

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

SPECTRUM SOLUTIONS LLC,
Petitioner,

v.

LONGHORN VACCINES & DIAGNOSTICS, LLC,
Patent Owner.

IPR2021-00847 (Patent 8,084,443 B2)
IPR2021-00850 (Patent 8,293,467 B2)
IPR2021-00854 (Patent 8,669,240 B2)
IPR2021-00857 (Patent 9,212,399 B2)
IPR2021-00860 (Patent 9,683,256 B2)¹

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

ORDER
Granting *Sua Sponte* Director Review

¹ This Order applies to each of the above-listed proceedings.

IPR2021-00847 (Patent 8,084,443 B2)
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Spectrum Solutions LLC (“Petitioner”) filed Petitions requesting *inter partes* review of certain claims of five challenged patents. *See, e.g.*, IPR2021-00847, Paper 1 (“Pet.”).² Trial was instituted in each proceeding.

For example, in IPR2021-00847, Longhorn Vaccines & Diagnostics, LLC (“Patent Owner”) filed a Preliminary Response (Paper 7), Petitioner filed a Preliminary Reply (Paper 8), and Patent Owner filed a Preliminary Sur-reply (Paper 11). The Patent Trial and Appeal Board (“PTAB” or “Board”) granted review. Paper 13.

Thereafter, Patent Owner filed a Corrected Response (Paper 105),³ Petitioner filed a Reply to Patent Owner’s Response (Papers 39 (confidential), 45 (public)), and Patent Owner filed a Corrected Sur-reply (Paper 106).⁴ Patent Owner also filed a Contingent Motion to Amend (Paper 21) and Petitioner filed an Opposition to Patent Owner’s Motion to Amend (Papers 40 (confidential), 44 (public)). The Board issued Preliminary Guidance to the Motion to Amend (Papers 49 (confidential), 116 (public)). Patent Owner subsequently filed a Revised Motion to Amend (Papers 55, 90 (Corrected Revised Motion to Amend)), Petitioner filed an Opposition to the Revised Motion to Amend (Paper 67 (confidential), 75 (public)), Patent Owner filed a Reply in support of its Revised Motion to

² IPR2021-00850, IPR2021-00854, IPR2021-00857, and IPR2021-00860 include similar papers and exhibits. Unless otherwise noted, all citations are to papers and exhibits in IPR2021-00847 as representative. This Order applies equally to all captioned proceedings.

³ *See also* Paper 22 (Response), 65 (Amended Response).

⁴ *See also* Paper 54 (Sur-Reply).

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Amend (Paper 78), and Petitioner filed a Sur-reply to the Revised Motion to Amend (Papers 95 (confidential), 119 (public)).

The Board issued a Final Written Decision (“Decision”) that determined that Petitioner had demonstrated by a preponderance of the evidence that the challenged claims are unpatentable. Papers 112 (confidential), 114 (public). In the captioned proceedings, the Board determined that certain challenged claims are unpatentable based on the merits of the asserted grounds and, separately, that all challenged claims are unpatentable based on adverse judgment pursuant to 37 C.F.R. §§ 42.5, 42.11, and 42.12 as shown below:

Proceeding	Claims unpatentable based on the merits	Claims unpatentable based on adverse judgment
IPR2021-00847	1–51	1–51
IPR2021-00850	1–17, 24–42	1–42
IPR2021-00854	1–35	1–35
IPR2021-00857	1–35	1–35
IPR2021-00860	1–13, 15–20	1–20

As to the adverse judgment, prior to the Board issuing its Decision, the Petitioner, with authorization, filed a Motion for Sanctions, requesting that, based on certain actions and behavior of the Patent Owner, the Board (1) enter judgment against Patent Owner; (2) hold that a particular reference meets particular claim limitations and preclude Patent Owner from contesting otherwise; and (3) provide Petitioner compensatory expenses, including attorney fees. Papers 56 (confidential), 60 (public), 1–2. Patent Owner filed an Opposition to the Motion for Sanctions, arguing that Patent Owner’s conduct does not warrant sanctions and that the requested sanctions

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are improper and disproportionate given the lack of harm. Papers 76 (confidential), 77 (public). Petitioner submitted a Reply (Papers 84 (confidential), 94 (public)). The Board issued a Sanctions Order that determined that Patent Owner, through its counsel, failed to meet its duty of candor and fair dealing in its actions before the Board and, accordingly, entered adverse judgment against the challenged claims pursuant to 37 C.F.R. §§ 42.5, 42.11, and 42.12, as shown above. Papers 111 (confidential), 113 (public).

I have reviewed the Board's Decision, the Board's Sanctions Order, and the relevant papers and exhibits of record in the above-listed proceedings. I determine that *sua sponte* Director review of the Board's Decision in each captioned proceeding is appropriate. *See* Interim process for Director review § 8 (setting forth scope of Director review), § 10 (issues that may warrant Director review), § 22 (providing for *sua sponte* Director review of institution decisions in AIA proceedings and explaining that "the parties to the proceeding will be given notice" if Director review is initiated *sua sponte*). I will issue an order or decision in due course.

In consideration of the foregoing, it is hereby:

ORDERED that *sua sponte* Director review of the Board's Decision in each captioned proceeding is initiated; and

FURTHER ORDERED that an order or decision will issue in due course.

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FOR PETITIONER:

Joseph F. Jennings
Ali S. Razai
Paul N. Conover
Benjamin B. Anger
KNOBBE MARTENS, OLSON & BEAR, LLP
2j fj@knobbe.com
2azr@knobbe.com
paul.conover@knobbe.com
2bba@knobbe.com

FOR PATENT OWNER:

Elliot J. Williams
STOEL RIVES, LLP
elliott.williams@stoel.com

Matthew Smith
James Remenick
REMENICK PLLC
msmith@remenicklaw.com
mail@remenicklaw.com