

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TAKEDA VACCINES, INC.,  
Petitioner,

v.

VALNEVA AUSTRIA GMBH,  
Patent Owner.

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IPR2023-00354  
Patent 11,219,681 B2

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Before WESLEY B. DERRICK, ROBERT A. POLLOCK, and  
JAMIE T. WISZ, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

ORDER  
Denying Authorization of Motion  
37 C.F.R. § 42.5

Takeda Vaccine, Inc. (“Petitioner”) filed a petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–15 and 21–25 (“the challenged claims”) of U.S. Patent No. 11,219,681 B2 (“the ’681 patent”). Valneva Austria GmbH (“Patent Owner”) notified the Board, by email dated March 22, 2021, that it had filed a statutory disclaimer, disclaiming claims 1–15 and 21–25 of the ’681 patent. *See* Ex. 3001. Patent Owner further attached a copy of the statutory disclaimer, indicating its payment of necessary fees. *Id.*; Ex. 3002 (“Statutory Disclaimer”). Patent Owner requested that we advise “if any additional filings are necessary to request termination of IPR2023-00354.” Ex. 3001. Patent Owner copied Petitioner on its email to the Board, thereby informing Petitioner of its intentions. *Id.* Petitioner subsequently requested by email, dated March 24, 2023, that Patent Owner’s disclaimer of claims “be treated as a request for adverse judgment.” *See* Ex. 3003. Petitioner also requested, by email, dated March 28, 2023, that the Board authorize Petitioner to file a motion addressing the effect of Patent Owner’s statutory disclaimer of the challenged claims. Ex. 3004. A conference call with the Board and both parties was held on April 19, 2023. Ex. 1210.

Petitioner argues that we should construe Patent Owner’s disclaimer as a request for adverse judgment, relying on 37 C.F.R. § 42.73(b) and *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018). Ex. 1210, 10:4–11:6, 13:12–16:17. Petitioner contends that *Arthrex* “permits the board to enter an adverse judgment where the patent owner cancels all the claims at issue after an IPR has been filed but before institution decision.” *Id.* at 13:12–16; *see Arthrex*, 880 F.3d at 1350 (“37 C.F.R. § 42.73(b) permits the Board to enter an adverse judgment when a patent owner cancels all claims at issue after an IPR petition has been filed,

but before an institution decision.”). Petitioner further contends that “it would be unfair to allow the patent owner to cancel its claims . . . and pursu[e] patentably indistinct claims in continuation applications.”

Ex. 1210, 12:11–14.

Patent Owner argues that while *Arthrex* would permit the Board to enter adverse judgment upon cancellation of all challenged claims prior to a decision on institution, it does not require it, and that *General Electric Company v. United Technologies Corporation*, IPR2017-00491, Paper 9 (P.T.A.B., July 6, 2017) (precedential, designated September 9, 2019) (“*General Electric*”), is controlling. Ex. 1210, 18:17–19:10, 20:5–13, 20:20–22, 21:8–10. In *General Electric*, upon cancellation of all challenged claims prior to a decision on institution, the Board declined to institute review, but did not enter adverse judgment. *General Electric*, Paper 9 at 3. Patent Owner further contends that, subsequent to *General Electric* being deemed precedential, the Board has consistently declined to enter adverse judgment in cases where all challenged claims were disclaimed prior to a decision on institution, or to even permit additional briefing on the issue. Ex. 1210, 19:6–20:2. With regard to continuing applications, Patent Owner further contends that “the office will be fully apprised of all [Petitioner’s] evidence and arguments when it examines the pending claims” because Patent Owner “has filed an IDS submitting and making of record . . . [the] petition, [Petitioner’s] supporting expert declaration, and all the [cited] prior art.” *Id.* at 21:2–7.

Petitioner fails to persuade us that additional briefing directed to addressing the effect of Patent Owner’s statutory disclaimer of the challenged claims is necessary or helpful, particularly in light of the discussion regarding the relevant authority during the conference call.

ORDER

It is therefore

ORDERED that Petitioner's request for authorization for further briefing is *denied*.

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For PETITIONER:

Eldora L. Ellison  
Olga A. Partington  
Christopher M. Gallo  
STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C.  
Eellison-PTAB@sternekessler.com  
opartington-PTAB@sternekessler.com  
cgallo-PTAB@sternekessler.com

For PATENT OWNER:

Stephen S. Rabinowitz  
John R. Van Amsterdam  
WOLF, GREENFIELD & SACKS, P.C.  
SRabinowitz-PTAB@WolfGreenfield.com  
JVanAmsterdam-PTAB@WolfGreenfield.com