

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GUARDANT HEALTH, INC.  
Petitioner,

v.

UNIVERSITY OF WASHINGTON THROUGH ITS CENTER  
FOR COMMERCIALIZATION,  
Patent Owner.

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

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**PETITIONER'S MOTION TO STRIKE**

Patent Owner (“PO”) improperly combined multiple documents into a single exhibit, as a guise for untimely submission of substantive new evidence in Sur-Reply. *See* 37 C.F.R. §§ 42.6 & 42.23(b). PO did not request authorization to combine documents, submit new evidence or otherwise suspend Board rules. PO cannot retroactively cure the impropriety of its submissions. *E.g., Resi Media LLC, v. Boxcast Inc.*, IPR2022-00067, Paper 56, 48-49 (“the proper avenue for seeking entry of additional evidence is not by submitting such evidence *sub silentio* ...”); *see also Liquidia Technologies, Inc., v. United Therapeutics Corp.*, IPR2021-00406, Paper 50, 5 (“there is no right to submit additional evidence with Patent Owner’s Sur-Reply”). Exhibits 2072 and 2073 should be stricken from the record, as should the portions of the Sur-reply that rely on the improper new evidence within these exhibits.

Exhibits 2072 and 2073 purport to be the Larrea and Quackenbush deposition transcripts, (*see* Paper 34, ix) however, each include multiple additional documents. Exhibit 2072 includes “Exhibits” 1-9 (pp. 90-195), which are attorney-generated schematics, product guides, and a published patent application. Exhibit 2073 includes “Exhibits” 1-4 (pp. 299-370), which are portions of declarations and deposition transcripts from proceedings other than the instant IPR. Each of Exhibits 2072 and 2073 violates the prohibition on combined documents. 37 C.F.R. § 42.6; *Jack Henry & Assoc., Inc., v. Datatrans Corp.*, CBM2014-

00056, Paper 37, 11 (citing § 42.6) (“parties are not permitted to file combined documents”); *see also* 37 C.F.R. § 42.63 (requiring exhibits conform with § 42.6).

Exhibits 2072 and 2073 are also improper because they include “new evidence other than deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b); *see also* CTPG, 73-74. The Sur-reply is improper because it substantively relies on “Exhibits” 1-9 and “Exhibits” 1-4 to raise new non-responsive arguments. *See, e.g.*, Paper 34, 9, 18-19, 20, 21, 22, 23, 24, 25, 26, 27; *Edwards Lifesciences Corp. v. Cardiovalve Ltd.*, IPR2021-00383, Paper 60, 86-87 (barring substantive reliance on new deposition exhibits under § 42.23(b)); *Ascend Performance Materials Operations LLC, v. Samsung SDI Co.*, IPR2020-00349, Paper 53, 12 (same).

Patent Owner contends that “Exhibits” 1-9 and “Exhibits” 1-4 were used for testing the witness’s testimony and should be available for the purpose of evaluating the testimony. *See* Paper 37, 13-14. This argument is meritless as the “Exhibits” were introduced in deposition without substantive questioning. *E.g.*, EX2072, 49:12-51:9, 51:23-53:15, 58:3-59:3; EX2073, 91:5-93:5, 93:6-97:15. Even if the “Exhibits” could have been properly used for impeachment, it is improper to rely on such evidence “regarding the patentability of the challenged claims” as PO does in Sur-reply. *Ascend*, 12; *see also Edwards*, 27.

Respectfully submitted,

Dated: June 8, 2023

/ Michael T. Rosato /  
Michael T. Rosato, Lead Counsel  
Reg. No. 52,182

## **CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing Petitioner's Motion to Strike was served on June 8, 2023, at the following electronic service addresses:

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