

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MODERNA THERAPEUTICS, INC.,
Petitioner,

v.

ARBUTUS BIOPHARMA CORPORATION,
Patent Owner.

Case IPR2019-00554
Patent 8,058,069 B2

Before TINA E. HULSE, CHRISTOPHER G. PAULRAJ, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Authorizing Motion to Strike
37 C.F.R. § 42.5

This Order memorializes a conference call that was held in this proceeding on March 11, 2020. The Judges of this panel, as well as counsel for Patent Owner and Petitioner participated. The purpose of the call was to address Patent Owner's request for authorization to file a motion to strike Petitioner's Reply in light of allegedly new arguments included with a declaration from Petitioner's new expert witness (Ex. 1020). Patent Owner contends that much of Petitioner's Reply declaration attempts to belatedly introduce aspects of Petitioner's obviousness case that were specifically identified in the Patent Owner Response as critically missing from the petition materials. Patent Owner further contends that other aspects of the declaration introduce entirely new theories and arguments never previously presented.

Petitioner responds that its original expert, Dr. Andrew Janoff, passed away on December 19, 2019, and, as such, Petitioner engaged a replacement expert, Dr. Thomas Anchordoquy to provide the Reply declaration. Petitioner contends that Dr. Anchordoquy's declaration and Petitioner's Reply properly respond to the arguments set forth in Patent Owner's Response.

Having considered the parties' respective positions during the conference call, we authorize Patent Owner to file a motion to strike and Petitioner to file an opposition to such a motion to strike. During the conference call, counsel for Patent Owner also inquired about including new evidence with its Sur-Reply, currently due March 25, 2020, to address the allegedly new arguments in the Reply. We decline to authorize new evidence with the Sur-Reply. As set forth in our Trial Practice Guide, "[t]he sur-reply may not be accompanied by new evidence other than deposition

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transcripts of the cross-examination of any reply witness.” *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide, 73 (Nov. 2019), available at:

<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>.

Accordingly, it is hereby:

ORDERED that Patent Owner is authorized to file a motion to strike, limited to five pages in length, by no later than March 25, 2020;

FURTHER ORDERED that Petitioner is authorized to file an opposition to Patent Owner’s motion to strike, also limited to five pages in length, by no later than April 1, 2020; and

FURTHER ORDERED that Patent Owner is not authorized to file any new evidence with its Sur-Reply other than the deposition transcripts of the cross-examination of any reply witness.

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