

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 UPDATED MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owner ChemGenes Corporation (“Patent Owner”) respectfully submits the following Updated Mandatory Notices to reflect changes regarding Related Matters and Patent Owner’s Back-Up counsel.

I. 37 C.F.R. § 42.8(b)(1): NOTICE OF REAL PARTY-IN-INTEREST (No change)

The ’885 patent is currently assigned to ChemGenes Corporation.

II. 37 C.F.R. § 42.8(b)(2): RELATED MATTERS (Updated)

On April 20, 2023, Petitioner filed a petition for *Inter Partes* Review of U.S. Patent No. 8,541,569 (“the ’569 patent”), IPR2023-00862. On October 24, 2023, the Board granted institution. This proceeding is still pending.

On April 24, 2023, Petitioner filed a petition for *Inter Partes* Review of U.S. Patent No. 8,309,707 (“the ’707 patent”), IPR2023-00875. On October 24, 2023, the Board granted institution. This proceeding is still pending.

Out of an abundance of caution, Patent Owner identifies the following district court action: On February 18, 2022, Patent Owner filed a patent infringement action against Hongene Biotechnology Ltd. in the U.S. District Court for the District of Massachusetts (Case No. 1-22-cv-10290). The asserted patents included, *inter alia*, the ’885 patent, the ’707 patent, and the ’569 patent. This action was voluntarily dismissed by Patent Owner on July 7, 2022.

On April 5, 2023, Patent Owner filed a reissue application in The United States Patent and Trademark Office relating to the '885 patent, which the U.S.P.T.O. has assigned U.S. Reissue Application No. 18/130,902.

On September 1, 2023, the U.S.P.T.O. notified Patent Owner that it was suspending, *sua sponte*, the examination of U.S. Reissue Application No. 18/130,902 for a period of six (6) months from the September 1, 2023 notice date, in view of this IPR.

III. 37 C.F.R. § 42.8(b)(3): LEAD AND BACK-UP COUNSEL (Updated)

Patent Owner identifies the following lead and back-up counsel:

Lead Counsel	Back-up Counsel
Daniel L. Shores (Reg. No. 74,571) ROTHWELL, FIGG, ERNST & MANBECK, P.C. 10 Post Office Square, Suite 800 Boston, MA 02109 Tel: (617) 312-3101 Fax: (202) 783-6031 Email: dshores@rfem.com	Joseph A. Hynds (Reg. No. 34,627) Aydin H. Harston, Ph.D. (Reg. No. 65,249) Adam M. Nicolais (Reg. No. 75,079) ROTHWELL, FIGG, ERNST & MANBECK, P.C. 901 New York Ave., N.W., Suite 900 East Washington, DC 20001 Tel: (202) 783-6040 Fax: (202) 783-6031 Email: jhynds@rfem.com Email: aharston@rfem.com Email: anicolais@rfem.com

A previously filed power of attorney (Paper 5) identifies practitioners associated with Rothwell, Figg, Ernst & Manbeck, P.C. (Customer No. 06449), which therefore includes the above listed practitioners.

IV. 37 C.F.R. § 42.8(b)(4): SERVICE INFORMATION (Updated)

Patent Owner may be served at the addresses found in Part III. Patent Owner consents to electronic service at:

- dshores@rfem.com
- jhynds@rfem.com
- aharston@rfem.com
- anicolais@rfem.com

Date: February 9, 2024

Respectfully submitted,

/s/ Daniel L. Shores

Daniel L. Shores (Reg. No. 74,571)
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
10 Post Office Square, Suite 800
Boston, MA 02109
Tel: (617) 312-3101
Fax: (202) 783-6031
Email: dshores@rfem.com

Joseph A. Hynds (Reg. No. 34,627)
Aydin H. Harston, Ph.D. (Reg. No. 65,249)
Adam M. Nicolais (Reg. No. 75,079)
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
901 New York Ave., N.W.,
Suite 900 East
Washington, DC 20001
Tel: (202) 783-6040
Fax: (202) 783-6031

Email: jhynds@rfem.com
Email: aharston@rfem.com
Email: anicolais@rfem.com

*Counsel for Patent Owner
ChemGenes Corporation*

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PATENT OWNER'S UPDATED MANDATORY NOTICES was served on February 9, 2024, to the following counsel for Petitioner via electronic mail at Hongene@procopio.com:

Jeremy J. Edwards (Reg. No. 60,982)
PROCOPIO, CORY, HARGREAVES & SAVITCH, LLP
1050 Connecticut Ave., NW, Suite 500
Washington, DC 20036
Tel.: 202-830-0707
E-mail: Hongene@procopio.com

Raymond K. Chan (Reg. No. 66,164)
PROCOPIO, CORY, HARGREAVES & SAVITCH, LLP
200 Spectrum Center Dr., Suite 1650
Irvine, CA 92618
Tel.: 949-383-2997
E-mail: Hongene@procopio.com

Xiaofan Yang (Reg. No. 61,459)
PROCOPIO, CORY, HARGREAVES & SAVITCH, LLP
12544 High Bluff Dr., Suite 400
San Diego, CA 92310
Tel.: 858-720-6300
E-mail: Hongene@procopio.com

Jack Shaw (Reg. No. 72,262)
PROCOPIO, CORY, HARGREAVES & SAVITCH, LLP
3000 El Camino Real, Suite 5-400
Palo Alto, CA 94306
Tel.: 650-645-9000
E-mail: Hongene@procopio.com

Counsel for Petitioner Shanghai Hongene Biotech Corporation

/s/ Daniel L. Shores

Daniel L. Shores (Reg. No. 74,571)
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
10 Post Office Square, Suite 800
Boston, MA 02109
Tel: (617) 312-3101
Fax: (202) 783-6031
Email: dshores@rfem.com