

From: [Olga A. Partington](#)
To: [Trials](#); Stephen.Rabinowitz@WolfGreenfield.com
Cc: [Christopher Gallo](#); [Eldora L. Ellison](#); SRabinowitz-PTAB@WolfGreenfield.com; JVanAmsterdam-PTAB@WolfGreenfield.com; [PTAB Account](#); [PTAB Account](#)
Subject: RE: Takeda Vaccines, Inc. v. Valneva Austria GmbH - Case No. IPR2023-00354
Date: Tuesday, March 28, 2023 11:15:18 AM
Attachments: [image001.png](#)

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Dear Honorable Board,

Takeda thanks the Board for its consideration of this issue and formally requests authorization to file a motion addressing this issue if it may be of benefit to the Board.

Respectfully,
Olga Partington
Back-up Counsel for Petitioner

Olga A. Partington
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: opartington@sternekessler.com
Direct: 202.772.8626

IP Assistant: Debra M. Colonna
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From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, March 28, 2023 8:27 AM
To: Stephen.Rabinowitz@WolfGreenfield.com; Trials <Trials@USPTO.GOV>
Cc: Christopher Gallo <CGALLO@sternekessler.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Olga A. Partington <OPARTINGTON@sternekessler.com>; SRabinowitz-PTAB@WolfGreenfield.com; JVanAmsterdam-PTAB@WolfGreenfield.com; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: Takeda Vaccines, Inc. v. Valneva Austria GmbH - Case No. IPR2023-00354

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Counsel,

The Board understands the Parties' positions. Nothing further is required at this time. A decision will issue in due course.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Stephen.Rabinowitz@WolfGreenfield.com <Stephen.Rabinowitz@WolfGreenfield.com>
Sent: Friday, March 24, 2023 6:30 PM
To: Trials <Trials@USPTO.GOV>
Cc: Christopher Gallo <CGALLO@sternekessler.com>; Eldora L. Ellison
<EELLISON@sternekessler.com>; Olga A. Partington <OPARTINGTON@sternekessler.com>;
SRabinowitz-PTAB@WolfGreenfield.com; JVanAmsterdam-PTAB@WolfGreenfield.com
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RE: Takeda Vaccines, Inc. v. Valneva Austria GmbH
Case No. IPR2023-00354

Dear Honorable Board,

Patent Owner respectfully objects to Petitioner's email of March 24, 2023 as presenting improper substantive argument by email.

If it is considered, Patent Owner responds that Petitioner's email fails to acknowledge or address the Board's precedential decision in *General Electric Co. v. United Technologies Corp.*, IPR2012-00491, Paper 9, 3 (PTAB July 6, 2017) (designated as precedential Sept. 9, 2019), which determined that "[b]ecause all claims challenged by GE have been disclaimed . . . no *inter partes* review is instituted in this proceeding." Since this decision was made precedential, the Board has repeatedly followed *General Electric* by denying institution – and declining to enter adverse judgment – in cases where the patent owner has filed a pre-institution disclaimer of all the challenged claims. See, e.g., *Select Sires, Inc. v. ABS Global Inc.*, PGR2022-00019, -00020, Paper 10, 2-3 & n. 3 (PTAB June 28, 2022); *Kymera Therapeutics, Inc. v. Dana-Farber Cancer Inst.*, PGR2021-00115, Paper 13, 2-3 (PTAB March 2, 2022); *Google LLC v. Jenam Tech. LLC*, PGR2021-00082, Paper 8, 2-3 & n.1 (PTAB Nov. 17, 2021). Petitioner cites no instance in which the Board granted the relief it requests, under these circumstances, after the date *General Electric* was made precedential, and Patent Owner is not aware of any such instance.

To the extent that the Board is inclined to entertain Petitioner's request, Patent Owner requests a conference call to respond more fully.

Respectfully,
Stephen Rabinowitz
Counsel for Petitioner

From: Christopher Gallo <CGALLO@sternekessler.com>

Sent: Friday, March 24, 2023 11:32 AM

To: Trials@uspto.gov

Cc: Eldora L. Ellison <EELLISON@sternekessler.com>; Olga A. Partington <OPARTINGTON@sternekessler.com>; PTAB Stephen Rabinowitz <SRabinowitz-PTAB@WolfGreenfield.com>; PTAB John Van Amsterdam <JVanAmsterdam-PTAB@WolfGreenfield.com>

Subject: RE: Takeda Vaccines, Inc. v. Valneva Austria GmbH - Case No. IPR2023-00354

RE: IPR2023-00354

Dear Honorable Board,

Petitioner requests that Patent Owner's Statutory Disclaimer of claims 1-15 and 21-25 of U.S. Patent No. 11,219,681 in response to Petitioner's Petition for *inter partes* review of those claims be treated as a request for adverse judgment in view of Patent Owner pursuing patentably indistinct claims in U.S. Appl. No. 17/548,721, which is a continuation of the '681 patent. *Google LLC v. SEVEN Networks, LLC*, IPR2018-01104, Paper 10, 4-5 (PTAB Dec. 6, 2018) (agreeing with petitioner "that 'it would be unfair if Patent Owner were able to avoid Petitioner's challenge through a statutory disclaimer and then pursue patentably indistinct claims in its continuation applications.'"). In *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir. 2018), the Federal Circuit held that the Board is permitted to enter an adverse judgment when a patent owner cancels all claims at issue in an *inter partes* review petition before the Board has entered a decision on institution. If needed, Petitioner can be available for a conference call at the Board's convenience.

Respectfully,

Christopher Gallo

Back-up Counsel for Petitioner

Christopher M. Gallo, Ph.D. (he/him)

Counsel

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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Assistant: Tamara Haynesworth (202.772.8775)

From: Stephen.Rabinowitz@WolfGreenfield.com <Stephen.Rabinowitz@WolfGreenfield.com>

Sent: Wednesday, March 22, 2023 4:57 PM

To: Trials@uspto.gov

Cc: Eldora L. Ellison <EELLISON@sternekessler.com>; Christopher Gallo <CGALLO@sternekessler.com>; Olga A. Partington <OPARTINGTON@sternekessler.com>; SRabinowitz-PTAB@WolfGreenfield.com; JVanAmsterdam-PTAB@WolfGreenfield.com

Subject: Takeda Vaccines, Inc. v. Valneva Austria GmbH - Case No. IPR2023-00354

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RE: Takeda Vaccines, Inc. v. Valneva Austria GmbH
Case No. IPR2023-00354

Dear Honorable Board,

The attached Statutory Disclaimer Under 37 CFR 1.321(a) was filed yesterday with the U.S. Patent and Trademark Office. Patent Owner disclaimed claims 1-15 and 21-25 of U.S. Patent No. 11,219,681 and, therefore, no challenged claims remain in IPR2023-00354.

Please let us know if any additional filings are necessary to request termination of IPR2023-00354.

Thank you



Stephen S. Rabinowitz

Counsel

212-849-3356

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