Paper No. __
Date Filed: August 21, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMGEN INC.,
Petitioner

v.

BRISTOL-MYERS SQUIBB COMPANY,
Patent Owner

IPR2025-00603
Patent No. 11,332,529

PATENT OWNER'S
SUPPLEMENTAL PRE-INSTITUTION BRIEF

Pursuant to the Board's August 20, 2025 email, Patent Owner below files a copy of the full email correspondence (including the Board response) as Patent Owner's Supplemental Pre-Institution Brief, as well as supporting Exhibit 2011 (the disclaimer referenced in the email).

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, August 20, 2025 11:43 AM
To: McKeown, Scott A.; Weil, Jason; Trials
Cc: Maslowski, Steven; Pearson, Matthew; Elsby, Rachel; Eldora L. Ellison; BMS-IPR603; PTAB Scott McKeown; PTAB Oona Johnstone; Loughran, Chelsea A.; Steenburg, Charles
Subject: RE: Case No. IPR2025-00603 - Request for authorization to file an exhibit

EXTERNAL Email

Counsel: Patent Owner improperly includes substantive arguments in its email request to the Board (see below, including multiple caselaw citations). In view of the information provided below, however, the Board authorizes Patent Owner to file, no later than August 21, 2025, a copy of the full email correspondence (including this Board response) as Patent Owner's Supplemental Pre-Institution Brief. This paper shall include no further textual argument, except to indicate the filing, as an exhibit supporting the paper, the disclaimer referenced in the email. No other new evidence is permitted.

Petitioner is authorized to file, no later than August 27, 2025, a five-page Response to Patent Owner's Supplemental Pre-Institution Brief. No new evidence may accompany Petitioner's paper.

No conference call is necessary. In the future, no substantive arguments shall be included in any email request to the Board. No party shall alter its email communication after the other party has reviewed it and provided its response.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: McKeown, Scott A. <Scott.McKeown@WolfGreenfield.com>
Sent: Tuesday, August 19, 2025 8:07 PM
To: Weil, Jason <jweil@akingump.com>; Trials <Trials@USPTO.GOV>
Cc: Maslowski, Steven <smaslowski@AKINGUMP.com>; Pearson, Matthew <mpearson@AKINGUMP.com>; Elsby, Rachel <relsby@akingump.com>; Eldora L. Ellison <eellison@sternekessler.com>; BMS-IPR603 <BMS-IPR603@akingump.com>; PTAB Scott McKeown <SMcKeown-PTAB@WolfGreenfield.com>; PTAB Oona Johnstone <OJohnstone-PTAB@WolfGreenfield.com>; Loughran, Chelsea A. <Chelsea.Loughran@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>
Subject: RE: Case No. IPR2025-00603 - Request for authorization to file an exhibit

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Honorable Board,

Patent Owner forwarded its proposed email and petitioner, as is customary, included its argument exactly as reproduced below. As such, it is surprising that Patent Owner has now forwarded a very different email that replaces its previously represented argument with case citations and arguments that were never discussed with Petitioner and are plainly improper in an email communication to the Board.

Petitioner respectfully requests a conference to discuss these and other serious concerns with Patent Owner's recent actions that bare directly on its request. Alternatively, and in the interests of procedural fairness, Petitioner requests 5-pages of briefing on the appropriate conclusion to this case based on the distinguishable authority improperly cited below in light of Patent Owner's recent prosecution filings.

Counsel for Amgen

From: Weil, Jason <jweil@akingump.com>
Sent: Tuesday, August 19, 2025 7:43 PM
To: TRIALS@uspto.gov
Cc: Maslowski, Steven <smaslowski@AKINGUMP.com>; Pearson, Matthew <mpearson@AKINGUMP.com>; Elsby, Rachel <relsby@akingump.com>; Eldora L. Ellison <eellison@sternekessler.com>; BMS-IPR603 <BMS-IPR603@akingump.com>; PTAB Scott McKeown <SMcKeown-PTAB@WolfGreenfield.com>; PTAB Oona Johnstone <OJohnstone-PTAB@WolfGreenfield.com>; Loughran, Chelsea A. <Chelsea.Loughran@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>
Subject: Case No. IPR2025-00603 - Request for authorization to file an exhibit

Some people who received this message don't often get email from jweil@akingump.com. Learn why this is important

IPR2025-00603
Request for authorization to file an Exhibit

To the Board:

On August 18, 2025, Patent Owner filed a statutory disclaimer of all claims of U.S. Patent No. 11,332,529, the subject of IPR2025-00603. Patent Owner requests permission to file a copy of the disclaimer as Exhibit 2011 in IPR2025-00603.

Patent Owner's Position:
Patent Owner believes that, as a result of this **pre-institution** statutory disclaimer of all challenged claims, trial should be denied without entry of Adverse Judgment. Patent Owner submits that Petitioner's objection below is baseless and its assertion that the disclaimer is a Request for Adverse Judgment is incorrect. The Board has repeatedly found that where all claims challenged in a Petition have been disclaimed pre-institution, it is proper to deny institution without entering an adverse judgment. *See Western Digital Techs. Inc. v. Godo Kaisha IP Bridge 1*, IPR2024-01448, Paper 11 at 3-4 (PTAB Mar. 26, 2025) ("*Because all claims challenged by Petitioner have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), we deny institution of an inter partes review and do not enter adverse judgment against Patent Owner*...Numerous other Board decisions subsequent to *General Electric* being made precedential have followed this approach in similar circumstances, and Petitioner points to no authority to the contrary."); *see also General Electric Company v. United Technologies Corporation*, IPR2017-00491, Paper 9 at 2-3 (PTAB July 6, 2017) (designated precedential on Sept. 9, 2019). Patent Owner respectfully submits that a conference call is not necessary.

Petitioner's Position:
Petitioner opposes to the extent the Patent Owner's request seeks to avoid adverse judgment. In accordance with controlling agency regulation, the filed disclaimer is a Request for Adverse Judgement. 37 C.F.R. § 42.73(b)(1). Should the panel consider waiving the rule in the absence of any demonstrated extraordinary situation to simply deny the petition (and not enter adverse judgment), Petitioner requests a teleconference to explain the basis of its opposition based on broader claims Patent Owner added via continuation two weeks before it disclaimed the '529 claims.

Best regards,
Jason Weil

Jason Weil
Akin
1735 Market Street | 12th Floor | Philadelphia, PA 19103-7501 | USA | Direct: +1 215.965.1328
jweil@akingump.com | akingump.com | Bio
Pronouns: he/him/his (What's this?)

From: McKeown, Scott A. <Scott.McKeown@WolfGreenfield.com>
Sent: Tuesday, August 19, 2025 4:01 PM
To: Elsby, Rachel; Weil, Jason; PTAB Scott McKeown; PTAB Oona Johnstone; Loughran, Chelsea A.; Steenburg, Charles
Cc: Maslowski, Steven; Pearson, Matthew; Eldora L. Ellison; BMS-IPR603
Subject: RE: IPR2025-00603

Counsel,

It is highly inappropriate to add broader claims than issued in the '529—via a claim set filed in the pending continuation on August 4th — and then disclaim the '529 claims two weeks later. Petitioner opposes your request to the extent it seeks to avoid adverse judgment designed to prevent such conduct. Please include the below insert in your email to the Board.

DRAFT TO BOARD

IPR2025-00603

To the Board:

On August 18, 2025, Patent Owner filed a statutory disclaimer of all claims of U.S. Patent No. 11,332,529, the subject of IPR2025-00603. Patent Owner requests permission to file a copy of the disclaimer as Exhibit 2011 in IPR2025-00603. Please let us know if the Board determines that a conference call is necessary to discuss the effect Patent Owner's disclaimer has on the pending IPR petition.

Petitioner opposes to the extent the Patent Owner's request seeks to avoid adverse judgment. In accordance with controlling agency regulation, the filed disclaimer is a Request for Adverse Judgement. 37 C.F.R. § 42.73(b)(1). Should the panel consider waiving the rule in the absence of any demonstrated extraordinary situation to simply deny the petition (and not enter adverse judgment), Petitioner requests a teleconference to explain the basis of its opposition based on broader claims Patent Owner added via continuation two weeks before it disclaimed the '529 claims.

From: Elsby, Rachel <relsby@akingump.com>
Sent: Tuesday, August 19, 2025 12:44 PM
To: McKeown, Scott A. <Scott.McKeown@WolfGreenfield.com>; Weil, Jason <jweil@akingump.com>; PTAB Scott McKeown <SMcKeown-PTAB@WolfGreenfield.com>; PTAB Oona Johnstone <OJohnstone-PTAB@WolfGreenfield.com>; Loughran, Chelsea A. <Chelsea.Loughran@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>
Cc: Maslowski, Steven <smaslowski@AKINGUMP.com>; Pearson, Matthew <mpearson@AKINGUMP.com>; Eldora L. Ellison <eellison@sternekessler.com>; BMS-IPR603 <BMS-IPR603@akingump.com>
Subject: RE: IPR2025-00603

Scott,

BMS has disclaimed the claims of the 529 Patent, the only patent at issue in IPR2025-00603. We believe the Board would like to be informed of that as soon as possible, and therefore plan to email the Board our simple request to submit the disclaimer as an exhibit by the end of the day today. Your suggestion that BMS should take any action

with respect to other patents or applications is inappropriate. Please let us know by 5:00 pm (ET) today whether you oppose the submission of the disclaimer as an exhibit.

Regards,
Rachel

Rachel J. Elsby
Akin
Direct: +1 202.887.4584

From: McKeown, Scott A. <Scott.McKeown@WolfGreenfield.com>
Sent: Monday, August 18, 2025 9:06 PM
To: Weil, Jason <jweil@akingump.com>; PTAB Scott McKeown <SMcKeown-PTAB@WolfGreenfield.com>; PTAB Oona Johnstone <OJohnstone-PTAB@WolfGreenfield.com>; Loughran, Chelsea A. <Chelsea.Loughran@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>
Cc: Maslowski, Steven <smaslowski@AKINGUMP.com>; Pearson, Matthew <mpearson@AKINGUMP.com>; Elsby, Rachel <relsby@akingump.com>; Eldora L. Ellison <eellison@sternekessler.com>; BMS-IPR603 <BMS-IPR603@akingump.com>
Subject: RE: IPR2025-00603

EXTERNAL Email

Counsel,

Can you please confirm whether you have disclaimed or will stipulate to disclaiming the claims of U.S. patents 10,174,113 and 9,856,320 given their similarity in scope to the '529? Likewise, will you agree to stipulate to forego seeking patentably indistinct claims in continuation filings, such as 18/787,822 in which such claims were introduced on August 4th?

Once we have your response to these inquiries, we will be able to consider our position with respect to your request.

Scott

From: Weil, Jason <jweil@akingump.com>
Sent: Monday, August 18, 2025 3:04 PM
To: PTAB Scott McKeown <SMcKeown-PTAB@WolfGreenfield.com>; PTAB Oona Johnstone <OJohnstone-PTAB@WolfGreenfield.com>; Loughran, Chelsea A. <Chelsea.Loughran@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>
Cc: Maslowski, Steven <smaslowski@AKINGUMP.com>; Pearson, Matthew <mpearson@AKINGUMP.com>; Elsby, Rachel <relsby@akingump.com>; Eldora L. Ellison <eellison@sternekessler.com>; BMS-IPR603 <BMS-IPR603@akingump.com>
Subject: IPR2025-00603

Counsel,

Today BMS filed the attached statutory disclaimer of all claims in U.S. Patent No. 11,332,529, currently the subject of Amgen's Petition in IPR2025-00603. BMS would like to promptly request permission from the Board to file the disclaimer as an exhibit in the IPR and plans to send the below email to the Board no later than tomorrow.

DRAFT TO BOARD

IPR2025-00603

IPR2025-00603
U.S. Patent No. 11,332,529

To the Board:

On August 18, 2025, Patent Owner filed a statutory disclaimer of all claims of U.S. Patent No. 11,332,529, the subject of IPR2025-00603. Patent Owner requests permission to file a copy of the disclaimer as Exhibit 2011 in IPR2025-00603. Please let us know if the Board determines that a conference call is necessary to discuss the effect Patent Owner's disclaimer has on the pending IPR petition.

Regards,
Jason Weil
Counsel for Patent Owner

Jason Weil
Akin
1735 Market Street | 12th Floor | Philadelphia, PA 19103-7501 | USA | Direct: +1 215.965.1328
jweil@akingump.com | akingump.com | Bio
Pronouns: he/him/his (What's this?)

Respectfully submitted,

Date: August 21, 2025

/*Steven D. Maslowski*/
Steven D. Maslowski
USPTO Registration No. 46,905
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of **PATENT OWNER'S SUPPLEMENTAL PRE-INSTITUTION BRIEF AND EXHIBIT 2011** were served on counsel of record on August 21, 2025, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as delivering a copy via electronic mail to the counsel of record for the Petitioners at the following addresses:

WOLF, GREENFIELD & SACKS, P.C.
Scott A. McKeown (SMcKeown-PTAB@wolfgreenfield.com)
Oona M. Johnstone (OJohnstone-PTAB@WolfGreenfield.com)
Chelsea A. Loughran (Chelsea.Loughran@WolfGreenfield.com)
Charles T. Steenburg (Charles.Steenburg@WolfGreenfield.com)

Date: August 21, 2025

Respectfully submitted,

By: /*Steven D. Maslowski*/
Steven D. Maslowski
USPTO Registration No. 46,905
Lead Counsel for Patent Owner