Trials@uspto.gov
571.272.7822

Paper No. 52
Entered: March 25, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER, INC.,
Petitioner,

v.

UNIQURE BIOPHARMA B.V.,
Patent Owner.

IPR2020-00388
Patent 9,249,404 B2

Before ERICA A FRANKLIN, ROBERT J. POLLOCK, and JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

JUDGMENT
Granting Request for Adverse Judgment after Institution of Trial
37 C.F.R. §§ 42.73(b)

Pfizer Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 6 and 9–15 of U.S. Patent No. 9,249,405 B2 ("the '405 Patent", Ex. 1001). UniQure Biopharma B.V. ("Patent Owner") filed a Preliminary Response. (Paper 8, "Prelim. Resp.") in conjunction with the Preliminary Response, Patent Owner filed a Statutory disclaimer pursuant to 37 C.F.R. § 1.321(a), in which Patent Owner disclaimed all interest in claims 6 and 9–13 of the '405 Patent. Ex. 2001. Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we instituted review as to the remaining challenged claims, claims 14 and 15. Paper 9.

On October 13, 2020, Patent Owner filed a non-contingent motion to amend substituting claims 16–18 for claims 14 and 15. Paper 25 ("MTA"). In the MTA, Patent Owner requested preliminary guidance as to the patentability of the substitute claims. MTA 1. Petitioner filed an opposition to the Motion to Amend on January 13, 2021. Paper 40.

On February 3, 2021, we issued our Preliminary Guidance with respect to Patent Owner's Motion to Amend. Paper 44. In the Preliminary Guidance, we opined that the proposed substitute claims were likely unpatentable. *Id.*

On February 23, 2021, a conference call was held among counsel for the parties and Judges Franklin, Pollock and Schneider to discuss Patent Owner's plan to withdraw its Motion to Amend and to disclaim claims 14 and 15. Ex. 2067. The purpose of the call was to discuss the scope of any adverse judgment arising from Patent Owner's withdrawal of the MTA and disclaimer of the challenged claims. *Id.* In an email sent on March 3, 2021, the Board authorized Patent Owner to file a motion to terminate, disclaimer and request to withdraw the MTA. Ex. 2069.

Patent Owner filed a Notice of Withdrawal of Motion to Amend and a Motion to Terminate on March 4, 2021 (Papers 47 and 48). Petitioner filed an authorized Opposition to the Motion to Terminate on March 16, 2021. Paper 50 ("Opp.").

Under our rules, a party may request adverse judgment against itself at any time during a proceeding, and we construe a disclaimer of all claims involved in a trial as a request for adverse judgment. 37 C.F.R. §42.73(b). Because Patent Owner has disclaimed all challenged claims, we construe Patent Owner's Motion to Terminate as a Request for Adverse Judgment.[1] Having satisfied the regulatory standard, we grant Patent Owner's request for adverse judgment as to instituted claims 14 and 15.

Petitioner contends that any adverse judgement should extend to claims 6, and 9–13 which were originally challenged in the Petition. Opp. 3–6. . We decline to extend the adverse judgment to those claims.

As noted above, claims 6 and 9–13 were disclaimed before we instituted this proceeding. Prelim Resp. at 1. In such instances, the disclaimed claims are not part of the *inter partes* review and cannot be subject to an adverse judgment. *See* 37 C.F.R. § 42.107(e); *Intuitive Surgical, Inc. v. Ethicon LLC,* IPR2018-01248, Paper 7 at 2 n.1, 9– 10 (PTAB Feb. 7, 2019) (discussing interplay of a disclaimed claim, Federal Circuit precedent, and our governing statutes and rules).

Petitioner cites to *Arthrex, Inc. v. Smith & Nephew, Inc*., 880 F.3d 1345 (Fed. Cir. 2018) in support of its contention that the adverse judgment should extends to claim 6 and 9–13. Opp. 3. While the court in *Arthrex* held

[1] Patent Owner requested that we terminate the proceedings as moot or in the alternative for adverse Judgement as to the instituted claims. Mot. Term. 1 n. 1.

that the Board may enter adverse judgment against disclaimed claims, we are mindful of prior precedent holding that disclaimed claims are treated as if they never existed. *Vectra Fitness, Inc. v. TNWK Corp*., 162 F.3d 1379, 1383 (Fed. Circ. 1998). If the claims never existed, we cannot have exercised jurisdiction over the disclaimed claims and therefore cannot enter adverse judgment against them. *See Sanofi-Aventis U.S., LLC v. Dr. Reddy's Lab., Inc.,* 933 F.3d 1367, 1374–75 (Fed. Cir. 2019) (District court lacked jurisdiction to declare disclaimed claims invalid). This in contrast to claims 14 and 15 which were not disclaimed until after we instituted trial and exercised jurisdiction over those claims.

We also decline to extend adverse judgment to proposed substitute claims 16–18. As provided by the terms of the Motion to Amend Pilot Program, Patent Owner has withdrawn the MTA. Paper 47. The Program guidance states that if a patent owner withdraws a MTA, "the Board will not address the MTA in a final written decision." Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 FR 9497, 9502, March 15, 2019. We interpret this language to extend to any adverse judgment that may rise from the proceeding as it treats the proposed substitute claims as not being part of the proceeding.

Based on the foregoing, we finds that adverse judgment in this proceeding should be limited to the claims upon which we instituted this proceeding, claims 14 and 15.

Accordingly, it is

ORDERED that, pursuant to 37 C.F.R. §42.73(b), *inter partes* review of claims 14 and 15 of the '405 patent is terminated.[2]

[2] Patent Owner is reminded of the applicable estoppel provisions in 37 C.F.R. § 42.73(d)(3).

For PETITIONER:

David Berl
Dov Grossman
Xun (Michael) Liu
WILLIAMS & CONNOLLY LLP
dberl@wc.com
dgrossman@wc.com
mliu@wc.com

For PATENT OWNER:

Justin L. Krieger
Nicoletta M. Kennedy
Kathryn H. Wade
Tina Williams McKeon
KILPATRICK TOWNSEND & STOCKTON LLP
jkrieger@kilpatricktownsend.com
nkennedy@kilpatricktownsend.com
kwade@kilpatricktownsend.com
tmckeon@kilpatricktownsend.com