
From: Raich, William
Sent: Tuesday, February 25, 2025 4:45 PM
To: Brian Matty; Collins-Chase, Charles; Ashley DaBiere
Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Dear Brian,

As discussed during the parties' meet-and-confer, we disagree with the assertions you make in your email. We therefore intend to email the Board seeking a conference call to discuss Petitioner's request for authorization to file the motion to compel testimony and document production by arXiv. We will note that the parties met and conferred and that Patent Owner opposes Petitioner's request for authorization to file a motion to compel testimony and document production by arXiv.

By tomorrow (Feb. 26), please provide dates and times you are available next week so that we can propose multiple times to the Board, as required. I am currently available on Monday March 3 from 9-12, 1-2, and 3-5; Tuesday March 4 from 1-2 and 3:30-5; Wednesday March 5 from 9-12 and 1:30-3:30; Thursday March 6 from 9-12 and 1-2:30; and Friday March 7 from 9-5.

Best regards,
Bill

William B. Raich, Ph.D.

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413
202.408.4210 | fax: 202.408.4400 | william.raich@finnegan.com | www.finnegan.com

FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>
Sent: Tuesday, February 25, 2025 10:02 AM
To: Raich, William <William.Raich@finnegan.com>; Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965



Bill,

Yes, we can do April 17 for due date 1. So we have agreement on the dates.

Regarding arXiv, it was Petitioner's burden to establish the public availability of Gloor (and to do so in the Petition). The new testimony you are seeking to obtain and add to this proceeding is supplemental information under 37 CFR 42.123. You will be filing that supplemental information more than one month

after institution, which requires showing that the supplemental information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests of justice pursuant to 37 CFR 42.123(b). You have not explained why your request meets those standards, and we do not believe it does at least because the public availability issues are ones you were aware of at the time of the Petition in July 2024, or at the very least at the time of our Preliminary Response in October 2024. We reviewed the cases you provided and believe the attached case is closer to the situation here and supports our position. None of the Board's statements in its institution decision can set aside or supersede the requirements for filing supplemental information.

Regarding our arguments and any evidence responding to the Petition's assertions for Gloor, those will be included in our Patent Owner Response pursuant to the Board's rules and scheduling order.

Finally, we reserve all rights with regards to new evidence, including our rights to cross-examine anyone offering new testimony and to object to any late evidence.

Brian

Brian D. Matty
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D: (212) 808-2947 | C: (440) 552-2184

From: Raich, William <William.Raich@finnegan.com>
Sent: Monday, February 24, 2025 8:06 PM
To: Brian Matty <BMatty@desmaraisllp.com>; Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Subject: [Ext] RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Brian,

Thanks for your response. We appreciate your confirmation that you will not move to amend in these IPRs. We agree with your proposed dates for Due Dates 2 and 3, but Due Date 1 should be April 17, 2025 – which is what you proposed in the meet and confer. Please confirm we are in agreement, and we will notify the Board.

Regarding our request regarding arXiv, we don't understand the basis of your opposition. You state that you do not believe it meets the standards for submitting supplemental information in these proceedings, but you provide no explanation as to the aspects of the rules or regulations that allegedly have not been met, nor do you address the Board's statement encouraging the parties to develop the record on this issue during trial. Could you please elaborate so we can understand your position?

Additionally, you did not respond to our request for any evidence in your possession indicating that Gloor was not published in July 2010. To better consider your position, please promptly respond to that request.

Regards,
Bill

William B. Raich, Ph.D.

Partner

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FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>

Sent: Monday, February 24, 2025 5:54 PM

To: Raich, William <William.Raich@finnegan.com>; Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>;

Ashley DaBiere <ADaBiere@desmaraisllp.com>

Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Bill,

We confirm Dr. Spellman's deposition for April 9 in Palo Alto. We also confirm we will not be moving to amend in these IPRs. For the briefing dates, we made a couple minor changes below that we hope we can agree to. We added a couple days to our POR to make it due 9 days after the Spellman deposition and bumped our sur-reply to the end of the week to avoid a squeeze (your proposal shortened our time to prepare our sur-reply), and in view of the changes added another day to your Reply deadline. Let us know if you are amenable.

Due Date	Current Date	ML Proposed Date
1	April 7, 2025	April 18, 2025
2	June 16, 2025	July 3, 2025
3	July 21, 2025	August 8, 2025

For your request regarding arXiv, we understand this as a request to compel testimony via subpoena under 37 CFR 42.52 and to file supplemental information (i.e., to file any testimony obtained via the subpoena) under 37 CFR 42.123. We oppose the request because we do not believe it meets the standards for submitting supplemental information in these proceedings.

Best,

Brian

Brian D. Matty

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From: Raich, William <William.Raich@finnegan.com>

Sent: Friday, February 21, 2025 9:50 AM

To: Brian Matty <BMatty@desmaraisllp.com>; Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>

Subject: [Ext] RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Appreciate the update.

William B. Raich, Ph.D.

Partner

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FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>

Sent: Friday, February 21, 2025 9:42 AM

To: Raich, William <William.Raich@finnegan.com>; Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>;

Ashley DaBiere <ADaBiere@desmaraisllp.com>

Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Bill,

Just letting you know we are on this. Our client has been out of the office this week. We are meeting with them on Monday, and then will get back to you.

Brian

Brian D. Matty

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From: Raich, William <William.Raich@finnegan.com>

Sent: Tuesday, February 18, 2025 3:23 PM

To: Brian Matty <BMatty@desmaraisllp.com>; Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>; Ashley

DaBiere <ADaBiere@desmaraisllp.com>

Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Brian,

Assuming Molecular Loop confirms that it will not move to amend in these IPRs, we propose shifting Due Dates 1-3 as follows. Please confirm you are amenable to this schedule. As discussed, Dr. Spellman will be available for deposition at Finnegan's Palo Alto office on April 9.

Due Date	Current Date	Proposed Date
1	April 7, 2025	April 16, 2025
2	June 16, 2025	July 2, 2025
3	July 21, 2025	August 4, 2025

Additionally, further to your request during the meet and confer, we attach a couple of relevant decisions involving motions to apply for a subpoena. The Board statement we were referring to spans pages 12-13 in IPR2024-00964 and is on page 10 of the institution decision in IPR2024-00965. The statement follows a paragraph referring to "testimony from a 'custodian with any personal knowledge of arXiv.org or its regular practices,'" and it reads: "Thus, we encourage the parties to fully develop the record during trial to facilitate the ultimate resolution of this issue."

On this topic, please provide us with any evidence in your possession indicating that Gloor was not published in July 2010 as set forth in our petition.

Regards,
Bill

William B. Raich, Ph.D.
Partner

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FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>

Sent: Monday, February 17, 2025 2:57 PM

To: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>; Raich, William <William.Raich@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>

Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Thanks Charles. Could you identify the Board statement in the institution decision you are referring to? And if you have any Board precedent for granting such a request, it would be helpful if you would identify that for us so we can review and provide you with our position.

Brian

Brian D. Matty
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T: (212) 351-3400 | E: bmatty@desmaraisllp.com

From: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Sent: Monday, February 17, 2025 2:20 PM
To: Raich, William <William.Raich@finnegan.com>; Brian Matty <BMatty@desmaraisllp.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Subject: [Ext] RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Brian,

We would like to discuss with you another issue that should be raised in any initial conference call with the Board. Consistent with the Board's statement in its decisions granting institution, Illumina intends to request authorization to file a motion seeking a subpoena compelling testimony by arXiv.org regarding the July 2010 date of public accessibility of the *Gloor* reference. In advance of any conference call, we would like to know whether Molecular Loop would oppose Illumina's motion.

Best regards,
Charles

Charles T. Collins-Chase

Partner | [Bio](#)

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FINNEGAN

From: Raich, William <William.Raich@finnegan.com>
Sent: Monday, February 17, 2025 8:22 AM
To: Brian Matty <BMatty@desmaraisllp.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Brian,

I'll send a Teams invite for 3 pm today. Dr. Spellman is potentially available on April 9, although we need clarity on whether or not you will move to amend before we agree to shift due dates. He's also available for a remote deposition on any of the 5 dates we previously offered, if helpful, as well as March 14.

Regards,
Bill

William B. Raich, Ph.D.

Partner

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From: Brian Matty <BMatty@desmaraisllp.com>
Sent: Friday, February 14, 2025 2:49 PM
To: Raich, William <William.Raich@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Sure, we are available Monday at 3pm.

It will also help if we can understand Dr. Spellman's availability to figure out what needs to shift if you can get an idea of his schedule. For example, if we can do a March 31 deposition we would ask for a smaller shift for our POR date than if we do an April 4 deposition. We are also happy to do a weekend deposition if needed to fit his schedule, but hopefully it doesn't come to that.

Best,
Brian

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From: Raich, William <William.Raich@finnegan.com>
Sent: Friday, February 14, 2025 2:44 PM
To: Brian Matty <BMatty@desmaraisllp.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: [Ext] RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Brian,
It will be difficult to analyze any proposed shift in due dates unless we know whether or not you intend to amend. Perhaps it would be helpful to get on the phone to discuss.

Are you available Monday afternoon after 3 PM or Tuesday after 4 PM?

Regards,
Bill

William B. Raich, Ph.D.
Partner

FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>
Sent: Friday, February 14, 2025 1:38 PM
To: Raich, William <William.Raich@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Thanks Bill. We have not made a final decision yet on whether or not we will move to amend in either case. If we need to adjust dates for any motion to amend, we can discuss that once we settle on a deposition date.

Best,
Brian

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From: Raich, William <William.Raich@finnegan.com>
Sent: Friday, February 14, 2025 1:26 PM
To: Brian Matty <BMatty@desmaraisllp.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: [Ext] RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Brian,
We'll check on other alternatives and circle back. In the meantime, to consider your proposal about shifting due dates, please confirm that Patent Owner will not move to amend in either case.

We agree to taking one, seven-hour deposition of your technical expert that would cover both IPRs.

Regards,
Bill

William B. Raich, Ph.D.
Partner

FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>
Sent: Friday, February 14, 2025 10:16 AM
To: Raich, William <William.Raich@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Bill,

The earlier dates won't work for us due to other commitments. If Dr. Spellman is tied up March 17-30, we can look at the week of March 31-April 4 to accommodate his schedule. That would require shifting our Response date back a bit (with a corresponding shift to your Reply date), but there is room in the schedule for us to do that. Please let us know if a day that week would work.

Also, please confirm you agree to the same arrangement for our technical expert (one day, 7 hour deposition covering both IPRs).

Thanks,
Brian

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From: Raich, William <William.Raich@finnegan.com>
Sent: Thursday, February 13, 2025 12:51 PM
To: Brian Matty <BMatty@desmaraisllp.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>
Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>
Subject: [Ext] RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Brian,
Thanks for your response. Would any of March 7 or March 10-12 in our Palo Alto office work for you? I believe Dr. Spellman could make those work. Currently, he has other commitments and travel the weeks you propose.

We also prefer the typical district court rules for deposition costs and arrangements, so let's proceed with that understanding.

Regards,
Bill

William B. Raich, Ph.D.

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FINNEGAN

From: Brian Matty <BMatty@desmaraisllp.com>

Sent: Thursday, February 13, 2025 10:35 AM

To: Raich, William <William.Raich@finnegan.com>; Ashley DaBiere <ADaBiere@desmaraisllp.com>

Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>

Subject: RE: Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

Bill,

The March 13 week does not work for us. Could you please let us know Dr. Spellman's availability during the weeks of March 17-21 or 24-28? We can agree to a single 7-hour deposition covering both IPRs, assuming you agree to do the same for our technical expert.

For costs and arrangements, we prefer the typical district court rules if that is alright with you. So we would take care of the arrangements and costs for the reporting services.

Thanks,
Brian

Brian D. Matty

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From: Raich, William <William.Raich@finnegan.com>

Sent: Wednesday, February 12, 2025 1:05 PM

To: Brian Matty <BMatty@desmaraisllp.com>; Theodoros Konstantakopoulos <TKonstantakopoulos@desmaraisllp.com>

Cc: Collins-Chase, Charles <Charles.Collins-Chase@finnegan.com>

Subject: [Ext] Illumina v. Molecular Loop - IPR2024-00964, IPR2024-00965

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Counsel,

We write to offer a single, 7-hour deposition for Dr. Paul Spellman on Thursday March 13 in Finnegan's Palo Alto office. This deposition would apply for both IPR2024-00964 and -00965. Dr. Spellman has very limited availability, so we would appreciate your prompt confirmation.

Please also let us know if you prefer to follow the PTAB's default rule on deposition costs (*see* 37 CFR 42.53(g)), where the proponent of the direct testimony arranges for the reporter, or if you prefer typical district court rules.

Regards,
Bill

William B. Raich, Ph.D.

Partner

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FINNEGAN

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