

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHANGHAI HONGENE BIOTECH CORP.,
Petitioner,

v.

CHEMGENES CORP.,
Patent Owner.

IPR2023-00862, Patent 8,541,569 B2
IPR2023-00875, Patent 8,309,707 B2¹

Before JOHN G. NEW, ZHENYU YANG, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

YANG, Administrative Patent Judge.

Conduct of the Proceeding
Authorizing Patent Owner's Request
to Withdraw its Motion to Amend Claims
37 C.F.R. §§ 42.54, 42.121(b)

¹ This Order addresses the same issues for each of the above-identified proceedings. We therefore exercise our discretion to issue one order to be filed in each proceeding. The parties are not authorized to use this style heading in any subsequent papers without authorization.

IPR2023-00862, Patent 8,541,569 B2
IPR2023-00875, Patent 8,309,707 B2

On February 5, 2024, Patent Owner Chemgenes Corp. (“Patent Owner”) filed a Motion to Amend Claims in each of the above-referenced proceedings. IPR2023-00862, Paper 11; IPR2023-00875, Paper 11.

On May 13, 2024, we issued a Preliminary Guidance in each case. IPR2023-00862, Paper 15; IPR2023-00875, Paper 15.

On May 22, 2024, Patent Owner contacted the Board, *via* email, seeking authorization to withdraw its Motion to Amend Claims in each case. Ex. 3003. Specifically, Patent Owner seeks to withdraw proposed substitute claims 33 and 34 in IPR2023-00862, and proposed substitute claims 4 and 5 in IPR2023-00875, from further consideration. *Id.* In its email to the Board, Patent Owner also represented that Petitioner does not oppose these requests to withdraw. *Id.*

A patent owner “may choose to withdraw its initial [Motion to Amend]. In this circumstance, no further briefing is authorized, and the Board will not address the [Motion to Amend] in a final written decision.” *Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board*, Fed. Reg. 9497, 9502 (March 15, 2019). Therefore, we authorize Patent Owner to withdraw its Motion to Amend Claims in each case. The Motion to Amend Claims, Petitioner’s Opposition, and the Board’s Preliminary Guidance will remain of record, but will have no further effect upon the course of each proceeding. No further briefing on the subject matter of the Motion to Amend Claims is authorized, and Patent Owner’s Motion to Amend will not be addressed in any Final Written Decision entered by the Board in each proceeding.

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IT IS:

ORDERED that Patent Owner's request seeking authorization to withdraw its February 5, 2024 Motion to Amend Claims in IPR2023-00862 and IPR2023-00875 is granted; and

FURTHER ORDERED that Patent Owner's Motion to Amend Claims, Petitioner's Opposition to the Motion to Amend Claims, and the Board's Preliminary Guidance will remain of record in each *inter partes* review, but will be without effect in the further conduct of these proceedings; and

FURTHER ORDERED that Patent Owner's Motion to Amend Claims will not be addressed in any Final Written Decision entered by the Board in each *inter partes* review.

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IPR2023-00875, Patent 8,309,707 B2

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