

Paper No. _____
Filed: January 16, 2025

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 No. IPR2024-00028
Patent No. 11,091,794

**PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE
37 C.F.R. §42.64(c)**

Patent Owner's (PO's) Opposition fails to justify the admissibility of the evidence identified in Petitioner's (PacBio) Motion to Exclude.

The Opposition leaves many of the defects discussed in the Motion to Exclude (MTE) unaddressed entirely. For the content that is addressed, the Opposition is either nonresponsive to the issues raised, inconsistent with the record evidence, or both. PO's failure to cite EX2002 in post-institution briefing (lack of relevance) is unaddressed entirely. Exhibits 2041 and 2002 should be excluded.

I. THE INCURABLE DEFECTS OF THE KOO DECLARATIONS WERE TIMELY AND REPEATEDLY IDENTIFIED

Seeking to save Dr. Koo's unreliable testimony on a manufactured "gotcha," the Opposition (2-4) cites *Hunter's Mfg. Co.* and *Abbott Diabetes Care, Inc.* in arguing the defects in Dr. Koo's testimony were not sufficiently communicated to allow cure. This argument is without merit. Objections were not only timely served, but the defects in Dr. Koo's testimony were specifically raised and acutely realized during cross-examination. Petitioner's Reply also addressed the argument as not commensurate with the challenged claims, lacking critical review of references, lacking nexus, and ignoring evidence. *See, e.g.*, Reply 4-5, 9, 11, 15, 16-19, 23, 25, 27. PO can claim no surprise as it afforded opportunity to address these defects, e.g., in cross, redirect, and sur-reply briefing. The present case is unlike those cited where the subject party sought clarification but there was no

response to “elicit further clarity.” *Hunter’s Mfg. Co.*, IPR2023-00407, Paper 53 at 41 (P.T.A.B. Jul. 9, 2024). The defects in Dr. Koo’s testimony were timely and sufficiently communicated; accordingly, the cited cases are inapposite.

II. PO’S ARGUMENT FOR IGNORING HALF THE RECORD EVIDENCE IS UNAVAILABLE

The Opposition (6) argues a distinction of no significance in stating that the 25 exhibits ignored by Dr. Koo were not “withheld” from him, they simply were not “focused on.” Dr. Koo clearly stated he did not recall considering (1) any reference not listed in EX2031 or EX2055; or (2) Tahir (EX1035), Wenger (EX1032), PacBio Template Guide (EX1019), Tsai (EX1020), Davis (1013) or Clement (EX1018) specifically. MTE 7. PO also provides no excuse, because there is none, for Dr. Koo’s uncritical review of cited prior art like PacBio’s White Paper or his admitted disregard of EX1047. MTE 12-13. PO’s terminology nuance (“withheld” versus not “focused on”) does not save the day for Dr. Koo’s incomplete analysis. *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013) (rejecting an obviousness argument as legally flawed where it “narrowly focus[ed] on the four prior-art references...and ignore[ed] the additional record evidence”).

The Opposition (6) falsely states that for 18 of the 25 ignored exhibits there is “no reason why those exhibits are relevant.” There is no dispute the exhibits were discussed by Petitioner and Dr. Dessimoz in the petition materials, with

exemplary citations provided. MTE 5-6. As explained, the prior art in the petition is relevant to the POSA perspective and any critical assessment the petition case. Dr. Koo offers neither, which PO does not rebut.

Much of the Opposition turns the analysis on its head, illogically blaming Petitioner for Dr. Koo's incomplete analysis. But PO does not dispute, as it cannot, the content of those prior art references, their discussion in the petition materials, or the fact they contradict various aspects of Dr. Koo's testimony. For example, the Opposition (9-10) criticizes Tahir (EX1035) as not a "ground" reference but identifies 10 different citations to Tahir in the petition materials and even more in the Reply brief. Tahir was also addressed during cross-examination, where Dr. Koo confirmed he selectively ignored Tahir and its contents contradicting his testimony. MTE 8; EX1049, 133:9-134:23 (nucleotide identity as input to a CNN was "traditional" and "widespread"). PO offers no rebuttal.

Similarly, the Opposition (7) concedes that Exhibits 1018, 1019, 1020 and 1024 are cited for grounds of challenge (Grounds 2-4) and argues Dr. Koo offered only blinkered commentary on Ground 1. This only confirms the MTE issues raised. PO does not dispute those references inform the POSA perspective and include content (as argued in the petition) that contradicts Dr. Koo's testimony. *See* MTE 9-10. Regarding Exhibits 1032 (Wenger) and 1036 (DeepVariant), the Opposition (9) quibbles over the volume of citations in the petition. PO does not

dispute, however, Dr. Koo's lack of consideration of these references, their content, or the fact they refute PO argument about a BAM file as an input data file for a model. MTE 10.

Regarding Flusberg-666 (EX1045), PO misappropriates its Opposition (7-9) to relitigating its 325(d) argument that is now moot post-institution and which the Board already rejected. The petition (28) cited to EX1037, allowing claims and the Board authorized submission of the patent (EX1045) that issued as a result. The Institution Decision also detailed reasons rejecting PO's 325(d) argument. As such, if the Board is now to defer to prior action by the Office, the preponderance of those actions corroborate reason to reject PO's arguments in support of its claims.

The Opposition inconsistently complains of too little discussion of materiality for some references (Opp. 6) but falsely criticizes discussion of materiality elsewhere as "transparent merits arguments" (Opp. 10). PO then mischaracterizes the record in attempt to resuscitate its missing nexus case. Dr. Koo confirmed lack of nexus during cross-examination. MTE 14; *see also, e.g.*, EX1049, 25:12-18; 29:3-31:8; 64:10-21 (claims not limited to 5-MeC modification); 31:16-24; 68:14-69:8 (not limited to SMRT sequencing); 70:5-18; 72:14-73:7 (not limited to window size); 84:9-12 (bisulfite sequencing not excluded); 40:3-42:11; 78:9-12 (not limited to any particular model or sub-models); 60:12-14 (Tse, at best, an embodiment). The Opposition (10-11)

curiously claims an “unrebutted evaluation” when there was no evaluation by Dr. Koo and nexus has been thoroughly rebutted.

There is no credibility to the Opposition’s (11) denial of what Dr. Koo plainly stated (falsely) regarding experimental data of Figs. 11 and 14. EX1049, 97:18-99:11 (“it doesn’t represent real data,” “not experimental data,” “no real data”). The Opposition then admits Flusberg-338’s disclosure of a data structure including nucleotide identity, rebutting its own nonsensical argument it is somehow avoided. 11 (“Figures 11 and 14 confirm that the Flusberg publications had the same data as the PacBio-Bam”). PO (Opp. 12) mischaracterizes (objectional) questioning of Dr. Dessimoz as somehow supporting PO’s argument, where he explicitly rejected it. EX2037, 193:20-194:8 (rejecting PO’s false “dichotomy of ‘fixed’ versus ‘variable’”). Finally, the Opposition (12-13) cites to SAS, but Dr. Koo provided no “experiential conclusions.” His testimony and conclusions are based on an artificial and carefully curated false caricature, not the state of the art at the time.

Accordingly, the identified exhibits should be excluded.

Respectfully submitted,

Dated: January 16, 2025

/ Michael T. Rosato /
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Petitioner's Reply in Support of its Motion to Exclude was served on January 16, 2025, at the following electronic service addresses:

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