UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMGEN INC.,
Petitioner,

v.

BRISTOL-MYERS SQUIBB COMPANY,
Patent Owner.

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Case No. IPR2025-00603
Patent No. 11,332,529

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AUTHORIZED SUR-REPLY IN RESPONSE TO PATENT OWNER'S SUPPLEMENTAL PRE-INSTITUTION BRIEF

TABLE OF AUTHORITIES

Cases

Arthrex, Inc. v. Smith & Nephew, Inc.,
880 F.3d 1345 (Fed. Cir. 2018) 2

Bestway (USA), Inc. v. Intex Mktg., Ltd.,
PGR2024-00036, Paper 9 (PTAB Oct. 28, 2024) 2

Google LLC v. Seven Networks, LLC,
IPR2018-01118, Paper 22 (PTAB Jan. 11, 2019) 1

*Securus Technologies, Inc. v. Global Tel*Link Corporation*,
IPR2016-01446, Paper 7 (PTAB Jan. 10, 2017) 1

Smith & Nephew, Inc. v. Arthrex, Inc.,
IPR2016-00917, Paper 12 (PTAB Sept. 21, 2016).....2

PO concedes that adverse judgment is a matter of discretion. PO Reply, 1. The Board has construed statutory disclaimers as requests for adverse judgment in many instances where (as here) the patent owner disclaimed all challenged claims prior to institution decisions. PO cites a subset of those cases (neglecting others)[1] while mischaracterizing even those decisions. And most tellingly, PO fails to identify any case involving circumstances as extreme as the transparent shell game evident here—that is, where a patentee ostensibly "disclaims" claims to avoid institution while in parallel seeking to resurrect them in a pending continuation that is even broader. Discretion exists to protect the public from such gamesmanship.

One of the cases that PO mischaracterized is *Google LLC v. Seven Networks, LLC*, IPR2018-01118. PO wrongly suggests the Board's adverse judgment there turned solely on generic "finality concerns" and the timing of the patentee's disclaimer. PO Reply, 1. Not so: the Board highlighted how adverse judgment would prevent the patentee from pursuing "patentably indistinct" claims in continuation applications. IPR2018-01118, Paper 22 at 3-4 (Jan. 11, 2019). This is the same point

[1] *See*, *e.g.*, *Securus Technologies, Inc. v. Global Tel*Link Corporation*, IPR2016-01446, Paper 7 at 2 (Jan. 10, 2017) (issuing adverse judgment despite patentee's assertion that disclaimer was not "an admission or acquiescence" and later developments left challenged claims of "little economic interest," Paper 6 at 1).

the Board stressed and the Federal Circuit affirmed in IPR2016-00917. The Board entered adverse judgment because it would have been "unfair" to permit the patentee "to avoid Petitioner's challenge through a statutory disclaimer and then pursue patentably indistinct claims in its continuation applications." *Smith & Nephew, Inc. v. Arthrex, Inc*., IPR2016-00917, Paper 12 at 8-9 (Sept. 21, 2016), *aff'd*, 880 F.3d 1345 (Fed. Cir. 2018). Adverse judgment is warranted here for the same reason.

PO also wrongly suggests that *Bestway* (PGR2024-00036) "applies here." The patentee in *Bestway* had not "threatened to assert any claim of the [disclaimed] patent." PGR2024-00036, Paper 9 at 7 (Oct. 28, 2024).[2] And as Petitioner explained (Paper 11 at 5 n.3) and PO does not dispute, *Bestway* did not address the scope of the patentee's pending continuation claims. Here, by contrast, PO first represented that the '529 Patent ***would*** be asserted against Petitioner as part of the "Patent Dance." Paper 5 at 2-3, 9. Later, after its discretionary denial arguments failed, PO disclaimed it while introducing a new continuation claim set with indisputably broader claims. This "whack-a-mole" strategy has no parallel in *Bestway*.

Entering adverse judgment here would not force POs to defend every challenged claim in future IPR proceedings. The facts here are a far cry from an everyday case. PO does not dispute that newly added claim 43 in its pending

[2] By contrast, *Smith & Nephew* concerned claims asserted in litigation.

continuation is broader than disclaimed claim 1. *See* Paper 11 at 2 (claim chart). PO initially defended claims 8-18, only to then disclaim them as irrelevant to PO's revised FDA label. However, PO also disclaimed claims 1-7 without explanation only to pursue the same subject matter in the continuation, thereby indicating PO always maintained commercial interest in that subject matter.[3]

PO then tries to excuse adding pending claim 43 because (1) an analogous claim previously existed in PO's continuation and (2) PO filed IPR-related documents in an IDS. In essence, PO brazenly argues that it always had a plan to undermine the IPR. Even still, this is simply irrelevant to the undisputed fact that this continuation claim is patentably indistinct from (indeed, even broader than) "disclaimed" claim 1, which PO seeks to secret away from a more fulsome IPR analysis. The Board should exercise its discretion to prevent such gamesmanship.

Unless stopped, the abuse of agency resources demonstrated here will create an endless loop of the same patent claims, which will force iterative PTAB litigation to the detriment of agency resources and public confidence. Adverse judgment is warranted under these unique and egregious circumstances.

[3] For example, PO has not provided a covenant not to sue on indistinct claims, which would easily moot this debate from the perspective of the Petitioner.

Dated: September 12, 2025

Respectfully submitted,
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6 (e)(4)

I certify that on September 12, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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