

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

J. KYLE BASS and ERICH SPANGENBERG,
Petitioner,

v.

ALPEX PHARMA SA,
Patent Owner.

Case IPR2016-00245
Patent 8,440,170 B2

Before TONI R. SCHEINER, LORA M. GREEN, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

JUDGMENT AND FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

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Petitioner, Messrs. J. Kyle Bass and Erich Spangenberg, filed a Petition (Paper 5) requesting an *inter partes* review of claims 1–9 of U.S. Patent No. 8,440,170 B2 (Ex. 1001, “the ’170 patent”). Patent Owner, Alpx Pharma SA, filed a Preliminary Response. Paper 12.

On May 20, 2016, we granted the Petition to institute an *inter partes* review as to claims 1–3, 5, 6, 8, and 9 of the ’170 patent. Paper 13, 19. Patent Owner did not file a full Patent Owner Response. Rather, in an email dated August 22, 2016, Patent Owner stated that it would not be submitting a Response. *See* Paper 15, 2 (reproducing email of August 22, 2016). In a conference call held with the parties on August 22, 2016, Patent Owner reiterated what it had said in the email. *Id.* Accordingly, we ordered Patent Owner to show cause as to why adverse judgment should not be entered against it. *Id.* at 3.

Patent Owner filed a response to our order on October 4, 2016. Paper 16. In that response, Patent Owner confirmed that “it is not inclined, in the aftermath of refrainment from filing a response to the Petition, to contest the issues designated for trial any further.” *Id.* at 2. It acknowledged also that judgment may be entered against it, premised on the understanding that the entry of adverse judgment will “(i) relate solely to the issues designated for trial, (ii) result in the cancellation of only ’170 patent claims 1–3, 5, 6, 8, and 9, and (iii) leave intact ’170 patent claims 4 and 7 which were not designated for trial.” *Id.*

Pursuant to Board rules, “[a]ctions construed to be a request for adverse judgment include . . . [a]bandonment of the contest.” 37 C.F.R. § 42.73(b)(4). Patent Owner’s failure to file substantive papers in this trial is consistent with abandonment of the contest. As Patent Owner confirms that

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it will not contest the issues designated for trial, and as Patent Owner's understanding of the consequences of entry of adverse judgment is correct, we determine that under these circumstances, the entry of judgment adverse to Patent Owner and cancellation of the claims on which trial was instituted is appropriate.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request for adverse judgment under 37 C.F.R. § 42.73(b) with respect to claims 1–3, 5, 6, 8, and 9 of U.S. Patent No. 8,440,170 B2 is GRANTED;

FURTHER ORDERED that this constitutes a final written decision under 35 U.S.C. § 318(a); and

FURTHER ORDERED that claims 1–3, 5, 6, 8, and 9 of U.S. Patent No. 8,440,170 B2 be CANCELLED.

PETITIONER:

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