

From: [Trials](#)
To: [Krause, Andrew](#)
Cc: [~Walter, Derek](#); ["adrian.percer@weil.com"](#); [Personalis Foresight Service](#); [#ForesightIPRs](#); [~Naini, Amir](#); [Trials](#)
Subject: RE: IPR2023-00545/IPR2023-00546 - Petitioner's request for authorization to Reply to POPRs
Date: Thursday, May 25, 2023 2:38:36 PM

Counsel,

The Board authorizes additional briefing on the construction of “personalized genetic testing,” and on Patent Owner’s contentions regarding secondary considerations as requested in Petitioner’s May 25 email. Petitioner’s Reply shall be due by the COB on June 2, 2023. Patent Owner may file a responsive Sur-reply due no later than the COB on June 16, 2023. Neither parties’ brief shall exceed 5 pages.

Regards,

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

From: Krause, Andrew <AKrause@irell.com>
Sent: Thursday, May 25, 2023 12:58 PM
To: Trials <Trials@USPTO.GOV>
Cc: ~Walter, Derek <derek.walter@weil.com>; 'adrian.percer@weil.com' <adrian.percer@weil.com>; Personalis Foresight Service <Personalis.Foresight.Service@weil.com>; #ForesightIPRs <ForesightIPRs@irell.com>; ~Naini, Amir <amir@nainipc.com>
Subject: IPR2023-00545/IPR2023-00546 - 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 5-page reply to the Patent Owner Preliminary Response (“POPR”) filed in each of IPR2023-00545 and -00546.

Petitioner’s replies would address the following issues:

1. Claim construction of the term “personalized genetic testing.”
2. Patent Owner’s contentions regarding secondary considerations.

Good cause exists for Petitioner’s proposed replies for at least the following reasons. On issue (1), Patent Owner’s claim construction position -- particularly aspects of that position based on Patent Owner’s characterization of the intrinsic record, which Petitioner disputes -- was not foreseeable and additional briefing will clarify the record and aid the Board’s deliberations. On issue (2), Patent

Owner relies on allegations of “nexus” that were produced contemporaneously with the POPR and thus were unforeseeable.

Petitioner conferred with Patent Owner, and Patent Owner does not oppose this request, provided it is afforded a sur-reply of equal length to be due no sooner than 14 days after the filing of Petitioner’s replies. In light of the parties’ positions, Petitioner respectfully requests the Board authorize the request with the following briefing schedule:

1. Petitioner’s Replies – Due June 2, 2023
2. Patent Owner’s Sur-Replies – Due June 16, 2023

Respectfully,
Andrew Krause
Counsel for Petitioner Foresight Diagnostics Inc.

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