

Trials@uspto.gov
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Paper: 57
Date: July 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO. LTD and BIOCON BIOLOGICS INC.

Petitioner(s),

v.

REGENERON PHARMACEUTICALS, INC.,

Patent Owner.

IPR2023-00739

Patent 10,888,601 B2¹

Before JOHN G. NEW, ROBERT A. POLLOCK, and RYAN H. FLAX,
Administrative Patent Judges.

NEW, *Administrative Patent Judge.*

JUDGMENT

Granting Adverse Judgment after Institution of Trial

37 C.F.R. § 42.73(b)

¹ IPR2024-00201 has been joined with IPR2023-00739. A copy of this adverse judgment will be entered in IPR2024-00201.

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We instituted trial in this *inter partes* proceeding on October 20, 2023. Paper 9. On July 10, 2024, Patent Owner Regeneron Pharmaceuticals, Inc. (“Patent Owner”) communicated to the panel, *via* email, that it had filed a Disclaimer under 37 C.F.R. § 1.321(a), disclaiming claims 10–12, 17–19, 21, 25–28, and 33 of U.S. Patent No. 10,888,601 B2, which are the remaining challenged claims of this *inter partes* review. *See* Ex. 3002. Patent Owner had previously disclaimed all of the other claims challenged in this proceeding. *See* Exs. 2001, 2002. A copy of the Disclaimer was attached to the email, it is of record before the Office, and it is entered as Exhibit 3003.

Because no challenged claims now remain in this *inter partes* review, Patent Owner requested termination of the proceeding. Ex. 3002. Petitioner Samsung Bioepis Co. Ltd (“Petitioner”) subsequently addressed an email to the Board, requesting that the Board enter adverse judgment in this proceeding, in view of Patent Owner’s disclaimer of all challenged claims. Ex. 3004. Patent Owner has not expressly requested adverse judgment.

Section 42.73 of our rules provides, in relevant part, that: “A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include: ... (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b). According to our reviewing court, 37 C.F.R. § 42.73(b) gives the Board authority to construe a patent owner’s actions in disclaiming all challenged claims in an instituted trial as a request for an adverse judgment. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1349 (Fed. Cir. 2018).

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In the present *inter partes* review, Patent Owner has disclaimed all challenged claims of the '601 patent, such that there are none left to be contested by the Petition. We consequently view Patent Owner's filing of the Disclaimer, removing the last of the challenged claims from this *inter partes* review, and its request for termination of the proceeding, as a constructive request for adverse judgment against itself under § 42.73(b). *Arthrex*, 880 F.3d at 1349. Because there are no challenged claims left for the Petition to contest in this proceeding, adverse judgment against Patent Owner is *granted*.

ORDER

Accordingly, it is

ORDERED that Patent Owner's constructive request for adverse judgment is granted and adverse judgment is entered under 37 C.F.R. § 42.73(b) against Patent Owner with respect to all challenged claims of the '601 patent;

FURTHER ORDERED that Patent Owner shall file a notice and copy of this judgment in any proceeding or action involving the '601 patent; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d), Patent Owner is precluded from taking any action inconsistent with this judgment, including obtaining any patent claim that is not patentably distinct from disclaimed claim 1 of the '601 patent.

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For PETITIONER:

Raymond Nimrod
Matthew Traupman
Landon Smith
QUINN EMANUEL URQUHART & SULLIVAN, LLP
raynimrod@quinnemanuel.com
matthewtraupman@quinnemanuel.com
landonsmith@quinnemanuel.com

For PATENT OWNER:

Adam Brausa
Rebecca Weires
Kira Davis
Daralyn Durie
MORRISON & FOERSTER LLP
abrausa@mofocom
rweires@mofocom
kiradavis@mofocom
ddurie@mofocom