

From: [Trials](#)
To: [Lu, John](#); [Trials](#)
Cc: [Jeffries, Andrea W.](#); [Geers, Sarah A.](#); [IPR2023-00760](#); [Hughes, Diane L.](#); [PTABDocketL2Y7](#); [PTABDocketG2F1](#); [PTABDocketC3L8](#); [PTABDocketG3S7](#); [PTABDocketG3D7](#)
Subject: RE: IPR2023-00760: Miltenyi Biomedicine GmbH v. Fred Hutchinson Cancer Center
Date: Thursday, July 6, 2023 10:59:47 AM
Attachments: [image003.png](#)

Counsel,

From the Board –

Petitioner is authorized to file a ten-page reply to the POPR to address the topics identified in the email below. The reply must be filed by July 17, 2023.

Patent Owner is authorized to file a ten-page sur-reply to Petitioner's reply to address the arguments raised in the reply. The reply must be filed by July 31, 2023.

No new evidence is allowed with the briefing.

No conference is necessary at this time.

Regards,

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

From: Lu, John <jlu@orrick.com>
Sent: Wednesday, July 5, 2023 2:38 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jeffries, Andrea W. <a jeffries@jonesday.com>; Geers, Sarah A. <sgeers@jonesday.com>; IPR2023-00760 <IPR2023-00760@jonesday.com>; Hughes, Diane L. <dlhughes@JonesDay.com>; PTABDocketL2Y7 <PTABDocketL2Y7@orrick.com>; PTABDocketG2F1 <PTABDocketG2F1@orrick.com>; PTABDocketC3L8 <PTABDocketC3L8@orrick.com>; PTABDocketG3S7 <PTABDocketG3S7@orrick.com>; PTABDocketG3D7 <PTABDocketG3D7@orrick.com>
Subject: IPR2023-00760: Miltenyi Biomedicine GmbH v. Fred Hutchinson Cancer Center

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Dear Board,

I am lead counsel for Petitioner in *Miltenyi Biomedicine GmbH v. Fred Hutchinson Cancer Center*, IPR2023-00760. Last week, Patent Owner submitted a Preliminary Response. Petitioner requests a ten-page reply brief to address three issues raised by the POPR, identified below, and would agree to an equal-length sur-reply from Patent Owner in

response. Petitioner has conferred with Patent Owner (copied on this email), who believes additional briefing to be unnecessary. The parties disagree about whether these proposed topics for reply briefing were reasonably foreseeable.

Petitioner's three proposed topics for reply briefing are:

1. Whether "Singh-3" (Ex. 2001), a post-priority date publication, and "Singh-2" (Ex. 2003) discuss the same composition as Singh 2008 (Ex. 1003)
2. The law of anticipation as it applies to whether in-vivo data is required for Singh 2008
3. How, if at all, Ex. 2014, should be evaluated by the Board for transduction efficacy

The parties are available for a conference call on Thursday between 11am – 1pm ET and Friday between 11am – 3pm ET, should the Board wish to further discuss these matters.

Sincerely,
Yite John Lu
Lead Counsel for Petitioner Miltenyi
Reg. No. 63,158

John Lu

Partner

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