

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

**REPLY TO PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO EXCLUDE EVIDENCE**

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Patent Trial and Appeal Board
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Petitioner's Motion to Exclude Evidence ("Motion") demonstrated that the Board should exclude Dr. Sherman's testimony in paragraphs 35-82 and 91-122 of EX2006 under FRE 702 and 703. Patent Owner's Opposition to Petitioner's Motion ("Opposition") fails to show otherwise.

I. PETITIONER'S MOTION TO EXCLUDE IS PROPER.

As previously explained, Dr. Sherman's testimony in paragraphs 35-82 and 91-122 of 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. Motion, 2. Relying on *Apple Inc. v. Masimo Corporation*, Patent Owner contends that Petitioner's Motion is "not the proper subject of a motion to exclude," alleging that the Motion only offers "disagreements" with Dr. Sherman's testimony. Opposition, 1 (citing IPR2022-01291, Paper 81 at 134-135 (P.T.A.B. Nov. 6, 2024)).

Patent Owner is incorrect. Petitioner's Motion clearly explained that Dr. Sherman failed to provide underlying facts or data supporting his opinions, rather than dispute the *merits* of Dr. Sherman's opinions. Motion, 3-4. Moreover, *Apple* addressed the issue of incorporating arguments by reference, which is a PTAB-specific rule (37 C.F.R. § 42.6(a)(3)), *not* a rule of exclusion under the Federal Rules of Evidence—the basis of Petitioner's Motion. As the Board in *Apple* made

clear, “[m]otions to exclude concern *admissibility of evidence* under the Federal Rules of Evidence, not improper briefing.” *Apple*, Paper 81, 134-135 (emphasis added). Here, Petitioner’s Motion does not argue about improper briefing or the merits of Dr. Sherman’s opinions—the Motion addresses *admissibility*. Motion, 3-7.

A. There is no evidence of Dr. Sherman’s alleged experience in spatial transcriptomics.

Patent Owner argues that Dr. Sherman is “highly qualified,” but Dr. Sherman’s qualifications are inapt for this proceeding. Opposition, 3-5. As Petitioner’s Motion explained, Dr. Sherman testified on cross-examination that he is a professor of medicinal chemistry, microbiology and immunology, and chemistry, focusing on drug discovery, pharmaceutical development, and synthetic chemistry. EX1056, 16:4-9, 16:13-17:14; Motion, 5-6. He also founded and operates a litigation-support research company. EX1056, 18:2-7; Motion, 5-6; EX2014, 45. When asked about his experience with spatial transcriptomics, Dr. Sherman was unsure which commercial products he purportedly had experience using, and further testified that he had only worked with them in “the last 9 to 12 months.” EX1056, 21:24–22:6. He also admitted that the alleged systems he purportedly “used” were not in his own lab but operated by others in “core laboratories.” *Id.*, 20:24-21:3. Moreover, Dr. Sherman could point to no actual evidence of his research or experience in spatial transcriptomics, only vaguely

stating that his lab is purportedly “working on the manuscript.” EX1056, 22:1–3.

As with his unsupported direct testimony, Patent Owner asks the Board to take Dr. Sherman’s unsupported deposition testimony at face value, without any underlying facts or data in support.

Patent Owner’s reliance on *Arkansas Game & Fish Comm’n v. United States* does not help its case. In *Arkansas Game*, the expert was a timber appraiser—a field which the Court acknowledged is “often imprecise,” where “the *appraiser’s experience can be the most important factor* in establishing valuation.” 736 F.3d 1364, 1378 (Fed. Cir. 2013) (emphasis added). This is in marked contrast to the field of spatial transcriptomics, a highly complex biotechnical field requiring scientific precision and rigor.

B. Cross-examination further exposed the inadmissibility of Dr. Sherman’s testimony.

Patent Owner attempts to avoid the issue of Dr. Sherman’s unsupported direct testimony by arguing that Petitioner had the opportunity to cross-examine Dr. Sherman. Opposition, 6. Indeed, Petitioner *did* cross-examine Dr. Sherman and he was unable to provide credible answers. For example, despite previously testifying that So-456 discloses a ligation reaction (*see e.g.*, EX2006, ¶70, “This *ligated molecule* is then used ...”), Dr. Sherman astonishingly testified at deposition that So-456 discloses *no ligation* because the word “ligase” does not appear in the figure. EX1056, 35:23-36:14; Paper 39, at 19. Dr. Sherman’s

testimony remains unsupported, unreliable, and inadmissible. *Micro Chem.* does not support Patent Owner's Opposition. Opposition, 7 (citing *Micro Chem., Inc. v. Lextron, Inc.*, 317 F.3d 1387, 1392 (Fed. Cir. 2003)). In *Micro Chem.*, the expert in question allegedly relied on conflicting data and statements of others, and failed to perform his own independent investigation. *Micro Chem.*, 317 F.3d at 1392. As the Court explained, the expert nevertheless satisfied the "requirement for sufficient facts and data" under FRE 702, regardless of whether those facts and data were reliable. *Id.* "When, as here, the parties' experts rely on conflicting sets of facts, it is not the role of the trial court to evaluate the correctness of facts underlying one expert's testimony." *Id.* Here, in contrast, there *are no underlying facts or data* to support Dr. Sherman's opinions. This is not an issue of the reliability of underlying evidence, this is an issue of Dr. Sherman's failure to provide *any* underlying evidence at all, and thus his failure to comply with FRE 702.

C. Dr. Sherman relies upon the specification as prior art.

Patent Owner contends that it was proper for Dr. Sherman to rely on the '689 patent in discussing the alleged "novel" step of treating a tissue sample in the art. Opposition, 8–9. First, if treating a tissue sample as claimed in the '689 patent were truly "novel," as Patent Owner alleges, then a POSA would not have had such allegedly "novel" teachings available to her and thus could not be "lead" by those teachings in "the state of the art" as Dr. Sherman testified. EX2006, ¶¶45, 47,

48, 68; Motion, 4-5. Thus, Patent Owner’s position that treating a tissue sample was “novel” belies its defense of Dr. Sherman’s testimony. Second, the Board already found that treating a tissue sample was *not* novel. *See* Paper 14, 30 (“we agree with Petitioner that an ordinarily skilled artisan would have known how to prepare tissue for *in situ* histochemistry.”). Patent Owner cannot have it both ways.

D. The Board should exclude Dr. Sherman’s testimony

Petitioner’s Motion addresses the admissibility of Dr. Sherman’s testimony. Motion, 3-7. Patent Owner argues that the Motion addresses the weight of Dr. Sherman’s testimony, rather than admissibility. Opposition, 1, 7 (“Petitioner’s arguments are not the subject of a motion to exclude.”). As explained above, Patent Owner’s arguments are meritless. Nonetheless, should the Board agree with Patent Owner and choose not to exclude Dr. Sherman’s testimony, his testimony should be given no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (P.T.A.B. Aug. 24, 2022) (precedential); *see also, TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); 37 CFR § 42.65(a).

II. 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 28, 2025

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

I certify that the above-captioned **PETITIONER'S REPLY TO PATENT
OWNER'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE
EVIDENCE** was served in its entirety on February 28, 2025 upon the following
parties via electronic mail:

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