

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFIC BIOSCIENCES OF CALIFORNIA, INC,
Petitioner

v.

THE CHINESE UNIVERSITY OF HONG KONG,
Patent Owner

Case **IPR2024-00028**
Patent No. **11,091,794 B2**

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE
UNDER 37 C.F.R. § 42.64(b)(1)**

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner submits the following objections to Exhibit Nos. 1002, 1005, 1011, 1012, 1016, 1019, 1021, 1026, 1033, 1036, 1037, 1039, 1040, 1041, 1042, 1043, 1044, and 1046 which were filed by Petitioner, Pacific Biosciences of California, Inc., with its Petition for *Inter Partes* Review of U.S. Patent No. 11,091,794 B2. Patent Owner's objections apply equally to Petitioner's reliance on these exhibits in its Petition or any subsequently-filed documents regarding same. These objections are timely, having been served within ten (10) business days of the Board's decision to institute a trial in this proceeding.

Exhibit 1002

Patent Owner objects to Exhibit 1002 (Declaration of Dr. Christophe Dessimoz) under FRE 702 because the testimony is not based upon sufficient facts or data and is not the result of application of reliable principles and methods. Patent Owner further objects under FRE 703 that the facts or data are not of a type reasonably relied upon by experts.

Patent Owner further objects to Dr. Dessimoz's Declaration to the extent that any paragraph relies upon an exhibit that is objected to herein for the reasons set forth in those objections. Any paragraph in Dr. Dessimoz's Declaration that relies upon any exhibit not relied upon by the PTAB to institute this proceeding is

further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1005

Patent Owner objects to Exhibit 1005 (U.S. Patent Application No. 17/379,544 File History) as the Board did not rely on this Exhibit in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1011

Patent Owner objects to Exhibit 1011 (BAM Format Specification for PacBio, PacBioFileFormats 5.0 Documentation) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and

802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1011 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. Any portion of the Exhibit not relied upon by the PTAB to institute this proceeding is further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1012

Patent Owner objects to Exhibit 1012 (SAM/BAM Specification Working Group, Sequence Alignment/Map Format Specification) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1012 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1012 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1016

Patent Owner objects to Exhibit 1016 (“Detecting DNA Base modifications Using Single Molecule, Real-Time Sequencing”) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1016 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1016 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1019

Patent Owner objects to Exhibit 1019 (Pacific Biosciences Preparation and Sequencing Guide) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1019 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. Any portion of the Exhibit not relied upon by the PTAB to institute this proceeding is further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1021

Patent Owner objects to Exhibit 1021 (Pacific Biosciences kinetics Tools Manual) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1021 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not

rely on Exhibit 1021 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1026

Patent Owner objects to Exhibit 1026 (GenomeWeb, “PacBio Reveals Beta System Specs for RS; Says Commercial Release is on Track for First Half of 2011”) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1026 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1026 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1033

Patent Owner objects to Exhibit 1033 (Pacific Biosciences, PacBioFileFormats Documentation (Feb. 2022)) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1033 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1033 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1036

Patent Owner objects to Exhibit 1036 (DeepVariant Usage Guide) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1036 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1036 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1037

Patent Owner objects to Exhibit 1037 (U.S. Patent Application No. 18/189,084 File History) as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1037 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1039

Patent Owner objects to Exhibit 1039 (First Declaration of Nathaniel E. Frank-White) as improper lay testimony under FRE 701, to the extent it offers testimony outside of Mr. Frank-White's area of expertise or fails to disclose the underlying facts or data on which the opinion is based. To the extent Petitioner

relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Nathaniel E. Frank-White's Declaration to the extent that any paragraph relies upon an exhibit that is objected to herein for the reasons set forth in those objections. Any paragraph in the Nathaniel E. Frank-White Declaration that relies upon any exhibit not relied upon by the PTAB to institute this proceeding is further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1040

Patent Owner objects to Exhibit 1040 (Second Declaration of Nathaniel E. Frank-White) as improper lay testimony under FRE 701, to the extent it offers testimony outside of Mr. Frank-White's area of expertise or fails to disclose the underlying facts or data on which the opinion is based. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Nathaniel E. Frank-White's Declaration to the extent that any paragraph relies upon an exhibit that is objected to herein for the reasons set forth in those objections. Any paragraph in the Nathaniel E. Frank-White Declaration that relies upon any exhibit not relied upon by the PTAB to institute this proceeding is further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1041

Patent Owner objects to Exhibit 1041 (Declaration of Mozhgan Novbakhtian) as improper lay testimony under FRE 701, to the extent it offers testimony outside of Ms. Novbakhtian's area of expertise or fails to disclose the underlying facts or data on which the opinion is based. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Mozhgan Novbakhtian's Declaration to the extent that any paragraph relies upon an exhibit that is objected to herein for the reasons set forth in those objections. Any paragraph in the Mozhgan Novbakhtian Declaration that relies upon any exhibit not relied upon by the PTAB to institute

this proceeding is further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1042

Patent Owner Objects to Exhibit 1042 (GitHub, PacBio BAM 3.0) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1042 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1042 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact

more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1043

Patent Owner Objects to Exhibit 1043 (GitHub, PacBio BAM 5.0) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1043 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1043 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact

more or less probable than it would be without its admission, , making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1044

Patent Owner objects to Exhibit 1044 (PacBio Sequencing – How it Works video file) to the extent that it is an excerpt and not the complete document pursuant to FRE 106. Patent Owner further objects to this exhibit to the extent that it is an incomplete copy, and thus an inadmissible duplicate pursuant to FRE 1002 and 1003.

Patent Owner objects to this exhibit as not properly authenticated under FRE 901 because Petitioner has not presented sufficient evidence that the document is authentic nor that the document is self-authenticating under FRE 902. To the extent Petitioner relies on the contents of this exhibit for the truth of the matter asserted, Patent Owner objects to such content as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Patent Owner further objects to Exhibit 1044 as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1044 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact

more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

Exhibit 1046

Patent Owner objects to Exhibit 1046 (U.S. Patent Application No. 17/891,899 File History) as creating unfair prejudice, confusing the issues, or as a waste of time pursuant to FRE 403. The Board did not rely on Exhibit 1046 in its decision to institute trial, thus the Exhibit does not include any fact of consequence, nor does it have any tendency to make a fact more or less probable than it would be without its admission, making it irrelevant and inadmissible under FRE 401 and 402.

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In view of the foregoing objections, Patent Owner likewise objects to any testimony or argument purporting to rely on any of Petitioner's Exhibit Nos. 1002, 1005, 1011, 1012, 1016, 1019, 1021, 1026, 1033, 1036, 1037, 1039, 1040, 1041, 1042, 1043, 1044, and 1046. Furthermore, Patent Owner objects to paragraphs in the Petition that rely on exhibits objected to in this Patent Owner's Objection to Evidence.

Respectfully submitted,

Date: May 8, 2024

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that service on Petitioner was made as follows, in accordance with 37 CFR 42.6(e):

Date of service: May 8, 2024

Manner of service: 1. Electronic submission through the USPTO Patent Trial and Appeal Board P-TACTS System
2. Electronic mail

Document(s) served: **PATENT OWNER'S OBJECTIONS TO
PETITIONER'S EVIDENCE UNDER 37 C.F.R. §
42.64(b)(1)**

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