From: Trials
To: Walter, Derek; Jesse Salen; Martin Bader; Percer, Adrian
Cc: Trials
Subject: RE: Bio-Rad v. Chromacode, IPR2024-01177
Date: Thursday, November 14, 2024 2:35:20 PM

Counsel,

The Board has considered Petitioner's request for additional briefing and Patent Owner's opposition to that request, along with Patent Owner's alternative request. In this instance, the Board determines that good cause exists for the requested additional briefing and that such briefing would be useful to the panel when considering the issues at this stage in the proceedings of IPR2024-01177 and IPR2024-01178.

Accordingly, in each case, Petitioner is authorized to file a Reply to Patent Owner's Preliminary Response. The Reply shall be limited to 5 pages. In -01177, Petitioner may address only the Patent Owner's arguments in the Preliminary Response concerning Saxonov as prior art and discretionary denial based on *Fintiv*. In -01178, Petitioner may additionally address how it considers Patent Owner's characterization of the claims of the '170 patent in the Preliminary Response to be inconsistent with such characterization in related district court proceedings. **The Reply is due by November 25, 2024.**

In each case, Patent Owner is authorized to file a Sur-reply to Petitioner's Reply to Patent Owner's Preliminary Response, limited to 5 pages addressing only Petitioner's Reply. **The Sur-reply is due by December 5, 2024.**

The authorized additional briefings shall not include any new exhibits, except to confirm status updates/orders in the related district court proceeding regarding the schedule of that case.

The Board will file, as an exhibit in each proceeding, a copy of this email, along with the initial email from Petitioner's counsel.

Regards,

Ex. 3001
IPR2024-01177

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Walter, Derek <Derek.Walter@weil.com>
Sent: Tuesday, November 12, 2024 1:35 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jesse Salen <JSalen@sheppardmullin.com>; Martin Bader <MBader@sheppardmullin.com>; Percer, Adrian <adrian.percer@weil.com>
Subject: Bio-Rad v. Chromacode, IPR2024-01177

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board:

Petitioner (Bio-Rad) respectfully requests authorization to file a Reply to Patent Owner's Preliminary Response in IPR2024-01177 to address two specific issues in Patent Owner's arguments pertaining to all Grounds of the Petition:

(i) Patent Owner's position in this proceeding that Saxonov is not prior art;
(ii) Patent Owner's position in this proceeding regarding whether review should be instituted based on considerations related to *Fintiv*.

Petitioner believes there is good cause for a pre-institution reply as Patent Owner's Preliminary Response raises factual and legal errors that are potentially dispositive, nor could these issues have been anticipated by Petitioner. Petitioner accordingly seeks authorization to file a 5-page pre-institution reply to address these issues. *See, e.g.*, *Cardiovascular Sys., Inc. v. Shockwave Medical, Inc.*, IPR2019-00405, Paper 13 at 3-4 (P.T.A.B. May 8, 2019) (permitting reply to respond to arguments regarding whether reference was prior art under 102(e) because the "panel wishes to decide the issue of whether Mantell is prior art based on a record that includes Petitioner's response to Patent Owner's argument in the Preliminary Response"); *id.* at Paper 74 at 12:14-19. Petitioner is amenable to Patent Owner receiving authorization to file a sur-reply of equal length. Petitioner proposes filing the pre-institution reply 7 business days from the Board's date of authorization and filing Patent Owner's sur-reply 7 business days after the filing of Petitioner's pre-institution reply.

Patent Owner opposes this request. Patent Owner disagrees that Petitioner has good cause to file preliminary reply in this proceeding because the issues Petitioner seeks to raise in its preliminary reply have already been sufficiently briefed in the Petition and Patent Owner Preliminary Response or are based upon facts and arguments that were "foreseeable from the outset," and thus could have been included in the Petition. *See Intelligent Wellhead Systems, Inc. v. Downing Wellhead Equipment, LLC*, IPR2024-00256 and IPR2024-00300, Paper 10 at 3-4 (P.T.A.B., April 23, 2024) (denying Petitioner's request for leave to file a preliminary reply because the issues raised were "foreseeable [] from the outset."). To the extent the Board is inclined to grant Petitioner's request for leave to file a preliminary reply, such reply should be limited only to addressing facts that originated after the date Petitioner filed the petition in this proceeding (e.g., to update the Board on scheduling changes in the parallel district court proceeding), and should not exceed 3 pages. In such

case, Patent Owner would request the opportunity to file a sur-reply of equal length.

Should the Board believe a conference call is necessary, the Parties can be available at the following times:

- Thursday 11/14, 12pm-5pm ET;
- Friday 11/15, 12pm-5pm ET;
- Monday 11/18, 12pm – 5pm ET;
- Tuesday 11/19, 12pm – 5pm ET.

Thanks,

Derek

The information contained in this email message is intended only for use of the individual or entity named above. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by email, postmaster@weil.com, and destroy the original message. Thank you.