

Date Filed: August 6, 2024

Filed on Behalf Of:

Novartis Pharmaceuticals Corporation

By:

Nicholas N. Kallas

nkallas@venable.com

(212) 218-2243

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioner,

v.

REGENTS OF THE UNIVERSITY OF MICHIGAN AND
UNIVERSITY OF SOUTH FLORIDA,
Patent Owners.

Case IPR2023-01347
U.S. Patent No. 10,633,344

PETITIONER'S UNOPPOSED MOTION FOR ADVERSE JUDGMENT

Novartis Pharmaceuticals Corporation (“Petitioner”) respectfully requests entry of adverse judgment against the Regents of the University of Michigan and the University of South Florida (“Patent Owners”) as to claim 16 of U.S. Patent No. 10,633,344 (“the ’344 patent”). Patent Owners do not oppose this request. Ex. 1590 (Kane E-mail, July 24, 2024). On July 31, 2024, the Board granted Petitioner’s request for authorization to file this unopposed motion. Ex. 1591 (Board E-mail, July 31, 2024).

I. BACKGROUND

On March 13, 2024, the Board granted institution of *inter partes* review with respect to claim 16 of the ’344 Patent—the sole challenged claim in IPR2023-01347. Paper 8.

In their June 5, 2024, Patent Owners’ Response, Patent Owners stated that they had “disclaimed all interest in claim 16.” Paper 19 at 1, citing Ex. 2003.¹ On June 6, 2024, Patent Owners filed a disclaimer of claim 16 with the U.S. Patent Office (Ex. 1592, Transmittal Letter, Statutory Disclaimer, and Payment Receipt filed June 6, 2024, accessed via Patent Center).

¹ Ex. 2003, dated June 5, 2024, appears to be a draft of the June 6, 2024 disclaimer filed with the U.S. Patent Office (Ex. 1592). Like the June 6, 2024 disclaimer, the disclaimer in Ex. 2003 disclaims claim 16.

II. ARGUMENT

Under 37 C.F.R. § 42.73(b), “disclaimer of a claim such that the party has no remaining claim in the trial” is “construed to be a request for adverse judgment.”

37 C.F.R. § 42.73(b). Here, Patent Owner has disclaimed the sole challenged claim in IPR2023-01347 such that there are no remaining claims at issue in this proceeding.² See Ex. 1592. The disclaimer filed by Patent Owners meets the requirements set forth in 37 C.F.R. § 1.321(a) because it (1) was signed by an attorney of record, Edward R. Gates, (2) identifies the patent and claim being disclaimed, claim 16 of the ’344 patent, (3) states the patentee’s ownership interest in the patent (100%), and (4) was accompanied by the requisite fee. Ex. 1592; 37 C.F.R. § 1.321(a); see *Early Warning Services, LLC v. Fintech Innovation Assocs. LLC*, PGR2022-00046, Paper 18 at 3 (P.T.A.B. Feb. 17, 2023). Therefore, adverse judgment is appropriate. Cf. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1349 (Fed. Cir. 2018) (“[37 C.F.R.] § 42.73(b) gives the Board authority to construe a patent owner’s actions as a request for an adverse judgment.”). Under such circumstances, the Board routinely grants requests for adverse judgment. See,

² Claims 10, 11, and 18 of the ’344 patent have been challenged in a separate IPR proceeding, IPR2023-01346. Patent Owners have not disclaimed claims 10, 11, or 18.

e.g., Early Warning Services, LLC, PGR2022-00046, Paper 18 at 2 (“Because a statutory disclaimer of the sole claim in a proceeding is construed as a request by a patent owner for adverse judgment against itself pursuant to 37 C.F.R. § 42.73(b)... we enter adverse judgment against Patent Owner.”); *Resideo Techs. Inc. v. Ubiquitous Connectivity, LP*, IPR2021-01355, Paper 26 (P.T.A.B. Nov. 9, 2022); *Auris Health, Inc. v. Intuitive Surgical Operations, Inc.*, IPR2019-01547, Paper 31 (P.T.A.B. July 22, 2022); *Cloudflare, Inc. v. Sable Networks, Inc.*, IPR2021-00969, Paper 29 (P.T.A.B. June 13, 2022).

Accordingly, Petitioner respectfully requests the Board grant Petitioner’s unopposed motion for adverse judgment against Patent Owner as to claim 16 of the ’344 patent and terminate the present proceedings.

Date: August 6, 2024

/Nicholas N. Kallas/
Nicholas N. Kallas (Reg. No. 31,530)
VENABLE LLP
151 W. 42nd Street, 49th Floor
New York, NY 10036
Telephone: (212) 218-2243
Facsimile: (212) 218-2200
nkallas@venable.com

*Lead Counsel for Petitioner, Novartis
Pharmaceuticals Corporation*

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Petitioner's Unopposed Motion For Adverse Judgment, all supporting exhibits, and Petitioner's Updated Exhibit List were served on August 6, 2024 via electronic mail on the following counsel of record for Patent Owners:

Lead Counsel

Michael Kane
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
Phone: 202-783-5070
Fax: 877-769-7945
kane@fr.com
IPR51957-0001IP1@fr.com

Back-up Counsel

Kelly Del Dotto
Ahmed Davis
Taylor Burgener
Jacqueline Moran
60 South Sixth Street
Minneapolis, MN 55402
Phone: 202-783-5070
Fax: 877-769-7945
allenspach.del.dotto@fr.com
adavis@fr.com
burgener@fr.com
jtmoran@fr.com
IPR51957-0001IP1@fr.com

Date: August 6, 2024

/Nicholas N. Kallas/
Nicholas N. Kallas (Reg. No. 31,530)
VENABLE LLP
151 W. 42nd Street, 49th Floor
New York, NY 10036
Telephone: (212) 218-2243
Facsimile: (212) 218-2200
nkallas@venable.com

*Lead Counsel for Petitioner, Novartis
Pharmaceuticals Corporation*