

From: [Trials](#)
To: [Lu, John](#); [Trials](#)
Cc: [#Milbank-MiltenyiIPRs](#); [Landry, Brian R.](#); [Doyle, Kathryn](#); [Behrooz, Alireza](#); [Berniker, Jessamyn](#); [Krinsky, David](#); [Fletcher, Thomas](#)
Subject: RE: IPR2022-00853 and IPR2022-00855 - Petitioner's request for authorization for Reply to Patent Owner's Preliminary Response
Date: Friday, August 5, 2022 3:47:21 PM

Counsel,

Petitioner's request for leave to file 5 page Replies addressing "(1) characterization of the Porter reference as prior art in view of a new fact declaration submitted with the POPRs (Ex. 2044); (2) claim construction of the preamble 'treating cancer' (in IPR2022-00853 only), and 'anti-tumor effective amount' (in both IPRs); and (3) discretionary denial under Section 325(d)" is authorized because the panel believes that further briefing on these issues may be helpful. As proposed in Petitioner's email, the Replies are due within 5 business days of this communication. Patent Owner may submit Sur-replies of equal length within 5 business days of Petitioner's Reply.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Lu, John <JLu@milbank.com>
Sent: Friday, August 5, 2022 2:32 PM
To: Trials <Trials@USPTO.GOV>
Cc: #Milbank-MiltenyiIPRs <Milbank-MiltenyiIPRs@milbank.com>; Landry, Brian R. <Brian.Landry@saul.com>; Doyle, Kathryn <Kathryn.Doyle@saul.com>; Behrooz, Alireza <alireza.behrooz@saul.com>; Berniker, Jessamyn <JBerniker@wc.com>; Krinsky, David <DKrinsky@wc.com>; Fletcher, Thomas <TFletcher@wc.com>
Subject: IPR2022-00853 and IPR2022-00855 - Petitioner's request for authorization for Reply to Patent Owner's Preliminary Response

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Your Honors,

Petitioner respectfully requests authorization from the Board to file 5-page Replies to Patent Owner's Preliminary Responses ("POPR") in IPR2022-00853 and IPR2022-00855. Each Reply would address the following issues: (1) characterization of the Porter reference as prior art in view of a new fact declaration submitted with the POPRs (Ex. 2044); (2) claim construction of the preamble

“treating cancer” (in IPR2022-00853 only), and “anti-tumor effective amount” (in both IPRs); and (3) discretionary denial under Section 325(d). Petitioner does not oppose a Sur-Reply of equal length for Patent Owner. Petitioner submits that no new evidence should accompany either the Reply or Sur-Reply.

Petitioner proposes the briefing scheduled provided below:

| IPR Proceeding | Preliminary Response Filed | Institution Deadline | Petitioner’s Reply Deadline | Patent Owner’s Sur-Reply Deadline |
|----------------|----------------------------|----------------------|---|--|
| IPR2022-00853 | July 19, 2022 | October 19, 2022 | Within 5 business days of the Board’s authorization | Within 5 business days of Petitioner’s Reply |
| IPR2022-00855 | July 19, 2022 | October 19, 2022 | Within 5 business days of the Board’s authorization | Within 5 business days of Petitioner’s Reply |

Counsel for Petitioner and Patent owner met and conferred regarding this request. Patent Owner opposes this request, writing: “We would be willing to agree to a 3-page reply on the issue of Porter as prior art with a corresponding sur-reply for us. We view the other two issues you identify as points you were able to address adequately in your petitions. Please let us know if that proposal is agreeable to you. Otherwise, we oppose your request.”

Should the Board wish to convene a call on this matter, the Parties are jointly available at the following times:

- Wednesday, August 10: 1:00 - 4:00 pm Eastern
- Friday, August 12: 1:00 - 4:00 pm Eastern

If these times do not work for the Board, the parties will confer and offer additional times.

Good Cause: On issue (1), Patent Owner’s new fact witness declaration disclaiming prior-art disclosures was unforeseeable, and further briefing will establish that this is a factual dispute that should not preclude institution. On issue (2), Patent Owner’s claim construction position was not foreseeable, and additional briefing will clarify the record and aid the Board’s deliberations. On issue (3), while the Petitions preemptively address aspects of Patent Owner’s arguments for discretionary denial (pp. 69-71, IPR2022-00853 and pp. 78-80, IPR2022-00855), Petitioner could not have predicted all of Patent Owner’s arguments, particularly those based on misreading of caselaw.

Best Regards,

John Lu

Counsel for Petitioner

John Lu | **Milbank** | Partner

2029 Century Park East, 33rd Floor | Los Angeles, CA 90067-3019

O: [+1 424.386.4318](tel:+14243864318) | M: [+1 510.325.4415](tel:+15103254415)

JLu@milbank.com | milbank.com