

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UCB, INC.
Petitioner,

v.

GENENTECH, INC.
Patent Owner.

Case PGR2019-00044
Patent 10,011,654 B2

Before SUSAN L. C. MITCHELL, CRISTOPHER G. PAULRAJ, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

JUDGMENT AND FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

I. INTRODUCTION

On April 1, 2019, UCB, Inc., (“Petitioner”) filed a Petition for Post Grant Review of claims 1–7 of U.S. Patent No. 10,011,654 B2 (“the ’654 patent,” Ex. 1001). Paper 1. Genentech, Inc. (“Patent Owner”) timely filed a Preliminary Response to the Petition. Paper 7. On October 7, 2019, we instituted post grant review of claims 1–7 of the ’654 patent. Paper 12. On February 24, 2020, Patent Owner filed a Request for Adverse Judgment (“the Request” or “Patent Owner’s Request”). Paper 19.

II. DISCUSSION

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Here, Patent Owner has expressly requested judgment against itself “pursuant to 37 C.F.R. § 42.73(b)(4).” Paper 19. Petitioner does not oppose Patent Owner’s request. Paper 21. Accordingly, entry of judgment adverse to the Patent Owner is appropriate.

Having determined that entry of judgment is appropriate, we turn now to the form of that judgment. In an authorized Response to Patent Owner’s Request, Petitioner requests that in entering adverse judgment, we do so “based on the current record (*e.g.*, by referencing the reasons in the Institution Decision (Paper No. 12)) rather than cancelling the claims *pro forma*.” *Id.* Paper 21, 1. Petitioner contends that the Board has the authority to “to state its reasons for judgment, even when Patent Owner has abandoned its claims” and that “35 U.S.C. § 328(a) obligates the Board to do so.” *Id.* (citing *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-01488, Paper No. 87, 29 (PTAB Nov. 29, 2018)). Petitioner argues that granting judgment “on the merits” would “reduce the risk of . . . wasteful and vexatious litigation.” *Id.* at 1–2. We decline Petitioner’s invitation to provide independent

reasoning for the unpatentability of the claims at issue apart from Patent Owner's abandonment of the contest.

As an initial matter, we disagree with Petitioner that 35 U.S.C. § 328(a) obligates us to state the reasons for judgment where a request for adverse judgment has been filed. To the extent 35 U.S.C. § 328(a) requires that we provide reasons for entering judgment, Patent Owner's request that we enter judgment itself provides sufficient reason. We do not discern anything in the statute that obligates us to issue a final written decision containing our independent assessment of the patentability of the claims where a party has requested adverse judgment against itself.

Having determined that we are not obligated to issue a final written decision with our independent reasoning concerning the patentability of the challenged claims, we decline to consider whether we have the discretion to issue such a decision because we agree with the Patent Owner that, in this case, it would be inappropriate to do so. Patent Owner's Request was filed early in this proceeding, before a Patent Owner Response was filed and before the panel had the opportunity to gain familiarity with the trial record (which, at this point, remains incomplete). Although we did make a determination in our institution decision that "the information presented in the Petition establishes that it is more likely than not that Petitioner will prevail in showing that at least claim 1 of the '654 patent is unpatentable" (Paper 12, 20), that decision was a preliminary determination. *See, Cuzzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131, 2140 (2016) (noting that the "decision to initiate inter partes review is 'preliminary,' not 'final.'"). The circumstances of this case do not justify conversion of our preliminary determination into a final decision addressing the patentability of the

challenged claims or that we otherwise adopt the reasoning set forth in our institution decision, which was based on an incomplete record.

Accordingly, on the record before us in which Patent Owner has abandoned the contest, we enter adverse judgment against Patent Owner pursuant to 37 C.F.R. § 42.73(b) in the above-identified proceeding.

II. ORDER

Accordingly, it is:

ORDERED that Patent Owner's Request for Adverse Judgment pursuant to 37 C.F.R. § 42.73(b)(4) is *granted*;

FURTHER ORDERED that adverse judgment against the Patent Owner is entered under 37 C.F.R. § 42.73(b)(4);

FURTHER ORDERED that this constitutes a final written decision under 35 U.S.C. § 318(a); and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2017-01621
Patent 9,358,240 B2

For PETITIONER:

James S. Trainor
Robert E. Counihan
FENWICK & WEST LLP
jtrainor@fenwick.com
rcounihan-ptab@fenwick.com

For PATENT OWNER:

Matthew I. Kreeger
Parisa Jorjani
Stephanie L. Blij
MORRISON & FOERSTER LLP
mkreeger@mofo.com
pjorjani@mofo.com
sblij@mofo.com