

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner

v.

10X GENOMICS, INC.,
Patent Owner

Case IPR2023-00876
Patent 10,155,981

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

LIST OF EXHIBITS

Exhibit	Description
EX2001	U.S. Patent Pub. No. 2007/0020640 A1
EX2002	File History of U.S. App. No. 13/859,450
EX2003	Dictionary of Microbiology and Molecular Biology (2d ed. 1987)
EX2004	File History of U.S. App. No. 14/792,094
EX2005	File History of U.S. App. No. 13/387,343
EX2006	U.S. Patent Pub. No. 2007/0238113
EX2007	Laird <i>et al.</i> , <i>Hairpin-bisulfite PCR: assessing epigenetic methylation patterns on complementary strands of individual DNA molecules</i> , 101 PNAS 204-09 (Dec. 12, 2003)
EX2008	Parse Biosciences, Inc. v. 10x, Genomics Inc., IPR2023-00958, Pap.1 (May 25, 2023)
EX2009	File History of U.S. App. No. 14/172,694
EX2010	Declaration of Sayem Osman
EX2011	Parse Biosciences, Inc. v. 10x, Genomics Inc., IPR2023-00958, EX1002 (May 25, 2023) (Declaration of Gregory Cooper, Ph.D.)
EX2012	Parse Biosciences, Inc. v. 10x, Genomics Inc., IPR2023-00958, EX1054 (May 25, 2023) (Georgi K. Marinov <i>et al.</i> , <i>From single-cell to cell-pool transcriptomes: Stochastically in gene expression and RNA splicing</i> , 24.3 Genome Research 496-510 (2014) (“Marinov”))
EX2013	Declaration of Dr. John Quackenbush
EX2014	Bruce Alberts, <i>et al.</i> , <i>Molecular Biology of the Cell</i> , Garland Science (4th ed. 2002)
EX2015	Declaration of Sayem Osman
EX2016	Piovesan <i>et al.</i> , <i>On the length, weight, and GT content of the human genome</i> , BMC Res. Notes 12:106 (2019) (https://www.ncbi.nlm.nih.gov/pmc/articles/PMC6391780/#:~:text=Considering%20a%20mean%20weight%20in,units%2Fcarat.htm)
EX2017	T. Chauhan, <i>T4 DNA Ligase: Introduction, Functions, Applications, and Protocol</i> , (available at https://geneticeducation.co.in/t4-dna-ligase/)
EX2018	Deposition Transcript of Gregory Cooper, Ph.D.
EX2019	Li <i>et al.</i> , <i>Amplification and analysis of DNA sequences in single human sperm and diploid cells</i> , Nature 335(6189):414-417 (1998)
EX2020	May 2, 2024 Deposition Transcript of Gregory Cooper, Ph.D.

Exhibit	Description
EX2021	<i>Parse Biosciences, Inc. v. 10x Genomics Inc.</i> , IPR2023-00955, Pap.1 (May 25, 2023)
EX2022	<i>Parse Biosciences, Inc. v. 10x Genomics, Inc.</i> IPR2023-00955, EX1002 (Apr. 20, 2023) (Declaration of Gregory Cooper, Ph.D.)
EX2101	S. Guan, A. Blanchard, P. Zhang, & Z. Zhu, <i>Alteration of Sequence Specificity of the Type IIS Restriction Endonuclease BtsI</i> , (July 26, 2010) (marked as EX2101 in Dr. Cooper's May 2, 2024 deposition (EX2020))
EX2102	C. Wansgasnuwat <i>et al</i> , <i>Efficient and cost-effective bacterial mRNA sequencing from low input samples through ribosomal RNA depletion</i> , BMC Genomics (2020) 21:717 (marked as EX2102 in Dr. Cooper's May 2, 2024 deposition (EX2020))
EX2103	V. Llorens-Rico <i>et al</i> , <i>Single-cell approaches in human microbiome research</i> , Cell (2022) 185:2725 (marked as EX2103 in Dr. Cooper's May 2, 2024 deposition (EX2020))
EX2104	N. Sarkar, <i>Polyadenylation of mRNA in Prokaryotes</i> , Annu. Rev. Biochem (1997) 66:173-97 (marked as EX1067 in Dr. Cooper's May 2, 2024 deposition (EX2020))
EX2105	S. Slomovic <i>et al.</i> , <i>RNA Polyadenylation in Prokaryotes and Organelles; Different Tails Tell Different Tales</i> , Critical Revs. In Plant Scis. (2006) 25:65-77 (marked as EX1068 in Dr. Cooper's May 2, 2024 deposition (EX2020))

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I. Introduction

What Petitioner styles as a “Motion to Exclude” (“Mot.”) fails to comply with even the minimum requirements of § 42.64(c)¹ (governing actual motions to exclude), and is clearly nothing more than an improper and unauthorized merits brief—a self-help attempt at more briefing on improper new arguments Petitioner raised for the first time in its Reply. Tellingly, Petitioner’s motion *cites no caselaw, never discusses the governing evidentiary standards, and fails to raise even a colorable substantive argument* under the Federal Rules of Evidence.

While Petitioner suggests that EX2101, the subject of its motion, is irrelevant, this argument is baseless: the document directly contradicts and disproves the affirmative testimony of Petitioner’s expert, Dr. Cooper, and thus the sole basis for his theory that Linnarsson’s consistently-applied “fragment and capture” approach is somehow optional. And while Petitioner suggests that PO “intentionally aimed to confuse the Board” because Cooper was questioned about a restriction cut site for an enzyme other than a particular example in Linnarsson’s Figure 11 (BtsCI) (Mot.1), this argument flatly ignores (1) PO’s *explicit statements in briefing* that this was a “restriction enzyme cut site other than the specific example (for enzyme

¹ Unless stated, statutory and regulatory citations are to 35 U.S.C. or 37 C.F.R., as context indicates, internal citations omitted, and emphases/annotations are added.

BtsCI used in **Fig.11**” (e.g., Pap.26 (“POSR”), 10 (also noting Cooper offered “no opinion whether Fig.11 works with *other cut site*”)); (2) the Board’s clear competence to recognize that two different enzymes, BtsI and BtsCI, are different; and (3) that “the Board, sitting as a non-jury tribunal with administrative expertise, is well positioned to determine and assign appropriate weight to evidence presented.” *E.g.*, *Unified Patents, LLC v. Digimedia Tech, LLC*, IPR2022-01182, Pap.26, 42 (Jan. 12, 2024); *Novartis Pharms. Corp. v. Shilpa Pharma, Inc.*, IPR2022-00886, Pap.75, 18-19 (Sept. 29, 2023) (denying motion to exclude under Rule 403 noting “we are capable of weighing his credibility and assessing the probative weight of his evidence, without fear of undue prejudice [or] confusing the issues”). In sum, Petitioner fails to offer any persuasive reason why EX2101 is not relevant (it is), or how its probative value is substantially outweighed by any supposed prejudice (there is none) or confusion (also absent).

Petitioner’s motion should be denied.

II. Petitioner’s Motion Should Be Denied For Failing To Follow §42.64(c)

To begin, Petitioner ignores §42.64(c)’s explicit requirement that its “motion ***must*** identify the objections in the record in order and ***must*** explain the objections.” *See generally* Mot.1-7. Flouting this threshold Rule, Petitioner’s motion fails to cite or otherwise identify where in the record any objection was made, and it should be denied for this reason alone. *E.g.*, *Puzhen Life USA, LLC v. ESIP Series 2, LLC*,

IPR2017-02197, Pap.24, 48-49 (Feb. 27, 2019) (concluding that, even if the unauthorized “motion to exclude [a] Reply were procedurally proper, [the Board] would deny [the motion] for failure to comply with the rules governing motions to exclude,” which “requir[e] an identification of evidentiary objections in the record”); *HTC Corp. v. Advanced Audio Devices, LLC*, IPR2014-01156, Pap.36, 24-26 (Dec. 29, 2015) (stating that the failure to “identify where in the record its objections to evidence were made prior to their being the basis of the Motion to Exclude, in violation of Rule 42.64(c),” rendered the motion “procedurally deficient, and [that it] may be denied on this basis alone”).²

² Further, PO’s Sur-Reply arguments on pages 9-11 are supported by Cooper’s deposition testimony (including testimony prior to EX2101’s introduction), and thus they should not be “exclude[d]” as the motion incorrectly urges. Mot.1 (arguing to exclude arguments in “POSR at 9-11”); *see also Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00873, Pap.133, 49-50 (Oct. 18, 2019) (denying motion to exclude alleging a declaration contained “improper *argument*,” rather than “*inadmissible* evidence”) (emphasis original).

III. Petitioner’s Evidentiary Arguments Are Meritless, and Its Unauthorized Merits Briefing is Improper

A. EX2101 Is Clearly Relevant Because It Contradicts Petitioner’s Substantive Arguments

PO’s evidence in EX2101³ flatly contradicts the repeated assertion by Petitioner’s expert, Cooper, that—unlike Figure 11—Linnarsson’s “Figures 3 and 4 *do not include... a restriction enzyme cut site at all...*” *E.g.*, EX1059, ¶¶118, 42, 66-67 (testifying Figures 3 and 4 “*do not include... any restriction enzyme cut site*”). Disproving Cooper’s testimony, EX2101 confirms that *Figures 3 and 4 do, indeed, include a restriction enzyme cut site* (*e.g.*, EX2020, 123:6-124:21, 133:19-137:10), and Petitioner’s facially baseless argument that this evidence is somehow “*irrelevant*” (Mot.1-2, 5-6) doesn’t pass the straight face test. Instead, it is revealed for what it is: a grab for multiple pages of unauthorized merits briefing.

1. EX2101 Disproves Petitioner’s Assertion That Figures 3 And 4 Lack An Enzyme Restriction Cut Site, And That They Are Therefore An Exception To Linnarsson’s “Fragment And Capture” Approach

Linnarsson’s Figure 11 illustrates a process that relies on a restriction enzyme cut site (in the Figure’s example, a cut site for the enzyme BtsCI) as part of its process to prepare a sample for sequencing—a process Petitioner’s motion refers to as “fragmentation and capture.” *E.g.*, Mot.3. The original Petition and accompanying

³ See also n.2.

papers repeatedly *equated and combined Linnarsson's Figure 11 with Example I's Figures 2-4* to argue that elements of each disclosed—together—limitations of the challenged '981 Patent claims, including to argue that at the end of the process illustrated in Figure 11 the tagged polynucleotide is sequenced. *E.g.*, Pet.25-29, 41-43, 45-47, 56-57; EX1002, ¶¶139-141, 143, 153-156, 163-166; POR.25, 53, 55 n.21; POSR.14-15. But in doing so, the Petition and Petitioner's expert, Cooper, never addressed fragmentation and biotin in Figure 11 (and in Example I and II, more generally, discussed below). Pet.51-57, 66-68; EX1002, ¶¶192, 240-242; POR.27-28, 53, 56, 59-60, 62-64.

PO then explained in the POR (Pap.13) that Petitioner's arguments failed because the argued prior art combination included Linnarsson's fragmentation and capture process illustrated in Figure 11—a process consistently used in Linnarsson's only two Examples (Example I (which introduced Figures 2-4), and Example II). *E.g.*, POR.11, 24, 55 n.21; EX2020, 94:8-97:11, 131:10-19. PO demonstrated that, as a result of Linnarsson's fragmentation and capture process, Petitioner's Grounds failed. For Ground 1, the entirety of the tagged polynucleotide is not sequenced. POR.24. And for Ground 2, ligating a tag to Linnarsson's CDS or TSO in Petitioner's argued combination fails to render obvious claim 5. POR.52-67. (For the CDS, a biotin blocks any tag being ligated to it. POR.53-57. And for the TSO, any tag would remain bound to the bead because it would be ligated to the 5' end of the

restriction cut site. POR.57-59.)

But in its Reply, Petitioner improperly shifted course and argued for the first time that the fragmentation and capture steps shown in Figure 11 were entirely *optional*, and pointed to Figures 3 and 4 as its supposed evidence. Rep.5-7, 23; *see also* Mot.3-4; *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (“Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines.”). After opining that the “biotin (in the case of both the CDS and TSO) and *restriction enzyme cut site* (in the case of the TSO) are *part and parcel of the fragmentation method used in Figure 11*” (EX1059, ¶31), Petitioner’s expert, Cooper, broadly testified that “Figures 3 and 4 do not include a biotin or *a restriction enzyme cut site at all*, thus confirming that Linnarsson teaches approaches that do not require them.” EX1059, ¶118; *see also id.* at ¶42 (“The *lack of a restriction enzyme cut site*... in Figure 3 is critical because it shows that Linnarsson is not limited to the fragment and capture approach of Figure 11.”), ¶66 (“Linnarsson, however, contains numerous other exemplary embodiments that *do not* include... *any restriction enzyme cut site*. ... Linnarsson’s Figure 3 and Figure 4 show exemplary TSO and CDS that... do not contain *any* restriction enzyme cut site.”) (bold italics original), ¶67 (“As I explain above, *where* no biotin and *no restriction enzyme cut site* are present, the *embodiment does not involve fragmenting*

the tagged polynucleotides as disclosed in Figure 11.”); EX2020, 118:5-122:14.⁴

Petitioner’s reliance on Figures 3 and 4 fails as a factual matter. Even a cursory review reveals Cooper’s improper new theories⁵ entirely *failed to consider* other easily-identified restriction enzyme cut sites when Cooper presented these sweeping—and false—assertions to the Board. And at deposition, confronted with evidence contradicting those assertions, Cooper agreed. *First*, Cooper admitted POSITA had easy access at the critical date to resources identifying other enzyme cut sites. *E.g.*, EX2020, 120:7-122:14. Thus, POSITA (unlike Cooper) would have readily identified the restriction enzyme cut site for BtsI in Figures 3 and 4—not as

⁴ Apart from their erroneous interpretation of Figures 3 and 4, Petitioner and Cooper identified no Linnarsson embodiment or disclosure (from tagging through sequencing) in which biotin and fragmentation were not used. Cooper’s only other attempt (made for the first time at deposition) was to point to the broad “process” claimed in claim 1. *E.g.*, EX2020, 131:20-132:6; Rep.5-7. But this claim’s breadth is not a disclosure of an embodiment without fragmentation. *See, e.g., In re Benno*, 768 F.2d 1340, 1345-46 (Fed. Cir. 1985) (“The scope of a patent’s claims determines what *infringes* the patent; it is no measure of what it *discloses*.”); *see also* POSR.11-12.

⁵ PO received permission to file a table identifying new arguments Petition made on Reply, of which this was one. Pap.25.

mere “coincidence,” and certainly with no need to “scour[] the Internet....” Cf. Mot.4, 1, 6. Second, Cooper admitted he had *not consulted those resources* or looked for any cut sites other than the example in Figure 11 in providing his testimony that Figures 3 and 4 did not contain “any” enzyme restriction cut sites “at all.” E.g., EX2020, 120:7-18, 121:22-122:14. Third, Cooper admitted he was in no position to dispute that Figures 3 and 4 actually *do* include the GCAGTG cut site sequence for enzyme BtsI, or that Figure 11’s “fragmentation and capture” would work with restriction enzymes and cut sites other than its BtsCI example. E.g., EX2020, 123:6-125:22 (“[Q:] And you don’t have an understanding one way or the other about whether [GCAGTG] is such a cut site? [A:] I don’t....”), 129:2-14 (“it’s possible that [Linnarsson] includes one” in Figures 3 and 4), 126:17-20 (Cooper acknowledging he “wouldn’t say one way or another” whether Figure 11 would work with a different enzyme and cut site), 127:21-129:7 (“could it work other ways? Maybe. I don’t know”). And fourth, confronted with EX2101, Cooper admitted this article from a well-respected source states that the GCAGTG sequence—found in both Figures 3 and 4 (e.g., EX2020, 123:6-124:21)—is, in fact, a restriction enzyme cut site. EX2020, 133:19-137:10.⁶

⁶ Cooper’s testimony prior to page 134 was independent of EX2101, which was first referenced on page 133. See also n.2.

With Cooper’s concessions and backtracking in hand, PO properly responded in its Sur-Reply (POSR) to Petitioner’s improper new Reply theory, citing both Cooper’s testimony and EX2101,⁷ and explaining that, per Cooper’s “part and parcel” theory (*e.g.*, EX1059, ¶31; EX2020, 129:2-7), Figures 3 and 4 rely on fragmentation and capture because they include a restriction enzyme cut site for fragmenting—and are thus compatible with using biotin for capturing.⁸ POSR.9-10.

2. FRE401 And FRE402 Confirm EX2101 Is Relevant

Under Rule 401, “[e]vidence is relevant if: (a) it has *any tendency to make a fact more or less probable* than it would be without the evidence; and (b) *the fact is of consequence* in determining the action.” And under Rule 402, “[r]elevant evidence is admissible” unless prohibited by the Constitution, a federal statute, a rule of evidence, or rule prescribed by the Supreme Court. (Here, Petitioner’s motion

⁷ See n.2.

⁸ Petitioner’s Motion also argues Figures 3 and 4 do not show biotin. *E.g.*, Mot.5, 6. But as PO explained, Figures 3 and 4 show only the polynucleotide sequence, and biotin is not a polynucleotide. POSR.9-10. And as demonstrated above, the polynucleotide sequences in Figures 3 and 4 *do* include a restriction enzyme cut site, which Cooper admits is “part and parcel of [Linnarsson’s] fragmentation method.” *E.g.*, EX1059, ¶31; EX2020, 129:2-7; POSR.10-11.

urges Rule 402 only in arguing irrelevance under Rule 401. Mot.5.)

EX2101 “easily clears the very low threshold of relevance” set by the Rules. *E.g., Spinal Elements, Inc. v. Spectrum Spine IP Holdings, LLC*, PGR2021-00050, Pap.47, 54-55 (Aug. 17, 2022) (denying motion to exclude). Tellingly, Petitioner ***never even mentions this standard***, let alone explains how EX2101 could be irrelevant when it ***directly contradicts Cooper’s uninformed, erroneous testimony***. Together with Cooper’s own admissions at deposition even before EX2101 was introduced (*see* n.6), EX2101 provides clear context and confirms Linnarsson’s Figures 3 and 4 are, indeed compatible with Linnarsson’s “fragmentation and capture” process—per Cooper’s “part and parcel” opinions (EX1059, ¶31) they are “fragmentation and capture” embodiments. *Compare, e.g.,* EX1059, ¶66 (“Linnarsson’s Figure 3 and Figure 4 show exemplary TSO and CDS that do not contain a biotin and ***do not contain any restriction enzyme cut site***.”), *with* EX2020, 124:2-125:11 (referring to BtsI cut site sequence and testifying “[t]hat stretch of nucleotide[s] (GCAGTG)] is there” in the sequence of Figures 3 and 4); *Medtronic Vascular, Inc. v. TMT Sys., Inc.*, IPR2021-01532, Pap.56, 46-48 (Mar. 7, 2023) (declining to exclude exhibit as irrelevant where it “gives context to the testimony,” noting “the Board is well-positioned to determine and assign appropriate weight to the” evidence); *Mylan Pharms. Inc. v. Regeneron Pharms., Inc.*, IPR2021-00880, Pap.89, 19 (Nov. 9, 2022) (denying motion to exclude uncited exhibit because, *inter alia*, it

was testified to in deposition and thus has “a tendency to make a fact more or less probable”); *Ascend Performance Materials Operations LLC v. Samsung SDI Co.*, IPR2020-00349, Pap.53, 12-13 (July 15, 2021) (finding relevant exhibits introduced during cross-examination of petitioner’s witness because they tested the testimony).

As detailed above, Cooper broadly and repeatedly testified in his second declaration that Figures 3 and 4 “do not contain any restriction enzyme cut site” to support his argument that those figures show fragmentation and capture is optional in Linnarsson. *E.g.*, EX1059, ¶¶42, 66, 67, 118. Thus, EX2101, which ***proves Cooper wrong*** by identifying GCAGTG (found in Figures 3 and 4) as an enzyme restriction cut site, is certainly relevant, as “it has [a] tendency to make a fact more or less probable than it would be without the evidence.” Fed. R. Evid. 402. Here, EX2101 tends to make Cooper’s assertion that Figures 3 and 4 “do not contain any restriction enzyme cut site” far less probable—indeed, it ***proves Cooper’s assertion is false***. EX1059, ¶¶42, 66, 67, 118. And this fact matters because it negates Petitioner’s only purported support⁹ for its improper new theory that fragmentation is optional in Linnarsson’s method.

Petitioner further offers the make-weight argument that EX2101 is irrelevant

⁹ Figures 3 and 4 are the only embodiments Petitioner alleged do not include these features. *See n.4.*

because BtsI is different from the BtsCI enzyme “used [and] mentioned in Linnarsson.” Mot.6. But first, EX2101 is relevant to challenging Cooper’s theory and testimony because that theory and testimony *were not limited to the BtsCI enzyme* Linnarsson presented as an example: Cooper testified—erroneously—that Figures 3 and 4 “*do not* include... any restriction enzyme cut site” “at all.” E.g., EX1059, ¶¶42, 66-67, 118. Petitioner thus made other restriction enzymes relevant regardless of whether Linnarsson explicitly identifies them. And second, Linnarsson’s express disclosures extend beyond BtsCI, and include “modifications which do not substantially affect the activity of the various embodiments of this invention are also provided within the definition of the invention.” EX1003, 22:29-32. Petitioner never asserts, let alone explains, how swapping one restriction enzyme for another “substantially affect[s] the activity of [Linnarsson’s] various embodiments” such that it has no relevance to Linnarsson’s disclosures. See, e.g., EX2020, 26:17-20 (Cooper acknowledging he “wouldn’t say one way or another” whether Figure 11 would work with a different enzyme and cut site), 127:21-129:7 (“could it work other ways? Maybe. I don’t know”). Again, there is no question that EX2101 “easily clears the very low threshold of relevance” here, and Petitioner’s motion fails. E.g., *Spinal Elements*, PGR2021-00050, Pap.47, 54-55.

B. EX2101 Is Not Unfairly Prejudicial Or Confusing, And The Board Is Well Positioned To Assess This Evidence

Equally specious is Petitioner’s assertion that EX2101 is somehow

“prejudicial and confusing,” which rests on the unsupported argument that PO “intentionally” “aims to confuse the Board” by referring to a cut site for BtsI. Mot.1, 6-7. *First*, Petitioner’s argument that the Sur-Reply “intentionally” misleads the Board suggests Petitioner never read it: PO’s brief explicitly calls out that Cooper was questioned about a “restriction enzyme cut site ***other than the specific example (for enzyme BtsCI) used in Fig.11*** (which Cooper repeatedly argued was non-limiting).” POSR.10 (noting Cooper offered “no opinion whether Fig.11 works with ***other cut site***”). *Second*, the Board is more than capable of distinguishing between “BtsI” and “BtsCI” enzymes and their cut sites. And *third*, Petitioner skipped any mention or analysis of the governing standard for good reason: Under Rule 403, the Board “may exclude relevant evidence if its probative value ***is substantially outweighed*** by a danger of... ***unfair prejudice***, confusing the issues, [or] misleading the jury.” Fed. R. Evid. 403. Petitioner never acknowledges that, even if, *arguendo*, there were unfair prejudice (there isn’t, and Petitioner has shown none), EX2101’s probative value must be ***substantially*** outweighed to be excluded—and Petitioner never argues it is. Mot.6-7. Moreover, as the Board has noted, “Rule 403 has limited applicability, if any, to bench trials like this proceeding,” *Spinal Elements*, PGR2021-00050, Pap.47, 54-55, and—working as a technically-qualified factfinder without a jury—“the Board is well-positioned to determine and assign appropriate weight to the presented evidence.” *See Medtronic Vascular*, IPR2021-01532,

Pap.56, 46-48 (rejecting motion to exclude material under, *e.g.*, Rule 403, that was argued to “confuse the issues”); *Fox Factory, Inc. v. SRAM, LLC*, IPR2017-00472, Pap. 64, 60 (Apr. 18, 2018) (“As the factfinder, we are able to consider this evidence, in light of the parties’ arguments, and give it the appropriate weight.”); *Neste Oil Oyj v. Reg Synthetic Fuels, LLC*, IPR2013-00578, Pap.53, 10-11 (Mar. 12, 2015) (proceedings “before the Board are not jury trials; in the absence of a jury, the risk of unfair prejudice against which Rule 403 guards is diminished, if not eliminated entirely”); *see also United States v. Preston*, 706 F.3d 1106, 1117 (9th Cir. 2013), *rev’d on other grounds*, 751 F.3d 1008 (9th Cir. 2014) (en banc) (“Rule 403 is *inapplicable* to bench trials.”).

C. Petitioner’s Purported “Motion To Exclude” Is An Improper, Unauthorized Brief On Its Late Reply Arguments

As demonstrated above, far from raising any legitimate (or even colorable) evidentiary concerns, Petitioner’s motion to exclude is nothing more than a brief directed to the merits of this proceeding: Petitioner helped itself without the Board’s authorization to further briefing on its improper, late new arguments first raised in Reply. But this, as well as any complaints Petitioner purports to have about how and when EX2101 was raised (*e.g.*, Mot.1-2, 5), is improper subject matter for a motion to exclude, and Petitioner’s motion should be denied on this additional basis, as well. “While a motion to exclude may raise issues related to admissibility of evidence, it is not an opportunity to file a sur-reply, and also is not a mechanism to

argue that a reply contains new arguments.” *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00002, Pap.66, 62 (Jan. 23, 2014); *see also Illumina, Inc. v. The Tr. of Columbia Univ. in the City of New York*, IPR2018-00797, Pap.65, 10-11 (Sept. 9, 2019) (denying petitioner’s motion to exclude where they were “directed to the sufficiency rather than the admissibility of evidence”); *Envirotainer AB v. DoubleDay Acquisitions, LLC*, IPR2022-00293, Pap.83, 102-103 (Feb. 1, 2024) (denying aspect of motion that argues “that the documents exceed the scope of a proper reply”); USPTO, *Consolidated Trial Practice Guide*, 79 (Nov. 2019) (“A motion to exclude... may not be used to challenge the sufficiency of the evidence to prove a particular fact... [or] for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents.”).

IV. Conclusion

For all of the foregoing reasons, Petitioner’s improper and unsupported Motion to Exclude EX2101 should be denied.

Respectfully submitted: /Megan Raymond/ June 28, 2024

CERTIFICATE OF PAGE COUNT

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

Dated: June 28, 2024

Respectfully Submitted,

By: /Megan Raymond/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE has been served in its entirety by causing the aforementioned document to be electronically mailed to the following attorneys of record for the Petitioner listed below:

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Dated: June 28, 2024

Respectfully submitted,

By: /Sayem Osman/
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