

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEGRATED DNA TECHNOLOGIES, INC.,
Petitioner,

v.

TECAN GENOMICS, INC.,
Patent Owner.

IPR2024-01506
Patent 11,725,241 B2

Before GEORGIANNA W. BRADEN, ZHENYU YANG and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ADVERSE JUDGMENT AND TERMINATION AFTER INSTITUTION
35 U.S.C. § 253; 37 C.F.R. §§ 42.72, 42.73(b)(1)

I. BACKGROUND

On September 30, 2024, Integrated DNA Technologies, Inc.
("Petitioner") filed a Petition (Paper 1) requesting *inter partes* review of

claims 1–16 of U.S. Patent No. 11,725,241 B2 (Ex. 1003, “the ’241 patent”). Tecan Genomics, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6.

On April 21, 2025, we instituted an *inter partes* review of claims 1–16 of the ’241 patent. Paper 7. On July 11, 2025, Patent Owner filed a disclaimer of the entire term of the ’241 patent. Ex. 2016.

The parties have filed a joint motion asking the Board to enter adverse judgment under 37 C.F.R. § 42.73(b)(2) and to terminate the *inter partes* review because no challenged claims remain in this proceeding. Paper 21. Section 42.73 provides that “[a] party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include: (1) Disclaimer of the involved application or patent; (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b).

The disclaimer filed by Patent Owner, however, is not a statutory disclaimer under 37 C.F.R. § 42.73(b)(2) because the disclaimer disclaims the entire term of the claims rather than the claims themselves. According to the Manual of Patent Examining Procedure (“MPEP”) this type of disclaimer is a terminal disclaimer, not a statutory disclaimer. *See* MPEP § 1490. Terminal disclaimers are provided for in 37 C.F.R. § 1.321(b), which states that “[a]n applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted.” *See also* 35 U.S.C. § 253(b) (“any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted”). Therefore, we determine that it is appropriate to

consider Patent Owner's filing as a terminal disclaimer and that adverse judgment is available under 37 C.F.R. § 42.73(b)(1).

Based on the foregoing, we agree that adverse judgment and termination are appropriate in view of the disclaimer because no challenged claim remains.

Accordingly, it is:

ORDERED that the joint motion for adverse judgment and termination is *granted*; and

FURTHER ORDERED that the *inter partes* review is terminated.

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