

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CEPHEID,
Petitioner,

v.

ROCHE MOLECULAR SYSTEMS, INC. and
MAYO FOUNDATION FOR MEDICAL EDUCATION
AND RESEARCH,
Patent Owner.

Case IPR2015-00881
Patent 5,643,723

Before JACQUELINE WRIGHT BONILLA, SUSAN L. C. MITCHELL,
and ZHENYU YANG, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

INTRODUCTION

Cepheid (“Petitioner”) filed a Petition (Paper 1), seeking an *inter partes* review of claim 21 of U.S. Patent No. 5,643,723 (“the ’723 patent,” Ex. 1101). On September 17, 2015, the Board instituted trial to review the patentability of claim 21. Paper 9 (“Dec.”).

On December 1, 2015, Roche Molecular Systems, Incorporated and Mayo Foundation for Medical Education and Research (collectively, “Patent Owner”) filed a document titled “STATUTORY DISCLAIMER IN PATENT UNDER 37 C.F.R. § 1.321(A)” as a part of this *inter partes* review at the Board. Paper 11.

On January 7, 2016, the panel held a telephonic conference with counsel for both parties. During the conference, the panel explained that the statutory disclaimer should be filed with, not the Board, but a different branch of the Office. The panel also pre-authorized Patent Owner to file a motion to request adverse judgment with the Board, after properly filing its statutory disclaimer. To date, Patent Owner has not yet filed such a motion.

DISCUSSION

In the Decision to Institute, we determined that Petitioner has established a reasonable likelihood that it would prevail in showing claim 21 unpatentable as obvious over Telenti¹ and Honore.² Dec. 13.

Under 35 U.S.C. § 253, a patentee “may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent.” The requirements for a statutory disclaimer are prescribed in 37 C.F.R. § 1.321. The Certificate of Correction Branch of the Office is responsible for processing such a statutory disclaimer. See Manual of Patent Examining Procedure § 1490.

On January 8, 2016, Patent Owner filed a statutory disclaimer, satisfying all the requirements under 37 C.F.R. § 1.321. See Ex. 3001. As such, Patent Owner properly disclaimed claim 21, the only claim involved in this trial. In an *inter partes* review, a party may request judgment against itself at any time during a proceeding. See 37 C.F.R. § 42.73(b). Even though Patent Owner did not file a motion for adverse judgment as we suggested, we construe a “disclaimer of a claim such that the party has no remaining claim in the trial” as a request for entry of adverse judgment. 37 C.F.R. § 42.73(b)(2). As a result, we determine that entry of judgment

¹ Telenti et al., *Detection of Rifampin-Resistance Mutations in Mycobacterium Tuberculosis*, 341 THE LANCET 647–50 (1993) (Ex. 1102, “Telenti”).

² Honore & Cole, *Molecular Basis of Rifampin Resistance in Mycobacterium Leprae*, 37 ANTIMICROB. AGENTS & CHEMOTHER. 414–18 (1993) (Ex. 1108, “Honore”).

IPR2015-00881
Patent 5,643,723

against Patent Owner with respect to claim 21 of the '723 patent is appropriate.

ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claim 21 of the '723 patent; and

FURTHER ORDERED that this Order constitutes a final written decision under 35 U.S.C. § 318(a).

PETITIONER:

M. Paul Barker
Erik R. Puknys
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
paul.barker@finnegan.com
erik.puknys@finnegan.com
adam.breier@finnegan.com

PATENT OWNER:

R. Danny Huntington
Seth E. Cockrum
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
dhuntington@rfem.com
scockrum@rfem.com