UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner

v.

10X GENOMICS, INC.,
Patent Owner

Case IPR2023-00955
Patent 10,240,197

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE

LIST OF EXHIBITS

Exhibit	Description
EX2001	File History of U.S. App. No. 15/677,957
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 *et al*., *Hairpin-bisulfite PCR: assessing epigenetic methylation patterns on complementary strands of individual DNA molecules*, 101 PNAS 204-09 (Dec. 12, 2003)
EX2008	Parse Biosciences, Inc. v. 10x, Genomics Inc., IPR2023-00876, Pap.1 (May 25, 2023)
EX2009	File History of U.S. App. No. 14/172,694
EX2010	Declaration of Sayem Osman
EX2011	Declaration of Sayem Osman
EX2012	*Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00876, EX1002 (Apr. 20, 2023) (Declaration of Gregory Cooper, Ph.D.)
EX2013	Declaration of Dr. John Quackenbush
EX2014	Bruce Alberts, et al., *Molecular Biology of the Cell*, Garland Science (4th ed. 2002)
EX2015	S. Guan, A. Blanchard, P. Zhang, & Z. Zhu, *Alteration of Sequence Specificity of the Type IIS Restriction Endonuclease BtsI*, (July 26, 2010)
EX2016	Piovesan *et al., On the length, weight, and GT content of the human genome,* 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, *T4 DNA Ligase: Introduction, Functions, Applications, and Protocol*, (available at https://geneticeducation.co.in/t4-dna-ligase/)
EX2018	IPR2023-00876 Deposition Transcript of Gregory Cooper, Ph.D.
EX2019	Li *et al.*, *Amplification and analysis of DNA sequences in single human sperm and diploid cells,* Nature 335(6189):414-417 (1998)
EX2020	IPR2023-00955 Deposition Transcript of Gregory Cooper, Ph.D.
EX2021	INTENTIONALLY OMITTED

Exhibit	Description
EX2022	INTENTIONALLY OMITTED
EX2023	Excerpt of *10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 001 (D. Del. Aug. 24, 2022) (Complaint)
EX2024	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00878, Pap.1 (Apr. 20, 2023)
EX2025	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00958, Pap.1 (May 25, 2023)
EX2026	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-01030, Pap.1 (June 06, 2023)
EX2027	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-01033, Pap.1 (June 06, 2023)
EX2028	INTENTIONALLY OMITTED
EX2029	INTENTIONALLY OMITTED
EX2030	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 121 (D. Del. Dec. 21, 2023) (Order Denying Motion to Stay)
EX2031	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00958, Pap.8 (Jan. 05, 2024) (Rehearing Request)
EX2032	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 048 (D. Del. Mar. 07, 2023) (Scheduling Order)
EX2033	INTENTIONALLY OMITTED
EX2034	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 164 (D. Del. Feb. 20, 2024) (Order Denying Parse Renewed Motion to Stay)
EX2035	Excerpt of *10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 229 (D. Del. June 12, 2024) (Parse's Opposition to 10x Ltr. re Motion to Strike Portions of Cooper Report; Ex. A: Sept. 19, 2023 Parse First Amended Invalidity Contention; Ex. B: Apr. 16, 2024 Parse Second Amended Invalidity Contention)
EX2036	Excerpt of *10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 218 (D. Del. May 30) (10x Ltr. re Motion to Strike Portions of Cooper Report; Ex. A: May 17, 2024 Expert Report of Dr. Gregory Cooper Regarding Invalidity (Excerpted))
EX2037	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, May 21, 2024 Email from J. Reich to D. Walter re Cooper Report

Exhibit	Description
EX2038	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, May 28, 2024 Email from D. Walter to J. Reich re Cooper Report
EX2039	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 224 (D. Del. June 06, 2024) (Parse Ltr. Requesting New Trial Date)
EX2040	IPR2023-00955 September 3, 2024 Deposition Transcript of Gregory Cooper, Ph.D.
EX2041	Wayback Archive Records for https://link.springer.com/article/10.1007/s10528-007-9114-x, (available at https://web.archive.org/details/https://link.springer.com/article/10.1007/s10528-007-9114-x)
EX2042	Wayback Archive Records for https://pubmed.ncbi.nlm.nih.gov/17955361/, (available at https://web.archive.org/details/https://pubmed.ncbi.nlm.nih.gov/17955361/)
EX2043	Wayback Archive Records for https://www.researchgate.net/publication/5891130_Encoding_PCR_Products_with _Batch-stamps_and_Barcodes, (available at https://web.archive.org/details/https://www.researchgate.net/publication/5891130_Encoding_PCR_Products_with%20_Batch-stamps_and_Barcodes)
EX2044 – EX2101	INTENTIONALLY OMITTED
EX2102	C. Wansgasnuwat *et al, Efficient and cost-effective bacterial mRNA sequencing from low input samples through ribosomal RNA depletion*, BMC Genomics (2020) 21:717 (marked as EX2102 in Dr. Cooper's September 3, 2024 deposition (EX2040))
EX2103	V. Llorens-Rico *et al, Single-cell approaches in human microbiome research*, Cell (2022) 185:2725 (marked as EX2103 in Dr. Cooper's September 3, 2024 deposition (EX2040))

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981 F.3d 1060 (Fed. Cir. 2020).....2, 5

I. McCloskey Is Irrelevant Under FRE 402 And Its Date Is Hearsay

McCloskey's printed date is ***hearsay*** and should be excluded. Mot.4 (Pap.36). And since Parse can't rely on that printed date, McCloskey should be excluded as irrelevant because Parse failed to provide any admissible evidence it was publicly accessible as of the 2009 critical date. Parse's Opposition ("Opp", Pap.38) identifies no hearsay exception (*e.g.,* FRE803 or FRE807) for the date or argument why any such exception would apply.

First, Parse argues McCloskey's availability as an ***online*** article (Opp.2, 5), but with ***no evidence of the timing of its public accessibility***, let alone ***actual dissemination***. Dr. Hall-Ellis's untimely Declaration (*see* §II) admits McCloskey could be located on three websites, but ***none establish availability as of 2009***. EX1085, 26 nn.16-18. Indeed, per the Wayback Machine, McCloskey first appeared on Springer's site on March 4, ***2016*** and on PubMed in ***2022***. EX2041; EX2042. (There is no archive for ResearchGate. EX2043.) Petitioner has submitted neither a copy of the alleged print version of McCloskey, nor any evidence establishing the public accessibility of any print version.

Second, Parse's "conventional markers of publication" arguments may suffice for institution, but such evidence does not establish that a date later challenged as hearsay suffices as proof of availability at trial—*e.g.*, to prove a date actually "Received" or "Published," let alone that either date established public accessibility.

Opp.5. And none of Parse's cases addresses a ***hearsay*** dispute. *See Trend Micro*, IPR2019-00803, Pap.29, 9 (cited Opp.5-6, denying motion to exclude based on authentication with no mention of hearsay); *Meta Platforms*, IPR2023-00923, Pap.16, 26-28 (institution decision cited Opp.6, finding sufficient evidence "***at this stage***" of publication and accessibility, but recognizing "[PO] may challenge Petitioner's evidence" post-institution). Parse's citation to *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1064-1067 (Fed. Cir. 2020) is inapposite, as there was far more evidence of accessibility than just a publication date—unlike Parse's only "evidence" (albeit hearsay) here. And Parse's attempts to distinguish PO's cases only on the basis of the Board's reasoning in the related proceeding underscores Parse's failure to address ***hearsay*** of the dates on McCloskey or to prove ***public accessibility***. Opp.6-10. Indeed, PO's hearsay cases (*Neste* and *Standard Innovation*) confirm such dates do not provide proof of accessibility absent an applicable hearsay objection. *See* Mot.5-6 (describing cases). And other cases confirm publication dates alone are insufficient. *Schlumberger Tech. Corp. v. Integrated Drive Sys. LLC*, IPR2018-00603, Pap.40, 12-22 (Sept. 3, 2019) (online reference not a printed publication without evidence of accessibility); *Celltrion, Inc. v. Biogen, Inc.*, IPR2016-01614, Pap.65, 19-20 (Feb. 21, 2018) ("evidence merely demonstrating publication to the internet" insufficient). Parse also fails to distinguish *Acceleration Bay*, *Medivi*s, and *TRW*, which PO cited to demonstrate Parse needed to prove accessibility, yet Parse

identifies no such evidence. *Compare* Opp.9-10 *with* Mot.5-6. And Parse provides no evidence to establish "Biochemical Genetics" was regularly published.

Third, Parse's late attempt to rely on "several other references" it never previously argued to show prior art status also fails. Opp.6. Whether ***McCloskey II*** was publicly accessible as of the priority date, or shares similar subject matter or authors, is irrelevant to whether ***McCloskey*** was publicly accessible in 2009. Opp.6. By Parse's logic, McCloskey's authors could have written about the same subject matter in a lab notebook that was ***never shown to anyone***, and McCloskey II would somehow prove that notebook was publicly available prior art. Not so. Further, other documents' argued citations to McCloskey ***after the 2009 critical date*** fails to prove public accessibility ***as of 2009***. Citations during prosecution of the applications for the Fodor Patents (EX1029 & EX1053), which were not filed until 2010 and 2014, can't prove McCloskey was publicly accessible by 2009. *See* Opp.7-8; *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (submitting IDS ***not*** an admission that anything within it is accessible); *Medivis, Inc. v. Novarad Corp.*, IPR2023-00042, Pap.35, 28 (Mar. 6, 2024) (statement that reference "[a]vailable online 13 April 2015" did not establish public accessibility, as "***any reference can state it was published without actually being published***"); *see also Microsoft Corp. v. Bascotti Inc.*, IPR2014-01457, Pap.9, 25-28 (Mar. 19, 2015). Nor has Parse identified any evidence showing the named journal was established or well-known

to POSITA such that a conclusion of dissemination or accessibility can be reached. *Cf.* EX1071, 90:25-91:17 (McCloskey's alleged journal is "pretty obscure[]").

II. The Second Hall-Ellis Declaration Is Untimely

Parse's assertion that the second Hall-Ellis declaration wasn't late because Parse wasn't on notice of PO's McCloskey objection until the POR (Opp.11) is baseless. PO's objections explicitly explained "Petitioner has failed to authenticate EX1004… To the extent that Petitioner attempts to rely on any date that may appear in EX1004… to establish public accessibility as a printed publication, any such date is hearsay…." Pap.11 at 1-2. Parse's failure to, *e.g.*, provide any evidence to authenticate or establish a hearsay exception for multiple exhibits, thus forcing PO to object to each, doesn't render PO's objections "boilerplate" or "vague." Opp.1, 11. Further, Parse's complaint that PO did not include McCloskey in its list of art with "***printed dates***" which "***significantly post-date[] the effective date of the challenged patent***" (Pap.11 at 2) is misplaced since McCloskey doesn't include a post-priority *printed date*. Opp.11.

Parse's other arguments and cases each rest on the same flawed assumption that "The Hall-Ellis Declaration Is ***Responsive*** Supporting Evidence." Opp.10. 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.12 (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 '197." POR.21.

For these same reasons, Parse's cases are each inapposite. *See VidStream*, 981 F.3d at 1064-1067 (no abuse of discretion 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

Parse's unauthorized, late request for a waiver of the evidentiary requirements (Opp.15) does not establish good cause and should be rejected. *Bank of Am. V. Intellectual Ventures I LLC*, CBM2014-00028, Pap.14, 3 (Feb. 11, 2014). Parse waited ***five months*** after PO's objections to file its new Hall-Ellis declaration rather than serve it as supplemental evidence (or seeking permission to file supplemental information), and even then only incorporated it by reference. Rep.3. Respectfully submitted: /*Megan Raymond* / October 25, 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 limitation in 37 C.F.R. § 42.24(c)(2).

Dated: October 25, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER'S REPLY IN SUPPORT OF ITS 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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