

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 REPLY IN SUPPORT OF ITS
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>Cooler Masters Co. v. Aavid Thermalloy LLC</i> , IPR2019-00146, Pap.55 (June 4, 2020).....	5
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<i>Grunenthal GmbH v. Antecip Bioventures II LLC</i> , PGR2019-00026, Pap.24 (July 28, 2020).....	5
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<i>Medivis, Inc. v. Novarad Corp.</i> , IPR2023-00042, Pap.35 (Mar. 6, 2024)	2
<i>Meta Platforms, Inc. v. VL Collective IP LLC</i> , IPR2023-00923, Pap.16 (Dec. 6, 2023).....	2
<i>Microsoft Corp. v. Bascotti Inc.</i> , IPR2014-01457, Pap.9 (Mar. 19, 2015)	3
<i>Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth</i> , IPR2023-00726, Pap.10 (Sept. 15, 2023).....	2
<i>ResQNet.com, Inc. v. Lansa, Inc.</i> , 594 F.3d 860 (Fed. Cir. 2010)	3
<i>Sirius XM Radio Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschung E.V.</i> , IPR2018-00690, Pap.63 (July 23, 2020)	3, 4
<i>Trend Micro Inc. v. Cupp Computing AS</i> , IPR2019-00803, Pap.29 (Sept. 15, 2020).....	1

<i>TRW Auto. U.S. LLC v. Magna Elecs. Inc.</i> , IPR2014-01348, Pap.25 (Jan. 15, 2016).....	2
<i>VidStream LLC v. Twitter, Inc.</i> , 981 F.3d 1060 (Fed. Cir. 2020)	4

Petitioner's Opposition ("Opp."; Pap.37) does not rebut PO's showing in its Motion ("Mot", Pap.35) that McCloskey and the belated Hall-Ellis Declaration should be excluded. First, Petitioner did not even attempt to rebut PO's arguments that McCloskey's publication date is *hearsay* (instead arguing only that it is *authenticated*), and Petitioner's new substantive arguments are late and improper. Second, the Hall-Ellis declaration itself is improper, late, and impermissibly incorporated by reference and is not properly responsive to arguments in the POR, and therefore cannot fix the Petition's shortcomings regarding McCloskey's printed publication status.

I. McCloskey's Date Is Hearsay And Irrelevant Under FRE 402

PO's Motion (Pap.35) established that McCloskey's printed date is *hearsay* and should be excluded. Mot.4. Petitioner's Opposition fails to even mention FRE803 (detailing exceptions to the hearsay rule) or FRE807, let alone identify any hearsay exception or argue why it applies. Instead, Petitioner argues that McCloskey is *authenticated* and bears "conventional markers of publication." Opp.8. While such assertions may be sufficient for institution, they are not applicable to whether a date in McCloskey (or other purported "conventional markers") is hearsay when challenged as such in a motion to exclude. Petitioner's cases in support of its assertions are almost entirely institution decisions (not final written decisions), and none are directed to a dispute regarding *hearsay*. See *Trend Micro Inc. v. Cupp*

Computing AS, IPR2019-00803, Pap.29, 9 (Sept. 15, 2020) (cited in Opp.8-9, and denying motion to exclude based on authentication with no mention of hearsay); *Meta Platforms, Inc. v. VL Collective IP LLC*, IPR2023-00923, Pap.16, 26-28 (Dec. 6, 2023) (institution decision cited in Opp.9-10 finding sufficient evidence “at this stage,” but recognizing “Patent Owner may challenge Petitioner’s evidence” post-institution); *Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth*, IPR2023-00726, Pap.10, 33-34 (Sept. 15, 2023) (institution decision cited in Opp.10). And Petitioner’s attempts to distinguish PO’s cases on the basis of “conventional, markers of publication and accessibility” simply underscore its failure to address *hearsay*. Opp.11-12. PO’s hearsay cases (*Neste* and *Standard Innovation*) confirm that such dates fail when no hearsay exception applies. *See* Mot.4 (describing cases).¹

Petitioner’s late attempt to rely on “several additional references” also fails. Opp.11. Petitioner cites just two related patents that did not issue until long *after* McCloskey’s 2009 priority date. EX1053, 4; EX1029, 3. Neither indicates McCloskey was actually published or accessible *in 2009*—they simply recite the hearsay date on McCloskey’s face—and Petitioner did not argue these references evidenced

¹ Petitioner also attempts to distinguish *Acceleration Bay*, *Medivis*, and *TRW*, but does so on a basis unrelated to the reasons for which those cases are cited in the motion. *Compare* Opp.11-12 with Mot.5-6.

accessibility in the Petition or Reply. *Id.*; Pet.29; Rep.3; *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (submitting IDS is not an admission anything within it is accessible); *see also Microsoft Corp. v. Bascotti Inc.*, IPR2014-01457, Pap.9, 25-28 (Mar. 19, 2015). Further, Petitioner identified no timely admissible non-hearsay evidence showing the named journal was established or well-known to POSITA. *Cf.* EX1057, 90:25-91:17 (Dr. Quackenbush testifying McCloskey’s alleged journal is “pretty obscure[]”).² And Petitioner’s improper ~~status~~subarguments for accessibility should be ignored. *Sirius XM Radio Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschung E.V.*, IPR2018-00690, Pap.63, 10, 13-15 (July 23, 2020) (rejecting new reply arguments that could have been presented earlier).

II. The Second Hall-Ellis Declaration Is Untimely

Petitioner’s arguments and cases each rest on the same flawed assumption that

² Cooper’s cited McCloskey opinions in the Opposition (cited only for *authentication* (Opp.10)) are also not related to printed publication status (or cited for that proposition in the substantive papers (*see* Pet.29-30; Rep.3)) and he performs no analysis regarding accessibility. Opp.10; Pet.29; Rep.3; EX1002, ¶¶99-104; EX1059, ¶¶48-53. He does not claim to have personal knowledge of its availability as of that date. EX1002, ¶¶99-104; EX1059, ¶¶48-53.

“The Hall-Ellis Declaration Is ***Responsive*** Supporting Evidence.” Opp.3. But PO made no argument in the POR to which the new evidence is responsive. Relying on *Hulu*’s requirement that the petition includes “the prior art relied upon ***and evidence that it qualifies as such***” (see also Opp.4 (quoting *Hulu*’s consideration of reply declaration as “***further*** support”)), the Board in *Sirius XM* (IPR2018-00690, Pap.63, 13-15), ***refused to consider reply evidence*** purportedly showing the reference was prior art because “Patent Owner’s Response ***simply pointed out the defect*** in the Petition.” That is exactly what PO did here: “Petitioner failed to establish McCloskey is, in fact, prior art to ’981.” POR.18³; cf. Opp.3 (criticizing “limited” mention).

For these same reasons, Petitioner’s cases are each inapposite. See *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1064-1067 (Fed. Cir. 2020) (finding no abuse

³ Petitioner’s footnote asserting the document attached to Dr. Hall-Ellis’s declaration is “the ***exact*** same document as EX1004” is another improper new argument with unauthorized evidence first served in Opposition. Opp.6 n.1 (emph. orig.). The Petition never argued McCloskey was publicly accessible (let alone “on or shortly after January 3, 2008”) based on evidence from Hall-Ellis (EX1028 does not mention McCloskey), or that McCloskey was publicly accessible because it was catalogued. See Pet.29. This new argument reflects a date and library never mentioned in the Petition (or even the Reply). EX1065, ¶45.

of discretion in allowing “**additional** evidence” in Reply); *Cooler Masters Co. v. Aavid Thermalloy LLC*, IPR2019-00146, Pap.55, 18-27 (June 4, 2020) (finding declaration responsive to **substantive** accessibility challenge); *Grunenthal GmbH v. Antecip Bioventures II LLC*, PGR2019-00026, Pap.24, 19 (July 28, 2020) (responsive to **substantive** accessibility challenge based on hyperlink date (see Pap.10, 13)).

III. The Evidentiary Requirements Should Not Be Waived

Petitioner’s late and unauthorized request for a waiver of the evidentiary requirements (Opp.7-8) should also be rejected. PO identified its hearsay and relevance objections to McCloskey (and the related issues with the first Hall-Ellis declaration) at the earliest opportunity to submit evidentiary objections (Pap.11), but Petitioner waited **five months** to file its new Hall-Ellis declaration, rather than serving it as supplemental evidence (or seeking permission to file it as supplemental information)—even then it was only incorporated by reference. Rep.3 (citing EX1065). And Petitioner’s suggestion that a patentee somehow waives arguments by not including them in an **optional** POPR (Opp.2) is specious and directly contrary to authority. *Fluke Corp. v. Ametek Denmark A/S*, IPR2016-01428, Pap.48, 21 (Apr. 15, 2019) (“[PO’s] decision not to include that argument in its [POPR] is irrelevant...as [PO] is not required to file a [POPR]”). Lastly, as discussed above, the Hall-Ellis declaration was not “[i]n response to the POR.” Opp.3.

Respectfully submitted: /Megan Raymond/ July 5, 2024

CERTIFICATE OF PAGE COUNT

The undersigned certifies that the foregoing PATENT OWNER'S REPLY
IN SUPPORT OF ITS MOTION TO EXCLUDE complies with the 5-page limita-
tion in 37 C.F.R. § 42.24(c)(2).

Dated: July 5, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER’S RE-
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