

Filed: January 21, 2024

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 OBJECTIONS TO EVIDENCE FILED WITH REPLY TO
MOTION TO EXCLUDE**

I. INTRODUCTION

Pursuant to 37 C.F.R. §42.64(b)(1), Pacific Biosciences of California, Inc. (“Petitioner”) submits the following objections to the Chinese University of Hong Kong’s (“Patent Owner”) Exhibits 2058-2060.

Petitioner’s objections are made pursuant to the Code of Federal Regulations (“C.F.R.”) governing this proceeding, including without limitation 37 C.F.R. §§42.61-42.65 and §42.6(a)(3). As required by 37 C.F.R. §42.62, Petitioner’s objections below apply the Federal Rules of Evidence (“F.R.E.”).

II. OBJECTIONS

1. Exhibits 2058-2060

Grounds for Objection: F.R.E. 401 (Test for Relevant Evidence); F.R.E. 402 (General Admissibility of Relevant Evidence); F.R.E. 403 (Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons).

Each of Exhibits 2058, 2059, and 2060 was filed with Patent Owner’s reply in support of its motion to exclude evidence on January 16, 2024, without authorization from the Board and identifying no rule allowing their submission. Exhibits 2058 and 2059 appear to be copies of error messages received when counsel’s paralegal accessed certain web addresses. Exhibit 2060 is a declaration from counsel’s paralegal, Amy Candeloro, regarding these web exhibits (EXS2058, 2059). These three new exhibits are untimely, and their filing at this

late stage precludes response to the evidence, undermines opportunity for cross-examination, and the evidence is both irrelevant and unduly prejudicial.

Regarding EX2059, the Candeloro declaration (EX2060) indicates it reflects a message returned when she introduced a typographical error in the web address compared to the correct web address identified in Petitioner's Exhibit List (changing the word "output" to "ouput"). The Candeloro declaration does *not* appropriately address the webpage from the website identified in Petitioner's Exhibit List (*see* Paper 19, 32-33, listing EX1048 as corresponding to web address https://www.pacb.com/press_releases/pacific-biosciences-launches-new-sequel-ii-system-featuring-8-times-the-dna-sequencing-data-output/). EX2059 and Ms. Candeloro's testimony regarding it are thus irrelevant, unduly prejudicial, are likely to cause confusion, and substantially outweighing any probative value.

Regarding EX2058, the Candeloro declaration (EX2060) indicates that it was a web page returned on January 15, 2025, from <https://github.com/PacificBiosciences/R-kinetics>, when she visited the page years after the relevant critical date. The Candeloro declaration, however, does not discuss webpage accessibility to members of the public *prior* to the critical date. The Candeloro declaration does not dispute that the webpage as indicated in Petitioner's Opposition was available to access and archived by the Internet Archive's Wayback Machine prior to the '794 patent's effective filing date, or that

both that archived page and EX1047 remain available for download from the Internet Archive at the URLs supplied in Petitioner's Opposition and Reply. Accordingly, EX2058 and Ms. Candeloro's testimony regarding it are irrelevant, unduly prejudicial, and likely to cause confusion, substantially outweighing any probative value.

Ms. Candeloro's declaration (EX2060) addresses only the above-discussed exhibits. As those exhibits are themselves inadmissible and untimely, EX2060 has no relevance. Moreover, the timing of the filing of EX2060 frustrates any chance to cross-examine Ms. Candeloro regarding her testimony. To the extent any of EX2060 is deemed relevant, it is unduly prejudicial, misleading, and a waste of time, substantially outweighing any probative value.

Furthermore, Patent Owner first submitted Exhibits 2058, 2059, and 2060 upon the close of briefing and less than one week prior to Oral Hearing. Shortly after filing these exhibits, Petitioner alerted Patent Owner as to their impropriety. The parties met and conferred through email communication, but Patent Owner's counsel declined to withdraw the exhibits as requested. Given the irrelevance of the newly cited exhibits, their prejudicial nature, and their untimely submission, the Board should dismiss Patent Owner's motion to exclude as moot and notice the authenticity of Exhibits 1047 and 1048. Indeed, Patent Owner has identified no reason to doubt their authenticity. Petitioner reserves the right to move to strike

Exhibits 2058, 2059, and 2060 and Patent Owner's reply brief discussing those exhibits.

III. CONCLUSION

The aforementioned exhibits were submitted on January 16, 2025. These objections are made within 5 business days of submission pursuant to 37 C.F.R. §42.64.

Respectfully submitted,

Dated: January 21, 2025

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Petitioner's Objections to Evidence was served on January 16, 2025, at the following electronic service addresses:

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Respectfully submitted,

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