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To: [Krause, Andrew](#)
Cc: [~Walter, Derek](#); adrian.percer@weil.com; Personalis.Foresight@weil.com; [#ForesightIPRs](#); [~Naini, Amir](#); [Trials](#)
Subject: RE: IPR2023-00224/IPR2023-00317 - Petitioner's request for authorization to Reply to POPRs
Date: Friday, April 7, 2023 3:09:18 PM

Counsel,

From the Board –

Petitioner is authorized to submit a Reply of no more than 6 pages to the Patent Owner Preliminary Response (“POPR”) filed in IPR2023-00224, and a Reply of no more than 4 pages to the POPR filed in IPR2023-00317. Petitioner’s briefs are due no later than COB on Friday, April 14. Patent Owner may file responsive Sur-replies having the same page limits and due no later than COB on Friday, April 28.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Krause, Andrew <AKrause@irell.com>
Sent: Friday, April 7, 2023 1:54 PM
To: Trials <Trials@USPTO.GOV>
Cc: ~Walter, Derek <derek.walter@weil.com>; adrian.percer@weil.com; Personalis.Foresight@weil.com; [#ForesightIPRs](mailto:#ForesightIPRs@irell.com); ~Naini, Amir <amir@nainipc.com>
Subject: IPR2023-00224/IPR2023-00317 - Petitioner's request for authorization to Reply to POPRs

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Your Honors,

Petitioner respectfully requests authorization from the Board to file a 6-page reply to the Patent Owner Preliminary Response (“POPR”) filed in IPR2023-00224 (U.S. Patent No. 11,384,394) and a 4-page reply to the POPR filed in IPR2023-00317 (U.S. Patent No. 11,408,033). Petitioner could file such replies within 5 business days of receiving the Board’s authorization.

Petitioner’s replies would address the following issues:

1. Claim construction of the term “whole genome sequencing.” [-00224 IPR only]
2. Claim construction of the term “capture probe.” [both IPRs]
3. Patent Owner’s contentions regarding secondary considerations. [both IPRs]

Good cause exists for Petitioner's proposed replies for at least the following reasons. On issue (1), Patent Owner's claim construction position and accompanying new testimonial evidence (Ex. 2007) were not foreseeable and additional briefing will clarify the record and aid the Board's deliberations. On issue (2), while the Petitions preemptively address aspects of Patent Owner's arguments, Petitioner could not have predicted all of Patent Owner's arguments, particularly those based on Patent Owner's characterization of the intrinsic record, which Petitioner disputes. Thus, additional briefing will clarify the record and aid the Board's deliberations. On issue (3), Patent Owner relies on allegations of "nexus" that were produced contemporaneously with the POPRs (-00224 IPR, Ex. 2012; -00317 IPR, Ex. 2008) and thus were unforeseeable.

Petitioner conferred with Patent Owner, and Patent Owner opposes this request. The parties are conferring on available times should the Board wish to convene a conference call to discuss this matter.

Respectfully,
Andrew Krause
Counsel for Petitioner Foresight Diagnostics Inc.

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