

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 REQUEST FOR ORAL ARGUMENT
PURSUANT TO 37 C.F.R. § 42.70(a)**

Pursuant to 37 C.F.R. § 42.70(a) and the Board's Scheduling Order dated July 20, 2023 (Paper 8 at 6-8), Patent Owner ChemGenes Corporation ("Patent Owner") hereby requests oral argument on issues related to the patentability of U.S. Patent No. 9,884,885.

Patent Owner intends to discuss the issues raised by the Parties in the papers the Parties submitted in this proceeding as well as any other issues the Board deems appropriate.

Patent Owner respectfully requests that oral argument, which is currently scheduled to occur on April 23, 2024 (Due Date 8), take place **in-person** at USPTO's headquarters in Alexandria, Virginia. The request for in-person oral argument has been jointly agreed to by the Parties. *See* Ex. 2040.

Patent Owner does not anticipate that more than five (5) individuals will attend the argument on its behalf.

Patent Owner respectfully requests that it be granted a total of one (1) hour of oral argument time and that no more than that amount of time be granted to Petitioner. The request for a total of one (1) hour of oral argument time per side (subject to later requests that may be made under the LEAP program discussed below) has been jointly agreed to by the Parties. *See* Ex. 2040.

Patent Owner also respectfully requests that it be permitted to provide a sur-rebuttal and that the time for such sur-rebuttal be the total amount of any unused

time otherwise allotted to Patent Owner for its main argument. *See* November 2019 Consolidated Trial Practice Guide at 83.

In addition, Patent Owner requests the use of audio-visual equipment to assist its arguments, including a computer-connectable projector and a screen. Patent Owner also requests the services of a court reporter to transcribe the proceeding.

Finally, pursuant to the Scheduling Order (Paper 8 at 7-8), Patent Owner further respectfully reserves the right to request an additional fifteen (15) minutes of argument time under the LEAP program. The Parties have jointly recognized, pursuant to the terms of the Scheduling Order (*id.*), each other's right to make such a request. Ex. 2040.

Dated: March 12, 2024

Respectfully submitted,

/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 REQUEST FOR ORAL ARGUMENT PURSUANT TO 37 C.F.R. § 42.70(a) was served on March 12, 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

/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

**Counsel for Patent Owner,
ChemGenes Corporation**