

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SELECT SIRES INC., SEMEX ALLIANCE, INC., URUS GROUP LP,
AND INGURAN, LLC D/B/A STGENETICS,
Petitioner,

v.

ABS GLOBAL, INC.,
Patent Owner.

PGR2022-00019 (Patent 10,975,351 B2)
PGR2022-00020 (Patent 10,982,187 B2)¹

Before ULRIKE W. JENKS, SUSAN L. C. MITCHELL, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

JENKS, *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)

¹ This Decision addresses issues that are the same in both captioned proceedings. We exercise our discretion to issue one Decision to be filed in each proceeding. The parties are not authorized to use this style of heading in subsequent papers.

On June 1, 2022, Patent Owner ABS Global Inc. (“Patent Owner”) notified the Board, via an email, that it filed a Notice of Disclaimer with the U.S. Patent and Trademark Office, disclaiming all claims of US 10,975,351 B2 (“the ’351 patent”) and US 10,982,187 B2 (“the ’187 patent”). *See* Exs. 3001–3003². Patent Owner indicated that Petitioner³ was notified of the filing of the disclaimers. *See* Ex. 3001 (“Counsel for Petitioner is copied on this email.”). In its email, Patent Owner stated that, in view of its statutory disclaimer of all of the claims of the ’351 patent and the ’187 patent, Patent Owner understood that the Board would terminate the post grant review proceedings associated with each patent. Ex. 3001.

Patent Owner has disclaimed all claims of the ’351 patent and the ’187 patent and paid the requisite fees. *See* Ex. 3002 and Ex. 3003; *see also* 37 C.F.R. § 1.321 (setting forth requirements for statutory disclaimer). Accordingly, we deny institution of the requested post-grant review. *See* 37 C.F.R. § 42.207(e) (“No post-grant review will be instituted based on disclaimed claims.”); *see also General Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (denying

² Exhibit numbers refer to proceeding PGR2022-00019. Corresponding Exhibits were entered in PGR2022-00020.

³ We acknowledge Petitioner’s request to treat the terminal disclaimer as a request for adverse judgment (*see* Ex. 3004). However, because there are no pending claims for us to consider, we decline Petitioner’s request for further briefing. *See 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 upon disclaimer and declining petitioner’s request to file additional briefing regarding adverse judgment).

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institution of *inter partes* review under analogous rule 37 C.F.R. § 42.107(e) based on disclaimer) (“*General Electric*”).

In the present instance, and 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 Kymera Therapeutics, Inc. v. Dana-Farber Cancer Institute, Inc.*, PGR2021-00115, Paper 13 at 3 (March 2, 2022) (denying institution based upon disclaimer of all claims of the challenged patent); *Celltrion Inc. v. Regeneron Pharmaceuticals Inc.*, PGR2021-00117, Paper 16 at 3 (March 15, 2022) (denying institution based on disclaimer of all claims). Because the Board cannot institute trial on disclaimed claims and all the challenged claims have been disclaimed here, no post-grant review will be instituted.

ORDER

It is therefore

ORDERED that the Petition is *denied* and no post-grant review is instituted.

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