

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP., MERCK SHARP & DOHME
B.V., and ORGANON USA, INC.

Petitioners,

v.

MICROSPHERIX LLC,
Patent Owner.

IPR2018-01288
Patent 6,514,193 B2

Before ULRIKE W. JENKS, TINA E. HULSE, and JAMES A. WORTH,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

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

Merck Sharp & Dohme Corp., Merck Sharp & Dohme B.V., and Organon USA, Inc. (collectively “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1 and 2 of Patent No. 6,514,193 B2 (“the ’193 patent”). Paper 1 (“Pet.”). On January 11, 2018, we instituted *inter partes* review of those claims. Paper 8, 34.

On April 11, 2019, Patent Owner Microspherix LLC (“Patent Owner”) filed a Request for Adverse Judgment under 37 C.F.R. § 42.73(b). Paper 12. Although it disagrees with Petitioner’s arguments, Patent Owner requests cancellation of claims 1 and 2 “in an effort to streamline and conserve Board and party resources in light of other ongoing proceedings regarding related patents.” *Id.* at 2.

Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Cancellation or disclaimer of one or more claims, such that the patent owner has no remaining claim in the trial, is construed to be a request for adverse judgment. 37 C.F.R. § 42.73(b)(2). Patent Owner has requested cancellation of claims 1 and 2 of the ’193 patent on which a trial was instituted in the instant proceeding such that, after the cancellation, it has no remaining claim in the trial. Paper 12, 2.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s request to cancel claims 1 and 2 of the ’193 patent and for adverse judgment under 37 C.F.R. § 42.73(b) is granted; and

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 1 and 2 of the ’193 patent.

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