

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PROGENICS PHARMACEUTICALS, INC.,  
Petitioner,

v.

MAX-PLANCK-GESELLSCHAFT ZUR FOERDERUNG DER  
WISSENSCHAFTEN E.V.  
AND  
UNIVERSITAT ZU KOLN,  
Patent Owners.

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PGR2019-00052  
Patent 10,112,974 B2

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Before GEORGIANNA W. BRADEN, J. JOHN LEE, and  
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On February 28, 2020, a conference call was held among counsel for the parties and Judges Valek, Braden, and Lee to discuss Patent Owner's decision not to file a response in the proceeding. During the call, Patent Owner stated it was waiving the right to file a response and motion to amend. Patent Owner further indicated it did not intend to file any of the other papers contemplated in the Scheduling Order (Paper 8).

Patent Owner indicated it did not intend to disclaim, or request adverse judgment as to, all the claims in the proceeding. Patent Owner explained it would only be willing to disclaim those claims for which we determined Petitioner had met its initial burden in our Decision on Institution. *See* Paper 7, 35 (stating the information in the Petition "demonstrates it is more likely or not that claims 1–5, 7, 9, 13, 15, and 31 are unpatentable on one or more of the asserted grounds"). Thus, Patent Owner will not request adverse judgment as to Petitioner's grounds for claims 6, 8, 10–12 and 14. Accordingly, the post grant review will continue as instituted, albeit without a response or other papers from Patent Owner.

In light of Patent Owner's decision to waive its response, there is no need for the reply, sur-reply, and motion to exclude contemplated by the Scheduling Order and our rules. Petitioner may request that we allow it to file a short brief limited to addressing issues discussed in the institution decision. New evidence, however, will not be permitted.

In consideration of the foregoing, it is hereby:

ORDERED that the Scheduling Order (Paper 8) is amended as follows:

1. DUE DATES 1–3 and 5–7 are cancelled. Neither party may file any of the papers contemplated under those DUE DATES without first arranging a conference call with the parties and the Board to seek permission to do so.
2. If Petitioner decides to request the additional briefing noted above, the request must be made by March 13, 2020. The request should be made by email to [Trials@uspto.gov](mailto:Trials@uspto.gov), indicating: a) the number of pages Petitioner seeks; b) a proposed deadline for filing; c) the parties have conferred regarding Petitioner’s request; and d) whether Patent Owner opposes the request.
3. The deadline for DUE DATE 4 is changed to March 27, 2020.

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