

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BICARA THERAPEUTICS, INC.,

Petitioner

v.

THE JOHNS HOPKINS UNIVERSITY,

Patent Owner.

PGR2026-00025

U.S. Patent No. 12,295,968

PATENT OWNER'S NON-CONTINGENT MOTION TO AMEND

I. INTRODUCTION

Pursuant to 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221, Patent Owner The Johns Hopkins University (“Patent Owner”) moves to amend U.S. Patent No. 12,295,968 (“the ’968 patent”) by canceling claims 2, 3, 4, 5, 6, 7, and 8. No substitute claims are proposed.

This motion is not contingent upon the Board finding any original claim unpatentable. Patent Owner requests that the Board cancel claims 2-8 regardless of the outcome of this proceeding as to the original claims. Claims 1 and 9 are not addressed by this motion and remain unamended.

II. STATEMENT OF RELIEF REQUESTED

Patent Owner respectfully requests that the Board:

- (a) cancel claims 2-8 of the ’968 patent; and
- (b) terminate Grounds 3-6 as moot in their entirety for the reasons set forth below.

Claims 1 and 9 remain subject to Grounds 1 and 2, addressed in Patent Owner’s Response.

III. CANCELING CLAIMS 2-8 MOOTS GROUNDS 3-6 OF ALLEGED UNPATENTABILITY AND NARROWS GROUNDS 1 AND 2

Section 42.221 authorizes cancelation of a challenged claim. *See* 37 C.F.R. § 42.221(a)(3) (“Any motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims.”).

Grounds 3, 4, 5, and 6 challenge only claims 2-8 for alleged improper dependency and indefiniteness. *See* Petition at 9. For example, the Petition argues that claim 2 is improperly dependent and indefinite because it contradicts claim 1. Petition at 88. In particular, the Petition argues that (1) claim 1, from which claim 2 depends, recites “the targeting moiety comprising an antibody or antibody fragment thereof, comprising amino acids 1-119 of SEQ ID NO: 2 and the amino acid sequence of SEQ ID NO: 71”; (2) the amino acid sequence of SEQ ID NO: 71 is a “light chain amino acid sequence”; (3) claim 2 recites “the targeting moiety compris[ing] an antibody fragment selected from a Fab or scFv”; and (4) an scFv does not have a full light chain. *Id.* at 88-90 (emphases added). The Petition also argues that, because claims 3-8 depend from claim 2, those claims are likewise invalid. *Id.* at 90-91.

Because claims 2-8 will no longer exist if this motion is granted, Grounds 3-6 are moot in their entirety. There is no surviving claim for those grounds to reach, and the Board need not resolve the parties’ dispute over the proper construction of the terms “scFv” or “or.” *See* Patent Owner’s Preliminary Response at 6-13.

Grounds 1 and 2—alleged lack of written description and lack of enablement—challenge claims 1 and 9 as well, and Patent Owner does not seek to amend those claims. Grounds 1 and 2 thus are moot only as applied to canceled claims 2-8. As to claims 1 and 9, Grounds 1 and 2 remain live and are addressed on

the merits in Patent Owner's Response to the Petition.

For the avoidance of doubt, Patent Owner's decision to cancel claims 2-8 is a procedural measure directed at the dependent-claim formalities underlying Grounds 3-6, not a substantive concession regarding the patentability of any subject matter recited in those claims. For example, as noted above, the Petition argues that claim 2 and its dependents (claims 3-8) are inconsistent with and do not further narrow claim 1 because of the words "or scFv" in claim 2. Accepting that argument as true, claims 2-8 would be unpatentable and Patent Owner elects to cancel those claims on that basis. Their cancellation removes claims whose dependency structure Petitioner has challenged, without any adjudication of the patentability of the underlying subject matter those claims recite. In addition, nothing in Grounds 3-6 affects the patentability of independent claims 1 and 9, which remain in the proceeding and are addressed on the merits in Patent Owner's Response, and Patent Owner does not concede the correctness of any claim construction or other argument advanced by Petitioner regarding claim language other than "or scFv" in claim 2.

Patent Owner thus requests that the Board terminate Grounds 3-6 in their entirety, and terminate Grounds 1 and 2 as moot solely with respect to claims 2-8.

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board grant this motion, cancel claims 2-8, terminate Grounds 3-6 in their entirety, and terminate Grounds 1 and 2 solely with respect to claims 2-8.

Dated: October 6, 2026

Respectfully submitted,

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/Jennifer Librach Nall/

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APPENDIX A – LISTING OF CANCELED CLAIMS

Claims 2, 3, 4, 5, 6, 7, and 8 (canceled):

- ~~2. The molecule of claim 1, wherein the targeting moiety comprises an antibody fragment selected from a Fab or scFv.~~
- ~~3. The molecule of claim 2, wherein the antibody fragment comprises a light chain domain or a variable heavy chain domain.~~
- ~~4. The molecule of claim 3, wherein the antibody fragment comprises a light chain domain comprising the amino acid sequence of SEQ ID NO: 71.~~
- ~~5. The molecule of claim 4, further comprising a polypeptide linker comprising the amino acid sequence of SEQ ID NO: 104.~~
- ~~6. The molecule of claim 5, wherein the light chain domain comprising the amino acid sequence of SEQ ID NO: 71 is fused to an N-terminus of the polypeptide linker comprising the amino acid sequence of SEQ ID NO: 104.~~
- ~~7. The molecule of claim 6, wherein the immunomodulatory moiety comprising the amino acid sequence of SEQ ID NO: 87 is fused to a C-terminus of the polypeptide linker comprising the amino acid sequence of SEQ ID NO: 104.~~
- ~~8. The molecule of claim 3, wherein the variable heavy chain domain comprises amino acids 1-119 of SEQ ID NO: 2.~~

Claims 1 and 9 (unchanged, reproduced for reference):

1. An isolated molecule comprising a targeting moiety fused with an immunomodulatory moiety, wherein: (a) the targeting moiety comprising an antibody or antibody fragment thereof, comprising amino acids 1-119 of SEQ ID NO: 2 and the amino acid sequence of SEQ ID NO: 71, which specifically binds Epidermal Growth Factor Receptor (EGFR); and (b) an immunomodulatory moiety comprising an amino acid sequence of the extracellular domain of Transforming

growth factor-beta receptor II (TGF- β RII) comprising the amino acid sequence of SEQ ID NO: 87.

9. An isolated molecule comprising: (a) a targeting moiety comprising an antibody fragment which specifically binds Epidermal Growth Factor Receptor (EGFR) comprising a light chain domain comprising the amino acid sequence of SEQ ID NO: 71 and a variable heavy chain domain comprising amino acids 1-119 of SEQ ID NO: 2; (b) an immunomodulatory moiety comprising an amino acid sequence of the extracellular domain of Transforming growth factor-beta receptor II (TGF- β RII) comprising the amino acid sequence of SEQ ID NO: 87; and (c) a polypeptide linker comprising the amino acid sequence of SEQ ID NO: 104; wherein the light chain domain comprising the amino acid sequence of SEQ ID NO: 71 is fused to an N-terminus of the polypeptide linker comprising the amino acid sequence of SEQ ID NO: 104, and wherein the immunomodulatory moiety comprising the amino acid sequence of SEQ ID NO: 87 is fused to a C-terminus of the polypeptide linker comprising the amino acid sequence of SEQ ID NO: 104.

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PATENT OWNER'S MOTION TO AMEND** was served on Petitioner's lead and backup counsel in its entirety by electronic service at the following email addresses:

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