

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDANT HEALTH, INC.,
Petitioner

v.

UNIVERSITY OF WASHINGTON,
Patent Owner

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

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-145

Petitioner moves to strike on two grounds: (i) that Patent Owner’s deposition transcript Exhibits 2072 and 2073 are allegedly improper “combined documents” because each transcript includes exhibits introduced at deposition; and (ii) that the deposition exhibits are improper “new evidence.” Paper 38, 1–2. The Board should deny Petitioner’s Motion, as neither argument has merit.

Attaching deposition exhibits to a deposition transcript is proper and in accordance within the Board’s rules. As the Board stated in *Ascend Performance Materials Operations LLC, v. Samsung SDI Co.*, “if exhibits are introduced during a deposition for the purposes of testing the witness’ testimony, a party should be able to submit those exhibits with the transcript, so the Board has the full context available in order to evaluate the testimony.” IPR2020-00349, Paper 53, 12 (PTAB July 15, 2021). In *Ascend*, the deposition exhibits were “relevant to [patent owner]’s cross-examination of [petitioner’s reply witness], and thus constitute proper evidence to submit along with the deposition transcript.” *Id.*, 12–13. Such is the case here. As shown below, each deposition exhibit was introduced to impeach and test the witness’ direct testimony, and was relevant to their cross-examination:

Exhibit	Content	Cross-exam	Relevance
EX2072, Ex. 1	Larrea’s list of documents	EX2072, 10:15–14:6	Materials Larrea brought to deposition
EX2072, Exs. 2–5	Larrea’s annotations of polymerase binding sites	EX2072, 28:16–32:18	Impeachment and testing of Larrea’s direct testimony on “multiple polymerase binding sites” (EX1033, ¶¶8–20)
EX2072, Ex. 6	PacBio Glossary describing ZMW occupancy	EX2072, 39:14–42:25	
EX2072,	PacBio ’331 describing	EX2072,	

Exhibit	Content	Cross-exam	Relevance
Ex. 9	ZMW occupancy	57:8–59:3	
EX2072, Ex. 7	ChromaSpin User Manual for size selection	EX2072, 49:9–51:10	Impeachment and testing of Larrea’s direct testimony on size selection methods (EX1033, ¶¶21–23)
EX2072, Ex. 8	Li et al. article describing DNA damage via gel electrophoresis	EX2072, 51:23–53:15	
EX2073, Exs. 1–4	Quackenbush prior testimony from related proceedings, including inconsistent claim constructions	EX2073, 7:25–23:11, 47:20–51:11; 91:5–93:5, 93:6–97:15	Impeachment and testing of Quackenbush’s direct testimony on ’127 patent claim terms (EX1039, ¶¶6–24)

The deposition exhibits in EX2072–2073 are not prejudicial to Petitioner, because Larrea and Quackenbush each “had an opportunity to respond to the exhibits during the deposition.” *Edwards Lifesciences Corp. v. Cardiovalve Ltd.*, IPR2021-00383, Paper 60, 87 (PTAB July 18, 2022). Additionally, Petitioner’s counsel had full and fair opportunity to question its witnesses on the same exhibits via re-direct examination. EX2072, 59:12–61:6; EX2073, 108:8–109:5.

Petitioner’s cited cases do not support its cause. In *Resi Media LLC v. Boxcast Inc.*, the surreply evidence comprised *two new declarations* with exhibits. IPR2022-00067, Paper 42, 2–3. In *Liquidia Tech., Inc. v. United Ther. Corp.*, PO’s request to submit new evidence was denied because PO only listed “*vague types* of evidence that *might* be submitted.” IPR2021-00406, Paper 50, 4–5. And in *Jack Henry & Assoc., Inc. v. Datatrans Corp.*, the Board actually allowed the petitioner to “combine” certain exhibits because “briefing ha[d] closed,” and there was “insufficient prejudice.” CBM2014-00056, Paper 37, 11–12.

Respectfully submitted,

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

/R. Wilson Powers III/

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

Date: June 13, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S
OPPOSITION TO PETITIONER'S MOTION TO STRIKE** was served
electronically via e-mail on June 13, 2023, in its entirety on the following counsel
for Petitioner via email:

Michael T. Rosato (Lead Counsel) mrosato@wsgr.com
Jad A. Mills (Back-up Counsel) jmills@wsgr.com
Sonja R. Gerrard (Back-up Counsel) sgerrard@wsgr.com
Patrick M. Medley (Back-up Counsel) pmedley@wsgr.com
WILSON SONSINI GOODRICH & ROSATI

Respectfully submitted,

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

/R. Wilson Powers III/

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

Date: June 13, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600