Trials@uspto.gov
571-272-7822

Paper 9 (IPR2015-00009)
Paper 8 (IPR2015-00010)
Entered: March 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIO-RAD LABORATORIES, INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2015-00009 (Patent 7,294,503 B2)
Case IPR2015-00010 (Patent 8,252,539 B2)[1]

Before GRACE KARAFFA OBERMANN, DONNA M. PRAISS, and KRISTINA M. KALAN, *Administrative Patent Judges.*

PRAISS, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.21

[1] This caption is being used because the same issue is involved in each of these proceedings. The parties are not authorized to use this caption on any paper filed with the Board.

Bio-Rad Laboratories, Inc. ("Petitioner") filed Petitions to institute an *inter partes* review of claims 1, 2, 5–15, 18, 19, 30–35, 39–43, 46, 47, and 49–51 of U.S. Patent No. 7,294,503 ("the '503 patent") in IPR2015-00009 and claims 1–17 of U.S. Patent No. 8,252,539 ("the '539 patent") in IPR2015-00010 pursuant to 35 U.S.C. §§ 311–319 (collectively "Petitions"). The Petitions, as well as the '503 and '539 patents themselves, identify California Institute of Technology ("Patent Owner") as the patent owner and assignee, respectively. A certificate of service filed in each of the *inter partes* review proceedings indicates service of the Petitions was made on California Institute of Technology at Kilpatrick Townsend and Stockton LLP, the correspondence address of record for the '503 and '539 patents. Footnote numbered 1 in the Petitions states "[i]t is our understanding from the prosecution history, however, that Fluidigm Corp. is an exclusive licensee." No citation to the record was provided to support this statement.

Fluidigm Corporation ("Fluidigm") filed Mandatory Notices and Preliminary Responses in each of the captioned *inter partes* review proceedings[2] that represent "Fluidigm is an exclusive licensee with all substantial rights to the ['503 and '539 patents]" and "[t]herefore, the real party in interest is Fluidigm." Fluidigm additionally states in footnote 1 in each Preliminary Response that "Fluidigm has an exclusive license to the ['503 patent and '539 patents] for the life of the patent, which includes enforcement rights and the right to sub-license the ['503 and '539 patents]."

[2] Fluidigm also replaced the Patent Owner with itself in the headings for its Mandatory Notices and Preliminary Responses. The parties are to use the heading on the first page of the Notice of Filing Date Accorded to Petition in the appropriate proceeding until the Board makes a determination otherwise.

Fluidigm provides no evidence in support of its assertion that it is an exclusive licensee with all substantial rights to the ’503 and ’539 patents.

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may be authorized only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). According to 35 U.S.C. § 313, it is the patent owner who has the right to file a preliminary response to a petition, not a licensee of the involved patent. The Office’s Trial Practice Guide explains that the Board will apply traditional common-law principles in determining the real party-in-interest. Fed. Reg., Vol. 77 No. 157 (Aug. 14, 2012) at 48759. This uniformity of approach between the Federal Courts and the Office was intended to ensure that conventional principles of estoppel and preclusion would apply in both places, and that the integrity of the patent system will thus be preserved.

The question of who is the real party-in-interest when a patent is licensed has been judicially addressed in the context of standing. Thus, several Federal Circuit cases provide guidance on when an exclusive licensee has standing to sue for patent infringement in Federal Court. *See, e.g., Sicom Sys. Ltd. V. Agilent Techs., Inc.*, 427 F.3d 971 (Fed. Cir. 2005); *Prima Tek II, L.L.C. v. A-Roo Co.*, 222 F.3d 1372 (Fed. Cir. 2000). These cases hold that an exclusive licensee with all substantial rights is the “effective patentee,” and thus meets the constitutional standing requirement to sue in its own name without mandatory joinder of the named patentee. *Sicom*, 427 F.3d at 976; *Prima Tek II*, 222 F.3d at 1377.

The current record in each of these proceedings includes no evidence to support the assertion that Fluidigm is an exclusive licensee with all substantial rights to the '503 and '539 patents, including the right under § 313 to file the Preliminary Response, or otherwise participate, in these proceedings. "To determine whether a license agreement has conveyed all substantial rights in a patent, and is thus tantamount to an assignment, we must ascertain the intention of the parties and examine the substance of what was granted." *Prima Tek II*, 222 F.3d at 1378 (citing *Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA*, 944 F.2d 870, 875 (Fed. Cir. 1991). Therefore, we do not have a basis on which to consider the Preliminary Response filed on behalf of Fluidigm, who is not shown to stand in the shoes of the Patent Owner in these proceedings.

The Board shall expunge the Preliminary Response from the record in each of these proceedings unless, within five (5) business days of the date of this Order, a paper is filed (jointly or individually) that shows cause why Fluidigm should be entitled to file a preliminary response to the Petitions.

I. ORDER

Accordingly, it is

ORDERED that the Preliminary Response shall be expunged from the record unless, within five (5) business days of the date of this Order, a paper is filed (jointly or individually) that shows cause why Fluidigm should be entitled to file a preliminary response to the Petitions;

FURTHER ORDERED that the parties, until further notice, shall use the headings indicated on the Notice of Filing Date Accorded to Petition in each of these proceedings;

FURTHER ORDERED that any paper authorized by this Order shall not exceed five (5) pages.

IPR2014-01386
Patent 6,012,103

PETITIONER:

Dion Bregman
Michael J. Lyons
biorad.service@morganlewis.com

PATENT OWNER:

Randolph T. Apple
Tapple@kilpatricktownsend.com

James Murphy
Margaux Aviguetero
FluidigmIPR@novakdruce.com