

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CRESCENDO BIOSCIENCE, INC.,
Petitioner,

v.

L. DOUGLAS GRAHAM,
Patent Owner.

Case PGR2017-00020
Patent 9,387,246 B2

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
37 C.F.R. § 42.208

I. INTRODUCTION

Crescendo Bioscience, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”), requesting institution of a post-grant review of claims 1–28 of U.S. Patent No. 9,387,246 B2 (Ex. 1001, “the ’246 patent”). L. Douglas Graham (“Patent Owner”) timely filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With his Preliminary Response, Patent Owner provided evidence that he filed with the Office a statutory disclaimer of claims 1–28 of the ’246 patent pursuant to 37 C.F.R. § 1.321(a). Ex. 2001.

We have statutory authority under 35 U.S.C. § 324(a). In view of Patent Owner’s disclaimer of all the challenged claims, we deny institution of a post-grant review of the ’246 patent.

II. DISCUSSION

In his Preliminary Response, Patent Owner contends that the Board should deny trial without entering adverse judgment in view of the statutory disclaimer of all challenged claims. Prelim. Resp. 1–8. We agree.

A patentee may “make disclaimer of any complete claim Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent.” 35 U.S.C. § 253(a). When a patent owner files a statutory disclaimer with its preliminary response, “no post-grant review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.207(e).

As prior panels have held, and we agree, a statutory disclaimer filed prior to institution of trial in a case should not be construed as a request for adverse judgment. *See, e.g., Corvus Pharm., Inc. v. U.S.A.*, PGR2016-00042, Paper 10, 5 (PTAB March 31, 2017). Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a

proceeding” and “[a]ctions construed to be a request for adverse judgment include . . . (2) [c]ancellation or disclaimer of a claim *such that the party has no remaining claim in the trial*” (emphasis added). The term “trial” in 37 C.F.R. § 42.73(b)(2) means “a contested case instituted by the Board based upon a petition.” See 37 C.F.R. § 42.2. Nothing in 37 C.F.R. § 42.73(b)(2) requires us to construe Patent Owner’s statutory disclaimer as a request for adverse judgment prior to institution of a trial.¹

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that pursuant to 35 U.S.C. § 324(a), no post-grant review is instituted as to any claim of the ’246 patent, as each of the challenged claims has been disclaimed.

¹ In light of the grant of certiorari in *Oil States Energy Services v. Greene’s Energy Group, LLC*, No. 16-712 (U.S. June 12, 2017), Patent Owner also contends that “[s]hould the Supreme Court hold that patents are private rights, the Board should vacate and terminate this proceeding.” Prelim. Resp. 8–9. Given our denial of institution based on Patent Owner’s voluntary disclaimer of the challenged claims, we find that argument moot as to this proceeding.

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