

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 B2

Before SHERIDAN K. SNEDDEN, SUSAN L. C. MITCHELL, and
TINA E. HULSE, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion for Leave to
Request a Certificate of Correction
35 U.S.C. § 256; 37 C.F.R. § 1.324

I. INTRODUCTION

BeiGene USA, Inc. and BeiGene, Ltd. (collectively, “Petitioner”) filed a Petition requesting a post-grant review of claims 1–8, 12, and 20 of U.S. Patent No. 11,672,803 B2 (Ex. 1001, “the ’803 Patent”). Paper 2. We instituted a post-grant review of the challenged claims on May 9, 2024. Paper 9.

Almost one month after institution, Pharmacyclics LLC (“Patent Owner”) requested authorization to file an unopposed motion to request a certificate of correction to correct inventorship, which we granted. Ex. 3002. Patent Owner filed the Motion for Leave to Request Certificate of Correction Under 35 U.S.C. § 256 and 37 C.F.R. § 1.324 on June 20, 2024. Paper 20 (“Mot.”). For the reasons set forth below, we *grant* Patent Owner’s Motion.

II. FACTUAL BACKGROUND

The ’803 Patent currently names Joseph J. Buggy as the sole inventor. Ex. 1001, code 72. According to Patent Owner, Petitioner raised allegations of incorrect inventorship of the ’803 Patent in the related district court proceeding. Mot. 2. Patent Owner asserts that it has now determined that Lee Honigberg, David Loury, and Ahmed Hamdy should be added as co-inventors of the ’803 Patent. *Id.* Patent Owner states that their contributions are reflected in the ’803 Patent claims and that each of the individuals has assigned their rights to the ’803 Patent to the Patent Owner, which is the sole assignee. *Id.* With its Motion, Patent Owner submits a proposed Request for Certificate of Correction, which includes statements from each added and existing inventor and Patent Owner as the sole assignee that they agree (or do not disagree) to the change of inventorship. *See* Ex. 2008, 4–9.

III. ANALYSIS

Under 35 U.S.C. § 256, “[w]henver through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.” Moreover, 37 C.F.R. § 1.324(b) states that any request to correct inventorship of a patent must be accompanied by: (1) a statement from each person being added as an inventor and each currently named inventor either agreeing to the change of inventorship or stating that they do not disagree to the requested change; (2) a statement from all assignees of the parties agreeing to the change in inventorship; and (3) a fee. 37 C.F.R. § 1.324(b)(1)–(3).

Here, Patent Owner seeks to add Lee Honigberg, David Loury, and Ahmed Hamdy as co-inventors of the ’803 Patent. Mot. 2. And Patent Owner’s proposed Request for Correction of Inventorship includes statements from each added and currently named inventor and the Patent Owner as sole assignee stating that they agree or do not disagree to the change of inventorship. Ex. 2008, 4–9. Accordingly, we grant Patent Owner leave to request correction of inventorship under 35 U.S.C. § 256 and 37 C.F.R. § 1.324.

IV. ORDER

In consideration of the foregoing, it is hereby
ORDERED that Patent Owner’s Motion for Leave to Request Certificate of Correction Under 35 U.S.C. § 256 and 37 C.F.R. § 1.324 is *granted*;

FURTHER ORDERED that Patent Owner may file, within ten days of entry of this Order, its Request for Certificate of Correction and also file a copy of that request as an exhibit in this proceeding; and

FURTHER ORDERED that when a decision is rendered on Patent Owner's request for a Certificate of Correction, Patent Owner shall file, within ten business days of the date of such decision, a copy of the decision as an exhibit in this proceeding.

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