

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 MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. §§ 42.62 AND 42.64**

Under 37 C.F.R. §§ 42.62 and 42.64(c) and the Scheduling Order (Paper 9), Patent Owner moves to exclude Exhibits 1047 and 1048 filed by Petitioner with its Reply on October 28, 2024 (Paper 19). Admission of these untimely and unauthenticated exhibits violates the procedural safeguards intended to ensure a fair and efficient resolution.

I. PATENT OWNER’S OBJECTIONS ARE TIMELY

Objections to evidence must be made in writing and filed within five business days of service of the evidence. *See* 37 C.F.R. §§ 42.64(a), (b)(1). Exhibits 1047 and 1048 were first served with Petitioner’s Reply on October 28, 2024. *See* Paper 19 at 34. Patent Owner objected to Exhibits 1047 and 1048 in writing and within five business days. *See* Paper 20. In addition, Exhibit 1047 was first introduced during the October 15, 2024, deposition of Patent Owner’s expert, Dr. Koo. EX1049, 118:10–122:23. During the deposition, Patent Owner’s counsel objected to Exhibit 1047. *Id.*

II. EXHIBIT 1047

Patent Owner respectfully requests that the Board exclude Petitioner’s Exhibit 1047 from the record in this IPR. Exhibit 1047 is inadmissible because it was not timely submitted and has not been properly authenticated. As detailed below, the

untimely and unauthenticated nature of Exhibit 1047 warrants its exclusion to ensure procedural fairness.

A. Exhibit 1047 Was Not Timely Submitted

Under 37 C.F.R. § 42.23(b), a petitioner's reply is limited to responding to arguments raised in the patent owner's response or the Board's decision on institution. But Exhibit 1047 introduces new evidence that could and should have been presented with the Petition. The issues purportedly addressed by Exhibit 1047 were clearly raised earlier in the proceeding, including whether the prior art discloses using pulse width ("PW") in base modification detection. Paper 19 at 15. Exhibit 1047 is a document originating from Petitioner, and as such should have and could have been submitted with the Petition. Petitioner's strategic delay in serving Exhibit 1047 is unjustified and undermines the procedural fairness of this proceeding. By submitting Exhibit 1047 at this late stage, Petitioner effectively deprives Patent Owner of a full and fair opportunity to address the evidence with expert testimony or other evidence, prejudicing Patent Owner's ability to respond. For these reasons, the Board should exclude Exhibit 1047 as untimely.

B. Exhibit 1047 is Inadmissible Under F.R.E. 901

To authenticate Exhibit 1047 Petitioner must "produce evidence sufficient to support a finding that the item is what [Petitioner] claims it is." F.R.E. 901(a).

Petitioner has failed to provide any testimony, declaration, or other supporting evidence to establish the authenticity of Exhibit 1047. Furthermore, the document does not qualify as self-authenticating under F.R.E. 902, as it does not fall within any of the enumerated categories that allow for admission without extrinsic evidence of authenticity.

Without proper authentication, the reliability of Exhibit 1047 is speculative at best. This failure not only renders the document inadmissible but also prejudices the Patent Owner, who has been denied the opportunity to fully scrutinize and challenge the document's credibility during the proceeding. Authentication is a fundamental evidentiary requirement designed to ensure the integrity of the record. Allowing Exhibit 1047's admission without proper authentication would compromise the evidentiary safeguards that these proceedings depend on to maintain fairness and accuracy. Given Petitioner's failure to meet the requirements of F.R.E. 901, Exhibit 1047 should be excluded in its entirety.

III. EXHIBIT 1048

Petitioner has offered no testimony, declaration, or other evidence to establish that Exhibit 1048 is authentic or to demonstrate that it is what Petitioner purports it to be as required by F.R.E. 901. Moreover, Exhibit 1048 is not self-authenticating

under F.R.E. 902, as it does not fall into any of the categories of evidence that are deemed authentic without extrinsic evidence.

Petitioner's failure to authenticate Exhibit 1048 undermines its credibility and calls into question its reliability. This lack of authentication further prejudices the Patent Owner, who has been deprived of the opportunity to challenge the document's credibility during the proceeding. The late introduction of unauthenticated evidence is fundamentally unfair and contravenes the evidentiary standards that ensure the integrity of these proceedings. Allowing its admission without proper authentication would compromise the fairness and procedural integrity of this IPR proceeding. Given Petitioner's failure to meet the requirements of F.R.E. 901, Exhibit 1048 should be excluded in its entirety.

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board exclude Exhibits 1047 and 1048 from the record in this IPR proceeding.

Respectfully submitted,

Date: January 2, 2025 By: / Joseph P. Hamilton /
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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: January 2, 2025

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 MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. §§ 42.62 AND 42.64**

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