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Paper 25
Date: July 25, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DAIICHI SANKYO, INC. AND
ASTRAZENECA PHARMACEUTICALS, LP,
Petitioner,

v.

SEAGEN INC.,
Patent Owner.

PGR2021-00042
Patent 10,808,039 B2

Before ERICA A. FRANKLIN, SHERIDAN K. SNEDDEN, and CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

JUDGMENT
Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

I. DISCUSSION

Daiichi Sankyo, Inc. and AstraZeneca Pharmaceuticals, LP (collectively "Petitioner") filed a Petition requesting a post-grant review of claims 6–8 of U.S. Patent No. 10,808,039 B2 (Ex. 1001, "the '039 patent"). Paper 1 ("Pet."). Seagen Inc. ("Patent Owner") filed a Preliminary Response to the Petition. Paper 8 ("Prelim. Resp."). Petitioner filed a Reply to Patent Owner's Preliminary Response. Paper 9 ("Reply"). Patent Owner filed a Sur-reply to Petitioner's Reply. Paper 10 ("Sur-reply"). Upon consideration of the information presented by the parties, we exercised our discretion to deny institution under 35 U.S.C. § 324(a) in view of the scheduled trial date of a parallel district court proceeding being nearly four months before our projected statutory deadline for issuing a final written decision, and other *Fintiv*[1] factors. Paper 12.

Petitioner filed a Request for Rehearing, asking us to reconsider our Denial Decision because Patent Owner dropped claims 6–8 of the '039 patent—the claims at issue here—from its infringement contentions in the parallel district court proceeding. Paper 13 ("Reh'g Req." or "Request"), 4–5. Concurrently therewith, Petitioner requested that the Board's Precedential Opinion Panel ("POP") reconsider the Denial Decision. Paper 14; Ex. 3001 ("POP Request"). The POP declined to review the issues raised in Petitioner's POP Request. Paper 17. Upon consideration, we granted Petitioner's Request for Rehearing and instituted post-grant review. Paper 18.

[1] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv* Order").

During the trial, Patent Owner filed a Request for Adverse Judgment Under 37 C.F.R. § 42.73(b)(2). Paper 24. Patent Owner also filed a statutory disclaimer of claims 6–8. Ex. 2041. A disclaimer is "considered as part of the original patent" as of the date on which it is "recorded" in the Office. 35 U.S.C. § 253(a). For a disclaimer to be "recorded" in the Office, the document filed by the patent owner must:

> (1) Be signed by the patentee, or an attorney or agent of record;
>
> (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
>
> (3) State the present extent of patentee's ownership interest in the patent; and
>
> (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a). "[N]othing in the statutes or regulations requires any action by the [Patent Office] for a disclaimer to be 'recorded.'" *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998). From our review of Exhibit 2041 and the Office's public records, we conclude that a disclaimer of claims 6–8 of the '039 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of April 20, 2022. Ex. 2041.

Having reviewed Patent Owner's request for adverse judgment due to statutory disclaimer of claims 6–8, we determine that entry of judgment against Patent Owner is appropriate. Our Rules provide that "[a]ctions construed to be a request for adverse judgment include: . . . [c]ancellation or disclaimer of a claim such that the party has no remaining claim in the trial." 37 C.F.R. § 42.73(b)(2). Patent Owner's disclaimer of claims 6–8 leaves no claims remaining in the trial. Thus, we grant the request for adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2).

II. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner under 37 C.F.R. § 42.73(b)(2).

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