

From: [Diner, Bryan](#)
To: [Weinstein, Louis](#); [Trials](#)
Cc: [Hasford, Justin](#); [O'Connell, Caitlin](#); [Yang, Christina Ji-Hye](#); [Pollard, Patrick](#)
Subject: RE: IPR2022-00142 and IPR2022-00146 Petitioner's Request for Teleconference re: Replies on Fintiv and 325(d) issues
Date: Tuesday, March 15, 2022 6:17:33 PM

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To the Board:

We write to address Petitioner's request to file a pre-institution reply to Patent Owner's Preliminary Responses in IPR2022-00142 and IRP2022-00146. Specifically, we write to further clarify Patent Owner's position and its decision not to consent to Petitioner's request.

While Patent Owner does not believe that Petitioner is entitled to a pre-institution reply on either issue, Patent Owner nevertheless offered the following compromise during the parties' meet-and-confer teleconference:

- Patent Owner would not oppose Petitioner's request for a pre-institution reply with the following conditions:
 - 1) Petitioner's reply would be limited to addressing the *Fintiv* factors and would not include a reply on issues under 35 U.S.C. § 325(d)
 - 2) With respect to the *Fintiv* issues, the Petitioner could address Factors 1-5 and the specific arguments raised by Patent Owner with respect to Factor 6. The limitation on the scope of the reply for *Fintiv* Factor 6 was intended to ensure that the Petitioner could not use this reply as a means for responding to Patent Owner's arguments on the merits; and
 - 3) Patent Owner would be given an opportunity to file a sur-reply.

Petitioner did not accept Patent Owner's compromise proposal or offer any alternative proposal for Patent Owner to consider. Because the parties could not reach an agreement, Patent Owner informed Petitioner that it could not consent to Petitioner's request. Patent Owner remains willing to consent to a pre-institution reply under the conditions outlined above.

Should the Board wish to discuss this issue further, Patent Owner is available for a teleconference at the days and times noted in Petitioner's email below.

Respectfully submitted,
Bryan Diner
Reg. No. 32,409
Counsel for Patent Owner Eye Therapies LLC

From: Weinstein, Louis <lweinstein@windelsmarx.com>

Sent: Tuesday, March 15, 2022 5:19 PM

To: 'Trials@uspto.gov' <Trials@uspto.gov>

Cc: Diner, Bryan <bryan.diner@finnegan.com>; Hasford, Justin <Justin.Hasford@finnegan.com>; O'Connell, Caitlin <Caitlin.O'Connell@finnegan.com>; Yang, Christina Ji-Hye <Christina.Yang@finnegan.com>; Weinstein, Louis <lweinstein@windelsmarx.com>; Pollard, Patrick <ppollard@windelsmarx.com>

Subject: IPR2022-00142 and IPR2022-00146 Petitioner's Request for Teleconference re: Replies on Fintiv and 325(d) issues

EXTERNAL Email:

To the Board:

Petitioner respectfully asks for a teleconference in IPR2022-00142 and IPR2022-00146 to discuss Petitioner's request to file a Reply to Patent Owner's Preliminary Responses in IPR2022-00142 and IPR2022-00146. Petitioner's Replies would address: a) *Fintiv* issues, including without limitation the *Sotera* type Stipulation filed by Petitioner March 10, 2022 in [District Court](#); and b) Issues under 35 U.S.C. Sec. 325(d).

Petitioner and Patent Owner conducted a meet and confer on March 15, 2022. Patent Owner did not consent to [Petitioner's](#) request to file Replies.

Except for March 17, Petitioner is generally available for a teleconference. Petitioner and Patent Owner are both available for a teleconference at the following times:

March 22 After 2:30 PM ET

March 24 Before noon ET

Respectfully submitted

Louis H. Weinstein

Reg. No. 45,205

*Counsel for Petitioner Slayback Pharma LLC
in IPR2022-00142 and IPR2022-00146.*

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