
From: Trials
Sent: Tuesday, April 2, 2019 7:44:48 AM (UTC-08:00) Pacific Time (US & Canada)
To: Fleming, Michael
Cc: Parmelee, Steve; Gerrard, Sonja; Rosato, Michael; Wells, Maclain
Subject: RE: IPR2018-00680 and IPR2018-00739

Counsel,

A conference call is not deemed necessary. Patent Owner's request to file a motion to strike in IPR2018-00680, Patent Owner's request for an additional 1500 words in its Sur-reply in IPR2018-00739, and Patent Owner's request for an extension of time for Due Date 3 (from April 10th to April 17th) in both IPR2018-00680 and IPR2018-00739, are GRANTED.

Counsel are strongly encouraged to resolve these types of matters by agreement without involving the Board. However, if the parties are unable to resolve their differences after thorough consultation, the Board is available to resolve outstanding issues.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Fleming, Michael <MFleming@irell.com>
Sent: Sunday, March 31, 2019 11:27 AM
To: Trials <Trials@USPTO.GOV>
Cc: Parmelee, Steve <sparmelee@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; Wells, Maclain <MWells@irell.com>
Subject: RE: IPR2018-00680 and IPR2018-00739

Dear Board,

Petitioner's counsel is available for a conference call as follows:

Monday, April 1st, from 2:30 PM to 5:00 PM Eastern (11:30 AM to 2:00 PM Pacific) or
Tuesday, April 2nd, from 1:00 PM to 5:00 PM Eastern (10:00 AM to 2:00 PM Pacific).

Many thanks

Mike Fleming

Michael R. Fleming
Irell & Manella
Attorney
Phone Number: 310-203-7915

From: Wells, Maclain <MWells@irell.com>
Sent: Friday, March 29, 2019 10:11 AM
To: Trials <Trials@USPTO.GOV>
Cc: Parmelee, Steve <sparmelee@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>; Fleming, Michael <MFleming@irell.com>; Rosato, Michael <mrosato@wsgr.com>
Subject: RE: IPR2018-00680 and IPR2018-00739

Dear Trials,

On Friday morning, we met and conferred with counsel for Patent Owner on the issues below. Petitioner opposes the requested relief. Included in Patent Owner's hearing request is improper argument regarding the issues to be addressed at the hearing. In accordance with the applicable rules, Petitioner will not reply to such arguments here.

Respectfully submitted,
C. Maclain Wells

From: Rosato, Michael <mrosato@wsgr.com>
Sent: Thursday, March 28, 2019 10:46 AM
To: Trials <Trials@USPTO.GOV>
Cc: Parmelee, Steve <sparmelee@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>; Wells, Maclain <MWells@irell.com>; Fleming, Michael <MFleming@irell.com>
Subject: IPR2018-00680 and IPR2018-00739

Dear Trials,

Following Petitioner's filings (Reply briefs, Opposition to Motion to Amend) on March 22, 2018, Patent Owner (Protiva Biotherapeutics) respectfully requests the following relief:

- Authorization to file a motion to strike in IPR2018-00680: The reply materials attempt to substitute a newly introduced reference (US 2010/0130588 submitted as EX1027) for the '069 patent on which trial was instituted. Also, the reply materials (e.g., Reply at 21-23) submit belated new argument and claim charts in attempt to cure previously identified deficiencies for Ground 4. See Institution Decision (paper 13), 27-28.
- Authorization for an additional 1500 words in the Surreply in IPR2018-00739: This is necessary to identify improper new argument and theories, including the theory that certain cationic lipids are non-toxic (e.g., Reply 6-8), new argument regarding motivation to combine variables (e.g., Reply 11), and reference to various citations and lipid formulations not previously cited or relied upon (e.g., Reply 17-18).
- Extension of time for Due Date 3 in both cases: Protiva seeks a one week extension of DD3 from April 10th, 2019 to April 17th, 2019. The extension is necessary to address, *inter alia*, three new declarations submitted by Petitioner and accommodate corresponding discovery. Parties have discussed the issue but were unable to reach agreement.

Petitioner has indicated it opposes the requested relief. Counsel for both parties are mutually available for a conference call with the Board either Monday, April 1st or Tuesday, April 2nd between 1pm and 5pm Eastern (10am-2pm Pacific) on either day.

Respectfully submitted,

Michael T Rosato (Lead Counsel for Protiva)

Wilson Sonsini Goodrich & Rosati

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