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Subject: RE: IPR2024-01197 - request to file reply to preliminary response
Date: Wednesday, November 20, 2024 2:39:47 PM

Counsel,

Petitioner's request for authorization to file a Reply addressing Patent Owner's arguments regarding discretionary denial under § 325(d) and *Advanced Bionics* is granted. Having considered the parties' respective positions as reflected in the email below, and based on our present review of the Petition and Preliminary Response, we find good cause exists to allow limited additional briefing as to these topics. Patent Owner devotes about 45 pages arguing for discretionary denial under § 325(d) (Paper 6 at 4–50). Petitioner does touch on § 325(d) discretion issues briefly (Paper 2 at 68–71), but we conclude on this record that the panel may benefit from hearing further from Petitioner on these discretionary issues, explaining why trial should be instituted notwithstanding Patent Owner's extensive argument.

The Reply shall be limited to 5 pages and shall be filed no later than 5 business days from the date of this e-mail. Patent Owner is authorized to file a 5-page Sur-Reply, limited to the same topics, no later than 5 business days after the filing of the Reply.

Tina Lee
Supervisory Paralegal Specialist
Patent Trial and Appeal Board
U.S. Patent and Trademark Office

From: Nate Luman <Nate.Luman@knobbe.com>
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IPR2024-01197
U.S. Patent No. 8,771,729
Dr. Falk Pharma v. Ellodi Pharmaceuticals

Dear Members of the Board,

Pursuant to 37 C.F.R. §§ 42.108(c) and 42.23, Petitioner requests leave to file a reply to Patent Owner's preliminary response limited to five pages in the above-referenced proceeding to address Patent Owner's arguments regarding discretionary denial under 35 U.S.C. § 325(d) and *Advanced*

Bionics. Petitioner submits that good cause exists for a reply to address Patent Owner's statements regarding the prosecution history, comparisons of prior art used in rejections during prosecution to the references used in the Petition, and so the Board can benefit from hearing from both parties on these issues. Petitioner would not oppose a sur-reply by Patent Owner of equal length.

The parties have conferred. Patent Owner opposes Petitioner's request. The parties are available for a teleconference, if requested by the Board, on Thursday 11/21, Monday 11/25, and Tuesday 11/26.

Best regards,
Nate Luman
Counsel for Petitioner

Nathanael R. Luman, Ph.D.

Partner

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