

Paper No. _____
Filed: June 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDANT HEALTH, INC.,
Petitioner,

v.

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

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

**PETITIONER’S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE
37 C.F.R. §42.64(c)**

I. INTRODUCTION

Patent Owner's (PO's) Opposition fails to justify the admissibility of the evidence identified in Petitioner's (Guardant's) Motion to Exclude.

II. EX2014 – SATIJA DECLARATION

Guardant moved to exclude EX2014 under F.R.E. 702, 402, and 403 because Dr. Satija's proffered opinions are frivolous and are not the product of reliable principles and methods reliably applied to the facts of this case. In particular, Dr. Satija's use of erroneous legal standards for challenging the operability of a prior art embodiment and regarding certain claim terms renders his testimony neither relevant nor reliable and is therefore inadmissible. PO's Opposition does not show otherwise. Thus, his testimony should be excluded.

As explained in the Motion to Exclude, the focus of nearly all of Dr. Satija's testimony is arguing the inoperability of the embodiment that 1) is admittedly disclosed by Travers; 2) unquestionably encompassed by the challenged claims; and 3) the '127 patent specification cites specifically to Travers for descriptive support of what is claimed. *See* EX2014, ¶¶39, 47, 108, 110, 113, 171, 193 (conceding and repeatedly reaffirming that Travers '075 and Travers 2010 disclose the same method). PO is in no position to criticize the operability of Travers (and no credible argument is advanced doing so) where its own specification critically relies on Travers to describe what it now claims. Indeed, multiple credible

witnesses with actual experience working with Pacific Biosciences technology (Drs. Quackenbush, Larrea) demonstrate that numerous references (objective evidence), including the '127 patent and the Travers references themselves, expressly contradict Dr. Satija's incredible assertions of alleged "problems." Dr. Satija attacks operability under the guise of a motivation to combine argument, but his arguments are legally irrelevant as he does not apply the correct law to either subject.

Dr. Satija's motivation arguments treat the embodiment disclosed in both Travers references as though it were a modification that needed to be justified, rather than an expressly described embodiment. No modification is needed and PO never demonstrates otherwise. *See* Paper 37, 6-7; *see also* Paper 14, 19 ("we do not see a need for modification"). PO asserts (p. 2) generally that Dr. Satija "presented extensive evidence" regarding lack of enablement where the same evidence actually expressly contradicts his incredible testimony. PO fails to demonstrate Dr. Satija's analysis is not sanctionable under 37 C.F.R. § 42.12 (for "advancing a misleading or frivolous argument"), let alone establishes that his analysis represents the product of reliable principles and methods. *See* Paper 37, 1-5.

PO's arguments (pp. 7-8) regarding claim construction fare no better. Dr. Satija fails to apply constructions according to the plain language of the claims and the teachings of the specification. Expert testimony founded on an improper claim

construction is legally irrelevant. The Opposition fails to explain why either of Dr. Satija's constructions is legally justified, focusing instead on the disclosure of the Travers references rather than the claims' plain meaning.

Finally, PO argues (pp. 8-9) that Guardant's objections lacked "sufficient particularity to allow correction in the form of supplemental evidence." 37 C.F.R. § 42.64(b)(1). Not so. The Motion explains how Dr. Satija's declaration is suffused with frivolous argument and principles and methods not reliably applied to the facts. PO could have withdrawn Dr. Satija's declaration and refiled omitting offending argument. Neither Petitioner nor the Board should be "required to sort proper from improper portions." Consol. Trial Practice Guide (Nov. 2019), 74.

In sum, Dr. Satija's testimony should be excluded as frivolous and predicated on legal error that renders it legally irrelevant and without basis. F.R.E. 702, 401, 403. PO's Opposition does not demonstrate otherwise.

III. EX2072 AND EX2073 – ("EXHIBITS" 1-9 AND "EXHIBITS" 1-4).

As explained in the Motion to Exclude, the exhibits appended to the deposition transcripts in EX2072 and EX2073 are inadmissible under multiple rules of evidence and applicable regulations. See Paper 36, 12 (citing F.R.E. 106, 402-403, 602, 702, 802; 37 C.F.R. §§42.6, 42.23, 42.63).

In the Opposition, PO cites no rule to render the challenged exhibits admissible. See Paper 37, 13-15. In addition to not satisfying the rules of evidence,

PO brazenly attempts to circumvent the requirement under 37 C.F.R. §42.23(b) that a sur-reply be accompanied only by deposition transcripts by submitting a compiled exhibit in violation of §§42.6(a)(3) & 42.63.¹ This maneuver not only violates multiple rules for this proceeding, but also prejudices Guardant by depriving it of an opportunity to respond or complete the record. F.R.E. 106, 403.

PO mischaracterizes (p. 14) its use of the exhibits as “impeach[ing] or otherwise test[ing] the declaration testimony of Drs. Larrea and Quackenbush.” This is false. PO repeatedly cites to the exhibits to make new substantive arguments based on their contents, rather than as characterization of the testimony of Drs. Larrea and Quackenbush. *E.g.*, Paper 34, 21 (citing to a purported PacBio Glossary appended to Dr. Larrea’s transcript to show “the understanding in the art,” not to impeach any statement by Dr. Larrea), 22 (citing to “Tomaney” for its teachings, noting only that it was a reference not considered by Dr. Larrea).

That PO’s use of the cited exhibits is not for impeachment purposes is underscored by the method the exhibits were introduced during deposition. Repeatedly, PO introduced documents without eliciting any testimony from the deponent to impeach, and without otherwise laying appropriate foundation. For

¹ The Board granted further briefing regarding the expungement of EX2072, EX2073, and the Sur-Reply for failure to comply with these rules. EX3001.

example, PO introduced Exhibit 7 to “refresh [his] recollection,” then read portions of the document into the record. EX1072, 49:12-51:9. PO misused the deposition process as a Trojan horse to improperly introduce new evidence, not to impeach. Nor does PO satisfy the requirements of authenticity or foundation.

PO’s failure to substantiate its purported “impeachment” of Guardant’s witnesses is unsurprising, as their testimony was not impeachable. Both Dr. Larrea and Dr. Quackenbush identified express content of record evidence contradicting Dr. Satija. PO seeks to use the new exhibits appended to EX2072 and EX2073 to distract from the indefensible merits of Dr. Satija’s testimony, not for any proper impeachment.

IV. CONCLUSION

PO has not justified the admissibility either of Dr. Satija’s nearly 250 paragraphs of frivolous testimony nor the conglomerations PO created in EX2072 and EX2073. Accordingly, each of EX2014, “Exhibits” 1-9 within EX2072, and “Exhibits” 1-4 within EX2073 should be excluded in their entirety; if not excluded, these should be restricted to minimize prejudice so far as possible or given no weight. F.R.E. 105.

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 Reply in Support of its Motion to Exclude was served on June 8, 2023, at the following electronic service addresses:

Ralph Wilson Powers III
David H. Holman
Kristina C. Kelly
Christopher M. Gallo
Byron L. Pickard
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
tpowers-PTAB@sternekessler.com
dholman-PTAB@sternekessler.com
kckelly-PTAB@sternekessler.com
cgallo-PTAB@sternekessler.com
bpickard-PTAB@sternekessler.com
PTAB@sternekessler.com

Respectfully submitted,

Dated: June 8, 2023

/ Michael T. Rosato /

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