

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROBIOTICA, LIMITED,
Petitioner,

v.

BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM,
Patent Owner.

PGR2023-00026
Patent 11,395,838 B2

Before JEFFREY N. FREDMAN, SUSAN L. C. MITCHELL, and JAMIE WISZ,
Administrative Patent Judges.

MITCHELL, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
Granting Request for Additional Briefing
37 C.F.R. § 42.5

Petitioner sought a conference call with the Board, which was held on September 14, 2023, to request authorization to file a reply and a declaration to address the following issues:

1. To address the application of the United States Supreme Court’s decision in *Amgen Inc. v. Sanofi*, No. 21-757, 143 S. Ct. 1243 (2023) (“*Amgen*”) issued after the Petition was filed;
2. To respond to Patent Owner’s application of two references dated after the filing date of the patent at issue, U.S. Patent No. 11,395,838 B2 (“the ’838 patent”), regarding enablement, *see* Patent Owner Preliminary Response (Prelim. Resp.), Paper 7, 64–66; and
3. To respond to Patent Owner’s argument that the Honda¹ reference is cumulative of the Tokyo² reference that was before the Examiner during prosecution of the ’838 patent, *see* Prelim. Resp. 30–32.

Petitioner asserts that none of these issues could have been foreseen and good cause exists for authorization to file a reply to address these issues. Patent Owner responds that no good cause exists for Petitioner’s reply because *Amgen* merely affirmed precedent of the Federal Circuit that existed at the time of the filing of the Petition, and Petitioner unduly delayed in raising the issue with the Board. Patent Owner also asserts that Petitioner’s declarant did not address the art of record sufficiently and should not be afforded a second opportunity now to correct this error to respond to the post-filing evidence supporting enablement or the cumulative nature of Honda as compared to Tokyo.

¹ WO 2015/156419 A1, published Oct. 15, 2015 (Ex. 1011, “Honda”).

² US Pat. App. Pub. No. 2016/0193257 A1, published July 7, 2016 (Ex. 2012, “Tokyo”).

Although we are not unsympathetic to Patent Owner's arguments, we determine that Petitioner's requested briefing may be helpful to the panel and authorize such briefing as set forth below in the Order. We do agree with Patent Owner, however, that the filing of additional declarations would be logistically challenging because of the timing for determining whether a post-grant review will be instituted. Therefore, we do not authorize any additional declarations on behalf of either party to be filed.

ORDER

Accordingly, it is

ORDERED that Petitioner's request for authorization to file a reply brief limited to the issues set forth above is *granted*;

FURTHER ORDERED that the Patent Owner is authorized to file a sur-reply to respond to Petitioner's reply;

FURTHER ORDERED that each party will be limited to ten pages for the reply and sur-reply;

FURTHER ORDERED that any reply filed by Petitioner is due by no later than Thursday, September 28, 2023; and

FURTHER ORDERED that any sur-reply filed by Patent Owner to Petitioner's reply is due no later than Thursday, October 12, 2023.

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