

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASTELLAS US LLC,
Petitioner,

v.

IMPERIAL COLLEGE INNOVATIONS LIMITED,
Patent Owner.

IPR2020-00764
Patent 10,052,317 B2

Before ZHENYU YANG, ROBERT A. POLLOCK, and
RICHARD J. SMITH, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

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

Astellas US LLC (“Petitioner”) filed a Petition, seeking an *inter partes* review of claims 1, 3–10, and 12 of U.S. Patent No. 10,052,317 B2 (“the ’317 patent”). Paper 2. We instituted trial to review the patentability of all challenged claims based on the asserted grounds set forth in the Petition. Paper 7.

In an email to the Board dated December 28, 2020 (Ex. 3001), counsel for Imperial College Innovations Limited (“Patent Owner”) informed us that Patent Owner has, on the same date, filed a statutory disclaimer, disclaiming the entire term of claims 1, 3–10, and 12 of the ’317 patent (*see* Exs. 3002, 3003). As a result, “there are no remaining claims pertaining to this IPR.” Ex. 3001.

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Under the Rules, actions construed as a request for entry of adverse judgment include “[c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. § 42.73(b)(2). Here, Patent Owner has disclaimed, under 37 C.F.R. § 1.321, claims 1, 3–10, and 12 of the ’317 patent, which constitute all challenged claims involved in this trial. We thus construe the statutory disclaimer as a request for entry of adverse judgment.

Having reviewed the statutory disclaimer, we determine that entry of judgment against Patent Owner with respect to claims 1, 3–10, and 12 of the ’317 patent is appropriate.

ORDER

Accordingly, it is

ORDERED that adverse judgment is entered under 37 C.F.R.
§ 42.73(b) against Patent Owner with respect to claims 1, 3–10, and 12 of
the '317 patent; and

FURTHER ORDERED that this proceeding is hereby
TERMINATED.

For PETITIONER:

Richard McCormick
Ying-Zi Yang
MAYER BROWN LLP
rmccormick@mayerbrown.com
yyang@mayerbrown.com

For PATENT OWNER:

Luke Kilyk
KILYK & BOWERSOX, PLLC
lkilyk@kbpatentlaw.com