

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DANISCO US INC.,
Petitioner,

v.

NOVOZYMES A/S,
Patent Owner.

IPR2019-01010
Patent 10,035,973 B2

Before GRACE KARAFFA OBERMANN, ROBERT A. POLLOCK, and
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

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

I. INTRODUCTION

Danisco US Inc. (“Petitioner”) filed a Petition for an *inter partes* review of claims 1–20 of U.S. Patent No. 10,035,973 B2 (“the ’973 patent,” Ex. 1001). Paper 1. Novozymes A/S (“Patent Owner”) timely filed a Preliminary Response. Paper 7. Petitioner filed an authorized Reply Brief (Paper 9) on September 17, 2019, and Patent Owner filed an authorized Sur-Reply Brief (Paper 10) on September 24, 2019.

On August 7, 2019, Patent Owner filed a Statutory Disclaimer in the ’973 patent disclaiming completely claims 1, 3–11, and 13–20 of the ’973 patent, leaving only claims 2 and 12 remaining. Ex. 2002. On November 5, 2019, we instituted *inter partes* review of claims 2 and 12 of the ’973 patent. Paper 13.

On January 27, 2020, Patent Owner filed a Request for Adverse Judgment. Paper 16. Patent Owner’s Request for Adverse Judgment stated, *inter alia*, “[p]ursuant to 37 C.F.R. § 42.73(b), Patent Owner Novozymes A/S (‘Novozyms’) hereby requests adverse judgment as to claims 2 and 12 of U.S. Patent No. 10,035,973 (the ’973 Patent).” *Id.* at 1. As noted above, claims 2 and 12 are the only claims remaining in the ’973 patent and challenged in this *inter partes* review.

II. DISCUSSION

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Here, Patent Owner has expressly requested judgment against itself on each of the claims remaining in the ’973 patent and challenged in this *inter partes* review. Paper 16. Under our Rules, “[a] party may request judgment against itself at any time during a

proceeding.” 37 C.F.R. § 42.73(b). Here, Patent Owner expressly disclaimed each of claims 1, 3–11, and 13–20 of the ’973 patent pre-institution (Ex. 2002), and Patent Owner has now expressly requested adverse judgment regarding each remaining claim 2 and 12 of the ’973 patent, which are the challenged claims for which trial was instituted, such that Patent Owner has no remaining claim in the trial or in the ’973 patent (Paper 16). Thus, entry of judgment adverse to the Patent Owner is appropriate.

III. CONCLUSION

Having reviewed Patent Owner’s request, we determine that entry of judgment against Patent Owner with respect to claims 2 and 12 of the ’973 patent is appropriate. Because no challenged claim remains in the trial, we enter judgment against Patent Owner and terminate the proceeding.
37 C.F.R. § 42.73.

IV. ORDER

Accordingly, it is:

ORDERED that adverse judgment against Patent Owner in this *inter partes* review is entered under 37 C.F.R. § 42.73(b) as to claims 2 and 12 of the ’973 patent; and

FURTHER ORDERED that all scheduled Due Dates (*see* Paper 15) in this proceeding are vacated; and

FURTHER ORDERED that this constitutes a Final Written Decision in this *inter partes* review under 35 U.S.C. § 318(a).

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