

**From:** [Trials](#)  
**To:** [Toft, Lukas](#); [Trials](#); [Zeilberger, Daniel](#); [Modi, Naveen](#)  
**Cc:** [Dittmann, Eric W.](#); [Yusem, Max](#); [Ho, Krystina L.](#); [bluebird-IPR-PH](#); [Chen, Joe](#); [French-Brown, Wanda D.](#); [Suh, Howard S.](#)  
**Subject:** RE: IPR2023-00070, -00074  
**Date:** Thursday, February 16, 2023 12:55:11 PM  
**Attachments:** [image001.png](#)

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Counsel,

From the Board –

Based on the circumstances involved, and in view of no opposition from Patent Owner, the due date for Petitioner’s Reply to Patent Owner’s Preliminary Response and Patent Owner’s Sur-reply is extended by one business day. Accordingly, Petitioner’s Reply filed today is timely, and Patent Owner’s Sur-reply will be due on or before February 27<sup>th</sup>.

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office  
(571) 272-7822

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**From:** Toft, Lukas <[ltoft@foxrothschild.com](mailto:ltoft@foxrothschild.com)>  
**Sent:** Thursday, February 16, 2023 12:33 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>; Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>  
**Cc:** Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>; Suh, Howard S. <[HSuh@foxrothschild.com](mailto:HSuh@foxrothschild.com)>  
**Subject:** RE: IPR2023-00070, -00074

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Patent Owner does not oppose the proposed extensions and will plan to file its Sur-reply by February 27<sup>th</sup>.

**Lukas Toft**  
**Fox Rothschild LLP**  
(612) 607-7336

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** February 16, 2023 11:15 AM  
**To:** Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Toft, Lukas <[ltoft@foxrothschild.com](mailto:ltoft@foxrothschild.com)>  
**Cc:** Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** [EXT] RE: IPR2023-00070, -00074

Counsel,

From the Board –

Based on the circumstances involved, we are inclined to extend the due date for Petitioner’s Reply and Patent Owner’s Sur-reply by one business day. With that extension, Petitioner’s filing today would be viewed as timely, and Patent Owner’s Sur-reply would be due on February 27<sup>th</sup>. If Patent Owner opposes this extension, a conference call will be scheduled with the parties to resolve the matter. Therefore, Patent Owner is instructed to respond to this email today indicating whether it opposes the proposed extension.

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office  
(571) 272-7822

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**From:** Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Sent:** Thursday, February 16, 2023 9:12 AM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Toft, Lukas <[ltoft@foxrothschild.com](mailto:ltoft@foxrothschild.com)>  
**Cc:** Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** RE: IPR2023-00070, -00074

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Thank you for the instructions. With the assistance of the PTAB P-TACTS Admin team, we were able to successfully submit the replies into P-TACTS this morning. We note that the file names were updated to remove apostrophes, as instructed by the P-TACTS Admin team, but the underlying PDFs are otherwise identical to what was sent yesterday (February 15).

As previously noted, we apologize for any inconvenience this may have caused, and are available for a call if the Board would like to discuss.

Respectfully,  
Daniel Zeilberger  
Counsel for Petitioner

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Thursday, February 16, 2023 8:20 AM  
**To:** Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Toft, Lukas <[ltoft@foxrothschild.com](mailto:ltoft@foxrothschild.com)>; Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Cc:** Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** [EXT] RE: IPR2023-00070, -00074

--- External Email ---

Counsel,

Thank you for the email. Please contact the PTAB P-TACTS Admin team for P-TACTS technical assistance. Please let the Board know when you have filed.

Email: [PTABP-TACTSAdmin@uspto.gov](mailto:PTABP-TACTSAdmin@uspto.gov)

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office  
(571) 272-7822

**From:** Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>  
**Sent:** Wednesday, February 15, 2023 11:54 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Toft, Lukas <[toft@foxrothschild.com](mailto:toft@foxrothschild.com)>; Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Cc:** Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** RE: IPR2023-00070, -00074

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Your Honors,

Petitioner has been trying to file the replies that were authorized in the email below, but is having trouble with the PTAB's P-TACTS system. We are getting an error that says "Application Systems Error. Please contact PTAB Support Team." As a result, we are attaching copies of the replies to this email and request that they be uploaded to the P-TACTS system.

We have copied counsel for the other side on this email. This email will also constitute service of these papers on them.

We apologize for any inconvenience this may cause and are available for a call should you want to have a call to discuss the issues we had with the filings.

Respectfully,  
Naveen Modi  
Counsel for Petitioner

Naveen Modi  
Global Co-Chair of IP & Partner  
Paul Hastings LLP  
(202) 551-1990

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Friday, February 10, 2023 3:21 PM  
**To:** Toft, Lukas <[toft@foxrothschild.com](mailto:toft@foxrothschild.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Cc:** Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** [EXT] RE: IPR2023-00070, -00074

--- External Email ---

Counsel, Patent Owner's unopposed request for additional briefing is granted. Accordingly, in each of IPR2023-00070, IPR2023-00074, Patent Owner is authorized to file a Sur-Reply of no more than five pages that addresses only the issues addressed in Petitioner's Reply to the Patent Owner Preliminary Response. No new exhibits shall accompany the Sur-Reply. The Sur-Reply shall be filed by February 24, 2023.

Thank you,  
Eric W. Hawthorne  
*Supervisory Paralegal Specialist*  
*Patent Trial and Appeal Board*

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**From:** Toft, Lukas <[toft@foxrothschild.com](mailto:toft@foxrothschild.com)>  
**Sent:** Friday, February 10, 2023 10:57 AM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Cc:** Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** RE: IPR2023-00070, -00074

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Your Honors,

Patent Owner respectfully requests the ability to file a corresponding sur-reply, not to exceed five pages and without additional exhibits, to respond to any arguments raised in the replies, which Petitioner has indicated below that it does not oppose. Patent Owner would be prepared to file any sur-reply on or before February 24.

Best Regards,  
Luke

**Lukas Toft**  
**Fox Rothschild LLP**  
(612) 607-7336

---

**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** February 10, 2023 7:07 AM  
**To:** Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Cc:** Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Toft, Lukas <[ltoft@foxrothschild.com](mailto:ltoft@foxrothschild.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Subject:** [EXT] RE: IPR2023-00070, -00074

Counsel,

From the Board –

Petitioner's request for additional briefing is granted. Under the circumstances, we find that additional briefing limited to the three issues itemized in Petitioner's email would be useful. Accordingly, in each of IPR2023-00070, IPR2023-00074, Petitioner is authorized to file a Reply to Patent Owner's Preliminary Response of no more than five pages that addresses only those issues. No new exhibits shall accompany the Reply. The Reply shall be filed by February 15, 2023. In view of this authorization, a conference call is not necessary.

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office  
(571) 272-7822

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**From:** Zeilberger, Daniel <[danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com)>  
**Sent:** Thursday, February 9, 2023 1:06 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Modi, Naveen <[naveenmodi@paulhastings.com](mailto:naveenmodi@paulhastings.com)>; Dittmann, Eric W. <[ericdittmann@paulhastings.com](mailto:ericdittmann@paulhastings.com)>; Yusem, Max <[maxyusem@paulhastings.com](mailto:maxyusem@paulhastings.com)>; Ho, Krystina L. <[krystinaho@paulhastings.com](mailto:krystinaho@paulhastings.com)>; bluebird-IPR-PH <[bluebird-IPR-PH@paulhastings.com](mailto:bluebird-IPR-PH@paulhastings.com)>; Toft, Lukas <[ltoft@foxrothschild.com](mailto:ltoft@foxrothschild.com)>; Chen, Joe <[joechen@foxrothschild.com](mailto:joechen@foxrothschild.com)>; French-Brown, Wanda D. <[WFrench-Brown@foxrothschild.com](mailto:WFrench-Brown@foxrothschild.com)>  
**Subject:** IPR2023-00070, -00074

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Your Honors,

Petitioner writes regarding the Patent Owner Preliminary Responses (“POPRs”) filed in IPR2023-00070 and IPR2023-00074 on January 25, 2023. Petitioner respectfully seeks authorization to file 5-page replies responding to the assertions made in the POPRs regarding the priority date of the challenged patents (i.e., U.S. Patent Nos. 7,541,179 and 8,058,061). Petitioner believes good cause exists for such replies because the POPRs make arguments that Petitioner could not have anticipated, including (1) misinterpreting the prosecution record and provisional applications; (2) distorting the substance of Petitioner’s argument, and (3) applying an incorrect legal standard. For the sake of clarity, Petitioner notes that it also disagrees with the other arguments advanced in the POPR. However, Petitioner believes the record is otherwise sufficiently developed for purposes of institution, and thus is not seeking a reply on any other issues. Petitioner would be prepared to file the replies within 2 business days, and would not oppose corresponding sur-replies responding to any arguments raised in the replies.

Petitioner has conferred with counsel for San Rocco Therapeutics (“SRT”), who represents in the POPRs that it has authority to act as the Patent Owner on behalf of Sloan Kettering Institute for Cancer Research. SRT requested that its position be reflected in this email as follows: SRT disagrees with Petitioner’s characterizations above and believes that no good cause exists. SRT believes the Board can properly interpret the prosecution record, provisional applications, and the Parties’ arguments and can apply the proper legal standard. SRT also believes that arguments related to the priority date of the challenged patents were reasonably foreseeable and that any arguments thereto could and should have been addressed in the Petition. Petitioner also delayed making this ask for two weeks from the filing of the POPRs. Accordingly, SRT opposes this request.

Should the Board wish to schedule a conference call to discuss this matter, the parties are available next week on Tuesday, February 14, between 2 p.m. and 5 p.m. ET, and Thursday, February 16, between 10 a.m. and 12 p.m. ET.

Respectfully,  
Daniel Zeilberger  
Counsel for Petitioner

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**PAUL  
HASTINGS**

**Daniel Zeilberger | Of Counsel, Litigation Department**

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Main: +1.202.551.1700 | Fax: +1.202.551.0493 | [danielzeilberger@paulhastings.com](mailto:danielzeilberger@paulhastings.com) |  
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\*\*\*\*\*  
This message is sent by a law firm and may contain information that is privileged or confidential. If you received this transmission in error, please notify the sender by reply e-mail and delete the message and any attachments. If you reply to this message, Paul Hastings may collect personal information including your name, business name and other contact details, and IP address. For more information about Paul Hastings’ information collection, privacy and security principles please click [HERE](#). If you have any questions, please contact [Privacy@paulhastings.com](mailto:Privacy@paulhastings.com).

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