

Filed on behalf of: Pharmacyclics LLC

Entered: June 20, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BeiGene USA, Inc. and BeiGene, LTD.,
Petitioner,

v.

Pharmacyclics LLC,
Patent Owner

PGR2024-00009
Patent 11,672,803

**PATENT OWNER'S MOTION FOR LEAVE
TO REQUEST CERTIFICATE OF CORRECTION UNDER
35 U.S.C. § 256 AND 37 C.F.R. § 1.324**

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OTHER AUTHORITIES

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Exhibit List

Ex.	Description
2001	Douglas J. Marcotte et al., <i>Structures of Human Bruton's Tyrosine Kinase in Active and Inactive Conformations Suggest a Mechanism of Activation for TEC Family Kinases</i> , 19 Protein Science 429 (2010) ("Marcotte 2010")
2002	Michael Hallek et al., <i>Guidelines for the Diagnosis and Treatment of Chronic Lymphocytic Leukemia: A Report from the International Workshop on Chronic Lymphocytic Leukemia Updating the National Cancer Institute-Working Group 1996 Guidelines</i> , 111 Blood 5446 (2008)
2003	Michael Hallek et al., <i>iwCLL Guidelines for Diagnosis, Indications for Treatment, Response Assessment, and Supportive Management of CLL</i> , 131 Blood 2745 (2018)
2004	Press Release, AbbVie, <i>IMBRUVICA® (Ibrutinib) Awarded Prix Galien 2015 Best Pharmaceutical Agent</i> (Oct. 28, 2015), https://www.prnewswire.com/news-releases/imbruvica-ibrutinib-awarded-prix-galien-2015-best-pharmaceutical-agent-300167630.html
2005	USPTO Non-Final Rejection issued in U.S. Patent Application No. 18/180,064 (Jan. 9, 2024)
2006	U.S. Patent No. 10,570,139
2007	U.S. Patent No. 11,142,528
2008	[Proposed] Request for Correction of Inventorship in Patent Under 37 C.F.R. § 1.324 (Patent No. 11,672,803) (U.S.P.T.O. July 10, 2020)

I. Statement Of Relief Requested

Pursuant to the Board's June 5, 2024 email authorizing this Motion, Patent Owner seeks leave to request a Certificate of Correction to add three inventors to the '803 patent. Certificate of Correction is an appropriate vehicle to correct inventorship upon "application of all the parties and assignees[.]" 37 C.F.R. § 1.324(a); *see also* 35 U.S.C. § 256; Manual of Patent Examining Procedure (MPEP) § 1481.02. The request will not prejudice the Board or Petitioner, and will not affect any issues in this PGR. *See* 37 C.F.R. § 42.3 ("The Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order."). Thus, Patent Owner has a sufficient basis to request a Certificate of Correction and respectfully requests the Board grant this motion. *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019). Petitioner has indicated that it does not oppose this Motion.

II. There Is A Sufficient Basis That Inventorship Is Correctable

When evaluating a Motion to Request a Certificate of Correction, the Board determines whether there is a "*sufficient basis* supporting Patent Owner's position that the mistake *may* be correctable.'" *Honeywell*, 939 F.3d at 1349 (original emphases) (quoting *Plastic Dev. Grp., LLC v. Maxchief Invs., Ltd.*, IPR2017-00846, Paper 16 at 2 (P.T.A.B. Nov. 13, 2017)). Here, inventorship is correctable under at least 35 U.S.C. § 256 and 37 C.F.R. § 1.324.

The '803 patent currently names Joseph J. Buggy as the sole named inventor. In its answer to Patent Owner's assertion of infringement of the '803 patent in the related litigation, Petitioner BeiGene raised allegations of incorrect inventorship. Patent Owner has determined that Lee Honigberg, David Loury, and Ahmed Hamdy should be named as co-inventors of the '803 patent. Their contributions are reflected in the '803 patent claims. Each of these individuals has assigned their rights to the '803 patent to Patent Owner, such that Patent Owner will remain the sole owner and assignee of the '803 patent.

Inventorship is correctable by Certificate of Correction whenever "through error an inventor is not named in an issued patent . . . [and] on application of all the parties and assignees, with proof of facts and such other requirements as may be imposed[.]" 35 U.S.C. § 256; *see also* 37 C.F.R. § 1.324(a) (similar). Under the Office's rules, a request to correct inventorship via certificate must be accompanied by a fee in addition to statements from each assignee and each added and existing inventor agreeing (or not disagreeing) to the change of inventorship. 37 C.F.R. § 1.324(b)(1)-(3). Each inventor has agreed or not disagreed to the change of inventorship. *See* Ex. 2008 (proposed filing for Certificate of Correction). As Patent Owner will remain the sole assignee of the Patent, inventorship here can be corrected.

The Board has consistently allowed Patent Owners to correct inventorship during post-grant proceedings. *See, e.g., SharkNinja Operating LLC v. iRobot Corp.*, PGR2021-00066, Paper 17 at 3 (P.T.A.B. Aug. 20, 2021) (granting request to correct inventorship before institution); *Google LLC v. Space Data Corp.*, IPR2018-00944, Paper 20 at 6 (P.T.A.B. Nov. 7, 2018) (granting leave to correct inventorship in institution decision); *Aceto Agric. Chems. Corp. v. Gowan Co.*, IPR2016-00076, Paper 45 at 5 (P.T.A.B. Dec. 21, 2016) (granting leave to change inventorship in provisional application after institution).

The Board has denied a request to correct inventorship where the patent owner moved for relief only eight days before the oral argument, and the Board was “not inclined to complicate the record with a document that should have been filed earlier.” *Sanofi-Aventis U.S. LLC v. Immunex Corp.*, IPR2017-01879, Paper 79 at 2-3 (P.T.A.B. Nov. 9, 2018). But unlike the patent owner in *Sanofi*, here Patent Owner moves to correct inventorship early in the proceeding. Thus, the extenuating circumstances of *Sanofi* do not apply here, and authorization to file the Certificate of Correction is warranted.

III. Correcting Inventorship Would Not Affect This Proceeding.

A Certificate of Correction amending the inventorship of the '803 patent would not affect the merits of this PGR proceeding. The Petition includes four grounds, including a lack of written description (Ground 1), a lack of enablement

(Ground 2), anticipation (Ground 3), and obviousness (Ground 4). The addition of the above-named inventors does not affect the merits of any of these four grounds. In particular, the primary reference relied on in Ground 3 and Ground 4 post-dates the filing date for the earliest non-provisional patent application to which the '803 patent claims priority. Thus, the change in inventorship does not affect the determination of whether Petitioner's primary reference is available as prior art. Nor does the addition of these inventors affect the '803 patent's eligibility for PGR, which is disputed by the Parties. A Certificate of Correction would not prejudice the Board or its ability to meet statutory deadlines for institution or final decision. Nor would it prejudice the Petitioner who does not oppose and whose ability to pursue the grounds in the Petition is unaffected by this Motion.

IV. Conclusion

Inventorship is correctable by statute and by rule, and Patent Owner has shown a sufficient basis that inventorship may be correctable by a Certificate of Correction. Patent Owner's Motion should therefore be granted.

Respectfully submitted,

Dated: June 20, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 20th day of June, 2024, a true and correct copy of the foregoing **Patent Owner's Motion for Leave to Request Certificate of Correction Under 35 U.S.C. § 256 and 37 C.F.R. § 1.324 and Exhibit 2008** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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PO's Motion to Request
Certificate of Correction

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