

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNAFFIX B.V.,
Petitioner,

v.

HANGZHOU DAC BIOTECH CO., LTD.,
Patent Owner.

IPR2022-01531
Patent 10,131,682 C1

Before ZHENYU YANG, DEVON ZASTROW NEWMAN, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

SynAffix B.V. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–17, 20, 21, 24–26, and 29–34 of U.S. Patent No. 10,131,682 C1 (Ex. 1001, “the ’682 patent”). On August 22, 2023, we (“the panel”) issued a decision denying institution of *inter partes* review. Paper 17 (“the Decision,” “the prior Decision,” “Dec.”).

On September 21, 2023, Petitioner filed a request for Director Review. Paper 18 (“Petitioner’s Request”).

On November 16, 2023, the Director issued an Order delegating the Director Review of the Decision to a Delegated Rehearing Panel. Paper 19. Also on November, 16, 2023, the Board issued an Order identifying the Delegated Rehearing Panel (“the DRP”). Paper 20.

On November 17, 2023, the DRP issued an Order providing Hangzhou DAC Biotech Co., Ltd. (“Patent Owner”) the option to file a response to Petitioner’s Request, including on the issue of whether there is a prosecution history disclaimer. Paper 21. On November 22, 2023, the DRP extended the deadline for a response. *See* Ex. 3003; Ex. 3004. On December 15, 2023, Patent Owner filed a response. Paper 22.

On March 4, 2024, the DRP issued a decision granting rehearing, modifying the construction of claim 1 of the ’682 patent, vacating the prior Decision, and remanding to the panel for further proceedings. Paper 23 (“DRP Decision,” “DRP Dec.”).

In the DRP Decision, the DRP provided analysis based on its review of Petitioner’s Request (DRP Dec. 8–16), and “conclude[d], on the present record, that the Applicant made a clear and unmistakable prosecution history disclaimer, which was essentially commensurate in scope with the March 20, 2018 claim amendment.” *Id.* at 16. The DRP further

conclude[d] that the amendment to claim 1 was predicated on an understanding, by both the Examiner and the Applicant, that, when there is a terminal vinylsulfone, Y (or Z) is mapped to vinyl, and Q (or T) is mapped to sulfone, such that there must be at least one additional phosphinate, sulfonyl, or sulfoxide group as Q (or T).

Id. The DRP did “not reach Petitioner’s arguments as to claim 3,” but noted that “[o]n remand, the prior Decision’s findings as to claim 3 may need to be reconsidered in view of the revised construction of claim 1.” *Id.*

The DRP then “[o]rdered that rehearing is *granted*; . . . that the claim construction is modified; . . . that the Decision (Paper 17) is vacated; and . . . that the case is remanded to the panel for further proceedings consistent with this opinion.” Paper 23 at 16; *see also id.* at 2.

Pursuant to the Revised Interim Director Review Process,¹ including the Delegated Rehearing Panel Process,² and Standard Operating Procedure 3³, the panel will issue an institution decision on remand on or before September 4, 2024.

ORDER

Accordingly, it is:

¹ <https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process> (last visited on March 5, 2024).

² <https://www.uspto.gov/patents/ptab/decisions/delegated-rehearing-panel> (last visited on March 5, 2024).

³ https://www.uspto.gov/sites/default/files/documents/ptab_sop_3-2023-oct.pdf (last visited on March 5, 2024).

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ORDERED that an institution decision on remand will issue on or
before September 4, 2024.

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