

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC.,
Petitioner

v.

BRUKER SPATIAL BIOLOGY, INC.,
Patent Owner

Case IPR2023-01298
U.S. Patent No. 11,377,689

**PETITIONER'S MOTION TO EXCLUDE EVIDENCE
UNDER 37 C.F.R. § 42.64(c)**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioner 10x Genomics, Inc. files this motion pursuant to 37 C.F.R. §§ 42.62 and 42.64(c) and in accordance with Due Date 5 of the Revised Scheduling Order (Paper 35). The Board should exclude portions of Exhibit 2006 (Declaration of Dr. David H. Sherman) under FRE 702 and 703 as unreliable testimony lacking any underlying basis for support. Petitioner timely objected to the challenged evidence, and Patent Owner made no efforts to cure the objections through supplemental evidence.

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner moves to exclude from the record paragraphs 35-82 and 91-122 of EX2006.

II. STATEMENT OF MATERIAL FACTS

1. The Federal Rules of Evidence (FRE) govern the admissibility of evidence in *inter partes* review proceedings. 37 C.F.R. § 42.62.

2. Patent Owner Bruker Spatial Biology, Inc. filed the Declaration of Dr. David H. Sherman (EX2006) with its Patent Owner's Response on August 26, 2024. *See generally*, Paper 36; EX2006.

3. 10x timely objected to Dr. Sherman's testimony in EX2006 on September 3, 2024.¹ *See* Paper 37, 1-2.

¹ Given that September 2, 2024, was a federal holiday, 10x timely filed and

4. 10x specifically objected to Dr. Sherman's testimony in paragraphs 35-82 and 91-122 of EX2006 under FRE 702. *Id.*

5. Bruker failed to serve any supplemental evidence in response to 10x's objections to evidence.

6. Bruker relies on paragraphs 35-82 and 91-122 in EX2006 throughout its Patent Owner's Response. *See* Paper 36, at 14-17, 19-29, 31-34, 36-39, 42-58.

7. Bruker relies on paragraphs 35-82 and 91-122 in EX2006 throughout its Patent Owner's Sur-Reply. *See* Paper 43, at 3, 4, 7, 8, 10, 13-15, 25-27.

III. ARGUMENT

Dr. Sherman's testimony in EX2006 is inadmissible under FRE 702 and 703 because Dr. Sherman's declaration testimony is not based on sufficient facts or data, and there is no evidence that his testimony is the product of reliable principles and methods. Moreover, Dr. Sherman failed to explain how he purportedly applied such principles and methods to the facts of the case.

Rule 702 allows entry of expert testimony if:

(a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;

(b) the testimony is based on sufficient facts or data;

served its objections on the next business day, September 3.

(c) the testimony is the product of reliable principles and methods; and

(d) the expert has reliably applied the principles and methods to the facts of the case.

FRE 702.

As a gatekeeper, the Board must “ensure that all expert testimony is rooted in firm scientific or technical ground.” *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 711 F.3d 1348, 1373 (Fed. Cir. 2013). Indeed, the “Federal Rules of Evidence require that an expert’s testimony be the product of reliable principles and methods applied to sufficient facts or data.” *Id.* (citing FRE 702(b), (c)). Expert testimony must not only be relevant, but it must be *reliable*. As the Supreme Court stated in *Daubert*, “[t]he subject of an expert’s testimony must be scientific knowledge” and “the word ‘knowledge’ connotes more than subjective belief or unsupported speculation.” *Daubert v. Merrell Dow Pharm.*, 509 U.S. 579, 590 (1993) (cleaned up). And while “[t]rained experts commonly extrapolate from existing data[,] ... nothing in either *Daubert* or the Federal Rules of Evidence requires [the Board] to admit opinion evidence that is connected to existing data only by the *ipse dixit* of the expert.” *Lawes v. CSA Architects & Eng'rs LLP*, 963 F.3d 72, 98 (1st Cir. 2020).

Throughout his declaration, Dr. Sherman speculates from the viewpoint of a person of ordinary skill in the art, but fails to provide underlying facts or data on

which his opinions are based. For example, in paragraph 64 of his declaration, Dr. Sherman alleges that “[a] person of ordinary skill would have recognized challenges with bi-directional extension, and the requirements for unique chemistry and application of enzymes to permit such extension.” EX2006, ¶64. Dr. Sherman further states that “[m]erely adding enzymes would not necessarily cause a bi-directional extension reaction to occur.” *Id.* Neither Bruker nor Dr. Sherman provides any bases or underlying evidence for these unsupported assumptions and speculations. Similarly, in paragraph 71, Dr. Sherman states that “[a] person of ordinary skill would recognize that the referenced gap extension is not meant to capture a meaningful extension product, but correct for the possibility that the probes are too far apart to be ligated directly.” EX2006, ¶71. Again, Dr. Sherman speculates on a POSA’s understanding, while providing no underlying facts or data on which his opinion is based. *Id.* And in paragraph 95, Dr. Sherman testifies that “[a] POSA would have understood that a double-stranded sequence can be formed when an identifier oligonucleotide binds completely or partially to another sequence, such as the target sequence,” again providing no underlying evidence to support this assertion. EX2006, ¶95.

Dr. Sherman also erroneously relies on disclosures in the 689 patent for teaching a POSA. For example, in paragraph 45 of EX2006, Dr. Sherman testifies that “[t]he ’689 Patent’s disclosures *lead a person of ordinary skill to recognize the*

importance of treating the tissue sample to facilitate the binding of nucleic acid probes.” EX2006, ¶45. Dr. Sherman provides no evidence *from the prior art* that would “lead” a POSA, and instead relies on disclosures from the 689 patent. *Id.*; *see also id.*, ¶47 (“Further, other disclosures in the ’689 Patent would *lead a person of ordinary skill to understand* the importance of treating the tissue sample”), ¶48 (“In my opinion, this is consistent with the state of the art as of the priority date of the ’689 Patent.”), ¶68 (similar).

During cross-examination, it became evident that Dr. Sherman is not qualified to provide expert opinions on spatial transcriptomics and the state of the art as of the 689 patent’s 2018 claimed priority date. For example, Dr. Sherman testified that he is a professor of “medicinal chemistry ... microbiology and immunology ... [and] chemistry.” EX1056, 16:4-9. Dr. Sherman further testified that the nature of his academic research is “study[ing] drug discovery, molecules to develop pharmaceuticals,” and that “drug discovery” and “synthetic chemistry” are key aspects of his research. *Id.*, 16:13-17:14. Dr. Sherman also founded and operates a litigation-support research company called “PharmaForensics Laboratories,” which, according to Dr. Sherman, is “a lab that analyzes intellectual property matters at a technical level.” *Id.*, 18:2-7; *see also*, EX2014, 45. Dr. Sherman further testified that his lab at PharmaForensics performs “drug analysis, drug dissolution, analytical chemistry, HPLC mass spectrometry, ELISA assays,

[and] microbiology.” *Id.*, 18:8-14. Thus, not only does Dr. Sherman fail to provide underlying facts or data supporting his speculative opinions in his declaration, his background and experience as a synthetic chemist are poorly suited to provide expert opinions on a POSA’s viewpoint in the field of spatial transcriptomics in 2018.

This is not the first time Dr. Sherman’s testimony has been found not credible. *See, e.g.*, Mem. Op. at 14, *Merck Sharpe & Dhome Corp. v. Sandoz, Inc.*, No. 3:12-cv-03289-PGS-LHG (D.N.J. Aug. 27, 2015) (“Most of the witnesses at trial seemed generally credible. However, one witness in particular came to conclusions that were less than credible: Dr. Sherman.”). According to the District Court’s Opinion, “Dr. Sherman’s testimony was not focused on the state of mind of the POSA in 1994 [the critical date], who lacked the benefit of Merck’s confidential research or hindsight information available after 1994.” *Id.*

Accordingly, the Board should exclude paragraphs 35-82 and 91-122 of EX2006 because Dr. Sherman’s opinions are unsubstantiated, unreliable, and will not help the Board understand the evidence or determine a fact in issue. FRE 702, 703. Neither Dr. Sherman nor Bruker show that Dr. Sherman’s opinions are based on sufficient facts or data, as required by FRE 702 and 703 and 37 C.F.R. § 42.65. And Dr. Sherman’s technical background is not credible to provide unsupported opinions. “In the end, [the Board is] left with an expert opinion derived from

unreliable data and built on speculation ... Such unreliable testimony frustrates a primary goal of expert testimony in any case, which is meant to place experience from professional specialization at the jury's disposal, not muddle the jury's fact-finding with unreliability and speculation.” *Power Integrations*, 711 F.3d at 1374.

IV. CONCLUSION

For the foregoing reasons, the challenged evidence does not meet the threshold for admissibility and should be excluded from the record.

Respectfully submitted,

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Date: February 14, 2025

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PETITIONER'S MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64(c)** was served in its entirety on February 14, 2025, upon the following parties via electronic mail:

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