

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

PHARMACOSMOS A/S,
Petitioner

v.

LUITPOLD PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-01490
Patent 7,754,702 B2

Before TONI R. SCHEINER and CHRISTOPHER G. PAULRAJ,
Administrative Patent Judges.

PAULRAJ, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

During the course of this proceeding, Patent Owner filed a “Notice of Disclaimer” in which Patent Owner purported to disclaim claims 28 and 29 of U.S. Patent No. 7,754,702 B2 (“the ’702 patent”). Paper 52. Consistent with that Notice, the Board in its Final Written Decision determined that Petitioner’s challenge of claim 28 was moot. Paper 54, 7 n. 2 and 51.

35 U.S.C. § 253 governs statutory disclaimers before the Office and provides:

(a) IN GENERAL.—Whenever a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, *on payment of the fee required by law*, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. 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 to the extent of the interest possessed by the disclaimant and by those claiming under him.

35 U.S.C. § 253 (emphasis added). Additionally, 37 CFR § 1.321 provides, in relevant part:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a

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disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) *Be accompanied by the fee set forth in § 1.20(d).*

37 C.F.R. § 1.321(a) (emphasis added). As set forth in the Manual of Patent Examining Procedure (MPEP) § 1490(IV), the Office's Certificate of Correction Branch is responsible for processing all statutory disclaimers filed under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321. MPEP § 1490(IV).

Although Patent Owner informed us of its intention to disclaim claims 28 and 29 of the '702 patent, it does not appear that Patent Owner has otherwise followed the requirements for a statutory disclaimer, including payment of the relevant fee.

Accordingly, it is hereby:

ORDERED that, within 10 business days of this Order, Patent Owner shall file a statutory disclaimer for claims 28 and 29 of the '702 Patent in accordance with the requirements of 37 C.F.R. § 1.321(a) and MPEP § 1490(IV).

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