

From: [Trials](#)
To: [Jones, Brendan](#); [Trials](#)
Cc: [Jim Glass](#); [Sandra Haberny](#); [Jihong Lou](#); [Anastasia Fernands](#); [Ware, Donald](#); [Burg, Sarah](#); [Shore, David](#); [Geneoscopy IPR](#); [QE-Exact](#)
Subject: RE: Geneoscopy v. Exact Sciences, IPR2024-00459 - Request for Reply to POPR
Date: Monday, May 20, 2024 4:23:16 PM

Counsel:

Petitioner's request for authorization to file a Reply and Patent Owner's request for authorization to file a Sur-Reply are both granted, limited to the subject matter agreed upon by the parties.

The panel notes, however, that the Preliminary Response was filed three weeks ago on April 30, 2024. The parties' request for 2 weeks to file each paper, therefore, encroaches on the Board's time to prepare the decision on institution.

Accordingly, the Board modifies the parties' proposed briefing schedule as follows:

- Petitioner may file its 8-page Reply by no later than May 30, 2024.
- Patent Owner may file its 8-page Sur-reply by no later than June 10.

Regards,

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

From: Jones, Brendan <BJones@foleyhoag.com>
Sent: Monday, May 20, 2024 11:09 AM
To: Trials <Trials@USPTO.GOV>
Cc: Jim Glass <jimglass@quinnemanuel.com>; Sandra Haberny <sandrahaverny@quinnemanuel.com>; Jihong Lou <jihonglou@quinnemanuel.com>; Anastasia Fernands <anastasiafernands@quinnemanuel.com>; Ware, Donald <DRW@foleyhoag.com>; Burg, Sarah <SBurg@foleyhoag.com>; Shore, David <dshore@foleyhoag.com>; Geneoscopy IPR <GeneoscopyIPR@foleyhoag.com>; QE-Exact <qe-exact@quinnemanuel.com>
Subject: Geneoscopy v. Exact Sciences, IPR2024-00459 - Request for Reply to POPR

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Your Honors,

Petitioner Geneoscopy, Inc. respectfully requests authorization from the Board to file an 8-page Reply to Patent Owner Exact Sciences' Preliminary Response ("POPR") in IPR2024-00459. Geneoscopy requests this Reply in order to address the following issues: (1) Exact Sciences' arguments that the Board should discretionally deny institution under § 325(d); and (2) Exact Sciences' arguments that the Board should discretionarily deny institution under *General Plastic*.

Geneoscopy has agreed that the proposed reply will not raise new arguments regarding errors made by the Patent Office in its evaluation of Lenhard or Shuber. Geneoscopy does not oppose that Exact Sciences be permitted a Sur-reply of equal length.

The parties have met and conferred. Exact Sciences does not oppose Geneoscopy's request, subject to the above conditions and that it be given a sur-reply of equal timing and length. The parties propose that the Reply be due within two weeks of a Board decision granting this request, and that any Sur-reply be due two weeks after the filing of the Reply.

Should the Board wish to convene a call on this matter, the Parties are jointly available on:
May 22 between 2:00-4:00 ET
May 23 between 1:00-4:00 ET.

If those dates are not convenient for the Board, the parties will confer and propose additional times.

Statement of Good Cause: On issue (1), Geneoscopy could not have reasonably foreseen Exact Sciences' selection of references and combinations of references that they assert in the POPR as being substantially the same as or cumulative with the references relied upon in the grounds of the petition. Geneoscopy also could not have foreseen Exact Sciences' arguments related to the allowance of the '945 continuation application, which occurred after Geneoscopy filed its petition. On issue (2), Exact Sciences' arguments regarding *General Plastic* were not foreseeable since they would require a novel application of the *General Plastic* factors to discretionally deny institution based on an earlier filed *ex parte* reexamination request.

Respectfully Submitted,
Brendan Jones
Reg. No. 65,077
Counsel for Petitioner Geneoscopy, Inc.

Brendan Jones | Partner

FOLEY
HOAG LLP

FOLEY HOAG LLP
Seaport World Trade Center West
155 Seaport Boulevard
Boston, Massachusetts 02210-2600
phone 617.832.1267

www.foleyhoag.com