

**From:** [Trials](#)  
**To:** [Mitchell, Susan](#); [Shedden, Sheridan](#); [Smith, Richard J. \(PTAB\)](#)  
**Cc:** [Trials](#)  
**Subject:** FW: IPR2018-00739  
**Date:** Thursday, April 25, 2019 6:48:29 AM  
**Attachments:** [RE IPR2018-00739 -00680--Marked Up Exhibits.msg](#)

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Please see the below two e-mails

Thanks  
Andrew

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**From:** Rosato, Michael <mrosato@wsgr.com>  
**Sent:** Wednesday, April 24, 2019 8:39 PM  
**To:** Wells, Maclain <MWells@irell.com>; Trials <Trials@USPTO.GOV>  
**Cc:** Fleming, Michael <MFleming@irell.com>; Parmelee, Steve <sparmelee@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>  
**Subject:** RE: IPR2018-00739

Dear Trials,

Patent Owner opposes the requested relief, as neither the basis nor the specific relief (e.g., length of briefing, timing, etc.) has been identified (see also, attached email). The request is also confusing in that the same materials are addressed in Patent Owner's Reply to the Opposition to the Motion to Amend—and their entry in the record in that regard is unopposed.

In any event, the identified material directly addresses new arguments raised in Petitioner's Reply and, therefore, is properly responsive in Sur-Reply. Indeed, Petitioner does not contest that the identified material is properly responsive, just that is "new." Moreover, the identified material primarily addresses Petitioner's own publications, which also were properly introduced during cross-examination of Petitioner's witness for impeachment.

If Petitioner is authorized to file a motion to strike, Patent Owner requests authorization to file an opposition. Both briefs should be limited to 3 pages, with no reply.

Patent Owner further requests authorization to file a motion for sanctions (e.g., 37 CFR 42.12(a)(1)-(3), (6)) for Petitioner's failure to comply with discovery requirements (see 37 CFR 42.51(b)(1)(iii)) and its corresponding argument in the Reply materials directly contradicted by Petitioner's own publications—which it now seeks to strike.

Patent Owner is available for conference call 4/29 or 4/30 between 2-5pm Eastern.

Respectfully submitted,

**Michael T Rosato (Lead Counsel for Protiva/Patent Owner)**

Wilson Sonsini Goodrich & Rosati

[o] 206.883.2529 | [f] 206.883.2699

[mrosato@wsgr.com](mailto:mrosato@wsgr.com)

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**From:** Wells, Maclain [<mailto:MWells@irell.com>]  
**Sent:** Wednesday, April 24, 2019 2:52 PM  
**To:** Trials  
**Cc:** Fleming, Michael; Rosato, Michael; Parmelee, Steve; Gerrard, Sonja  
**Subject:** IPR2018-00739

Dear Trials,

Following Patent Owner's recent sur-reply filing on April 17, 2019, Petitioner (Moderna Therapeutics) respectfully requests the following relief:

- Authorization to file a motion to strike new evidence, new arguments and related portions of Patent Owner's sur-reply in IPR2018-00739: The sur-reply materials attempt to introduce new evidence for the '435 patent on which trial was instituted, including new exhibits 2046-2052 and related discussions in the sur-reply at pages 19-20 & 25-29. The sur-reply materials also attempt to introduce new arguments regarding the '554 publication at page 11, footnote 7 and test data from Examples 7-11 in the '435 patent that was not previously referenced.

Respectfully submitted,  
C. Maclain Wells

Counsel for Moderna Therapeutics

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Tuesday, April 2, 2019 7:45 AM  
**To:** Fleming, Michael <[MFleming@irell.com](mailto:MFleming@irell.com)>  
**Cc:** Parmelee, Steve <[sparmelee@wsgr.com](mailto:sparmelee@wsgr.com)>; Gerrard, Sonja <[sgerrard@wsgr.com](mailto:sgerrard@wsgr.com)>; Rosato, Michael <[mrosato@wsgr.com](mailto:mrosato@wsgr.com)>; Wells, Maclain <[MWells@irell.com](mailto:MWells@irell.com)>  
**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 10<sup>th</sup> to April 17<sup>th</sup>) 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

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**From:** Fleming, Michael <[MFleming@irell.com](mailto:MFleming@irell.com)>  
**Sent:** Sunday, March 31, 2019 11:27 AM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Parmelee, Steve <[sparmelee@wsgr.com](mailto:sparmelee@wsgr.com)>; Gerrard, Sonja <[sgerrard@wsgr.com](mailto:sgerrard@wsgr.com)>; Rosato, Michael <[mrosato@wsgr.com](mailto:mrosato@wsgr.com)>; Wells, Maclain <[MWells@irell.com](mailto: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 1<sup>st</sup>, from 2:30 PM to 5:00 PM Eastern (11:30 AM to 2:00 PM Pacific) or

Tuesday, April 2<sup>nd</sup>, 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

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**From:** Wells, Maclain <[MWells@irell.com](mailto:MWells@irell.com)>  
**Sent:** Friday, March 29, 2019 10:11 AM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Parmelee, Steve <[sparmelee@wsgr.com](mailto:sparmelee@wsgr.com)>; Gerrard, Sonja <[sgerrard@wsgr.com](mailto:sgerrard@wsgr.com)>; Fleming, Michael <[MFleming@irell.com](mailto:MFleming@irell.com)>; Rosato, Michael <[mrosato@wsgr.com](mailto: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

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**From:** Rosato, Michael <[mrosato@wsgr.com](mailto:mrosato@wsgr.com)>  
**Sent:** Thursday, March 28, 2019 10:46 AM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Parmelee, Steve <[sparmelee@wsgr.com](mailto:sparmelee@wsgr.com)>; Gerrard, Sonja <[sgerrard@wsgr.com](mailto:sgerrard@wsgr.com)>; Wells, Maclain <[MWells@irell.com](mailto:MWells@irell.com)>; Fleming, Michael <[MFleming@irell.com](mailto: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 10<sup>th</sup>, 2019 to April 17<sup>th</sup>, 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 1<sup>st</sup> or Tuesday, April 2<sup>nd</sup> between 1pm and 5pm Eastern (10am-2pm Pacific) on either day.

Respectfully submitted,

**Michael T Rosato (Lead Counsel for Protiva)**  
Wilson Sonsini Goodrich & Rosati  
[o] 206.883.2529 | [f] 206.883.2699  
[mrosato@wsgr.com](mailto:mrosato@wsgr.com)

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