

IPR2023-00876
U.S. Patent No. 10,155,981

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner,

v.

10X GENOMICS, INC.,
Patent Owner.

Case No. IPR2023-00876
U.S. Patent No. 10,155,981

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

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EX1063	Perez-Ortin, Jose, E., et al., <i>A genomic view of mRNA turnover in yeast</i> , C.R. Biologies, vol. 334 pp. 647-654 (2011)
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I. INTRODUCTION

Petitioner opposes Patent Owner's Motion to Exclude (Pap.35) the Declaration of Dr. Sylvia Hall-Ellis (EX1065) and the McCloskey reference (EX1004), the latter of which is a peer-reviewed scientific article that is unambiguously dated, published by a reputable publisher, and bears all the conventional markers of publication. It is undoubtedly prior art on its face. Its prior art status is further confirmed by the declaration of Dr. Hall-Ellis, the substance of which Patent Owner never challenges in the slightest. Patent Owner's specious attempt to exclude evidence as allegedly not qualifying as prior art without any material challenge to the underlying evidence confirming its admissibility is but one of many indicators of Patent Owner's weakness on the actual invalidity issues.

Nevertheless, Patent Owner's Motion fails on the merits. As noted, Patent Owner does not challenge the substance of Dr. Hall-Ellis's declaration. Rather, Patent Owner's only challenge to the declaration is that it is allegedly "untimely" because it was submitted on reply. Pap.35 at 3. Patent Owner is wrong on the law. In fact, a Precedential Opinion Panel of this tribunal has made clear that "if a patent owner challenges a reference's status as a printed publication, *a petitioner may submit a supporting declaration with its reply.*" See *Hulu v. Sound View*, IPR2018-01039, Pap.29, 15 (P.T.A.B. Dec. 20, 2019) (precedential). As if this

were not enough, the Federal Circuit has even confirmed that the Board may consider such evidence on reply. *See Vidstream v. Twitter*, 981 F.3d 1060, 1065-67 (Fed. Cir. 2020). The Hall-Ellis declaration is thus timely, and its undisputed substance puts to rest any suggestion that McCloskey is not prior art.

Moreover, even if the Hall-Ellis Declaration is not considered, there is still overwhelming evidence confirming that McCloskey is prior art. McCloskey bears all the conventional markers of publication, including a copyright date, edition identifier, publication by a commercial publisher, and the assignment of a DOI number. *Hulu*, IPR2018-01039, Pap.29 at 17 (precedential); *see also* EX1004.001.

Patent Owner's Motion to Exclude should be denied.

II. BACKGROUND

The McCloskey reference is a peer-reviewed journal article published in the December 2007 issue of the Biochemical Genetics journal. The McCloskey reference was available online through the reputable publisher Springer Science + Business Media, LLC on October 23, 2007. EX1065; EX1004.001. Petitioner relies upon McCloskey as part of a combination for both Ground 1 and Ground 2, collectively rendering all claims of the '981 Patent obvious. *See* Pap.1.

Patent Owner failed to challenge, or even address, the publication date, accessibility, or authenticity of the McCloskey reference in its Preliminary Response

to the Petition filed on July 28, 2023. *See* Pap.6. In fact, Patent Owner did not challenge the status of McCloskey until nearly six months later, after institution in the Patent Owner's Response filed on January 5, 2024. *See* Pap.13. Patent Owner's challenge was limited to a single paragraph lacking any explanation or basis, but including merely a conclusory assertion that "Petitioner failed to establish McCloskey is, in fact, prior art to '981." *Id.* at 18.

In response to the POR on March 29, 2024, Petitioner thus submitted a supporting declaration of Dr. Sylvia Hall-Ellis further confirming the availability and publication date of the McCloskey reference. *See* Pap.22, 3; EX1065. At no point has Patent Owner challenged the substance of Dr. Hall-Ellis's declaration, nor did Patent Owner seek to depose Dr. Hall-Ellis. Now, months later, Patent Owner moves to exclude Dr. Hall-Ellis's declaration and the McCloskey reference, still without challenging the substance of either document confirming that McCloskey is prior art. Pap.35.

III. McCloskey And The Hall-Ellis Declaration Should Not Be Excluded

A. The Hall-Ellis Declaration Is Responsive Supporting Evidence That Should Not Be Excluded

Patent Owner contends that Dr. Hall-Ellis's declaration should be excluded because it is "belated supplemental evidence" that was "late-submitted." Pap.35 at 7-8. The PTAB Precedential Opinion Panel, other panels of this tribunal, and even

the Federal Circuit, however, have rejected the very argument Patent Owner now advances.

In fact, it has consistently been held that that if a patent owner challenges a reference's status as a printed publication, a petitioner may submit supporting evidence, such as a declaration, with its reply. In *Hulu v. Sound View*, the precedential panel held that "if the patent owner challenges a reference's status as a printed publication, a petitioner may submit a supporting declaration with its reply to further support its argument that a reference qualifies as a printed publication." IPR2018-01039, Pap.29, 15 (precedential).

Similarly, the Federal Circuit upheld a panel decision denying a patent owner's motion to exclude and "relying on evidence that was first submitted with [petitioner's] reply briefs" to determine that a reference was an available printed publication. *Vidstream*, 981 F.3d at 1065-67 (Fed. Cir. 2020). Specifically, the Federal Circuit found that "the Board acted appropriately" when it "permit[ted] [petitioner] to respond to [patent owner's] challenge by providing additional evidence [in its reply] to establish the [reference's] publication date." *Id.* at 1065.

Other panels of this tribunal have likewise held that when a patent owner challenges a reference's status, a petitioner may properly submit supporting evidence with its reply. See *Cooler Masters Co., Ltd. v. Aavid Thermalloy LLC*,

IPR2019-00146, Pap.55, 22-23 (June 4, 2020) (The Board does “not agree with Patent Owner that Petitioner’s new evidence, submitted in the Reply, was improper as untimely” to support a showing that a reference is a printed publication because “it was filed in response to arguments raised in Patent Owner’s Response” and “did not amount to, or result in, a change in Petitioner’s theory in the case.”); *Grunenthal GMBH v. Antecip Bioventures II LLC*, PGR2019-00026, Pap.24, 19 (July 28, 2020) (“Patent Owner argues that Petitioner was required to submit any evidence of the printed-publication status of its asserted references with the Petition rather than with the Reply. That argument is unpersuasive in view of the decision in *Hulu, LLC v. Sound View Innovations, LLC*.”).

Thus, Patent Owner’s Motion can be fully resolved and denied on the law. Patent Owner has not challenged the substance of Dr. Hall-Ellis’s declaration, her opinions or conclusions, or any of the portions relied upon by Petitioner. Indeed, Patent Owner has not even sought Dr. Hall-Ellis’s deposition. The declaration of Dr. Hall-Ellis did not amount to any change in Petitioner’s theory in the case, but merely responded to Patent Owner’s new challenge to the McCloskey reference’s status as an available publication. Therefore, because a petitioner may properly

submit a supporting declaration with its reply and Patent Owner has not made any other objection to EX1065, Dr. Hall-Ellis's declaration should not be excluded.¹

While Petitioner's cases are right on point, Patent Owner's cases are all inapposite. *See, e.g., Dropbox, Inc. v. Synchronoss Techs., Inc.*, IPR2016-00850, Pap.41, 19-20 (Oct. 5, 2016) (pre-*Hulu* decision excluding a declaration that purported to support a substantively different reference, with different content, than the challenged reference); *FedEx Corp. Servs., Inc. v. Roambee Corp.*, IPR2022-

¹ Patent Owner argues in a footnote, without explanation, that EX1065 authenticates a "different version" of McCloskey, allegedly because of the inclusion of a copyright notice. Pap.35, 7 n. 4. "Arguments raised only in footnotes...are waived." *See Kennametal, Inc. v. Igersoll Cutting Tool Co.*, 780 F.3d 1376, 1383 (Fed. Cir. 2015) (citing *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1294 (Fed.Cir.2012)). Nevertheless, Patent Owner's footnote-suggestion that Dr. Hall-Ellis was working with a different version of McCloskey than what is cited in the Petition is totally wrong. In fact, as Dr. Hall-Ellis explains, the copyright notification was "affixed on the document when the Library prepared the scan" so that the library could comply with copyright laws. *See* EX1068 ¶ 3. EX1065 to Dr. Hall-Ellis's declaration is the *exact* same document as EX1004.

00934, Pap.41, 7-10 (Nov. 3, 2023) (excluding new evidence submitted by Patent Owner in a *sur-reply* in the form of a journal article and declaration used to support a *new* argument and claim construction); *Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01447, Pap.34, 44-47 (Mar. 9, 2016) (pre-*Hulu* decision excluding new evidence in the form of a webpage used to support a *new* argument); *Sirius XM Radio Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschung E.V.*, IPR2018-00690, Pap.63, 13-15 (July 23, 2020) (excluding new evidence supporting a *new* argument where “the Petition did not show the provisional application provides written description support for the claims of the issued patent” as required under *Dynamic Drinkware*). Patent Owner’s reliance on soundbite advocacy from inapposite cases does not remotely support exclusion.

Even ignoring the numerous on-point decisions, including the Precedential Opinion Panel’s decision in *Hulu*, Patent Owner’s argument based 37 C.F.R. § 42.64(b)(2) should be rejected. The Board has broad discretion and “may waive or suspend a requirement of parts 1, 41, and 42.” 37 C.F.R. § 42.5(b). In situations such as this, where Patent Owner waited until after institution in its Response to challenge McCloskey’s publication date, and Petitioner did not change any theory with its supplemental evidence, even if the timeline of 37 C.F.R. § 42.64 applied (it

does not), the Board should apply its discretion and waive the deadline because there can be no possible prejudice.

B. McCloskey Is Properly Authenticated And Bears Conventional Markers Of Publication

Patent Owner challenges McCloskey as supposedly “irrelevant” because the publication date “appearing within McCloskey is hearsay.” Pap.35, 4-5. For the reasons described above, however, Dr. Hall-Ellis’s declaration is properly considered and authenticates McCloskey’s publication date and accessibility. *Supra* Section III.A. Patent Owner does not challenge the substance of Dr. Hall-Ellis’s declaration or her opinions and conclusions. This puts Patent Owner’s motion to rest.

Even without the supporting declaration, however, McCloskey is properly considered because it bears all conventional markers of publication. “Especially when dealing with documents from recognized sources, such as these, and following the lead of the Federal Circuit” the Board considers “external indicia of publication as proof” on the issues of publication date and accessibility. *Trend Micro Inc. v. Cupp Computing AS*, IPR2019-00803, Pap.29, 9 (Sept. 15, 2020) (citing *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1376 (Fed. Cir. 2018)). The “indicia on the face of a reference, such as printed dates and stamps, are

considered as part of the totality of the evidence.” *Hulu*, IPR2018-01039, Pap.29, 17 (precedential).

McCloskey is a printed publication that should not be excluded because it bears all conventional markers of publication, including dates that it was received, accepted for publication, and published online; a copyright date; a peer-reviewed journal name and edition identifier and citation (Biochem Genet.); publication identifier of a reputable publisher (Springer Science + Business Media, LLC 2007); a DOI number; contact information for institutional authors; and all the conventional attributes of a peer-reviewed scientific publication (standard typeface, formatting, header, abstract, keywords, introduction, references). EX1004.001; *see, e.g., Hulu*, IPR2018-01039, Pap.29, 17 (precedential) (a reference meets the standard “where the reference bears conventional markers of publication, such as a copyright date; edition identifiers, publication by a commercial publisher, and the assignment of an ISBN number”).

Numerous decisions from panels of this tribunal have found the types of indicia present here as sufficient to establish publication date. *Trend Micro Inc. v. Cupp Computing AS*, IPR2019-00803, Pap.29, 9 (Sept. 15, 2020) (a date appearing on a reference is sufficient “when dealing with documents from recognized sources” with conventional markers.); *see also Meta Platforms et al., v. VL Collective IP LLC*,

IPR2023-00923, Pap.16, 27 (Dec. 6, 2023) (finding “conventional markers of publication found in [a reference], including the release date and copyright date” show a reasonable likelihood that a reference was published and available); *Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth*, IPR2023-00726, Pap.10, 33-34 (Sept. 15, 2023) (finding copyright date, printing date, ISBN number, and commercial publisher “sufficient to establish a reasonable likelihood that the disputed reference was a printed publication made available to the pertinent public prior to the critical date.”).

This is unsurprising because the Federal Circuit has likewise found that the type of indicia present here are sufficient to establish public availability. *Vidstream*, 981 F.3d at 1066 (finding conventional markers, such as a copyright date, “all uniformly support publication and public accessibility.”).

Additionally, Petitioner’s Expert Dr. Gregory Cooper recognizes McCloskey as prior art published on October 23, 2007 and provides detailed analysis and opinions regarding McCloskey. EX1002 ¶¶ 99-104; EX1059 ¶¶ 48-53. Dr. Cooper’s treatment of McCloskey further confirms the authenticity of the conventional markers demonstrating that McCloskey is indeed a published reference.

As if this were not enough, several additional references that are of record in this proceeding refer to the McCloskey reference and provide the same date of publication as listed on the McCloskey reference. *See* EX1029.003 (citing “McCloskey, et al. Encoding Per products with batch-stamps and barcodes. *Biochem Genet.* Dec. 2007;45(11-12):761-7. Epub Oct. 23, 2007.”); EX1053.004. Taken together, these numerous indicia of publication provide ample evidence of McCloskey’s publication and accessibility. Thus, even without considering Dr. Hall-Ellis’s supporting declaration, McCloskey should not be excluded.

Patent Owner again relies on several inapposite cases. *See, e.g., Neste Oil Oyj v. REG Synthetic Fuels, LLC*, IPR2013-00578, Pap.53, 5-7 (Mar. 12, 2015) (finding unreliable “handwritten dates, added to the documents by an unknown person at an unknown time” as hearsay where the documents lacked any additional indicia of publication); *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Pap.41, 13-18, 21-22 (Apr. 23, 2015) (rejecting dates on website printouts, including google search results, as hearsay where the website copyright provided date ranges and the printouts lacked any additional indicia of publication); *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773-774 (Fed. Cir. 2018) (finding that a reference was “not publicly accessible” because it was not published, but rather uploaded to a website that was not a reputable publisher and only provided a list of

authors and years, making the search feature “deficient” and the article not functionally accessible); *Medivis, Inc. v. Novarad Corp.*, IPR2023-00042, Pap.35, 28 (Mar. 6, 2024) (finding three references were not publicly accessible where two were product tutorials lacking any indicia of publication or accessibility, and the third reference was supported merely by a statement on the face that it was “available online” at a given date and a declaration from a self-interested employee of Petitioner’s law firm) *TRW Auto. U.S. LLC v. Magna Elecs. Inc.*, IPR2014-01348, Pap.25, 10 (Jan. 15, 2016) (finding that an ISBN number alone is insufficient to demonstrate accessibility where a reference lacked any additional marker of publication). Given that McCloskey bears numerous conventional markers of publication and accessibility, and for the reasons provided above, Patent Owner’s cases are inapposite and McCloskey should not be excluded.

IV. CONCLUSION

For the reasons explained above, EX1004 and EX1065 should not be excluded.

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CERTIFICATE OF PAGE COUNT

The undersigned certifies that the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE complies with the 15-page limitation in 37 C.F.R. § 42.24(a)(1)(v).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PETITIONER'S
OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE are being served
on June 28, 2024, via electronic mail pursuant to 37 C.F.R. § 42.6(e) to the counsel
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