

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 SEAL**

Pursuant to the briefing schedule authorized by the Board in its February 29, 2024 email to the Parties (Exhibit 2041), and in response to improper arguments Petitioner made in its Motion to Seal filed on March 15, 2024 (Paper 31), Patent Owner respectfully submits this response.

Petitioner's Motion to Seal contains unauthorized arguments (Paper 31 at 4-5) made in response to a portion of Patent Owner's *Sur-Reply* that addresses Petitioner's expert Dr. Baran and his financial and business relationships with Hongene that Hongene and Dr. Baran concealed from the record (Paper 27 at 1-3). Patent Owner does not address the substance of Petitioner's inappropriate arguments in this response but does address the impropriety of them.

Prior to Petitioner's filing its Motion to Seal, the Parties agreed to the terms of a modified protective order in this case, which the Board entered on February 15, 2024 ("Modified Protective Order"). (Paper 26). Under the Modified Protective Order, arguments to be made in the Motion to Seal *should have been* limited to Petitioner's rationale for its redacted confidentiality designations only. (Paper 26 at 6, Section 8(A)(ii), stating that the "Motion to Seal" should "set[] forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public.")). *See also* TPG, Appendix B, at 107-122.

Nothing in the TPG, Modified Protective Order, 37. C.F.R. 42 et. seq., orders from the Board, or other authority Patent Owner is aware of, provides (or even contemplates) authorization for a party to make arguments in a motion to seal that are in opposition to arguments that the opposing party made in a separate paper.

The Parties met and conferred over email regarding Petitioner's confidentiality designations from March 8 through March 14, 2024 and Patent Owner did so under the proper assumption that Petitioner's designations, disputed or not, would be the subject of a routine motion to seal as provided for under the Modified Protective Order and TPG. (*See* Exhibit 2042 at 1-5).

As a result of this process, and Petitioner's agreement to un-designate certain information because the information was not confidential, Patent Owner agreed it would not oppose Petitioner's proposed remaining designations, and the substance of the proposed Motion to Seal, as Patent Owner understood it, was therefore *unopposed. Id.* at 1-2.

At no time during this process did Petitioner inform Patent Owner or the Board that it intended to make arguments in response to Patent Owner's Sur-Reply. It cannot be disputed that the only logical reason Petitioner did not style its Motion to Seal as "unopposed" is so that it could place its arguments in response to the Sur-Reply in front of the Board, which is improper.

Petitioner's unauthorized arguments violate the rules and are prejudicial to Patent Owner. The Board's procedural rules and the present Scheduling Order (Papers 8 and 18) are clearly designed for Patent Owner (not Petitioner) to have the final submission in substantive briefing. (*See* TPG at 73-74). Here, Petitioner conducted an end-run-around of those rules to grant itself additional substantive briefing not related to this Motion to Seal.

Petitioner's conduct also wastes resources. Had Petitioner filed what would have been more appropriately styled as an "unopposed" motion to seal (sans the improper argument), Patent Owner would not have wasted time, effort and money writing this response and the Board would not have to waste time, effort and other valuable judicial resources considering these briefings.

Accordingly, for at least the foregoing reasons, Patent Owner respectfully requests that the arguments provided in Petitioner's Motion to Seal that respond to Patent Owner's Sur-Reply (i.e., the arguments in Paper 31 starting at bottom of page 4 through the top of page 5, including footnote 2) not be considered by the Board.

Patent Owner also respectfully requests that the Board withdraw its approval for Petitioner to have the right to file a "reply" to this paper (Exhibit 2041 at 1-2), or otherwise not consider such reply if Petitioner files one, because Patent Owner gave its consent to the proposed briefing schedule, and Petitioner solicited the Board's

approval, without disclosing its intent to submit arguments in response to Patent Owner's Sur-Reply.

Dated: March 29, 2024

Respectfully submitted,

/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 SEAL was served on March 29, 2024, to the following counsel for Petitioner via electronic mail at Hongene@procopio.com:

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