

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHANGHAI HONGENE BIOTECH CORP.,
Petitioner,

v.

CHEMGENES CORP.,
Patent Owner.

IPR2023-00490
Patent 9,884,885 B2

Before JOHN G. NEW, ZHENYU YANG, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

NEW, Administrative Patent Judge.

Conduct of the Proceeding
Authorizing Patent Owner's Request to Withdraw its Motion to
Amend Claims
37 C.F.R. §§ 42.54, 42.121(b)

On February 23, 2024, Patent Owner Chemgenes Corp. (“Patent Owner”) contacted the Board, *via* email, seeking authorization to withdraw its October 17, 2023 Motion to Amend Claims (Paper 17), including substitute claims 6 and 7, from further consideration in this *inter partes* review. *See* Ex. 3003. Petitioner Shanghai Hongene Biotech Corp. (“Petitioner”) had previously filed an Opposition to Patent Owner’s Motion to Amend Claims on January 19, 2024, and the Board entered its Preliminary Guidance on February 4, 2024. Papers 22, 23. In its email to the Board, Patent Owner represented that it had conferred with Petitioner regarding this matter, and that Petitioner “has not taken a position on this request.” Ex. 3003. In a reply email to the Board, Petitioner stated that it opposes Patent Owner’s intention to withdraw its Motion to Amend Claims. *Id.* Petitioner also stated that it intends to seek authorization of a renewed Motion to Stay the parallel reissue proceedings that are presently suspended by the Central Reexamination Unit (“CRU”) of the USPTO until March 1, 2023. A telephone conference was held between the parties and the panel on February 27, 2024 to address these matters.

As an initial matter, the Board has been informed by the CRU that it intends to renew the suspension of the reissue proceedings until at least the deadline by which the Final Written Decision is due (July 19, 2024). A copy of the USPTO’s suspension will be entered into the record of this proceeding upon receipt. Consequently, we deny as moot Petitioner’s request for authorization to file a renewed Motion to Stay the reissue proceeding. This denial is without prejudice: should the suspension be lifted by the USPTO prior to issuance of the Final Written Decision in this *inter partes* review, Petitioner may renew its request for authorization for a Motion to Stay.

In its email, and at the conference, Petitioner urged the Board to deny withdrawal of Patent Owner's Motion to Amend Claims, and for the Board to address all challenged claims of the '885 patent, as well as proposed substitute claims 6 and 7. Petitioner argued that doing so will promote efficiency and consistency by affording the reissue Examiner the benefit of a complete record and this Panel's analysis of patentability of the claims, including those that Patent Owner may intend to pursue during reissue. Petitioner urged the panel to take an expansive view of the Board's rules concerning motions to amend and permit additional briefing on the issue of its opposition to Patent Owner's withdrawal of its Motion to Amend Claims. Petitioner expressed its concern that to permit withdrawal of the Motion to Amend Claims would have complicated "downstream effects" subsequent to the resolution of the present *inter partes* review, including in any future reissue proceedings.

Patent Owner responded that, in view of Petitioner's substantive arguments in its Opposition to Patent Owner's Motion to Amend Claims, and the Board's Preliminary Guidance, it is allowable within the Board's rules for Patent Owner to withdraw its Motion to Amend Claims and its proposed substitute claims 6 and 7. Patent Owner stated that it would submit the Board's Preliminary Guidance to the reissue proceeding for the Examiner's consideration, should the reissue proceeding resume.

The USPTO's *Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board*, Fed. Reg. 9497 (March 15, 2019) (the "Pilot Program Notice"), states that "A patent owner also may choose to withdraw its initial [Motion to Amend]. In this

circumstance, no further briefing is authorized, and the Board will not address the [Motion to Amend] in a final written decision.” Pilot Program Notice, 9502.

In view of the language of the Pilot Program Notice, and also in view of Patent Owner’s declared intent to submit the Board’s Preliminary Guidance to the Examiner in future reissue proceedings, we authorize Patent Owner to withdraw its Motion to Amend Claims. The Motion to Amend Claims, Petitioner’s Opposition, and the Board’s Preliminary Guidance will remain of record in this *inter partes* review, but will have no further effect upon the course of the proceeding. No further briefing on the subject matter of the Motion to Amend Claims is authorized, and Patent Owner’s Motion to Amend will not be addressed in any Final Written Decision entered by the Board in this proceeding.

IT IS THEREFORE:

ORDERED that Petitioner’s request for authorization to file a renewed Motion to Stay the Reissue Proceeding is denied as moot and without prejudice;

FURTHER ORDERED that Patent Owner’s request seeking authorization to withdraw its October 17, 2023 Motion to Amend Claims is granted; and

FURTHER ORDERED that Patent Owner’s Motion to Amend Claims, Petitioner’s Opposition to the Motion to Amend Claims, and the Board’s Preliminary Guidance will remain of record in this *inter partes* review, but will be without effect in the further conduct of this proceeding; and

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FURTHER ORDERED that Patent Owner's Motion to Amend Claims will not be addressed in any Final Written Decision entered by the Board in this *inter partes* review.

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