

From: [Mills, Jad](#)
To: [Roberts, Jessica](#); [Rosato, Michael](#); [Hostetler, Michael](#); [Gerrard, Sonja](#)
Cc: [Goldberg, Joshua](#); [Feldstein, Mark](#); [Guerra, Kenneth](#)
Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request
Date: Friday, September 8, 2023 4:31:10 PM
Attachments: [shield-advisory.png](#)
[chevron-light.png](#)

 External email 

EXTERNAL Email:

Hi Jess,

Regarding routine discovery, thank you for your reminder about the parties' duty of candor.

Regarding additional discovery, thank you for providing us with the press release and investor presentation. Our understanding from the parties' meet and confer is that these two documents, and your belief that they somehow contradict the invalidity of the challenged patent, represent the basis for your discovery request. Having considered your request, it does not appear to satisfy the applicable threshold for the additional discovery.

Regards,

Jad A. Mills
Wilson Sonsini Goodrich & Rosati
701 5th Ave. Suite 5100
Seattle, WA 98104
Direct: 206.883.2554
Fax: 206.883.2699

From: Roberts, Jessica <Jessica.Roberts@finnegan.com>
Sent: Wednesday, September 6, 2023 1:57 PM
To: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXT - jessica.roberts@finnegan.com

Hi Jad,

Further to your request, attached is the Forte Sept. 1, 2023, Shareholder Presentation discussed on our

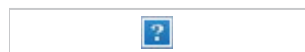
call.

As discussed, we look forward to whether Forte will agree to provide the discovery outlined in our August 30, 2023, email. Please also provide Forte's position in response to our August 1, 2023, email, to which we have still received no response.

Regards,
Jess

Jessica L. Roberts, PhD
Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
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From: Mills, Jad <jmills@wsgr.com>
Sent: Tuesday, September 5, 2023 4:35 PM
To: Roberts, Jessica <Jessica.Roberts@finnegan.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXTERNAL Email:

Hi Jess,

We confirm for 1pm Pacific tomorrow.

Thanks,

Jad

From: Roberts, Jessica <Jessica.Roberts@finnegan.com>
Sent: Tuesday, September 5, 2023 12:44 PM
To: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXT - jessica.roberts@finnegan.com

Jad,

We have adjusted our schedule and are available to meet and confer on Wednesday, Sept. 6th at 1 PM PT (4 PM ET), as you had previously offered. Please confirm your availability and we'll circulate dial-in information.

Regards,
Jess

Jessica L. Roberts, PhD
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From: Mills, Jad <jmills@wsgr.com>
Sent: Friday, September 1, 2023 6:46 PM
To: Roberts, Jessica <Jessica.Roberts@finnegan.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXTERNAL Email:

Hi Jess,

Unfortunately, we have existing conflicts at the times you have proposed on Tuesday. We can meet and confer Tuesday at 3pm Pacific or Wednesday at 1pm Pacific. Please let us know if either of those times work for you to meet and confer.

Thanks,

Jad

From: Roberts, Jessica <Jessica.Roberts@finnegan.com>
Sent: Friday, September 1, 2023 3:21 PM
To: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>

Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXT - jessica.roberts@finnegan.com

Hi Jad,

We're unavailable at the times you proposed. Please let us know if you're available on Tuesday (Sep. 5) at 9 AM or 10 AM PT for a meet and confer. If not, given Forte's continued delay in response, we will contact the Board by COB Tuesday. To that end, please let us know your availability next week for a call with the Board.

Regards,
Jess

Jessica L. Roberts, PhD
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From: Mills, Jad <jmills@wsgr.com>

Sent: Friday, September 1, 2023 5:23 PM

To: Roberts, Jessica <Jessica.Roberts@finnegan.com>; Rosato, Michael <mrosato@wsgr.com>;
Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>

Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark
<mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>

Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXTERNAL Email:

Hi Jess,

We request a telephonic meet and confer to discuss your request. We are for available to meet and confer at 1pm Pacific this coming Tuesday or at 10:30am Pacific this coming Wednesday. If neither of these times work for you, please propose additional times for the meet and confer.

Regards,

Jad A. Mills
Wilson Sonsini Goodrich & Rosati
701 5th Ave. Suite 5100
Seattle, WA 98104

Direct: 206.883.2554

Fax: 206.883.2699

From: Roberts, Jessica <Jessica.Roberts@finnegan.com>

Sent: Wednesday, August 30, 2023 11:02 AM

To: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>

Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>

Subject: RE: PGR2023-00014 (Forte v. UMass) - Discovery Request

EXT - jessica.roberts@finnegan.com

Jad,

We write to follow up on our August 1, 2023 correspondence regarding Petitioner's (Forte's) duty of candor and good faith before the Board to which we have received no response. Since Petitioner has not agreed to produce the requested information, we intend to seek leave from the Board to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2).

In addition to the reasons reflected in our prior correspondence, Forte's attached August 1, 2023, press release discloses that Forte is developing an anti-CD122 antibody (FB-102) for the treatment of autoimmune diseases, with clinical development relying on a mouse model of chronic GvHD. According to the Press Release, "[p]ublished preclinical PoC data also support the therapeutic potential of anti-CD122 in multiple autoimmune diseases anti-CD-122 including in vitiligo, celiac disease, alopecia areata, Type 1 diabetes and solid organ transplant." Forte's Chairman and Chief Executive Officer Dr. Paul Wagner further touts the therapeutic potential of FB-102, stating that "based on extensive proof of concept data, we believe FB-102 has consideration opportunity in a variety of indications."

Given Forte's positions in the PGR, including those by Dr. Plott, contending that treatment of vitiligo "using cytokine inhibition was only at its nascent stages" and the "the '505 patent's data from the mouse model would not enable treatment of natural or spontaneous vitiligo," (EX1004, ¶ 36), Patent Owner seeks information from Forte inconsistent with these positions. Specifically, Patent Owner seeks:

1. Documents sufficient to show Forte's use of, reliance on, and/or conclusions from animal models of autoimmune disease for the testing and/or development of its FB-102 antibody, including the mouse model of chronic GvHD identified in Forte's August 1, 2023, press release.
2. Documents sufficient to show the preclinical "proof of concept" data supporting the therapeutic potential of anti-CD122 in autoimmune diseases including in vitiligo, celiac disease, alopecia areata, Type 1 diabetes and solid organ transplant, described in Forte's August 1, 2023, press

release and Forte's use of, reliance on, and/or conclusions from that data.

3. Deposition of Dr. Paul Wagner, Forte's Chairman and Chief Executive Officer, regarding Forte's use of, reliance on, and/or conclusions from animal models for the treatment of autoimmune disease, including the basis for his representation in Forte's August 1, 2023, press release that "based on extensive proof of concept data, we believe FB-102 has consideration opportunity in a variety of indications."

Absent Forte's agreement COB, Friday, September 1 to produce the requested discovery, we will understand that Petitioner intends to oppose Patent Owner's request. To the extent Forte does not agree to provide the requested discovery, please then provide, by COB on September 1, your availability for a call next week with the Board.

Regards,
Jess

Jessica L. Roberts, PhD
Attorney at Law

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From: Roberts, Jessica

Sent: Tuesday, August 1, 2023 5:30 PM

To: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; Hostetler, Michael <mhostetler@wsgr.com>; Gerrard, Sonja <sgerrard@wsgr.com>

Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>

Subject: PGR2023-00014 (Forte v. UMass) - Discovery Request

Jad,

We write to remind you of your duty of candor and good faith before the Board, particularly with respect to information that is inconsistent with Petitioner's PGR positions. 37 C.F.R. § 42.11. You also have an obligation to disclose certain information and materials pursuant to Rule 42.51(b)(1)(iii) and the PTAB Trial Practice Guide, 23 (routine discovery includes "relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency"). As you are aware, these obligations apply to Petitioner's corporate officers and counsel, among others.

In this regard, Petitioner has advanced the position that animal models, in particular mouse models, would not be relied upon to enable treatment. This is reflected in, for example, Dr. Plott's assertion that "the '505 patent's data from the mouse model would not enable treatment of natural or spontaneous vitiligo, especially not in humans." EX1004, ¶ 36. The Board relied on Petitioner's position

in preliminarily finding that the patent failed to enable the full claim scope. ID, 25.

To the extent Petitioner relies on animal models, including mouse models, such as in its internal documents, patent applications, current or future regulatory materials to support treatment such as of vitiligo or other skin conditions, Petitioner would be required to provide such non-privileged information to the Board based on its duty of candor and good faith and to Patent Owner based on Rule 42.51(b)(1)(iii). *See, e.g., Spectrum v. Longhorn*, IPR2021-00847, Paper 107 (PTAB May 3, 2023) (granting petitioner's motions for sanctions). It appears that Petitioner has highly relevant documents, as reflected in U.S. Patent Pub. No. 2019/0343856 that covers the treatment of vitiligo among other conditions based on mouse models, and Petitioner's multiple pending patent applications directed to FB-102, thus also providing a basis for Patent Owner to obtain the inconsistent information through additional discovery pursuant to Rule 42.51(b)(2).

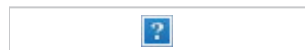
Petitioner's duty likewise applies to any information inconsistent with other positions advanced by Petitioner, including in Dr. Plott's and Dr. Abbas's declarations.

Accordingly, Patent Owner requests that Petitioner serve all inconsistent information without delay. If necessary, we can discuss a protective order to facilitate this.

Regards,
Jess

Jessica L. Roberts, PhD
Attorney at Law

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