

1 UNITED STATES PATENT AND TRADEMARKS OFFICE
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2 BEFORE THE PATENT TRIAL AND APPEAL BOARD
3 _____ X

4 MODERNA THERAPEUTICS, INC.,
5 Petitioner,

6 -vs-

7 PROTIVA BIOTHERAPEUTICS, INC.,
8 Patent Owner.

9 Case IPR2018-00680 (Patent 9,404,127)
10 Case IPR2018-00739 (Patent 9,364,435)
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11 Tuesday, April 30, 2019
12 2:01 p.m. - 2:34 p.m.

13 HEARING ON PATENT OWNER'S SUR-REPLY

14 Panel Judges Present Via Teleconference

15 JUDGE SUSAN L.C. MITCHELL
16 JUDGE SHERIDAN K. SNEDDEN
17 JUDGE RICHARD J. SMITH

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This cause came on to be heard at the time
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A P P E A R A N C E S

On Behalf of Petitioner:

IRELL & MANELLA LLP
1800 Avenue of the Stars
Los Angeles, California 90067-4276
BY: MICHAEL R. FLEMING, ESQUIRE
C. MACLAIN WELLS, ESQUIRE
mfleming@irell.com
mwells@irell.com
(Via Telephone)

On Behalf of Patent Owner:

WILSON SONSINI GOODRICH & ROSATI
Attorneys for Patent Owners
701 Fifth Avenue
Suite 5100
Seattle, Washington 98104-7036
BY: MICHAEL T. ROSATO, ESQUIRE
mrosato@wsgr.com
SONJA R. GERRARD, ESQUIRE
sgerrard@wsgr.com
(Via Telephone)

1 JUDGE MITCHELL: Oh, Great. Thank you.
2 Just, you know, and I'm sure you planned on as
3 soon as you get the transcript, if you could
4 file it in the record, that would be fantastic.

5 MR. WELLS: Yes, Your Honor.

6 JUDGE MITCHELL: Thank you.

7 And who is on the line for patent owner?

8 MR. ROSATO: Good morning, Your Honor, at
9 least on the West Coast.

10 JUDGE MITCHELL: Yeah.

11 MR. ROSATO: Good morning, good afternoon.
12 Mike Rosato on behalf of patent owner. I have
13 Sonja Gerrard here with me, both of Wilson
14 Sonsini. And we -- I guess, underscoring the
15 benefits of communication between counsel, we
16 also have a court reporter.

17 JUDGE MITCHELL: Oh, great. If you would
18 also, when you get that transcript, if you would
19 get that one on file, too, that would be
20 fantastic.

21 MR. ROSATO: Of course.

22 JUDGE MITCHELL: Well, let's get started.
23 I know that petitioner originally sought the
24 call, so let me start with petitioner.

25 MR. WELLS: Yes, Your Honor. We've asked

1 for authorization to file a motion to strike
2 regarding new evidence and new arguments that
3 the patent owner submitted with their sur-reply
4 brief. The Trial Practice Guide is clear that
5 there is -- quote, a sur-reply may not be
6 accompanied by new evidence other than
7 deposition transcripts of the cross-examination
8 of any reply witness.

9 By submitting new evidence and new
10 arguments in their sur-reply brief for the first
11 time, they've prejudiced our client. We don't
12 have the opportunity to respond or counter or
13 address the relevance of this evidence. And all
14 of this evidence is publicly available documents
15 that were foreseeable, and so we would like
16 permission to bring a motion to strike.

17 JUDGE MITCHELL: All right. Let me hear
18 from patent owner.

19 MR. ROSATO: Thank you, Your Honor.

20 So a couple things that warrants a
21 (indiscernible) in this instance, all these
22 materials, for one, are in a case where there's
23 both a motion to amend and in addition to the
24 briefing in the case in chief, so these are --
25 these are materials and evidence that are

1 properly of record in the context of the reply
2 brief in the motion to amend, as well as
3 exhibits in evidence that were properly brought
4 in during cross-examination of petitioner's
5 witness, specifically for impeach -- impeachment
6 purposes. So these are all properly of record
7 and -- at least in that regard.

8 But addition -- in addition to that, this
9 is a somewhat unique situation where the
10 references that are being brought in, they're --
11 the reason they're being brought in for
12 impeachment purposes is that, you know, one,
13 they're in direct conflict with arguments or
14 advanced in the reply materials; but, two, these
15 are really petitioner's own publications that
16 we're talking about.

17 And when petitioner has, as I noted, public
18 documents that they should have known about that
19 are running in direct and unquestionable
20 conflict with the arguments they're advancing,
21 those should have been disclosed. And the fact
22 that we were fortunately able to find some of
23 them doesn't extinguish the obligation under
24 Rule 51 that petitioner has to provide those
25 documents to us. We shouldn't be left in a

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