

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

ITM ISOTOPE TECHNOLOGIES MUNICH SE,
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,
Patent Owner.

PGR2025-00012
Patent 11,938,201 B2

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

DECISION
Denying Patent Owner's Request for Discretionary Denial

The Johns Hopkins University (“Patent Owner”) filed a request for discretionary denial (Paper 9, “DD Req.”) in the above-captioned case, and ITM Isotope Technologies Munich SE (“Petitioner”) filed an opposition (Paper 10, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the challenged patent issued on March 6, 2024, and Petitioner filed its Petition on December 24, 2024. Accordingly, Petitioner challenges the patent early in the life of the patent. Early challenges favor robust, predictable patent rights and weigh against discretionary denial. Additionally, Petitioner provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s request for discretionary denial is *denied*;

FURTHER ORDERED that the Petition is referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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