

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYMERA THERAPEUTICS, INC.,
Petitioner,

v.

DANA-FARBER CANCER INSTITUTE, INC.,
Patent Owner.

PGR2021-00115
Patent 10,849,980 B2

Before ERICA A. FRANKLIN, CHRISTOPHER G. PAULRAJ, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

DECISION

Denying Institution of Post-Grant Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 324; 37 C.F.R. § 42.207(e)

I. INTRODUCTION

Petitioner Kymera Therapeutics, Inc. filed a Petition requesting a post-grant review of all claims (claims 1–45) of U.S. Patent No. 10,849,980 B2 (“’980 patent,” Ex. 1001). Paper 1. Patent Owner Dana-Farber Cancer Institute, Inc. filed a Preliminary Response, together with a disclaimer of all claims of the ’980 patent, and requested that the Board deny the Petition due to the disclaimer. Paper 6 (“Prelim. Resp.”) 1; Ex. 2001 (disclaimer). With our authorization, the parties briefed whether the Board should enter adverse judgment against Patent Owner due to the disclaimer. Papers 7–9.

We have authority under 35 U.S.C. § 324 and 37 C.F.R. § 42.4(a). For the reasons discussed below, we deny the Petition for post-grant review and decline to enter adverse judgment.

II. ANALYSIS

Patent Owner has disclaimed all claims of the ’980 patent and paid the requisite fee. *See* Ex. 2001; 37 CFR § 1.321 (setting forth requirements for statutory disclaimer). Accordingly, we must deny institution of the requested post-grant review. 37 C.F.R. § 42.207(e) (“No post-grant review will be instituted based on disclaimed claims.”); *General Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (designated precedential on Sept. 9, 2019) (denying institution of *inter partes* review under analogous rule 37 C.F.R. § 42.107(e) based on disclaimer) (“*General Electric*”).

Petitioner argues that pursuant to 37 C.F.R. § 42.73(b), we should construe Patent Owner’s disclaimer as a request for adverse judgment. Paper 8, 1. Petitioner correctly notes that in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir. 2018), the Federal Circuit

construed Rule 42.73(b) to permit the Board to enter adverse judgment when a patent owner cancels all claims prior to institution. *Id.* However, we do not read *Arthrex* or Rule 42.73(b) as requiring us to enter adverse judgment in this context. Here, consistent with Rule 42.207(e) and the Board's precedential *General Electric* decision, we determine that a denial of institution is sufficient to dispose of this case. *See also General Elec. Co. v. United Techs. Corp.*, IPR2019-01489, Paper 11 at 4–5 (Dec. 10, 2019) (denying institution based on disclaimer and declining authorization to file motion for adverse judgment); *Google LLC v. Jenam Tech LLC*, PGR2021-00082, Paper 8 at 2 n.1 (Nov. 17, 2021) (denying institution based on disclaimer and declining petitioner's request to file additional briefing regarding adverse judgment).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that no post-grant review is instituted.

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Patent 10,849,980 B2

For PETITIONER:

Amanda Antons
Charles Hsu
DECHERT LLP
amanda.antons@dechert.com
charles.hsu@dechert.com

For PATENT OWNER:

Christopher Schultz
Daniel Clarke
BURNS & LEVINSON LLP
cschultz@burnslev.com
dclarke@burnslev.com