UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BioNTech SE and Pfizer, Inc.,
Petitioner,

v.

ModernaTX, Inc.
Patent Owner

Case No. IPR2023-01359

Patent 10,933,127

PATENT OWNER'S REQUEST FOR ORAL ARGUMENT

Pursuant to the Board's March 12, 2024 Scheduling Order (Paper No. 19), Patent Owner respectfully requests oral argument, as currently scheduled on December 10, 2024. Patent Owner respectfully requests that the oral argument be held in-person at the USPTO headquarters in Alexandria, Virginia. Patent Owner respectfully requests the ability to present possible demonstratives and exhibits.

Patent Owner further requests ninety (90) minutes of argument time for each side for IPR2023-01358 and IPR2023-01359, for a total of three (3) hours in the consolidated hearing, subject to any additional time allowed for participation in the LEAP program. To the extent the Board orders a different time allotment, Patent Owner respectfully requests at least the same amount of time granted to Petitioner. Patent Owner has conferred with Petitioner regarding this plan and Petitioner noted their agreement.

Pursuant to 37 C.F.R. § 42.70, Patent Owner specifies the following issues to be argued:

- Issues related to the Board's Decision Granting Institution of *Inter Partes Review* (Paper Nos. 18 and 20) and the grounds instituted in the Decision;
- Whether claims 1-3, 6-9, 11-13, 17-18, and 20 are patentable under 35 U.S.C. § 102(a) as not being anticipated by Schrum (Petitioner's Ground I);
- Whether claims 1-3, 6-9, 11-13, 17-18, and 20 are patentable under 35 U.S.C. § 103 as not being obvious over Schrum in view of Geall

(Petitioner's Ground II);

- Whether claims 1-3, 6-9, 11-13, 17-18, and 20 are patentable under 35 U.S.C. § 103 as not being obvious over Schrum in view of Yang (Petitioner's Ground III);
- Whether claims 1-3, 6-9, 11-13, 17-18, and 20 are patentable under 35 U.S.C. § 103 as not being obvious over Schrum in view of Altmeyer (Petitioner's Ground IV);
- Patent Owner's arguments raised in Patent Owner's Preliminary Response (Paper No. 9), Patent Owner's Sur-Reply in Support of Preliminary Response (Paper No. 15), Patent Owner's Response (Paper No. 42), and Patent Owner's Sur-Reply (Paper No. 72);
- Patent Owner's response to any arguments raised in the Petition (Paper No. 1), Petitioner's Reply to Preliminary Response (Paper No. 10), Petitioner's Reply to Patent Owner's Response (Paper Nos. 59 and 60);
- Patent Owner's Preliminary Statement Regarding Alleged Inconsistent Positions (Paper No. 11), Patent Owner's response to any arguments raised in Petitioner's Preliminary Statement Regarding Alleged Inconsistent Positions (Paper Nos. 14 and 16);
- Patent Owner's response to any issues specified by Petitioner in its Request for Oral Argument;

- Patent Owner's Motion to Seal and for Entry of Stipulated Protective Order (Paper No. 12), Petitioner's Motion to Seal (Paper No. 13);[1]
- Patent Owner's Motion to Seal (Paper No. 41), Petitioner's Motion to Seal (Paper No. 58), Patent Owner's Motion to Seal (Paper No. 71);
- Any arguments or additional issues raised by either party in a Motion to Strike (if any), Motion to Exclude (if any), or any other motion, paper, opposition, response, reply, or sur-reply filed by either party before oral argument; and
- Any other outstanding motions and pleadings, and any other issues that the Board deems necessary for issuing a Final Written Decision.

Respectfully submitted,

Date: October 23, 2024

By: /Emily R. Whelan/

Emily R. Whelan (Reg. No. 50,391)
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109
Tel. (617) 526-6567
Email: Emily.Whelan@wilmerhale.com
Counsel for Patent Owner

[1] The Board granted the Motion to Seal in Paper Nos. 12 and 13 in its Institution Decision, subject to further order from the Board.

CERTIFICATE OF SERVICE

I hereby certify that on October 23, 2024, I caused a true and correct copy of the foregoing materials:

- Patent Owner's Request for Oral Argument

to be served via email, as consented to by Petitioner, to:

COVIDPatentPfizer@wc.com
BioNTech-Moderna-IPR@paulhastings.com

By: /Wenli Gu/
Wenli Gu (Reg. No. 72,124)
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109
Tel: (617) 526-6567
Email: Wenli.Gu@wilmerhale.com