

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

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I. INTRODUCTION

Patent Owner presents no persuasive response to Petitioner's arguments that evidence regarding the BtsI enzyme—which is never mentioned in Linnarsson—would be irrelevant, prejudicial, and confusing under Rules 401, 402, and 403.

Rather than address the merits, Patent Owner begins with the procedural argument that Petitioner inadvertently did not cite where its objections were stated in the record. Yet, the motion identifies the objections pursuant to Rules 401, 402, and 403 in its first sentence and then explains them in detail. Patent Owner never suggests that these objections were not preserved per § 42.64(b). In fact, they were preserved. Patent Owner cites no case denying a motion to exclude solely due to a technical failure to include a citation to the objections in the record.

As to the merits, Patent Owner's overarching argument is that evidence regarding BtsI rebuts Dr. Cooper's testimony about whether Figures 3 and 4 of Linnarsson include a restriction enzyme cut site. This argument, however, attacks a strawman, which Patent Owner creates by taking Dr. Cooper's testimony out of context. Dr. Cooper was never contending that Figures 3 and 4 do not include *any* restriction enzyme site for *any* known restriction enzyme, including the countless random enzymes that are never mentioned in Linnarsson. Such testimony would be irrelevant. Dr. Cooper was only making clear that, *in the context of Linnarsson*,

Figures 3 and 4 do not contemplate any restriction enzyme, as in Figure 11. This is what matters.

Patent Owner's need to grossly decontextualize Dr. Cooper's testimony to try and justify submission of evidence related to BtsI simply confirms that such evidence is irrelevant, confusing, and prejudicial.

II. THE MOTION SHOULD NOT BE DENIED BASED ON § 42.64(C)

Patent Owner's assertion that the motion should be denied because Petitioner did not cite where it preserved its objection is meritless. Patent Owner does not deny that the objections were preserved, not just during Dr. Cooper's deposition but also under § 42.64(b)(1). *See* EX2020 at 134:3-4 ("And we'll object again to the introduction of this exhibit."); Paper 27 at 2-3 (identifying objections under FRE 401, 402 and 403 for EX2101 and FRE 403 for arguments based on EX2101 in POSR (Paper 26) including at "9-16."). Petitioner's motion relies upon the same substantive objections. *See* Paper 34 at 1 (identifying objections under "FRE 401, 402, and 403..."). It then explains them in detail. *See id.* at 5-7.

Patent Owner cites no case with facts akin to those here where a motion to exclude was denied solely because of a failure to cite specifically where the objections were preserved. For instance, in *Puzhen, LLC v. ESIP, LLC*, there was a failure "*to object at all on the record.*" IPR2017-02197, Paper No. 24 at 49 (Feb.

27, 2019). And, in *HTC Corp. v. Advanced Audio, LLC*, while the Board stated it “could” deny the motion based on alleged failure to cite the objections, it decided the motion on the merits. *See* IPR2014-01156, Paper No. 36 at 25 (Dec. 29, 2015).

III. PATENT OWNER DISTORTS DR. COOPER’S TESTIMONY

Patent Owner contends that EX2101 and arguments based thereupon are relevant because they disprove Cooper’s “repeated assertion” that Figures 3 and 4 “do not include...a restriction enzyme cut site at all.” Paper 38 at 4-6, 12. This argument, however, attacks an irrelevant argument that Petitioner is not making and relies upon taking Dr. Cooper’s testimony out of context.

Dr. Cooper was not opining that he had performed an analysis of the cut site sequences for every single restriction enzyme known to humankind—including the countless enzymes that are not mentioned in Linnarsson—to confirm that every possible sequence was absent from Figures 3 and 4. Nowhere does Dr. Cooper say such a thing. Such an analysis would be irrelevant. What matters is whether Figures 3 and 4 include a restriction enzyme sequence for the BtsCI enzyme that is actually used in Linnarsson. In other words, what matters is whether, *in the context of Linnarsson*, Figures 3 and Figure 4 contemplate an approach like that of Figure 11, which uses a restriction enzyme site that is repeatedly called out in Figure 11. *See* Paper 34 at 2-3.

In context, it is clear that Dr. Cooper's opinions are not about the universe of known restriction enzymes, but rather that Figures 3 and 4 do not contemplate the use of any restriction enzyme, as in Figure 11. Dr. Cooper's opinions repeatedly refer to the fact that Figures 3 and Figure 4 do not include the cut site as used in Figure 11, which is for BtsCI. *See, e.g.*, EX1059 ¶ 42 (It "cannot be the case that Linnarsson is contemplating the fragmentation and capture of **Figure 11** in all its embodiments because the restriction enzyme cut site that is needed to release the fragments following capture is also absent from Figure 3."); *see also id.* ¶¶ 37, 67, 112. As he confirmed at deposition, all sequences in Figures 3 and 4 are "accounted for" and Linnarsson does not contemplate using cut sites in them. *See* EX2020 at 122:18-123:5. Likewise, Dr. Cooper explained that he was not opining about whether Figures 3-4 included by "happenstance" a sequence for "any possible restriction enzyme in the world," but simply that Figures 3 and 4 lack "the key cut site that Figure 11 discusses as being necessary...." *See id.* at 151:5-152:14.

IV. PATENT OWNER DOES NOT DENY THE FACTS PROVING THAT EVIDENCE ABOUT BTSI IS IRRELEVANT

Patent Owner asserts that Dr. Cooper "repeatedly argued" that Figure 11 is "non-limiting." *See* Paper 38 at 13. Patent Owner thus apparently suggests that because Figures 3 and 4 coincidentally include an unmentioned sequence for BtsI, it

might mean that Figures 3 and 4 contemplate using fragmentation and capture, albeit with an enzyme that is never once mentioned in Linnarsson. This is nonsense.

Indeed, Patent Owner never once denies the numerous facts establishing that Linnarsson never uses the BtsI enzyme for anything, including in Figures 3 and 4:

- Patent Owner does not deny that BtsI is *not* disclosed, much less used anywhere in Linnarsson.
- Patent Owner admits that the two enzymes are different. Paper 38 at 2, 13 (“BtsI and BtsCI, are different”).
- Patent Owner does not deny that the appearance of the BtsI cut sequence in Figures 3 and 4 is a coincidence.
- Patent Owner does not deny that in Linnarsson “Bts” refers to the BtsCI cut site not the BtsI cut site. Paper 34 at 2-3.
- Patent Owner does not deny that “Bts” in its sur-reply, refers to the undisclosed, irrelevant and confusing BtsI enzyme and not the BtsCI enzyme that is actually used in Linnarsson. *Id.* at 6-7.
- Patent Owner does not deny that Figures 3 and 4 have no biotin, which is essential for fragmentation and capture. Paper 38 at n8.
- Finally, Patent Owner does not deny that EX2101 is belatedly introduced evidence. *See Intel Corp. v. Parkervision, Inc.* IPR2020-01265, Paper. No. 44 at 74 (Jan. 21, 2022) (found admission of belated “new evidence” in sur-reply prejudicial).

V. CONCLUSION

Petitioner’s motion to exclude should be granted.

Dated: July 5, 2024

Respectfully submitted,

/Derek C. Walter/

Lead Counsel for Petitioner

Reg. No. 74,656

Weil, Gotshal & Manges LLP

201 Redwood Shores Parkway

Redwood Shores, CA 94065.

CERTIFICATE OF PAGE COUNT

The undersigned certifies that the foregoing PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE complies with the 5-page limitation in 37 C.F.R. § 42.24(c)(2).

Dated: July 5, 2024

Respectfully submitted,

By: /Derek C. Walter/
Derek C. Walter (Reg. No. 74,656)
WEIL, GOTSHAL & MANGES LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Tel: (650) 802-3934
derek.walter@weil.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE are being served on July 5, 2024, via electronic mail pursuant to 37 C.F.R. § 42.6(e) to the counsel for Patent Owner at the addresses below:

J. Steven Baughman (Reg. No. 47,414)
Megan Raymond (Reg. No. 72,997)
GROOMBRIDGE, WU,
BAUGHMAN
& STONE LLP
801 17th Street, NW, Suite 1050
Washington, DC 20006
P: (202) 505-5832
steve.baughman@groombridgewu.com
megan.raymond@groombridgewu.com
10X-Parse-IPR@groombridgewu.com

Counsel for Patent Owner

Dated: July 5, 2024

By: /Derek C. Walter/
Derek C. Walter
Lead Counsel for Petitioner
Reg. No. 74,656