

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLTRION, INC.,
Petitioner,

v.

REGENERON PHARMACEUTICALS, INC.,
Patent Owner.

PGR2021-00117
Patent 10,857,231 B2

Before ERICA A. FRANKLIN, JOHN G. NEW, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

NEW, *Administrative Patent Judge*.

ORDER
Denying Institution of Post-Grant Review
35 U.S.C. § 324

On March 14, 2022, one day before the statutory date for the Board's Decision on Institution, Patent Owner Regeneron Pharmaceuticals Inc. ("Patent Owner") notified the Board, *via* an email, that it intended that day to file a Notice of Disclaimer with the U.S. Patent and Trademark Office, disclaiming all claims of US 10,857,231 B2 (the "'231 patent"). Ex. 3002. Patent Owner also notified the Board that it had notified Petitioner Celltrion Inc. of its intentions in this respect. *Id.* Patent Owner subsequently filed its Notice of Disclaimer that same day. *See* Ex. 2048. In its email, Patent Owner stated that, in view of its statutory disclaimer of all of the claims of the '231 patent, Patent Owner understood that the Board would terminate the proceeding and view the disclaimer as a request for adverse judgement in the present proceeding. Ex. 3002.

Patent Owner has disclaimed all claims of the '231 patent and paid the requisite fee. *See* Ex. 2048; *see also* 37 CFR § 1.321 (setting forth requirements for statutory disclaimer). Accordingly, we deny institution of the requested post-grant review. *See* 37 C.F.R. § 42.207(e) ("No post-grant review will be instituted based on disclaimed claims"); *see also General Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (denying institution of *inter partes* review under analogous rule 37 C.F.R. § 42.107(e) based on disclaimer) ("*General Electric*").

We decline to enter adverse judgement. We acknowledge that the Federal Circuit has construed Rule 42.73(b) as permitting the Board to enter adverse judgment when a patent owner cancels all claims prior to institution. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir.

2018). However, we do not read *Arthrex* or Rule 42.73(b) as necessarily requiring us to enter adverse judgment in this context.

In the present instance, and consistent with Rule 42.207(e) and the Board's precedential *General Electric* decision, we determine that a denial of institution is sufficient to dispose of this case. *See also General Elec. Co. v. United Techs. Corp.*, IPR2019-01489, Paper 11 at 4–5 (Dec. 10, 2019) (denying institution based on disclaimer and declining authorization to file motion for adverse judgment); *Google LLC v. Jenam Tech LLC*, PGR2021-00082, Paper 8 at 2 n.1 (Nov. 17, 2021) (denying institution based upon disclaimer and declining petitioner's request to file additional briefing regarding adverse judgment); *Kymera Therapeutics, Inc. v. Dana-Farber Cancer Institute, Inc.*, PGR2021-00115, Paper 13 at 3 (March 2, 2022) (denying institution based upon disclaimer of all claims of the challenged patent). We consequently deny institution of post-grant review.

ORDER

It is therefore

ORDERED that no post-grant review is instituted.

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Patent 10,857,231 B2

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