

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

FUJIREBIO DIAGNOSTICS, INC.,
Petitioner,

v.

QUANTERIX CORP.,
Patent Owner.

IPR2025-01060
Patent 11,275,092 B2

Before COKE MORGAN STEWART, *Deputy Under Secretary of
Commerce for Intellectual Property and Deputy Director of the United
States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

Quanterix Corp. (“Patent Owner”) filed a request for discretionary denial (Paper 9, “DD Req.”) in the above-captioned case, and Fujirebio Diagnostics, Inc. (“Petitioner”) filed an opposition (Paper 11, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

Some considerations weigh against discretionary denial. For example, the challenged patent has not been in force for a significant period of time (issued in 2022). Additionally, there is no scheduling order or trial date set for the parallel district court proceeding involving the parties. DD Opp. 33.

Other considerations, however, favor discretionary denial. In particular, in allowing the challenged patent, the patent examiner stated that Patent Owner provided rebuttal evidence of copying by others sufficient to overcome the obviousness rejection. Ex. 1002, 659–660. The patent examiner explained that “no group prior to the effective filing date had done more than perhaps suggest” using the claimed assay, “while dozens of groups utilized” that assay “after the date of Applicant’s contribution.” *Id.* at 660.

Patent Owner argues that discretionary denial under 35 U.S.C. 325(d) is appropriate because the patent examiner found that the objective indicia of nonobviousness evidence was persuasive in allowing the patent application. DD Req. 13–30. Although Petitioner addresses the sufficiency of Patent Owner’s evidence, Petitioner has not persuasively demonstrated that the Office erred in evaluating this evidence. DD Opp. 21; *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper

6 at 8 (PTAB Feb. 13, 2020) (precedential). Rather, Petitioner merely disagrees with the Examiner's treatment of the evidence without showing material error. DD Opp. 21–26. “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *See Advanced Bionics*, Paper 6 at 9. Under these circumstances, discretionary denial is appropriate.

Furthermore, to the extent resolution of this issue may require additional evidence regarding objective indicia of nonobviousness, a district court may be the more appropriate venue, as it may allow for more robust discovery. Accordingly, the considerations that favor discretionary denial outweigh those that counsel against it.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

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