § 42.6(b)(1), and was also in violation of our order of December 23, 2014 (Paper 14), requiring all papers to be signed by Patent Owner’s counsel of record. Paper 30, 1–2. Based on the representation in the e-mail, we authorized Patent Owner’s counsel of record to file a motion to withdraw, and ordered Patent Owner to update its mandatory notices designating new counsel, as well as file a response to our Order to Show Cause, within five business days of decision of a motion to withdraw. *Id.* at 4.

Patent Owner’s counsel of record filed a Motion to Withdraw as Counsel (Paper 31) on May 22, 2015, which we granted on May 26, 2015 (Paper 32). In granting the Motion to Withdraw, we ordered Patent Owner:

to update its mandatory notices, and designate registered counsel as lead counsel to represent it in this proceeding, as well as back-up counsel, as well as file a response to the Order to Show Cause why Adverse Judgment Should not be Entered Against Patent Owner (Paper 29) within five (5) business days from the date of this order.

Paper 32, 2.

In addition, we ordered that :

failure to do so by Patent Owner will be construed as Patent Owner abandoning the contest, and adverse judgment will be entered against Patent Owner.

Id.

Thus, Patent Owner was required to update its mandatory notices, as well as respond to the Order to Show Cause by June 2, 2015, five business days from May 26, 2015. Under 37 C.F.R. § 42.73(b)(4), abandonment of the contest may be construed as a request for adverse judgment. As Patent Owner has failed to update its Mandatory Notices, as well as respond to our Order to Show Cause, within the specified time period, we conclude that Patent Owner has abandoned the contest.

Under these circumstances, it is

ORDERED that adverse judgment is entered against Patent Owner as to claims 1–13 of the patent at issue, U.S. Patent No. 8,318,813;

FURTHER ORDERED that claims 1–13 of U.S. Patent No. 8,318,813 are cancelled; and

FURTHER ORDERED that the hearing scheduled for July 10, 2015 is cancelled.

IPR2014-00739
Patent 8,318,813 B2

PETITIONER:

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