

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

BOEHRINGER INGELHEIM INTERNATIONAL GMBH,
Patent Owner.

Case IPR2016-01565
Patent 8,853,156 B2

Before TONI R. SCHEINER, BRIAN P. MURPHY, and ZHENYU YANG,
Administrative Patent Judges.

SCHEINER, *Administrative Patent Judge.*

ORDER

Granting Patent Owner's Request for Adverse Judgment
37 C.F.R. §§ 42.72, 42.73

I. BACKGROUND

On February 9, 2017, the Board instituted a review of the patentability of claims 1, 2, 4, 5, and 23 of U.S. Patent No. 8,853,156 B2 (Ex. 1001, “the ’156 patent”). Paper 17. On April 14, 2017, Boehringer Ingelheim International GmbH (“Patent Owner”) filed a Request for Adverse Judgment under 37 C.F.R. § 42.73(b). Paper 21. Mylan Pharmaceuticals Inc. (“Petitioner”) filed a Response (Paper 22) opposing Patent Owner’s Request as premature, pending a decision on Petitioner’s Request for Rehearing (Paper 19). A decision denying Petitioner’s Request for Rehearing has since been entered (Paper 23). Accordingly, Patent Owner’s Request for Adverse Judgment is ripe for decision.

Patent Owner’s request is granted.

II. DISCUSSION

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Under the Rules, actions construed as a request for entry of adverse judgment include “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b)(2). Here, Patent Owner has requested that “the Board cancel the instituted claims (claims 1, 2, 4, 5, and 23) and enter adverse judgment against it.” Paper 21, 1.

III. CONCLUSION

Having reviewed Patent Owner’s Request, we determine that entry of judgment against Patent owner with respect to claims 1, 2, 4, 5, and 23 of the ’156 patent is appropriate. Because no challenged claim remains in the trial, we terminate the proceeding. 37 C.F.R. § 42.72.

IV. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to claims 1, 2, 4, 5, and 23 of U.S. Patent No. 8,853,156 B2; and

FURTHER ORDERED that this proceeding is hereby TERMINATED.

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Patent 8,853,156 B2

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