

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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SPECTRUM SOLUTIONS LLC,  
Petitioner,

v.

LONGHORN VACCINES & DIAGNOSTICS, LLC,  
Patent Owner.

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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)<sup>1</sup>

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

ORDER  
Modifying Entered Sanctions on Unopposed Remand and *Sua  
Sponte* Reconsideration

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<sup>1</sup> This order applies to each of the above-listed proceedings.

IPR2021-00847 (Patent 8,084,443 B2)  
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This Order modifies the July 26, 2024 Director Review Decision in this case (“Previous Director Review Decision,” Paper 143), on unopposed remand from the U.S. Court of Appeals for the Federal Circuit (Paper 146) and *sua sponte* reconsideration.<sup>2</sup>

The Previous Director Review Decision affirmed the Board’s entry of judgment in the trial, *i.e.*, entry of adverse judgment against all 183 challenged claims, as a sanction against Patent Owner Longhorn Vaccines & Diagnostics, LLC (“Patent Owner”), with modified reasoning. *See* Paper 143, 65. This Order maintains the prior determination, and underlying findings, that Patent Owner violated the identified provisions by affirmatively engaging in sanctionable misconduct to deceive and mislead the Board through its counsel by: (1) intentionally withholding and concealing relevant factual evidence; (2) intentionally relying on known falsely elicited expert testimony; and (3) intentionally making a false statement of fact. *See id.* at 3, 45, 65.

On reconsideration, cancelling all challenged claims is not an appropriate sanction here. Absent extraordinary circumstances, the Board should never cancel claims it has not determined to be unpatentable as a sanction. The Board’s entry of judgment in the trial as a sanction against Patent Owner and cancellation of all challenged claims, therefore, is vacated.

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<sup>2</sup> Unless otherwise noted, all citations are to papers and exhibits in IPR2021-00847. IPR2021-00847, IPR2021-00850, IPR2021-00854, IPR2021-00857, and IPR2021-00860 include similar papers and exhibits.

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Entry of compensatory expenses, including attorney fees under 37 C.F.R. § 42.12(b)(6), would have been appropriate as a sanction against Patent Owner. However, apportioning fees here is not appropriate at this time because Petitioner Spectrum Solutions LLC (“Petitioner”) has withdrawn itself from participation in further proceedings involving the challenged patents and the parties have entered into a settlement agreement to bear their own costs. *See Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, Nos. 23-2111, -2112, -2113, -2114, -2115, Order (Fed. Cir. Mar. 25, 2025) (granting Petitioner’s motion to dismiss its appeal); Nos. 23-2111, -2112, -2113, -2114, -2115, 24-2361, -2362, -2363, -2364, -2365, Cross-Appellant’s Motion to Withdraw and to Dismiss (Fed. Cir. Mar. 10, 2025) (“Spectrum has agreed . . . to refrain from participating in challenges against the patents at issue. . . . The parties have agreed to bear their own costs.”).

In the absence of other sanctions, Patent Owner is strongly admonished for its conduct and cautioned that any future misconduct before the Office will be met with additional sanctions. *See, e.g., Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229, Paper 143 at 13–14 (Vidal Dec. 13, 2023) (imposing similar sanction).

All other portions of the Previous Director Review Decision not explicitly vacated are maintained. The Board’s findings of unpatentability on the merits in the Final Written Decision are also maintained. *See* Paper 114 (public version).

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This decision does not preclude the USPTO's Office of Enrollment and Discipline from exploring potential sanctions or discipline for violations of Part 11 based on the conduct in these proceedings. *See* 37 C.F.R. §§ 11.81(c)(2), 11.19(b) (2021).

In consideration of the foregoing, it is hereby:

ORDERED that the Director Review Decision Modifying-in-Part Order Granting Petitioner's Motions for Sanctions (Paper 143) is *sua sponte* reconsidered; and

FURTHER ORDERED that the entry of sanctions is modified as follows: judgment in the trial against Patent Owner is vacated, and instead, Patent Owner is strongly admonished and cautioned that any future misconduct before the Office will be met with additional sanctions.

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