UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner

v.

10X GENOMICS, INC.,
Patent Owner

Case IPR2023-00958
Patent 10,697,013

PATENT OWNER'S MOTION TO EXCLUDE

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I. Introduction and Summary of Relief Requested

Patent Owner 10x Genomics, Inc. respectfully submits this Motion to Exclude pursuant to 37 C.F.R. §§ 41.62 and 42.64.[1] Patent Owner moves to exclude EX1004 ("McCloskey") and EX1085 ("Hall-Ellis Declaration"), and any reliance thereon. Patent Owner's objections to these exhibits were previously set forth in Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64. Pap.12, 1-2 (objecting to McCloskey under Federal Rules of Evidence 901, 602, 802, and 402); Pap.29, 4 (objecting to Hall-Ellis Declaration as untimely supplemental evidence).

Patent Owner's objections to these two exhibits—McCloskey and Hall-Ellis Declaration—are connected. The Petition and accompanying exhibits Petitioner filed on May 25, 2023, included McCloskey. But those papers failed to establish that the purported publication date in the document was subject to any hearsay exception, and otherwise failed to establish McCloskey was publicly accessible prior to the priority date of the '013 Patent—and thus Petitioner failed to establish McCloskey was relevant to the obviousness analysis set forth in the Petition.

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

Within the time period required under 37 C.F.R. § 42.64(b)(2), Patent Owner timely objected to McCloskey on each of those grounds. ***Petitioner did nothing***. The POR again called out these evidentiary failures of the Petition. In Petitioner's Reply, over ***four months past the deadline for supplemental evidence***, Petitioner filed the unauthorized Hall-Ellis Declaration on August 2, 2024. Petitioner attempted to portray the Hall-Ellis Declaration as "responsive" to the POR. This fails. The Hall-Ellis Declaration is belated, unauthorized, supplemental evidence filed well past the deadline under 37 C.F.R. §§ 42.123, 42.223. And Patent Owner timely objected to the Hall-Ellis Declaration as improper under 37 C.F.R. §§ 42.23(b) and 42.64(b)(2). Petitioner's evidentiary failures prevent Petitioner from relying on McCloskey, and McCloskey and the portions of Petitioner's expert's declarations relying on McCloskey should be excluded.

II. McCloskey And The Hall-Ellis Declaration Should Be Excluded

PO timely objected to McCloskey on February 15, 2024, noting, *inter alia*, that: "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 under **FRE 801** (hearsay) and is inadmissible under **FRE 802** (hearsay) …. Therefore, EX1004… [is] not relevant under **FRE 401** (test for relevance) and are inadmissible under **FRE 402** (relevance...)." Pap.12, 1-2. Per §42.64(b)(2), Petitioner could respond to this timely objection "by serving supplemental

evidence ***within ten business days*** of service of the objection." That deadline was ***February 29, 2024***. Petitioner waited… and waited… and only on Reply, ***over four months after the deadline for supplemental evidence***, did Petitioner attempt to cure these evidentiary failings, and it did so without authorization. EX1085 (filed Aug. 2, 2024). When Petitioner did file the second Hall-Ellis declaration, Patent Owner again objected, stating that EX1085 is untimely "and should have been served, but was not, as supplemental evidence within ten business days of 10x's timely objection." Pap.29, 4.

Petitioner's evidence that was timely and could properly be considered fails to establish McCloskey is admissible, and McCloskey should thus be excluded. Similarly, Petitioner's Hall-Ellis Declaration should be excluded as untimely supplemental evidence in violation of §42.64(b)(2)'s deadline.

A. McCloskey's Alleged Publication Date Is Hearsay, And It Is Accordingly Irrelevant Under FRE 402

McCloskey goes to the core issues of this case—whether the Challenged Claims are rendered obvious based on the teachings of McCloskey. Pet.5. It was thus paramount that Petitioner establish in its Petition that McCloskey is not hearsay (or is admissible despite its hearsay status), and that it is relevant to the obviousness analysis (*i.e.*, it's actually a printed publication). Yet, Petitioner established neither of these things. Pap.12, 1-2. Both of these failures demand exclusion of McCloskey.

Any Date Printed on McCloskey is hearsay. Any printed date in McCloskey relied on by Petitioner is an out-of-court statement offered for the truth of the matter asserted—*i.e.*, it is relied on for the proposition it is McCloskey's actual publication date. Pet.22. This is quintessential hearsay. Fed. R. Evid. 801(c); *Neste Oil Oyj v. REG Synthetic Fuels, LLC*, IPR2013-00578, Pap.53, 5-7 (Mar. 12, 2015) (granting patent owner's motion to exclude "Date Stamped" copies of the alleged prior art reference because "these handwritten dates that [petitioner] relies upon 'as further evidence of the public availability of [the reference] in 2007'" were hearsay); *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Pap.41, 13-18, 21-22 (Apr. 23, 2015) ("to the extent that the dates presented in Exhibit 1013 are relied upon as proof of dates relevant to the creation or publication date of Exhibits 1013 or 1002 itself, those dates are inadmissible hearsay" and stating the same for the dates on Exhibit 1002). Petitioner has not established an exception to the hearsay prohibition, and reliance on McCloskey's publication date as proof of creation or publication, including to establish public accessibility, is improper, and the Petitioner's reliance on this date as evidence (Rep.4-5; Pet.22; EX1002, ¶¶16, 109) should be excluded. Fed. R. Evid. 802 ("Hearsay is not admissible" unless an exception is established).

McCloskey is irrelevant. "Irrelevant evidence is not admissible." Fed. R. Evid. 402. According to Petitioner's Reply, "The Petition, however, states that

McCloskey was published online in October 2007 and is hence prior art under § 102(a) and (b)." Rep.4-5 (citing Pet.22). The Petition cites two pieces of evidence to support that assertion, (1) EX1028 (Dr. Hall-Ellis's *first* (different) declaration) and (2) EX1004 (McCloskey itself). Pet.22. But EX1028, Dr. Hall-Ellis's *first* declaration—the one actually filed with the Petition—***does not even mention McCloskey,*** let alone establish it is a publicly-accessible printed publication as of the priority date of the '013 Patent. *See generally*, EX1028. And the Petition's reliance on McCloskey to establish accessibility fails for multiple reasons. First, any date appearing within McCloskey is hearsay. *Supra*. Thus, Petitioner cannot rely on that date to prove the truth of the matter asserted, *i.e.*, the publication date. Second, even if, *arguendo*, this hearsay were treated as the publication date, a publication date alone does not establish "public accessibility." *See Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 770-772, 774 (Fed. Cir. 2018) (affirming FWD concluding article was not a printed publication where there was no showing it was "available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it"); *Medivis, Inc. v. Novarad Corp.*, IPR2023-00042, Pap.35, 28 (Mar. 6, 2024) ("any reference can state it was published without actually being published"); Pap.37, 4 ("""[T]he Petition...cites no evidence for public accessibility, except the references...themselves. This is insufficient and tantamount to submitting no proof

of public accessibility."). And ***attorney argument*** that McCloskey was published online cannot fill this gap. Pet.22; *TRW Auto. U.S. LLC v. Magna Elecs. Inc.*, IPR2014-01348, Pap.25, 10 (Jan. 15, 2016) (rejecting "attorney argument, not supported with evidence" that the ISBN established reference was published); *see also Medivis*, IPR2023-00042, Pap.35, 28-29 (rejecting declaration evidence submitted by knowledge-management attorney at firm representing petitioner because of the risk of implicit bias); *cf Sophos Ltd. v. Open Text Inc.*, IPR2023-00732, Pap.23, 12-19 (Nov. 2, 2023) (denying institution where Hall-Ellis declaration was given little to no weight, and there was no evidence that the undated reference was publicly disseminated or otherwise available to persons of skill as of the priority date).

There is also no *other* evidence in the record that McCloskey was publicly available as of the priority date. To the extent Petitioner points to, *e.g.*, the Fodor Patent (EX1053), ***that Patent issued in 2017, and thus post-dates the priority date by eight years***, and therefore does not constitute evidence that McCloskey was publicly accessible as of the ***2009 priority date***. *Cf. ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (agreeing that inclusion of manuals in an IDS does not convert them to prior art). Similarly, to the extent Petitioner points to McCloskey II, that is a ***different*** reference, and cannot establish the *public* accessibility of McCloskey.

Lastly, the belated (second) Hall-Ellis Declaration should not be considered in determining the admissibility of McCloskey, including whether it was publicly available, and should be separately excluded for the reasons laid out below. *TRW Auto. U.S.*, IPR2014-01348, Pap.25, 7 n.9 (refusing to consider exhibits purporting to support admissibility of another exhibit because they were "not filed timely as supplemental evidence"); *infra* §III.

For each of these reasons, McCloskey, the portions of Dr. Cooper's declarations (EX1002[2] and EX1070[3]) relying on McCloskey, and the portions of the Petition and Reply that rely on McCloskey (or Dr. Cooper's declarations that rely on McCloskey) should be excluded. *Riverbed Tech., Inc. v. Realtime Data LLC*, IPR2016-00978, Pap.67, 39-41 (Oct. 30, 2017) (excluding portions of expert report relying on excluded exhibit).

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[2] Including paragraphs 16, 45, 75, 79, 87-88, 109-112, 114, 143, 149, 161-162, 165-171, 173-178, 188, 190, 192-193, 201, 203, 205-207, 210-213, 215, 221-22, 226, 233-238, 240, 242-245, 247, 250-256, 258-262.

[3] Including paragraphs 14, 60-65, 67, 69-72, 74, 78-80, 87, 90, 92-94, 128-132, 137, 139-143, 145-148, 150-152.

B. The Second Hall-Ellis Declaration Is Unauthorized Supplemental Evidence

The Hall-Ellis Declaration is belated supplemental evidence that was filed without authorization and should be excluded.[4] Pap.29, 4; *Parse Biosciences, Inc. v. 10x Genomics, Inc.*, IPR2023-00876, Pap.47, 16-17 (Sept. 17, 2024) (excluding belated Hall-Ellis declaration filed on reply); *Dropbox, Inc. v. Synchronoss Techs., Inc.*, IPR2016-00850, Pap.41, 18-23 (Oct. 5, 2016) (granting motion to exclude and rejecting petitioner's attempt to cure the evidentiary failing after the POR: "[c]ategorizing supplemental evidence as a proper or timely reply to Patent Owner's arguments… does not shield Petitioner's evidence from the requirements that it comply with the rules regarding supplemental evidence"); *FedEx Corp. Servs., Inc. v. Roambee Corp.*, IPR2022-00934, Pap.41, 7-11 (Nov. 3, 2023) (granting motion to exclude evidence improperly included on sur-reply in violation of §42.23(b) where there was "no reasonable excuse for belatedly filing exhibits");

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[4] Because the Hall-Ellis Declaration should be excluded, that declaration also does not provide the authentication Petitioner argues it does. *E.g.*, Rep.4-5 n.4 ("The Petition inadvertently included an incorrect declaration from Sylvia Hall-Ellis…"). And even if considered, the Hall-Ellis Declaration purports to authenticate a different version of McCloskey, not EX1004. *Compare* EX1085, 37 (box top right with copyright notice) *with* EX1004, 1 (no box).

Toshiba Corp. v. Optical Devices, LLC, IPR2014-01447, Pap.34, 44-47 (Mar. 9, 2016) (granting motion to exclude exhibits submitted on reply, instead of served within the deadline for supplemental evidence, and rejecting petitioner's arguments that they were responsive to the patent owner's response); *Standard Innovation*, IPR2014-00148, Pap.41, 8-9, 18 (excluding exhibits filed on reply that sought to establish an exhibit was a printed publication, and stating "Patent Owner's challenge to the sufficiency of proof that [the Exhibit] is a printed publication does not create a second window for Petitioner to submit supplemental evidence."); *see also TRW Auto. U.S.*, IPR2014-01348, Pap.25, 7 n.9 (refusing to consider exhibits purporting to support admissibility of another exhibit because they were "not filed timely as supplemental evidence"); *Sirius XM Radio Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschung E.V.*, IPR2018-00690, Pap.63, 13-15 (July 23, 2020) (refusing to consider reply evidence that reference was prior art where "Patent Owner's Response simply pointed out the defect in the Petition").

Petitioner has no excuse for its failure. The late-submitted EX1065 is dated prior to the Petition, and Petitioner admits it simply never submitted the Hall-Ellis Declaration earlier, without even attempting to justify why it did not do so in response to PO's objections. Rep.4-5 n.4. §42.64(b)(2)'s deadline cannot be circumvented simply by filing supplementary evidence on reply. *See Sirius XM*,

IPR2018-00690, Pap.63, 13-15 (refusing to consider reply evidence that reference was prior art where "Patent Owner's Response simply pointed out the defect in the Petition").

III. Conclusion

For these reasons, both EX1085 and EX1004, along with the testimony of Dr. Cooper (EX1002 and EX1070) relying on these exhibits, should be excluded.

Respectfully submitted: /*Megan Raymond*/ October 11, 2024

CERTIFICATE OF PAGE COUNT

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

Dated: October 11, 2024

Respectfully Submitted,

By: /*Megan Raymond*/
Megan Raymond

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER'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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