

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIZYME, INC.,
Petitioner,

v.

GLAXOSMITHKLINE LLC,
Patent Owner.

IPR2020-00328
Patent 9,956,210 B2

Before SHERIDAN K. SNEDDEN, JO-ANNE KOKOSKI, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

JUDGMENT

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

I. INTRODUCTION

Epizyme, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claim 1 of U.S. Patent No. 9,956,210 B2 (the “’210 patent”). Paper 2 (“Petition”). On June 15, 2020, we instituted an *inter partes* review as to claim 1 of the ’210 patent, the only claim of the ’210 patent. Paper 10. At that time, we also entered a Scheduling Order that set September 8, 2020, as the due date for Patent Owner’s Response to the Petition and any motion to amend the ’210 patent. Paper 11. However, Patent Owner did not file its response or a motion to amend on or before September 8, 2020.

On September 10, 2020, counsel for Patent Owner forwarded an email to the Board indicating Patent Owner’s election to file a statutory disclaimer disclaiming the sole claim (claim 1) in the ’210 patent. Ex. 3001. On September 11, 2020, counsel for Petitioner forwarded an email to the Board requesting entry of adverse judgment against Patent Owner pursuant to 37 C.F.R. § 42.73(b), and further stating that Patent Owner agreed that entry of adverse judgment against Patent Owner was the appropriate mechanism for terminating this proceeding. *Id.* On September 14, 2020, we authorized Patent Owner to file a request for adverse judgment in this case. *Id.*

On September 29, 2020, Patent Owner filed a Request for Adverse Judgment Under 37 C.F.R. § 42.73(b)(2). Paper 19. Patent Owner also submitted a copy of the Statutory Disclaimer in the ’210 patent “disclaiming the only claim of the patent.” *Id.* at 1; Ex. 2001.

II. DISCUSSION

Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a proceeding.” As permitted by this Rule, Patent Owner has explicitly asked the Board to enter adverse judgment against Patent Owner under 37 C.F.R. § 42.73(b)(2), viz., “[c]ancellation or

disclaimer of a claim such that the party has no remaining claim in the trial.”
Paper 19. Claim 1 is the only claim at issue in this proceeding. *See* Paper
10, 2, 27.

III. CONCLUSION

Having reviewed Patent Owner’s request for adverse judgment, we
determine that entry of judgment against Patent Owner is appropriate. Thus,
we grant the request for adverse judgment pursuant to 37 C.F.R.
§ 42.73(b)(2). This constitutes a final written decision pursuant to 35 U.S.C.
§ 318(a) cancelling claim 1 of the ’210 patent.

IV. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner
pursuant to 37 C.F.R. § 42.73(b)(2);

FURTHER ORDERED that claim 1 of the ’210 patent is cancelled;

FURTHER ORDERED that this constitutes a Final Written Decision
under 35 U.S.C. § 318(a);

FURTHER ORDERED that Patent Owner shall file a notice and copy
of this judgment in the files of any proceeding or action involving the ’210
patent; and

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3),
Patent Owner is precluded from taking any action inconsistent with this
judgment, including obtaining any patent claim that is not patentably distinct
from cancelled claim 1 in this proceeding.

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