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Paper 41
Entered: February 23, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC,
Petitioner,

v.

PERSONALIS, INC,
Patent Owner.

IPR2023-00224 (Patent 11,384,394 B2)
IPR2023-00317 (Patent 11,408,033 B2)

Before ULRIKE W. JENKS, ROBERT A. POLLOCK, and TIMOTHY G. MAJORS, *Administrative Patent Judges.*

POLLOCK, *Administrative Patent Judge*.

ORDER[1]
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

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[1] The combined caption is for administrative convenience only and does not indicate that IPR2023-00224 and IPR2023-00317 have been joined. The parties are not authorized to use this caption without express permission of the Board.

On February 22, 2024, a teleconference was held between counsel for Petitioner, counsel for Patent Owner, and Judges Jenks, Pollock, and Majors. The purpose of the call was to discuss Petitioner's request for authorization to move to strike Exhibits 2178, 2181, and 2183 in IPR2023-00224, Exhibits 2178, 2181, 2185, and 2186 in IPR2023-00317, and the corresponding arguments in Patent Owner's Sur-Replies in each proceeding.

During the call, Petitioner asserted that these exhibits, as well as arguments corresponding to these exhibits in Patent Owner's Sur-Replies in IPR2023-00224 and IPR2023-00317, were untimely under 37 C.F.R. § 42.23(b). Patent Owner responded that these exhibits and arguments are responsive to arguments raised in Petitioner's Reply briefs. Patent Owner also asserted that these exhibits are relevant to the construction of the claim term "capture probes."

Having considered the parties' arguments, we do not authorize Petitioner to file a motion to strike. However, to aid us in reaching our final written decision in these proceedings and to give Petitioner an opportunity to further address in writing, the subject exhibits, we authorize Petitioner to file a response to Patent Owner's Sur-Replies in IPR2023-00224 and IPR2023-00317 subject to the instructions set forth below.

In consideration of the foregoing, it is hereby

ORDERED that Petitioner's request for authorization to file a motion to strike is *denied*;

FURTHER ORDERED that Petitioner is authorized to submit a brief in IPR2023-00224, not to exceed three (3) pages, addressing Exhibits 2178,

2181, and 2183 and the corresponding arguments in Patent Owner's Sur-Reply, and due February 29, 2024;

FURTHER ORDERED that Petitioner is authorized to submit a brief in IPR2023-00317, not to exceed three (3) pages, addressing Exhibits 2178, 2181, 2185, and 2186 and the corresponding arguments in Patent Owner's Sur-Reply, and due February 29, 2024;

FURTHER ORDERED that no other briefing is authorized.

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