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. IPR2023-00955
U.S. Patent No. 10,240,197

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 procedural arguments that Petitioner's motion is improper for being directed to arguments and waived for exceeding objected page numbers in Patent Owner's sur-reply. Panels of this tribunal, however, regularly exclude arguments based on improper evidence. *See supra* at 2-3. Regarding waiver, Patent Owner's argument is without merit because Patent Owner has long been on notice about the nature of the objection.

As to the merits, Patent Owner's overarching argument is that evidence regarding BtsI respond to Petitioner's argument and 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 IS NOT IMPROPER AND NOT WAIVED

Patent Owner's assertion that a motion seeking exclusion of arguments is improper is without merit. Paper 39 at 3. Indeed, panels of this tribunal regularly exclude arguments relating to evidence found to be irrelevant and/or prejudicial. *See, e.g.*, *Netflix, Inc., v. Divx, LLC*, IPR2020-00511, Paper 46 at 55 (P.T.A.B. Aug. 13, 2021) (declining to "consider[] the portions of Patent Owner's Sur-reply" relying upon new prejudicial evidence); *ABS Global, Inc. v. XY, LLC*, IPR2018-01224, Paper 28 at 19 (P.T.A.B. Dec. 9, 2018) (excluding "portions of the Petition and Reply" that relied on evidence found to be irrelevant). To the extent, Patent Owner argues that "the motion to exclude [is] improper on the basis that it could have been filed as a motion to strike," such argument has also been repeatedly rejected. *See Edwards Lifesciences Corp. v. Cardiovalve Ltd.*, IPR2021-00383, Paper 60 at 88 (P.T.A.B. Jul. 18, 2022) ("proceed[ing] to analyze the ***substance*** of the motion," rather than dismiss it on procedural defects); *see also Celltrion, Inc. v. Genentech, Inc.,* IPR2017-01139, Paper 68 at 27 (P.T.A.B. Oct. 3, 2018) (exercising discretion to treat a motion to exclude as a motion to strike).

Next, Patent Owner's assertion that the motion is waived because it seeks to "exclude arguments from additional POSR pages" is frivolous. Paper 39 at 2. What matters is that Petitioner's objections made clear that they pertain to "arguments based upon use of ***other*** restriction enzymes in Linnarsson" including the enzyme BtsI while citing "Patent Owner's Sur-Reply (Paper 31) at 6" as an example. Paper 33 at 2 (emphasis added). Patent Owner cannot cry foul because it had clear and sufficient notice about the nature and extent of Petitioner's objection.

III. PATENT OWNER DISTORTS DR. COOPER'S TESTIMONY AND PETITIONER'S ARGUMENTS

Patent Owner contends that its sur-reply arguments regarding BtsI are relevant because they disprove Petitioner's and Cooper's "repeated assertions" that Figures 3 and 4 "do not include…a restriction enzyme cut site at all." Paper 39 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 analyzed 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. Paper 37 at 2-3.

In context, it is clear that Petitioner's arguments and 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.*, EX1070 ¶ 50 (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.* ¶¶ 45, 97, 152. As he confirmed at deposition, sequences in Figures 3 and 4 are "all demarcated…So there's not an allocation to a cut site." EX2040 at 69:18-70:5. Likewise, Dr. Cooper explained that use of the BtsI enzyme in Figures 3 and 4 is "totally happenstance or coincidental." *Id.* at 71:10-21; *see also id.* at 70:14-22 ("That's a different enzyme ***than the one*** that is part of the example in Linnarsson").

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

Patent Owner asserts that Dr. Cooper agreed "other restriction enzymes" are "within Linnarsson's scope." Paper 39 at 13. Patent Owner thus apparently suggests that because Figures 3 and 4 coincidentally show an unmentioned sequence for BtsI, it ***might*** mean that they 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. *Id*. at 2, 13 ("BtsI and Bts**C**I, are different").
- Patent Owner does not deny that the appearance of the BtsI cut sequence in Figures 3 and 4 is a coincidence. Paper 37 at 5-7.
- Patent Owner does not deny that in Linnarsson "Bts" refers to the Bts**C**I cut site not the Bts**I** cut site. *Id.* at 2-3.
- Patent Owner does not deny that Figures 3 and 4 have no biotin, which is essential for fragmentation and capture. Paper 39 at n.3.

V. CONCLUSION

Petitioner's motion to exclude should be granted.

Dated: October 25, 2024

Respectfully submitted,

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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: October 25, 2024

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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 October 25, 2024, via electronic mail pursuant to 37 C.F.R. § 42.6(e) to the counsel for Patent Owner at the addresses below:

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