

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHANGHAI HONGENE BIOTECH CORPORATION,
Petitioner

v.

CHEMGENES CORPORATION,
Patent Owner

Case IPR2023-00490
U.S. Patent No. 9,884,885

PETITIONER'S MOTION TO STAY REISSUE APPLICATION

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Petitioner Shanghai Hongene Biotech Corporation respectfully moves for a stay of post-petition Reissue Application No. 18/130,902 (“Reissue”), filed by the Patent Owner Chemgenes Corp. with respect to U.S. Patent 9,884,855 B2 (“’855 patent”), upon which the Board instituted this IPR.

During the initial conference on July 26, 2023, the Panel asked if Patent Owner would consent to staying the Reissue. Patent Owner refused. The Panel then granted Petitioner leave to file this motion.

I. INTRODUCTION

The Board has instituted review on all five of the claims of the ’855 patent. Paper 7, 19. In the Reissue, however, Patent Owner does not seek to amend claims 2 and 3.¹ Accordingly, the parallel IPR and Reissue examination pose a substantial risk of *duplicative effort and inconsistent results* with respect to claims 2 and 3. And as to proposed amended claims 1, 4 and 5, Patent’s Owner’s proposed amendments could *change the scope of the claims while the Board is in the midst of its review. Id.* Further, because the IPR final decision will address obviousness, and all of the issues encompassed by obviousness, completion of the IPR likely will *simplify Reissue examination*. Finally, Patent Owner will *not suffer any cognizable prejudice* as a result of the stay.

¹ See Exhibit 1031 ("Declaration of Jeremy J. Edwards in Support of Petitioner's Stay Motion to Stay Reissue Application") and Exhibit 1032 ("Reissue Preliminary Amendment") at 5-7, 15.

II. ARGUMENT

A. Controlling Law

The Board has discretionary authority to stay a reissue application during the pendency of an IPR of the underlying patent. *See* 35 U.S.C. §315(d), 37 C.F.R. § 42.122; 37 C.F.R. § 42.3. The Board consistently has exercised its discretionary authority to stay prosecution of post-petition reissue applications with respect to patents upon which IPRs have been instituted.

Such concurrent proceedings are stayed, *inter alia*, to avoid inefficiency, to avoid inconsistent results, and to simplify reissue proceedings as a result of the guidance provided by the *inter partes* review decision. *See Hewlett-Packard Co. v. MCM Portfolio LLC*, IPR2013-00217, Paper 8, 2-3 (PTAB May 10, 2013).

B. The Requested Stay Would Avoid Duplicative Effort and Risk of Inconsistent Results.

The Reissue contains the same claims 2 and 3 upon which the Board instituted this IPR. (*See* Exhibit 1031 and Exhibit 1032 at 5-7, 15.) Hence, without a stay, the Board in this IPR and the examiner in the Reissue will be evaluating the patentability of the same two claims at the same time. Such duplicative effort and the resulting risk of inconsistent results provide ample basis for a stay. *See, e.g., Unified Patents Inc. v. Harry Heslop and Sportbrain Holdings, LLC*, IPR2016-01464, Paper 13, 2 (PTAB Feb. 10, 2017); *Acrux DDS PTY Ltd. v. Kaken Pharmaceutical Co., Ltd.*, IPR2017-00190, Paper 31, 3 (PTAB Aug. 31, 2017);

Legend3D, Inc. v. Prime Focus Creative Services Canada, Inc., IPR2016-00806, Paper 38, 3-4 (PTAB Feb. 2, 2017).

C. The Requested Stay is Needed to Prevent Patent Owner from Interfering with the IPR by Changing the Scope of Claims While the IPR is in Process.

The Board has not hesitated to stay reissue proceedings in which the proposed amended claim and proposed new claim in the reissue application could “chang[e] the scope of the claim while the Board is conducting its review.” *Bio-Rad Laboratories, Inc. v. GE Healthcare Bio-Sciences AB*, IPR2015-01826, Paper 18, 3 (PTAB April 8, 2016); *Dermira, Inc. v. Purepharm, Inc.*, IPR2015-01593, Paper 24, 3 (PTAB June 7, 2016). Here, Patent Owner’s requested amendments of claims 1, 4 and 5 in the Reissue threaten to change the scope of the claims under review, while the Board is conducting its review of the claims – thus presenting the Board and Petitioner with a moving target. This, too, favors staying the reissue proceedings.

D. The Requested Stay Will Simplify Subsequent Reissue Examination.

The Board recognizes that a stay is appropriate where “any final written decision in [a] *inter partes* review with respect to the patentability of the challenged claims may simplify the issues in the reissue application.” *Acrux DDS PTY Ltd.*, IPR2017-00190, Paper 31, 3. This IPR will include obviousness of the challenged claims, and resolution of factual and legal issues attendant to

obviousness, such as person of ordinary skill, scope of the prior art, motivation to combine, reasonable expectation of success, and secondary considerations. In determining the validity of claims 1-5 in the Reissue (as well as the sixty new claims), the Examiner likely will get significant guidance from a final written decision in the IPR.

E. The Requested Stay Will Not Prejudice Patent Owner.

Patent Owner will not suffer any cognizable prejudice by virtue of the requested stay. Any alleged “prejudice” arising from a potential delay in prosecuting the Reissue is outweighed by the potential for conflicting results and duplicative efforts. *See Legend3D, Inc.*, IPR2016-00806, Paper 38, 3-4. And even if Patent Owner has a cognizable pressing need for speed, the Patent Owner could and should avail itself of the provisions made in this IPR proceeding for amending claims.

III. CONCLUSION

The Board should stay prosecution of the Reissue for any one, some, or all of the foregoing grounds.

Respectfully submitted,
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP

Dated: August 9, 2023

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CERTIFICATE OF SERVICE

I, the undersigned, hereby certify that a copy of the above Petitioner's Motion to Stay Reissue Application, along with all exhibits supporting and filed with the Motion, were served on August 9, 2023 via electronic mail to counsel of record for Patent Owner ChemGenes Corporation at the following addresses:

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