

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LIMITED,
Petitioner,

v.

VERTEX PHARMACEUTICALS INCORPORATED,
Patent Owner.

Case IPR2015-00405
Patent 6,436,989 B1

Before LORA M. GREEN, SHERIDAN K. SNEDDEN, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

JUDGMENT
Request for Adverse Judgment
37 C.F.R. § 42.73(b)

I. INTRODUCTION

We instituted an *inter partes* review as to claims 1 and 4–9 of U.S. Patent No. 6,436,989 B1 (Ex. 1001; “the ’989 Patent”) for the following proposed grounds of unpatentability:

- (i) claim 1 of the ’989 Patent as unpatentable under 35 U.S.C. § 103 over the combination of Roy and Grobelny; and
- (ii) claims 4–9 of the ’989 Patent as unpatentable under 35 U.S.C. § 103 over the combination of Roy, Grobelny, and Bighley.

Decision to Institute 25 (Paper 13).

Vertex Pharmaceuticals Incorporated (“Patent Owner”) now requests adverse judgment and the cancelation of claims 1 and 4–9 of the ’989 patent. Paper 25.

Lupin Limited (“Petitioner”) opposes under 37 C.F.R. § 42.23 the grant of the Request for Adverse Judgment filed by Patent Owner before a decision is rendered on Petitioner’s Request for Rehearing (Paper 15).

A decision on Petitioner’s Request for Rehearing has been entered. Paper 27 (denying request for rehearing).

II. DISCUSSION

Under 35 U.S.C. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Also, under 37 C.F.R. § 42.73(b)(2), actions construed as a request for entry of adverse judgment include cancellation of a claim such that the party has no remaining claim in the trial.

Patent Owner has requested adverse judgment and the cancellation of all claims involved in this *inter partes* review, such that after the

cancellation it will have no remaining claim in the trial.

We hereby grant Patent Owner's request for adverse judgment.

III. ORDER

Accordingly, it is

ORDERED that Patent Owner's request to cancel claims 1 and 4–9 and request for entry of adverse judgment are granted;

FURTHER ORDERED that judgment is herein entered against Patent Owner with respect to claims 1 and 4–9 of Patent 6,436,989; and

FURTHER ORDERED that claims 1 and 4–9 of Patent 6,436,989 are herein cancelled.

PETITIONER:

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