

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDANT HEALTH, INC.,	)	
	)	
Petitioner,	)	
	)	
vs.	)	No. IPR2022-00817
	)	
UNIVERSITY OF WASHINGTON,	)	Patent No.
	)	10,760,127
Patent Owner.	)	

REMAND HEARING

May 27, 2026

Taken Remotely Via Telephone

GUARDANT – EXHIBIT 1042
Guardant Health, Inc.v. University of Washington IPR2022-00817

Reporter: Christy Sheppard, CCR, RPR

APPEARANCES

JUDGE YANG
JUDGE SNEDDEN
JUDGE MAJORS

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1 BE IT REMEMBERED that on Wednesday,
2 May 27, 2026, via telephone, at 1:00 p.m., before Christy
3 Sheppard, Certified Court Reporter, CCR, RPR;

4 WHEREUPON, the following proceedings
5 were had, to wit:

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10 JUDGE YANG: Good afternoon. We are
11 here in the matter of Guardant Health, Inc. versus the
12 University of Washington, case number IPR2022-00817.

13 This hearing is held to discuss the mandate from the
14 Circuit Court of Appeals remanding this case back to the
15 Board, specifically regarding the issue of enablement. I
16 want to introduce the panel. With me today are Judge
17 Snedden and Judge Majors and I am Judge Yang.

18 Counsel, I understand you are prepared to give your
19 reasons why additional briefing should or should not be
20 permitted on this issue?

21 MR. ROSATO: I'm happy to do so. So
22 you noted the issue on remand is enablement of a specific
23 embodiment that is in the Travers '075 reference.

24 The problem is that patent owner never simply
25 addressed -- never squarely addressed that issue in its

1 briefing before the Board, and certainly not from the
2 perspective that prior art is presumed enabled, and that
3 it's patent owner's burden to demonstrate otherwise. So
4 there is a burden issue and a forfeiture issue that
5 requires briefing.

6 And just to add some further detail on that because
7 we know the previous briefing before the Board, patent
8 owner's arguments addressed a hypothetical combination of
9 two prior art references that the Federal Circuit has
10 confirmed is not relevant to the issue on remand. They
11 attacked a hypothetical combination of Travers '075 and
12 Travers 2010, two different prior references, and then
13 argued that Petitioner had failed to prove that the
14 proposed combination would be desired.

15 Again, the Federal Circuit has confirmed that that's
16 the wrong subject matter. It's also from the wrong
17 perspective, so that's what the previous briefing had
18 addressed, the wrong subject matter from the wrong
19 perspective, but the previous briefing by patent owner
20 never squarely addressed the right embodiment from the
21 correct perspective. Specifically, they never squarely
22 addressed the disclosed embodiments that's found in a
23 single prior art reference, and they never addressed that
24 from the perspective that prior art is presumed enabled.

25 Again, their arguments focused on this irrelevant

1 straw man combination, and then attacked it on the basis
2 of an alleged failure of proof by Petitioner, which, of
3 course, improperly inverts the appropriate burden on the
4 issue.

5 There's also the issue of claim scope, which patent
6 owner never contended with. In fact, it's their own
7 claim scope confirms precisely why they so assiduously
8 avoided addressing this issue directly. The claims, and
9 there's no dispute, the claims -- challenged claims are
10 not limited to any particular type of amplification, or
11 any particular type of sequencing. Claims unquestionably
12 and undisputedly encompass this prior subject matter.

13 And that was -- that's always been a problem for them and
14 why they didn't attack or address this particular subject
15 matter because they know that their claims cover the same
16 subject matter, and they've got a problem if the prior
17 art subject matter is -- lacks enablement, their claims
18 are invalid.

19 So this was never squarely addressed, and we believe
20 it presents a --

21 JUDGE YANG: Counsel, let me.

22 MR. ROSATO: -- but a forfeiture issue
23 as well.

24 JUDGE YANG: Counsel, let me stop you
25 there before you go on. I understand that the case is

1 back from the Federal Circuit. All the argument you just
2 mentioned, wouldn't that be -- shouldn't that be
3 addressed in the reply if, you know, regarding the scope,
4 or the misrepresentation of the straw man combination,
5 all that -- shouldn't this be in the reply to address
6 instead of after the remand to -- the way I read the
7 Federal Circuit's remand is pretty clear, based on this
8 record, is it enabled or is it not.

9 Why, at this time, should we reopen briefing to
10 discuss this?

11 MR. ROSATO: Well, thank you for the
12 question, Your Honor. If that is the question that's
13 posed on remand, which it is, again the question is
14 enablement of the specific embodiment in Travers '075,
15 addressing that issue of course involves looking at
16 whether patent owner sufficiently addressed this issue in
17 briefing below, or sorry, the previous briefing before
18 the Board.

19 JUDGE YANG: Let me stop you there,
20 too. I have another question for you. Whose burden is
21 it to show nonenablement?

22 MR. ROSATO: Prior art is presumed
23 enabled, and it's the responsibility of, in this case,
24 the patent owner to demonstrate that it lacks enablement.

25 JUDGE YANG: Okay. So if I understand

1 the patent owner's argument in the email correctly, they
2 are saying we don't want to say anymore. We rest on our
3 briefs, and that's it. And then we are going to look at
4 whatever, you know, either their -- or according to you,
5 lack thereof, arguments to support that -- support the
6 nonenablement challenge, then that's it. It's their
7 battle to lose.

8 Why is Petitioner concerned about it?

9 MR. ROSATO: Thank you, Your Honor. I
10 agree with that in part, it is their battle to lose.
11 Part of the issue is the patent owner can restate their
12 own position, but as I understand it is they believe that
13 the issue on remand was briefed below. We disagree with
14 that. We think the issue on remand was not adequately or
15 directly addressed by patent owner below, and that issue
16 has been forfeited.

17 JUDGE YANG: All right. Did I hear
18 you saying you had a fourth point you want to go on with?
19 If so, please go ahead.

20 MR. ROSATO: Yeah, thank you, Your
21 Honor. I didn't say fourth, just the claim scope issue
22 was an issue that, you know, underscores the forfeiture
23 and lack of sufficiency in the argument below. And that
24 is they never -- patent owner never addressed the issue
25 of their claim scope covering this very subject matter.

1 And the problem it presents in that if the prior art
2 lacks enablement, their claims are invalid. And we think
3 that was precisely the reason why they dodged this issue
4 in their briefing earlier.

5 JUDGE YANG: Okay. Anything else at
6 this time?

7 MR. ROSATO: Not at this time, Your
8 Honor.

9 JUDGE YANG: Okay. Let's's hear what
10 patent owner has to say. Any response?

11 MR. POWERS: Yes, Your Honor. This is
12 Ralph Powers, lead counsel for University of Washington.
13 No additional briefing is warranted here. According to
14 SOP-9, in this situation additional briefing is not
15 authorized if the issue was adequately briefed already in
16 the record, and that's the case here.

17 The parties already extensively briefed the issue of
18 enablement and whether the embodiment in question is
19 operable without undue experimentation.

20 For example, in the POR, the reply and the
21 sur-reply, the parties dedicated dozens of pages to the
22 issue of enablement of the embodiment that Petitioner
23 identified in its petition, including analysis of the
24 Wands factors.

25 And the operability or not of that embodiment was

1 the extensive focus of lengthy oral argument. There's
2 simply no ambiguity about what that embodiment was.
3 Everyone understood what the Petitioner referenced to,
4 and it was the focus of the factual findings already made
5 by the Board.

6 Federal Circuit's opinion, Your Honor, merely held
7 that because the amplification steps and the sequencing
8 steps are found in the same reference that the reason to
9 combine the framework was not the correct framework to
10 evaluate the issue, and instead the issue in this case
11 should be evaluated in the context of enablement, but,
12 again, the parties briefed this issue extensively. So
13 for those reasons, the patent owner sees no reason to
14 burden the Board with additional briefing.

15 And just a quick -- I would like to address the
16 issue of claim scope that opposing counsel brought up a
17 few times. That issue was addressed squarely by the
18 Board in the final written decision at Pages 24 through
19 30. Guardant did not appeal those factual findings by
20 the Board, and therefore, that issue, I think, is moot.

21 JUDGE YANG: All right. Let me ask
22 you -- earlier I asked the Petitioner this question.
23 Whose burden is it to show nonenablement?

24 MR. POWERS: Your Honor, while it's
25 true that there is a rebuttable presumption that an

1 embodiment in the patent document is enabled. The patent
2 owners already more than adequately rebutted that
3 presumption on the record as it exists. The Board's
4 factual findings and credibility determinations from the
5 final written decision makes that clear.

6 JUDGE YANG: I appreciate that answer.
7 My question is, whose burden, Petitioner's or patent
8 owner's?

9 MR. POWERS: It is patent owner's
10 burden to rebut the presumption.

11 JUDGE YANG: Thank you. Do you have
12 anything else at this time, Mr. Powers?

13 MR. POWERS: No, Your Honor.

14 JUDGE YANG: Okay. Petitioner, you
15 have an opportunity for a short rebuttal.

16 MR. ROSATO: Thank you, Your Honor. I
17 will keep it brief. I will quickly state that on claim
18 scope no one, not the patent owner nor the Board has
19 offered some construction of the claims that would
20 exclude the subject matter that's at issue. And, of
21 course -- and, of course, it doesn't exclude that.

22 In terms of the sort of the patent owner response
23 argument that was identified by patent owners counsel,
24 that's, you know, potentially this short conclusory
25 drive-by argument that's on Page 59 and a little bit onto

1 60 of the patent owner response underscores the point I
2 made and our concern. And here the argument is
3 specifically addressing what patent owner refers to as
4 Petitioner's embodiment, Petitioner's RCR embodiment.
5 And it's specifically talking about the combination of
6 two references.

7 Again, this is the hypothetical combination that the
8 Federal Circuit has identified as not relevant. What we
9 don't see in the briefing is squarely addressing the
10 disclosed embodiment in the single prior art reference,
11 and any discussion about a presumption of enablement.

12 MR. POWERS: I think we all understand
13 what the embodiment was, and that was the embodiment that
14 was addressed. And that is the embodiment RCR followed
15 by sequencing the concatemers made therefrom. That
16 embodiment was addressed extensively in the briefing
17 below already.

18 JUDGE YANG: Mr. Rosato, do you agree
19 with the embodiment, not whether briefed or not, do you
20 agree with patent owner's counsel's representation of the
21 embodiment?

22 MR. ROSATO: I agree that their
23 briefing focused on what they presented as a hypothetical
24 combination of two prior art references. I do not agree
25 that their briefing squarely addressed the expressly

1 disclosed embodiment in the single prior art reference of
2 Travers '075 under the correct burden of proof.

3 JUDGE YANG: All right. I am going to
4 put the parties on hold for a bit and the panel will
5 discuss the issue. Thank you. Please stay on the line.

6 MR. ROSATO: Thanks, Your Honor.

7 JUDGE YANG: So the panel discussed
8 this issue, and at this time we understand the parties'
9 positions, but we do not believe additional briefing is
10 warranted at this time. So we -- the panel will leave it
11 to the record and make a decision on the enablement based
12 on the existing record as the Federal Circuit directed us
13 to do.

14 If there is no other issues, we are done. We are
15 adjourned.

16 MR. ROSATO: Your Honor, if I may?

17 JUDGE YANG: Yes. Go ahead.

18 MR. ROSATO: Thank you. This is Mike
19 Rosato for Petitioner.

20 So one other issue out of concern of avoiding
21 inconsistent outcomes, I will note that the issue that
22 the Court sent back on remand has previously been
23 adjudicated by the Office in Patent No. 9910956. This is
24 a continuation from the Travers '075, and there the
25 examiner had raised an enablement rejection, considered

1 declaration evidence of actual reduction of practice, and
2 issues claimed covering the same Travers embodiment that
3 is at issue here.

4 MR. POWERS: Your Honor, this is
5 improper new argument.

6 JUDGE MAJORS: This is Judge Majors,
7 Counsel, have you even conferred on that issue with each
8 other?

9 MR. POWERS: It's a complete ambush,
10 Your Honor. They didn't bring that up to us at all.
11 This is Ralph Powers for the University of Washington.

12 JUDGE MAJORS: Okay. Well, I'm not
13 going to attribute any bad motive to anybody. What I
14 would suggest is that you get together and talk about
15 that issue among yourselves, and then you can reach out
16 to us if you think there is some further intervention
17 that the Board needs to get involved with.

18 MR. POWERS: Thank you, Your Honor.

19 JUDGE YANG: All right. If there is
20 nothing else, this call is adjourned.

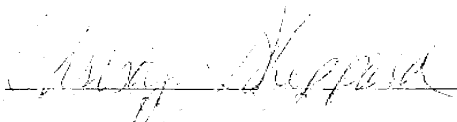
21 (Proceedings adjourned at 1:26 p.m.)
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1 STATE OF WASHINGTON) I, Christy Sheppard, CCR, RPR,
2 County of Pierce) ss a certified court reporter
3 in the State of Washington, do
4 hereby certify:

5 That the foregoing hearing was taken before me and
6 completed on May 27, 2026, and thereafter was transcribed
7 under my direction;

8 That I am not a relative, employee, attorney or
9 counsel of any party to this action or relative or
10 employee of any such attorney or counsel and that I am
11 not financially interested in the said action or the
12 outcome thereof;

13 IN WITNESS WHEREOF, I have hereunto set my signature
14 on Jun 10, 2026.

15 
16 /s/Christy Sheppard, CCR, RPR
17 Certified Court Reporter No. 1932
18 (Certification expires 05/06/27.)
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