

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDANT HEALTH, INC.,
Petitioner

v.

TEMPUS AI, INC.,
Patent Owner

Case IPR2026-00185
U.S. Patent No. 10,991,097

**PATENT OWNER'S BRIEF ON
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	<i>Tempus AI, Inc. v. Guardant Health, Inc.</i> , 3:25-cv-06622 (N.D. Cal.), Order Granting Defendant's Motion to Dismiss [Dkt 82] (January 21, 2026)
2002	<i>Tempus AI, Inc. v. Guardant Health, Inc.</i> , 3:25-cv-06622 (N.D. Cal.), Judgment [Dkt 86] (February 9 2026)
2003	<i>Tempus AI, Inc. v. Guardant Health, Inc.</i> , 3:25-cv-06622 (N.D. Cal.), Termination Order (February 9, 2026)
2004	<i>Tempus AI, Inc. v. Guardant Health, Inc.</i> , 3:25-cv-06622 (N.D. Cal.), Stipulation Waiving Rights to Appeal, Challenge Judgment, or Seek Sanctions, Fees, Expenses, or Costs [Dkt 88] (February 23, 2026)
2005	<i>Tempus AI, Inc. v. Guardant Health, Inc.</i> , 3:25-cv-06622 (N.D. Cal.) [Proposed] Stipulation and Final Judgment [Dkt 85] (February 9, 2026)
2006	Email Exchange Between Parties, March 9-12, 2026

Patent Owner Tempus AI, Inc. (“Tempus”) respectfully requests that the Director exercise discretion to deny institution of *inter partes* review of U.S. Patent No. 10,991,097 (“the ’097 patent”) in the above-captioned proceeding. As discussed in more detail below, all challenged claims in this case have been held invalid in a parallel district court proceeding. As such, the efficiency and integrity of the patent system are best served by denying institution, consistent with the informative holding in *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27 (April 17, 2025) (informative May 7, 2025) (“*Hulu*”).

Patent Owner previously asserted claims of the ’097 patent in *Tempus AI, Inc. v. Guardant Health, Inc.*, 3:25-cv-06622 (N.D. Cal.). In that proceeding, the district court granted Defendant’s Motion to Dismiss, holding independent claim 1 invalid under 35 U.S.C. § 101 for failing to recite patent-eligible subject matter. EX2001, 9-13. The court further held that “Claim 1 is representative of the ’097 Patent because all claims are directed to the same abstract idea.” EX2001, 9; *see also* EX2005, 2-3 (“the Court’s analysis and conclusions in the Motion to Dismiss Order as to... claim 1 apply equally to the other claims in [the ’097 patent]”). The district court entered final judgment and terminated the case on February 9, 2026. EX2002; EX2003. Tempus then “waive[d] its right to appeal or to file any post-judgment motion challenging” the court’s ruling, and “thereby discontinue[d] this

action with prejudice.”¹ EX2004, 2.

The Board should deny institution in this proceeding based on the informative guidance provided in *Hulu*. There, a district court similarly held the challenged claims invalid under 35 U.S.C. § 101. *Hulu* at 2. The Board denied institution in *Hulu* because “the patent claims already [stood] invalid” and it was “unnecessary to institute another proceeding.” *Id.* The Board reasoned that the “efficiency and integrity of the patent system is best served by denying institution.” *Id.* at 3.

This case is on all fours with the considerations discussed in *Hulu*. Indeed, the facts here support a denial of institution even more strongly because, in *Hulu*, unlike in this case, the Patent Owner still had right to appeal. *Id.* at 2-3. Despite the right to appeal at the time, the Board in *Hulu* found denial to be the “better and more efficient approach” because, “[i]n the event the Federal Circuit reverses the district court’s decision, Petitioner may raise such invalidity arguments in the district court on remand.” *Id.* The Board should thus deny institution here, as done in *Hulu*.

Moreover, since *Hulu*, the Board has consistently denied institution when the challenged claims have been found invalid in other proceedings. *See Google*

¹ Moreover, the deadline to appeal was on March 9, 2026.

LLC v., Booter, LLC, IPR2025-00967, Paper 10 (October 31, 2025); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00846, Paper 10 (October 10, 2025); *Google LLC v. TJTM Technologies, LLC*, IPR2025-00586, Paper 12 (August 14, 2025); *UIPath, Inc. v. Rule 14 LLC*, IPR2025-00623, Paper 8 (July 29, 2025); *HighLevel, Inc. v. Etison LLC d/b/a ClickFunnels*, IPR2025-00235, Paper 11 (June 2, 2025); *Shopify Inc. v. DKR Consulting LLC*, IPR2025-00131, Paper 10 (June 2, 2025); *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2025-00081, Paper 12 (May 1, 2025). The Board should not deviate here.

Indeed, both parties agree that this IPR proceeding should not result in a trial in light of the district court ruling. Petitioner has stated that, “[r]ather than burden[ing]... the Board with additional briefing,” the parties should “request[] the IPR be dismissed as moot.” EX2006, 5. Tempus submits, however, that denial of institution is the proper disposition. Consistent with *Hulu*’s informative guidance, denying institution would best serve the efficiency and integrity of the patent system.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S BRIEF ON DISCRETIONARY DENIAL** and associated Exhibits 2001-2006 were served in their entireties on March 13, 2026, upon the following parties via electronic mail:

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