

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHANGHAI HONGENE BIOTECH CORPORATION,

Petitioner,

v.

CHEMGENES CORPORATION,

Patent Owner.

IPR2023-00490

U.S. Patent No. 9,884,885 B2

**PATENT OWNER'S RESPONSE TO
PETITIONER'S MOTION TO STAY**

Patent Owner ChemGenes Corporation (“Patent Owner”) respectfully responds to Petitioner Shanghai Hongene Biotech Corporation’s (“Petitioner”) motion (“Motion”) to stay Reissue Application No. 18/130,902 (“Reissue Application”) directed to U.S. Patent No. 9,884,885 B2 (“the ’885 Patent”) in view of this IPR2023-00490 (“the IPR”). *See* Paper No. 10.

I. RESPONSE

During the initial conference on July 26, 2023 (“Initial Conference”), Patent Owner indicated that Petitioner has challenged only a fraction of the compounds covered by the ’885 Patent’s Markush claims, and because Patent Owner is pursuing claims to numerous patentably distinct compounds in the Reissue Application, delaying examination in the Reissue Application would cause prejudice to Patent Owner. Patent Owner also stated that it would evaluate the merits of a motion to stay by Petitioner and determine whether it would oppose it.

Petitioner was notified about the filing of the Reissue Application on April 24, 2023, but did not contact Patent Owner regarding staying the Reissue Application at any point in advance of the Initial Conference. *See* Paper No. 6.

Having carefully considered the Motion, and while Patent Owner is pursuing numerous claims to compounds in the Reissue Application that are not being challenged in the IPR, Patent Owner acknowledges that the parallel examination of Claims 2 and 3 of the ’885 Patent could potentially result in judicial inefficiencies and therefore will not oppose the Motion.

II. CONCLUSION

For the foregoing reasons, Patent Owner does not oppose the Motion.

Date: August 16, 2023

Respectfully submitted,

/s/ Daniel L. Shores

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO STAY was served on August 16, 2023, to the following counsel for Petitioner via electronic mail at Hongene@procopio.com:

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