

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDANT HEALTH, INC.
Petitioner,

v.

UNIVERSITY OF WASHINGTON,
Patent Owner.

Case No. IPR2022-00817
Patent No. 10,760,127

**PATENT OWNER'S RESPONSE TO CORRECTED
PETITIONER'S EXPLANATION OF MULTIPLE
PETITIONS AND RANKING OF PETITIONS**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. THE BOARD SHOULD DENY INSTITUTION IN BOTH PROCEEDINGS

Petitioner Guardant Health, Inc. simultaneously filed two petitions for *inter partes* review against U.S. Patent No. 10,760,127 (“the ’127 patent): the Kinde Petition (IPR2022-00816) and the Travers Petition (IPR2022-00817). Both petitions should be denied institution for being contrary to the guidance of the PTAB Consolidated Trial Practice Guide, which strongly disfavors filing multiple parallel petitions, and for being weak on their merits. Indeed, the Trial Practice Guide states:

Two or more petitions filed against the same patent at or about the same time ... may place *a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns*. See 35 U.S.C. § 316(b). In addition, multiple petitions by a petitioner *are not necessary in the vast majority of cases*.

See PTAB Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), 59 (emphases added). “[T]he Board recognizes that there may be circumstances in which more than one petition may be necessary,” such as a “patent owner [] assert[ing] a large number of claims in a litigation or ... a dispute about priority date [may] require[e] arguments under multiple prior art references.” *Id.* No such circumstances exist here.

Guardant has challenged the same exact set of claims in both petitions, just with different art. Guardant's multiple petitions, therefore, do not seek to solely address the number of claims asserted by Patent Owner in parallel litigation. And neither petition identifies any dispute between the parties regarding the '127 patent's priority date or the potential for antedating asserted art. Instead, Guardant's petitions are based solely on a desire to address different embodiments covered by the challenged claims. More than one petition was not "necessary" here (*see id.* at 59); instead, it was a strategic choice by Guardant, which raises significant fairness and efficiency concerns. There is no reason Guardant could not have brought its challenge in a single petition.

In fact, Guardant has challenged 23 claims of another of Patent Owner's patents, across three grounds, one of which includes a combination of Kinde, Craig, and the Travers Publications. *See* IPR2022-00935, Paper 2. That is the same prior art Guardant raises—but splits up—in the two separate Kinde and Travers Petitions here. Guardant controlled the number of references and grounds that are used in the separate Kinde and Travers Petitions. Guardant could have filed all its arguments here in a single petition, because it has already done so with the same art.

Guardant's strategic choice thus places a substantial and unnecessary burden on the Board and Patent Owner and, as stated above, raises fairness and efficiency

concerns. Both the Board and Patent Owner are faced with having to address parallel challenges to the same set of claims for no material reason.

Guardant further fails to “identify ... why the issues addressed by the differences [between the petitions] are material.” CTPG at 60. Guardant, instead, simply asserts that both petitions “are complementary” because they each present different types of adapters allegedly known in the prior art. *See* Ranking Statement at 3. That is not a reason that warrants multiple petitions. Indeed, the Board has stated that the CTPG “nowhere indicates that mere alternative arguments that are different from each other constitute sufficient justification for filing multiple petitions.” *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01630, Paper 13, at 10 (P.T.A.B., Apr. 2, 2020).

Moreover, each of Guardant’s petitions is weak on the merits. As outlined in Patent Owner’s Preliminary Response (“POPR”) to the Kinde Petition, each challenged claim requires attaching adapters comprising barcodes to a sample’s original double-stranded DNA fragments. Kinde POPR at 3-6. Yet, Guardant fails to demonstrate that the asserted Kinde or Craig references disclose this claim limitation. *Id.* at 19-25. Indeed, Kinde and Craig only introduce index sequences (Craig) or unique identifiers (Kinde) onto *copies* of the original DNA fragments. *Id.*

Similarly, as outlined in the POPR to the Travers Petition, each challenged claim requires that an amplifying step occur *after* attaching adapters and *before* a sequencing step. Travers POPR at 4-8. But Guardant misunderstands the disclosed SMRT™ sequencing method of the Travers Publications as meeting these limitations. *Id.* at 8-15, 19-23. Contrary to Guardant’s Petition, the Travers SMRT™ sequencing method was recognized as advantageous in the art precisely because there is “*no amplification* of sequencing fragments.” IPR2022-00817, EX2002, Table 2. Because of these deficiencies, Guardant also fails to show that a skilled artisan would have had a reason to arrive at the claimed methods. Accordingly, the Board should also deny institution in both proceedings on the merits

II. CONCLUSION

The parallel petitions here place a substantial and unnecessary burden on the Board and Patent Owner and raise fairness and efficiency concerns. The petitions, moreover, do not qualify as one of the rare circumstances for which more than one petition would be necessary. The Board should exercise its discretion to deny institution of both the Kinde and Travers Petitions. Indeed, both petitions also fail on their merits and can be denied on that additional basis.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/R. Wilson Powers III/

Date: July 20, 2022
1100 New York Avenue, NW
Washington, DC 20005
(202) 371-2600

Ralph Wilson Powers III, Ph.D.
Registration No. 63,504
Lead Attorney for Patent Owner

CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e))

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S RESPONSE TO CORRECTED PETITIONER'S EXPLANATION OF MULTIPLE PETITIONS AND RANKING OF PETITIONS** was served in its entirety on July 20, 2022, upon the following parties via email:

Michael T. Rosato
Jad A. Mills
Sonja R. Gerrard
WILSON SONSINI GOODRICH & ROSATI
701 Fifth Avenue, Suite 5100
Seattle, WA 98104
mrosato@wsgr.com
jmills@wsgr.com
sgerrard@wsgr.com

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/R. Wilson Powers III/

Dated: July 20, 2022
1100 New York Avenue, NW
Washington, DC 20005
(202) 371-2600

Ralph Wilson Powers III, Ph.D.
Registration No. 63,504
Lead Attorney for Patent Owner