

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 PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S UPDATED 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
2007	Statutory Disclaimer of Claims 1-18 of U.S. Patent No. 10,991,097

The Board should not institute *Inter Partes* Review (IPR) of U.S. Patent No. 10,991,097 (“the ’097 patent) because Patent Owner has disclaimed all challenged claims under 35 U.S.C. § 253. Under Patent Office rules and Board precedent, “[n]o inter partes review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e); *see also Gen. Elec. Co. v. United Techs. Co.*, IPR2017-00491, Paper 9 (July 6, 2017) (precedential) (“Because all [challenged claims] have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), no inter partes review is instituted in this proceeding.”).

Patent Owner’s disclaimer of claims 1-18 of the ’097 patent was properly filed and recorded under 37 C.F.R. § 1.321(a) on April 6, 2026. *See Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that disclaimer is immediately “recorded” on the date that the Office receives disclaimer meeting requirements of 37 C.F.R. § 1.321(a) and that no further action is required in the Office). A copy of the as-filed disclaimer is provided as Exhibit 2007.

Thus, because all challenged claims have been disclaimed, Patent Owner respectfully submits that the Board should deny institution of this IPR. Patent Owner strongly disagrees with the Petition’s unpatentability contentions, and the disclaimer of claims 1-18 should not be construed as an admission or acquiescence with regard to the Petition. *Raytheon Tech. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1379 n.4 (Fed. Cir. 2021) (citation omitted) (a “disclaimer does not legally

constitute ‘an admission that the subject of the disclaimer appears in the prior art.’”).

Moreover, the disclaimer should not be construed as a request for adverse judgment. Patent Owner respectfully submits that denial of institution is a sufficient mechanism to dispose of this proceeding, and that the Board should not enter adverse judgment. Director Squires recently held that, under similar circumstances, denying institution without entering adverse judgment “is a more efficient use of the Office’s resources.” *Cisco Sys. Inc. v. Dynamic Mesh Networks, Inc. D/B/A MeshDynamics*, IPR2025-01303, Paper 14 at 3 (March 3, 2026). It also “encourages similarly situated patent owners to file a disclaimer prior to institution.” *Id.*

Indeed, although 37 C.F.R. § 42.73(b) *permits* the Office to enter an adverse judgment here, the Board routinely declines to do so under similar circumstances. For instance, in *Bestway (USA), Inc. v. Intex Marketing, Ltd.*, the Board held that, “the efficient administration of the Office weighs against entering adverse judgment because [doing so] would have the effect of discouraging other similarly situated patent owners from filing disclaimers prior to institution in appropriate cases and also encourage patent owners to continue to litigate every AIA trial proceeding through Final Written Decision in such cases.” PGR2024-00036, Paper 9 at 8 (Oct. 28, 2024). As another example, in *Pfizer, Inc. v. UniQure Biopharma*

B.V., the Board declined to enter adverse judgment because “disclaimed claims are treated as if they never existed.” IPR2020-00388, Paper 52 at 2 (Mar. 25, 2021).

The Board reasoned: “[i]f the claims never existed, we cannot have exercised jurisdiction over the disclaimed claims and therefore cannot enter adverse judgment against them.” *Id.* (citing *Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Lab., Inc.*, 933 F.3d 1367, 1374-75 (Fed. Cir. 2019)).

Many other examples support this line of reasoning. *See, e.g., Cisco Sys., Inc. v. Security Profiling, LLC*, IPR2021-01428, Paper 13 at 7 (Mar. 14, 2021) (“The statutory disclaimer was filed before institution. In view of this disclaimer . . . we determine a denial of institution is sufficient to dispose of this case.”); *Microsoft Corp. v. Litl, LLC*, IPR2021-01011, Paper 11 at 3 (Apr. 5, 2022) (“we determine that denying institution without entering adverse judgment is the appropriate means for disposing of this case”); *Crescendo Bioscience, Inc. v. L. Douglas Graham*, PGR2017-00020, Paper 8 at 2 (Oct. 17, 2017) (“As prior panels have held, and we agree, a statutory disclaimer filed prior to institution of trial in a case should not be construed as a request for adverse judgment.”); *Takeda Vaccines, Inc. v. Valneva Austria Gmbh*, IPR2023-00354, Paper 7 at 4 (June 9, 2023); *CommScope Techs., LLC v. Belden Inc.*, IPR2023-01058, Paper 8 (Nov. 30, 2023).

Thus, in view of Director Squires’s reasoning in *Cisco Systems*, supported

by similar reasoning in numerous prior Board decisions, Patent Owner requests that the Board deny institution without entering adverse judgment.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 722 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

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

I certify that the above-captioned **PATENT OWNER PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(a)** and associated Exhibit 2007 were served in their entireties on April 13, 2026, upon the following parties via electronic mail:

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