

From: [Trials](#)
To: [Daley, Kathleen](#); Scott.McKeown@WolfGreenfield.com; [Trials](#)
Cc: SMcKeown-PTAB@WolfGreenfield.com; OJohnstone-PTAB@WolfGreenfield.com; TFoley-PTAB@WolfGreenfield.com; [Charles Steenburg](#); [Jean Ge](#); [Miller, Richard W.](#); [Marty, Scott](#); [South, Clint](#); [Sommers, Erin](#)
Subject: RE: IPR2024-01014
Date: Monday, September 30, 2024 11:54:44 AM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)

Counsel,

Petitioner is authorized to file a five-page reply to the Preliminary Response. The reply is limited to address the two issues outlined in Petitioner's e-mail to the Board dated September 24. The reply must be filed within five business days of this authorization.

Patent Owner is authorized to file a five-page sur-reply to Petitioner's reply. The sur-reply is limited to address the arguments raised in the reply. The sur-reply must be filed within five business days of the reply.

No conference is necessary at this time.

Best regards,

Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Daley, Kathleen <kathleen.daley@finnegan.com>
Sent: Friday, September 27, 2024 11:15 AM
To: Scott.McKeown@WolfGreenfield.com; Trials <Trials@USPTO.GOV>
Cc: SMcKeown-PTAB@WolfGreenfield.com; OJohnstone-PTAB@WolfGreenfield.com; TFoley-PTAB@WolfGreenfield.com; Charles Steenburg <Charles.Steenburg@WolfGreenfield.com>; Jean Ge <Jean.Ge@wolfgreenfield.com>; Miller, Richard W. <millerrw@ballardspahr.com>; Marty, Scott <martys@ballardspahr.com>; South, Clint <southc@ballardspahr.com>; Sommers, Erin <Erin.Sommers@finnegan.com>
Subject: RE: IPR2024-01014

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The Honorable Board,

Patent Owner writes in response to Petitioner's request to note that Patent Owner does not agree that this proceeding, including specifically the issues that Petitioner identifies, presents issues of first impression.

Best regards,

IPR2024-01014
Ex. 3001

Kathleen Daley
Counsel for Patent Owner

Kathleen A. Daley

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FINNEGAN

From: Scott.McKeown@WolfGreenfield.com <Scott.McKeown@WolfGreenfield.com>
Sent: Tuesday, September 24, 2024 1:45 PM
To: trials@uspto.gov
Cc: SMcKeown-PTAB@WolfGreenfield.com; OJohnstone-PTAB@WolfGreenfield.com; TFoley-PTAB@WolfGreenfield.com; Charles Steenburg <Charles.Steenburg@WolfGreenfield.com>; Jean Ge <Jean.Ge@wolfgreenfield.com>; Miller, Richard W. <millerrw@ballardspahr.com>; Marty, Scott <martys@ballardspahr.com>; South, Clint <southc@ballardspahr.com>; Daley, Kathleen <kathleen.daley@finnegan.com>
Subject: IPR2024-01014

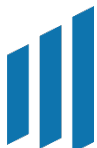
Trials,

Petitioner seeks authorization for an 8-page Reply to the POPR in the above-captioned proceeding. Both parties agree that this proceeding presents issues of first impression. Good cause exists for further development of the record on these issues as outlined below:

- ☐ ☐ ☐ Whether for purposes of enablement under 112(a) a Patent Owner's own sales of the patented corn plant can substitute for a seed deposit when—the claimed transgenic “event” could not be reproduced without access to the patented germplasm. Good cause exists as this issue of first impression would benefit from further briefing as Patent Owner confuses the standard for enablement of a specification under 112(a) with the standard for enablement of prior art under 102.
- ☐ ☐ ☐ Whether discretionary denial is appropriate where PO does not dispute that the claimed transgenic “event” cannot be reproduced without access to the patented germplasm. Good cause exists given the absence of any indication on the record that the examiner considered the POPR arguments that the commercial sale of the patented germplasm sufficed for enablement under 112(a).

The parties have conferred, Patent Owner opposes Petitioner's request for additional briefing because Patent Owner's arguments were foreseeable and there is not good cause for additional briefing. Patent Owner is generally available at the Board's convenience in the next few weeks except for Friday, September 27 and Monday, September 30. To the extent the Board is inclined to order briefing without a teleconference, Patent Owner requests a 5-page limit for both sides.

To the extent a conference is deemed necessary, petitioner's counsel will remain available in PO's window noted above.



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