

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLTRION, INC.,
Petitioner,

v.

REGENERON PHARMACEUTICALS, INC.,
Patent Owner.

IPR2023-00620
Patent 10,406,226 B2

Before JOHN G. NEW, SUSAN L. C. MITCHELL, and ROBERT A. POLLOCK,
Administrative Patent Judges.

MITCHELL, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314; 37 C.F.R. §§ 42.107(e)

I. INTRODUCTION

Celltrion, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–4 of U.S. Patent No. 10,406,226 B2 (Ex. 1001, “the ’226 patent”). Paper 2 (“Pet.”). Regeneron Pharmaceuticals, Inc. (“Patent Owner”) did not file a Preliminary Response. Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons described below, we deny institution of *inter partes* review of any claims.

II. DISCUSSION

Patent Owner filed a statutory disclaimer of claims 1–4 of the ’226 patent. Ex. 2001. With the Board’s authorization, Patent Owner filed a Motion to Terminate Proceeding. Paper 8 (“Motion”). Patent Owner indicated that Petitioner does not oppose the Motion. *Id.* at 3.

Under 37 C.F.R. § 42.107(e), “patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent” and “[n]o *inter partes* review will be instituted based on disclaimed claims.” A disclaimer under 35 U.S.C. § 253(a) 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); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that § 253 disclaimer is immediately “recorded” on date that Office receives disclaimer meeting requirements of 37 C.F.R. § 1.321(a) and that no further action is required in the Office).

Based on our review of Exhibit 2001, the Motion, and Office public records, we conclude that a disclaimer of claims 1–4 of the '226 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of August 4, 2023. Ex. 2001. Because all claims challenged by Petitioner have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted in this proceeding. 37 C.F.R. § 42.107(e).

III. ORDER

Accordingly, it is

ORDERED that no *inter partes* review is instituted for any claim challenged by Petitioner in U.S. Patent No. 10,406,226 B2.

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