

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 OPPOSITION TO PETITIONER'S
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. Introduction

Petitioner’s “Motion to Exclude” (“Mot.”) improperly seeks to exclude *arguments* (not *evidence*) from PO’s Sur-Reply (“POSR” (Pap.33)); improperly extends to *waived* objections addressing POSR pages and Rules Petitioner never included in its actual, filed objections; and is, on its face, nothing more than an unauthorized, self-help attempt at more briefing on improper new arguments Petitioner first raised in its Reply.¹ Tellingly, Petitioner’s motion *cites no caselaw* and *fails to raise even a colorable substantive argument* under the Rules of Evidence.

While Petitioner suggests certain Sur-Reply arguments related to BtsI (the subject of its brief) are irrelevant and confusing or prejudicial, this is baseless: these POSR arguments *respond directly to Petitioner’s argument* that Linnarsson’s Figs.3-4 show fragmentation is optional (and Petitioner’s expert’s assertion that Figs.3 and 4 “do not contain *any* restriction enzyme cut site”), and they establish that Figs.3-4 are consistent with the fragmentation disclosure throughout Linnarsson’s Example I (where they appear). And while Petitioner suggests PO “intentionally aimed to confuse the Board” by discussing BtsI (Mot.1), this flatly ignores (1) Petitioner’s own expert’s admission that restriction enzymes other than BtsCI are

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

within Linnarsson’s scope (EX2040, 37:16-21), (2) the POSR’s explicit statement that “another restriction enzyme cut site (CGAGTG) is present in Figs.3-4,” (POSR, 19 (first underline added) (also noting Cooper testimony “agreeing *other* restriction enzymes within Linnarsson’s scope”), n.9); (3) the Board’s clear competence to recognize BtsI and BtsCI are different; and (4) that “the Board, sitting as a non-jury tribunal with administrative expertise, is well positioned to determine and assign appropriate weight to evidence...” *E.g., Unified Patents, LLC v. Digimedia Tech, LLC*, IPR2022-01182, Pap.26, 42 (Jan. 12, 2024); *Novartis Pharms. Corp. v. Shilpa Pharma, Inc.*, IPR2022-00886, Pap.75, 18-19 (Sept. 29, 2023) (denying Rule 403 exclusion “we are capable of weighing his credibility and assessing [testimony’s] probative weight...without fear of undue prejudice [or]...confus[ion]”). Petitioner fails to show why the POSR’s BtsI arguments aren’t relevant, or how their probative value is substantially outweighed by supposed prejudice (there is none) or confusion (also absent). Petitioner’s motion should be denied.

II. Petitioner’s Motion Should Be Denied As Improper and Waived

While Petitioner objected only to “certain arguments” on pages “11-12” and “19-20” of the POSR, and only under FRE403 (Pap.35, 1-2), Petitioner now seeks to broaden its motion beyond those actual objections: it moves to exclude arguments from additional POSR pages (now spanning “18-21,” rather than just “19-20”), and apparently also based on FRE401 and 402. Mot.1-2, 8 (citing POSR at 18-21). But

Petitioner’s arguments directed to portions of the Sur-Reply to which it *didn’t object* and on the basis of rules it *didn’t cite* in its objections are waived. *Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2022-00914, Pap.45, 56 (Nov. 2, 2023) (denying exclusion including “because Petitioner did not timely object to the evidence on the basis asserted in the MTE”); *see also id.*, 57 (finding objection to hundreds of declaration paragraphs followed by vague objection was insufficient).

More fundamentally, Petitioner’s motion is improper because it “fail[s] to identify any evidence to exclude” and is directed to *arguments*, not *any evidence*. *Unified Patent LLC v. Mobilepay LLC*, IPR2019-00466, Pap.36, 11 (July 29, 2020) (denying motion to exclude “as improper for failing to identify any evidence to exclude with reference to a proper objection” and “not ‘challeng[ing] the admissibility of evidence,’ but rather request[ing] the striking of *arguments* submitted”) (italics orig.), *aff’d* No. 2022-2102, 2022 WL 738634 (Fed. Cir. Mar. 11, 2022); *Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00873, Pap.133, 49-50 (Oct. 18, 2019) (denying motion to exclude “improper *argument*” rather than “*inadmissible evidence*”) (italics orig.); *see* § III.C.

III. Petitioner’s Arguments Are Meritless, and Its Unauthorized Merits Briefing is Improper

A. Petitioner’s Sur-Reply Arguments Are Clearly Relevant Because They Rebut Petitioner’s Substantive Arguments

PO's sur-reply arguments regarding BtsI² respond to the repeated assertions in Petitioner's Reply and testimony of its expert, Cooper, that—unlike Figure 11—Linnarsson's "Figures 3 and 4 *do not include... a restriction enzyme cut site at all....*" E.g., EX1070, ¶¶31-59, 114-127 (testifying Fig. 3 & 4 "*do not include... any restriction enzyme cut site*"); Rep.11-13. Disproving the Reply and Cooper's testimony, the POSR arguments show *Figs. 3 and 4 do, indeed, include a restriction enzyme cut site* (e.g., EX2040, 25:21-31:9; POSR 18-21), and Petitioner's facially baseless argument that this evidence is somehow "*irrelevant*" (Mot.1-2, 5, 8-9) fails. Rather, this reveals the motion as a grab for pages of unauthorized briefing.

1. The Challenged Sur-Reply Arguments Disprove Petitioner's Assertion That Figures 3 And 4 Lack An Enzyme Restriction Cut Site, And Are Therefore An Exception To Linnarsson's "Fragment And Capture" Approach

Linnarsson's Fig. 11 illustrates a process that relies on a restriction enzyme cut site (in the Figure's example, a cut site for the enzyme BtsCI) as part of its process to prepare a sample for sequencing—which Petitioner's motion calls "fragmentation and capture." E.g., Mot.1-2. The original Petition and accompanying papers

² Further, the POSR arguments on pages 18 and 21 (even if Petitioner's waived challenge to them were considered) similarly respond to *Petitioner's* positions and *Cooper's* testimony, and thus should not be "exclude[d,]" either. Mot.1-2, 8.

repeatedly *equated and combined Linnarsson's Fig. 11 with Example I's Figs. 2-4* to argue that elements of each disclosed—together—limitations of the challenged '013 Patent claims, including to argue that at the end of the process illustrated in Fig. 11 the entire tagged polynucleotide is sequenced. *E.g.*, Pet. 32-33, 42-47; EX1002, ¶¶ 135-137, 139, 155-156; POR.42-48; POSR.17-26. But in doing so, the Petition and Petitioner's expert, Cooper, never addressed fragmentation and biotin in Fig. 11 (and in Example I and II, more generally, discussed below). *E.g.*, Pet. 34-43; EX1002, ¶¶ 146-148, 175; POR. 33-38; POSR.23-26.

PO then explained in the POR (Pap.21) that Petitioner's arguments failed because the argued prior art combination included Linnarsson's fragmentation and capture process illustrated in Fig. 11—a process consistently used in Linnarsson's only two Examples (Example I (which introduced Figs. 2-4), and Example II). *E.g.*, POR.12, 32, 38-39; EX2040, 25:18-30:19. PO demonstrated that, as a result of Linnarsson's fragmentation and capture process, Petitioner's various arguments failed. For example, in all Grounds, ligating a tag to Linnarsson's CDS or TSO in Petitioner's argued combination fails to render obvious any asserted claims. *E.g.*, POR.29-36. (For the CDS, a biotin blocks any tag being ligated to it. POR.2, 15, 29-31. And for the TSO, any tag would remain bound to the bead because it would be ligated to the 5' end of the restriction cut site. *E.g.*, POR.2, 34-35.) Additionally, in all Grounds, the entirety of the tagged polynucleotide is not sequenced. POR.42-48.

But in its Reply, Petitioner argued for the first time that the fragmentation and capture steps shown in Fig. 11 were entirely *optional*, and pointed to Figs. 3 and 4 as its supposed evidence. Rep.12, 17-19; *see also* Mot.3-4; *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (“Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines.”). Petitioner asserted that Linnarsson’s Figs. 3 and 4—“which are cited throughout the Petition—include neither a biotin nor a restriction enzyme cut site.” Rep.17-18; EX1070, ¶89 (“Figures 3 and 4 do not include a biotin or *a restriction enzyme cut site at all*, thus confirming that Linnarsson teaches approaches that do not require them.”); *see also id.* at ¶48 (“The *lack of a restriction enzyme cut site*... in Figure 3 is critical because it shows that Linnarsson is not limited to the fragment and capture approach of Figure 11.”), ¶117 (“Linnarsson contains numerous other exemplary embodiments that *do not* include... any restriction enzyme cut site. ... Linnarsson’s Figure 3 and Figure 4 show exemplary TSO and CDS that... do not contain any restriction enzyme cut site.”) (bold italics original), ¶118.³

³ Apart from their erroneous interpretation of Figs. 3 and 4, Petitioner and Cooper identified no Linnarsson embodiment or disclosure (from tagging through sequencing) in which biotin and fragmentation were not used. Cooper’s only other attempt was to point to the broad method claimed in independent claim 1. *E.g.*, EX2040,

Petitioner's reliance on Figs. 3 and 4 fails as a factual matter, as the Sur-Reply explains. Even a cursory review reveals Petitioner and its expert entirely *failed to consider* other easily-identified restriction enzyme cut sites when Cooper presented these erroneous assertions to the Board. *E.g.*, POSR.18-21. And at deposition, confronted with evidence contradicting those assertions, Cooper agreed. First, Cooper admitted Linnarsson encompasses the use of restriction enzyme cut sites other than BtsCI (EX2040, 37:16-21), and that Fig.11's "fragmentation and capture" would work with restriction enzymes and cut sites other than its BtsCI example. *E.g.*, EX2040, 35:5-20, 37:16-21, 36:6-21. Second, Cooper admitted POSITA could easily alter an oligo to use a different restriction enzyme. *E.g.*, EX2040, 35:21-37:21 ("[Q:] And it's your position that a POSITA would have to actually alter Linnarsson to use something other than BtsC1, as opposed to a POSITA understanding Linnarsson to broadly describe the use of a restriction enzyme cut site? [A:] ...So one modification that they would need to make is to alter -- at the position of the cut site

41:8-19; Rep.18-19 (arguing "fragmenting" an optional feature of dependent claim 27). But this claim's breadth is not a disclosure of an embodiment without fragmentation. *See, e.g., In re Benno*, 768 F.2d 1340, 1345-46 (Fed. Cir. 1985) ("The scope of a patent's claims determines what *infringes* the patent; it is no measure of what it *discloses*."); *see also* POSR.22-23.

they'd have to alter that sequence in their oligo design. That is certainly within the competencies of a skilled artisan.”). Thus, POSITA (unlike Cooper) would have readily identified the restriction enzyme cut site for BtsI in Figs.3 and 4. *See* Mot.5 (arguing these are “easily found”). *Third*, Petitioner and Cooper don’t dispute that Figs.3 and 4 actually *do* include the GCAGTG cut site sequence for enzyme BtsI. *E.g.*, Reply 18, n.7; EX1070, ¶58. And Petitioner’s Reply (recognizing the problem Petitioner faced with Cooper’s admissions), affirmatively argued “the presence of the BtsI sequence in Figures 3 and 4 is irrelevant.” Mot.5 (arguing Petitioner and Cooper “explained” this in Reply); Reply 18, n.7.

With Petitioner’s concessions and backtracking in hand, PO properly responded in its Sur-Reply (POSR) to Petitioner’s improper new Reply theory, explaining that Figs. 3 and 4 rely on fragmentation and capture because they include a restriction enzyme cut site for fragmenting—and are thus compatible with using biotin for capturing.⁴ POSR.17-26.

⁴ Petitioner’s Motion also argues Figs 3 and 4 don’t show biotin. *E.g.*, Mot.1, 4, 8. But as PO explained, those figures show only the polynucleotide sequence, and biotin isn’t a polynucleotide. POSR.23-24. And as discussed, Figs. 3 and 4’s polynucleotide sequences *do* include a restriction enzyme cut site, which Cooper admits is

2. FRE401 And FRE402 Confirm the Challenged Sur-Reply Arguments Are Relevant

Petitioner failed to timely object under FRE401 or 402, so any exclusion arguments based on those rules⁵ were waived. Pap.35, 1-2. Further, those rules *confirm* the challenged arguments are, in fact, relevant. Per Rule 401, “[e]vidence is relevant if: (a) it has *any tendency to make a fact more or less probable* than it would be without the evidence; and (b) *the fact is of consequence* in determining the action.” And under Rule 402, “[r]elevant evidence is admissible” unless prohibited by the Constitution, or a federal statute, rule of evidence, or Supreme Court rule.

PO’s sur-reply arguments “easily clear[] the very low threshold of relevance” set by the Rules. *E.g.*, *Spinal Elements, Inc. v. Spectrum Spine IP Holdings, LLC*, PGR2021-00050, Pap.47, 54-55 (Aug. 17, 2022) (“*Spinal Elements*”) (denying motion to exclude). Tellingly, Petitioner *never even mentions this standard*, let alone explains how the challenged sur-reply arguments could be irrelevant when they *directly respond to Petitioner’s related Reply arguments* (see Mot.5 (citing Reply

“part and parcel of [Linnarsson’s] fragmentation method.” *E.g.*, EX1070, ¶37; POSR.20, n.11.

⁵ Petitioner also never articulates any: its sole mention of FRE401 appears in the motion’s first sentence, and its brief offers no explanation for that mention. And Petitioner merely cites FRE402 on page 1 and quotes it on page 8 of the motion.

n.7)) and contradict Cooper's uninformed, erroneous testimony. These POSR arguments provide clear context and confirm that Linnarsson's Figs. 3 and 4 are, indeed, compatible with Linnarsson's "fragmentation and capture" process. *Compare, e.g.,* EX1070, ¶117 ("Linnarsson's Figure 3 and Figure 4 show exemplary TSO and CDS that do not contain a biotin and ***do not contain any restriction enzyme cut site.***"), *with* EX2040, 36:3-5 ("I think a POSA could reasonably alter the design of their oligos to use a different enzyme, yes."). *See also* Mot.5 (citing Reply at n.7, as purportedly "explain[ing] the presence of the BtsI sequence in Figures 3 and 4 is irrelevant"); *Medtronic Vascular, Inc. v. TMT Sys., Inc.*, IPR2021-01532, Pap.56, 46-48 (Mar. 7, 2023) (declining to exclude as irrelevant exhibit "giv[ing] context to the testimony," noting "Board is well-positioned to determine and assign appropriate weight to" evidence); *Mylan Pharms. Inc. v. Regeneron Pharms., Inc.*, IPR2021-00880, Pap.89, 19 (Nov. 9, 2022) (declining to exclude uncited exhibit that was testified to in deposition and thus had "tendency to make a fact more or less probable"); *Ascend Performance Materials Operations LLC v. Samsung SDI Co.*, IPR2020-00349, Pap.53, 12-13 (July 15, 2021) (finding exhibits introduced to test testimony during cross-examination relevant).

As detailed above, Petitioner's expert Cooper broadly and repeatedly testified in his second declaration that Figs. 3 and 4 "do not contain any restriction enzyme cut site" to support his argument those figures show fragmentation and capture in

Linnarsson is optional. *E.g.*, EX1070, ¶¶117-118, 48. Thus, the challenged POSR argument, which *explains (relying on evidence Petitioner does not seek to exclude⁶) why Petitioner and Cooper were wrong* by identifying GCAGTG (found in Figs. 3 and 4) as an enzyme restriction cut site, is certainly relevant: “it has [a] tendency to make a fact more or less probable....” Fed. R. Evid. 402. Here, this POSR argument explains the evidence that tends to make Cooper’s assertion that Figs. 3 and 4 “do not contain any restriction enzyme cut site” far less probable—indeed, it *proves Cooper’s assertion false*. EX1070, ¶¶117-118, 48; *cf.* Mot.5 (citing Reply at n.7 as “explain[ing] presence of... BtsI sequence... is irrelevant”). And this fact matters it negates Petitioner’s only purported support⁷ for its improper new theory that fragmentation in Linnarsson’s method is optional.

Petitioner further offers the make-weight argument that the challenged POSR arguments are irrelevant because BtsI is different from the BtsCI enzyme “used [and] mentioned in Linnarsson.” Mot.8. But *first*, these arguments are relevant to

⁶ Unlike in IPR2023-00876, Pap.34, 1, here Petitioner did not move to exclude underlying *evidence* (*e.g.*, EX2015) confirming it and Cooper were wrong. *Cf.* Mot.4, n.1.

⁷ Figures 3 and 4 are the only “embodiments” Petitioner alleged do not include these features. *See* n.4.

challenging Cooper’s theory and testimony because his theory and testimony *were not limited to the BtsCI enzyme* Linnarsson presented as an example: Cooper testified—erroneously—that Figures 3 and 4 “*do not* include... any restriction enzyme cut site” “at all.” E.g., EX1070, ¶¶117-118, 48. *Petitioner thus made other restriction enzymes relevant*, whether or not Linnarsson explicitly names them. And second, *Linnarsson’s express disclosures extend beyond BtsCI*, and include “modifications which do not substantially affect the activity of the various embodiments of this invention are also provided within the definition of the invention.” EX1003, 22:29-32. Petitioner never asserts, let alone explains, how swapping one restriction enzyme for another “substantially affect[s] the activity of [Linnarsson’s] various embodiments” (*id.*) so as to make it irrelevant to Linnarsson’s disclosures. *See, e.g.*, EX2040, 35:5-20 (Cooper acknowledging “[I]t is certainly possible one could imagine using a different enzyme, depending on the experimental context.”), 37:18-20 (“[U]sing different enzymes would be within scope of what Linnarsson discloses, yes.”). Again, there is no question the POSR’s arguments “easily clear[] the very low threshold of relevance” and this motion fails. E.g., *Spinal Elements*, 54-55.

B. Sur-Reply Arguments Are Not Unfairly Prejudicial Or Confusing Under FRE403, And The Board Is Well Positioned To Assess This Evidence

Equally specious is Petitioner’s assertion the POSR’s arguments are somehow “prejudicial and confusing,” which rests on the unsupported argument that PO

“intentionally” “aims to confuse the Board” by referring to a cut site for BtsI. Mot.1, 9. *First*, Petitioner’s argument that the POSR “intentionally” misleads the Board suggests Petitioner never read it: the POSR explicitly calls out that Cooper was questioned about “another restriction enzyme cut site.” POSR.19-20 (underline added) (also noting Cooper testimony “agreeing *other* restriction enzymes within Linnarsson’s scope”), n.10. *Second*, the Board is more than capable of distinguishing between “BtsI” and “BtsCI” enzymes and their cut sites. And *third*, Petitioner skipped any mention or analysis of the governing standard for good reason: Under Rule 403, the Board “may exclude relevant evidence if its probative value *is substantially outweighed* by a danger of... *unfair prejudice*, confusing the issues, [or] misleading the jury.” Petitioner never acknowledges that, even if, *arguendo*, there were unfair prejudice (there isn’t, and Petitioner has shown none), these arguments’ probative value must be *substantially* outweighed to be excluded—and Petitioner never argued it is. Mot.8-9. Moreover, as the Board has noted, “Rule 403 has limited applicability, if any, to bench trials like this proceeding,” *Spinal Elements*, 54-55, and—working as a technically-qualified fact-finder without a jury—“the Board is well-positioned to determine and assign appropriate weight to...evidence.” *See Medtronic Vascular*, IPR2021-01532, Pap.56, 46-48 (rejecting motion to exclude material argued to “confuse the issues”); *Fox Factory, Inc. v. SRAM, LLC*, IPR2017-00472, Pap.64, 60 (Apr. 18, 2018) (“As the factfinder, we are able to consider this evidence, in light of the

parties’ arguments, and give it the appropriate weight.”); *Neste Oil Oyj v. Reg Synthetic Fuels, LLC*, IPR2013-00578, Pap.53, 10-11 (Mar. 12, 2015) (Board proceedings “are not jury trials; in the absence of a jury, the risk of unfair prejudice against which Rule 403 guards is diminished, if not eliminated entirely”); *see also United States v. Preston*, 706 F.3d 1106, 1117 (9th Cir. 2013), *rev’d on other grounds*, 751 F.3d 1008 (9th Cir. 2014) (en banc) (“Rule 403 is *inapplicable* to bench trials.”).

C. Petitioner’s Purported “Motion To Exclude” Is An Improper, Unauthorized Brief On Its Late Reply Arguments

As demonstrated above, far from raising any legitimate (or even colorable) evidentiary concerns, Petitioner’s motion to exclude is nothing more than an improper brief directed to the merits of this proceeding: Petitioner helped itself without the Board’s authorization to arguing issues beyond those Petitioner had actually preserved in any objections, and to further briefing on Petitioner’s improper, late new arguments first raised in Reply. But this, as well as any complaints Petitioner purports to have about how and when the POSR arguments were raised (*e.g.*, Mot.2), is improper subject matter for a motion to exclude, and Petitioner’s motion should be denied on this additional basis, as well. “While a motion to exclude may raise issues related to admissibility of evidence, it is not an opportunity to file a sur-reply, and also is not a mechanism to argue that a reply contains new arguments.” *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00002, Pap.66, 62 (Jan. 23, 2014); *see also Envirotainer AB v. DoubleDay Acquisitions, LLC*, IPR2022-00293, Pap.83,

102-103 (Feb. 1, 2024) (denying aspect of motion that argues “that the documents exceed the scope of a proper reply”); *Abbott*, IPR2022-00914, Pap.45, 57 (denying motion to exclude and agreeing that “Petitioner’s arguments in the MTE are no more than a ‘transparent attempt to . . . circumvent the word-count limits of its merits briefing by injecting merits arguments in its evidentiary motion’”); USPTO, *Consolidated Trial Practice Guide*, 79 (Nov. 2019) (“A motion to exclude... may not be used to challenge the sufficiency of the evidence to prove a particular fact... [or] for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents.”).

IV. Conclusion

For all of the foregoing reasons, Petitioner’s improper and unsupported Motion to Exclude Sur-Reply Arguments should be denied.

Respectfully submitted: /J. Steven Baughman/ October 18, 2024

CERTIFICATE OF PAGE COUNT

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

Dated: October 18, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER'S OPPOSITION TO PETITIONER'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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Dated: October 18, 2024

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