

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 REPLY RE MOTION TO EXCLUDE (PAPER 25)

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CASES

Analog Devices, Inc. v. Xilinx, Inc.,
IPR2020-01596, Paper 52, 2022 WL 1157604 (P.T.A.B. Apr. 13,
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Parse Biosciences, Inc. v. 10x Genomics, Inc.,
IPR2023-00876, Paper 47, 2024 WL 4218540 (P.T.A.B. Sept. 17,
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OTHER AUTHORITIES

37 C.F.R. §42.64(a).....1

37 C.F.R. §42.64(b)(2).....1

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I. EX1047

There is no evidence that EX1047 is the document referenced in EX1016, footnote 9, which Petitioner claims “provides a hyperlink where the document was obtainable.” Paper 26 at 5. Petitioner does not dispute that the hyperlink does not link to any document, let alone EX1047. *See also* EX2058; Candeloro Decl., ¶ 4.

Petitioner’s attempt to authenticate EX1047 in response to Patent Owner’s Motion to Exclude comes too late. For deposition evidence, “[e]vidence to cure the objection must be provided during the deposition” and for other evidence one must serve “supplemental evidence within ten business days of service of the objection.” 37 C.F.R. §§42.64(a) and (b)(2). Petitioner first presented EX1047 during the October 15, 2024, deposition of Dr. Koo and Patent Owner objected. EX1049 at 120:23–121:3. Petitioner provided no evidence to authenticate the document in response. *Id.* at 121:7–128:15. And contrary to Petitioner’s assertion, Dr. Koo did not authenticate EX1047, instead testifying that “[i]t’s not clear whether this was taken from this GitHub link or whether it was created somewhere else. I -- I don't really know the -- I -- I wouldn't be able to tell you that this is that -- that reference.” EX1049 at 122:19–23. Petitioner then served EX1047 with Petitioner’s Reply. Paper 19 at 34. Patent owner objected again. Paper 20 at 1. Petitioner did not serve any evidence or respond in any way.

Petitioner's belated and unauthenticated screenshots and arguments here should not be accorded any weight. *See Parse Biosciences, Inc. v. 10x Genomics, Inc.*, IPR2023-00876, Paper 47, 16–17, 2024 WL 4218540 at *7–8 (P.T.A.B. Sept. 17, 2024) (granting motion to exclude where “Petitioner clearly missed the deadline” to serve supplemental evidence). *See also TRW Auto. U.S. LLC v. Magna Elecs. Inc.*, IPR2014-01348, Paper 25, 7, n.9, 2016 WL 212791 at * n.9 (P.T.A.B. Jan. 15, 2016) (declining to consider late supplemental evidence and granting motion to exclude).

Regardless, Petitioner's attorney argument and unauthenticated web screenshots do not demonstrate that EX1047 is authentic. Petitioner asserts that its screenshots confirm that EX1047 was available in 2017. Paper 26 at 6. But, Petitioner presents no evidence regarding whether EX1047 existed prior to 2017, let alone that EX1047 is the document referenced by EX1016 in 2012.

Moreover, Petitioner provides no declaration directed to EX1047. EX1039 and EX1040 relate to other exhibits. They do not address or refer Exhibit 1047 and cannot authenticate EX1047. *See Analog Devices, Inc. v. Xilinx, Inc.*, IPR2020-01596, Paper 52, 22–23, 2022 WL 1157604, at *9 (P.T.A.B. Apr. 13, 2022).

Next, Petitioner has failed to present authenticated versions of anything to show how the structure, format, and appearance of EX1047 is consistent with the structure, format, or appearance of an authenticated document. *Id.* In fact, while

EX1016 and EX1047 are both Petitioner's purported publications from the same time period, they are not similar in structure, format, or appearance.

In addition, EX1047 does not include any reference to the purported URL where it can be found. *See TRW Automotive U.S. LLC v. Magna Electronics Inc.*, Paper 25, 9–12, 2016 WL 212791 at *2–5 (P.T.A.B. Jan. 15, 2016) (excluding an exhibit that “does not bear any statement of publication, let alone an identification of the medium in which it allegedly was published.”).

Also, a copyright notice does not demonstrate that EX1047 is authentic. *See id.* at *4 (“the copyright notice is probative that IEEE owns a copyright to the article, it is not probative that the article was ever published by IEEE or anyone else.”).

Finally, Petitioner did not confront or impeach Dr. Koo with EX1047 and instead Petitioner's cross consisted of reading portions of the exhibit and asking Dr. Koo if those words and phrases appear in the document. *See* EX1049 119:24-128:15. Regardless, any arguments regarding impeachment or relevance of EX1047 should have been in the Petition or the Reply. But, neither the Petition nor Petitioner's expert cite EX1047. Instead, Petitioner's single citation to EX1047 comes in Reply with conclusory attorney argument. Paper 19 at 15. Petitioner could have but did not provide any expert testimony or evidence regarding how any portion of EX1047 is understood by a POSA. Petitioner's belated, unsupported and conclusory attorney

arguments here are entitled to no weight and are not relevant to Petitioner's failure to authenticate Exhibit 1047.

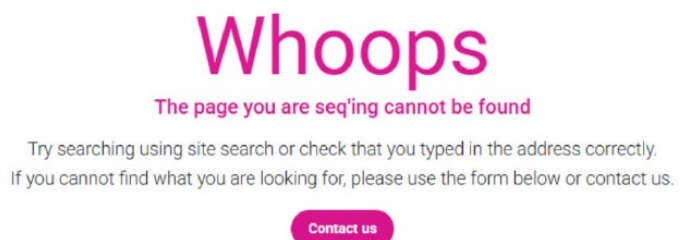
EX1047 is purportedly Petitioner's own document. Petitioner's failure to authenticate EX1047 is inexcusable. Petitioner's complaint that Patent Owner's expert did not review EX1047 in preparing his declarations in this matter defies logic, particularly where EX1047 was provided by Petitioner for the first time months after Dr. Koo's declarations were filed and served. The Petition and Petitioner's own expert do not cite EX1047 for any reason, the hyperlink in Petitioner's own EX1016 does not link to EX1047, and Petitioner itself can't demonstrate the authenticity of its own document. Accordingly, Patent Owner requests that EX1047 be excluded under FRE 901.

II. EX1048

Petitioner claims that EX1048 is authentic because petitioner's attorney purportedly retrieved EX1048 from PacBio's website as follows: "EX1048 was retrieved from the URL https://www.pacb.com/press_releases/pacific-biosciences-launches-new-sequel-ii-system-featuring-8-times-the-dna-sequencing-data-output/."

Paper 26 at 9. But, contrary to
Petitioner's unsupported
assertion, that web address does

not link to EX1048. *See* EX2059 (portion above); Candeloro Decl., ¶ 5.



Moreover, EX1048 provides reason to doubt its authenticity. Petitioner asks the Board to compare EX1048 with EX2018. *See* Paper 26 at 9. But, a comparison of the two casts doubt on authenticity. Specifically, EX2018 is a press release from 2022 and shows a copyright date of 2022 on the final page. In comparison, EX1048, which is purportedly a press release from 2019, shows a copyright date of 2024. EX1048 at 8. EX2018 and EX1048 are further not similar in structure, format, or appearance sufficient to conclude that EX1048 is authentic.

Like EX1047, EX1048 is purportedly Petitioner's own document. Petitioner's failure to authenticate the document is inexcusable. Accordingly, Patent Owner requests that EX1048 be excluded.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board exclude EX1047 and EX1048 for lack of authentication.

Respectfully submitted,

Date: January 16, 2025	By: <u>/ Joseph P. Hamilton /</u>
	Joseph P. Hamilton, Reg. No. 51,440
	Perkins Coie LLP
	1888 Century Park East, Suite 1700
	Los Angeles, CA 90067
	Phone: 310-788-3271
	Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that service on Petitioner was made as follows, in accordance with 37 C.F.R. § 42.6(e):

Date of service: January 16, 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 REPLY RE MOTION TO EXCLUDE (PAPER 25)**

Persons served: Michael T. Rosato (Reg. No. 52,182)
mrosato@wsgr.com

Sonja R. Gerrard (Reg. No. 72,802)
sgerrard@wsgr.com

Patrick M. Medley (Reg. No. 74,735)
pmedley@wsgr.com

/ Amy Candeloro /

Paralegal
Perkins Coie LLP