

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ETHICON, INC.,
Petitioner,

v.

BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM,
Patent Owner.

IPR2019-00407
Patent 7,033,603 B2

Before SUSAN L. C. MITCHELL, AVELYN M. ROSS,
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

JUDGMENT
Request for Adverse Judgment
37 C.F.R. § 42.73(b)

Ethicon, Inc. (“Petitioner”) filed a Petition (“Pet.”) to institute an *inter partes* review of claims 1, 2, 6, 11, 13, and 19 of U.S. Patent No. 7,033,603 B2 (Ex. 1001, “the ’603 patent”). Paper 1. The Board of Regents, The University of Texas System (“Patent Owner”) did not file a preliminary response to the Petition.

On June 10, 2020, we instituted trial as to all challenged claims. Paper 29. Patent Owner filed a Patent Owner Response stating that on September 2, 2020, Patent Owner filed a statutory disclaimer in the Office disclaiming all challenged claims of the ’603 patent. Paper 31, 3. Patent Owner notes that no challenged claim remains in this proceeding, and requests termination of the proceeding. *Id.* at 4. Patent Owner concludes that “[p]ursuant to 37 C.F.R. § 42.73(b)(2), Patent Owner respectfully requests the Board terminate IPR2019-00407 and enter judgment in the IPR.” *Id.* at 5.

Under 35 U.S.C. § 253(a), a patentee may disclaim its whole interest or any sectional interest in any patent claim. When a party in an *inter partes* review disclaims all the claims at issue in the proceeding, we construe the disclaimer as a request for adverse judgment. 37 C.F.R. 42.73(b)(1)–(2). Because Patent Owner has explicitly requested adverse judgment against itself pursuant to Rule 42.73(b)(2), and has statutorily disclaimed all claims in the ’603 patent that were challenged in this proceeding, Patent Owner’s request for adverse judgment is granted.

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Accordingly, it is hereby:

ORDERED that judgment is herein entered against Patent Owner with respect to claims 1, 2, 6, 11, 13, and 19 of the '603 patent;

FURTHER ORDERED that the instant proceeding is terminated; and

FURTHER ORDERED that claims 1, 2, 6, 11, 13, and 19 of the '603 patent are herein *cancelled*.

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FOR PETITIONER:

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