

Paper No. _____
Filed: March 18, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENE COMPANY PTY LTD,
Petitioner,

v.

THE TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK,
Patent Owner.

Case No. IPR2024-00313
Patent No. RE47,045

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

PO's Opposition (Opp., Paper 46) fails to justify the admissibility of exhibits identified in Petitioner's Motion to Exclude (MTE, Paper 44).

I. EXHIBITS NOT CITED POST-INSTITUTION (EXHIBITS 2001, 2002, 2004, 2005, 2007, 2010-2013, 2020, 2021, 2024, 2026, 2036, AND 2037)

PO does not dispute that the majority of the exhibits identified in the MTE were not relied on after institution. In particular, PO's opposition does not dispute that none of exhibits 2001, 2002, 2010, 2011, 2012, 2013, 2020, 2021, 2024, 2026, 2033, and 2037 was relied on in any way during trial. See Opp., 1-2. Regarding these exhibits, PO does not even attempt to show admissibility, asserting instead that this inadmissible evidence (indeed, all exhibits) should be admitted "to preserve the record." *Id.* at 2. However, excluding exhibits does not eliminate them from the record; it only precludes improper reliance on them.

Belying PO's assertion that these exhibits should be admitted merely to "preserve the record," PO in the next paragraph invites the Board to "rely on these exhibits in its Final Written Decision," despite them not being relied on in any argument advanced at trial. *Id.* This invites the Board to play "archaeologist with the record," contrary to both its rules and Federal Circuit precedent. *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023) (quoting *DeSilva v. DiLeonardi*, 181 F. 3d 865, 866-67 (7th Cir. 1999)). The Board "must base its decision on arguments that were advanced by a party, and to which the

opposing party was given a chance to respond.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016).

Seeking to avoid these rules, PO attempts to distinguish *Nike, Inc. v. Adidas AG*, 955 F.3d 45, 50 (Fed. Cir. 2020), on the basis that it involved amended claims. Opp., 2. However, this is immaterial: in *Nike* the Federal Circuit described generally applicable law for IPR proceedings, merely confirming that motions to amend were held to the same standard. *See* 955 F.3d at 52-53 (citing, *inter alia*, *Magnum Oil*, 829 F.3d 1364) (confirming general rule that Board may not rely on arguments not advanced by a party). PO’s argument should be rejected.

Regarding the remaining exhibits, PO argues that exhibits 2004, 2005, 2007, and 2036 were cited in the institution decision. However, exhibit 2036, the declaration of Dr. Sessler, was *withdrawn* by PO without opportunity for cross-examination. The Opposition confirms this, disclaiming any reliance on Dr. Sessler’s testimony. Opp., 1 n.1. The citation in the institution decision to Dr. Sessler’s declaration does not rescue it from PO’s voluntary withdrawal of that testimony. The same goes for exhibits 2004, 2005, and 2007, which the institution decision cited to describe PO’s abandoned arguments and the prosecution history, neither of which were argued at trial. *See* ID, 11, 38. PO cannot make evidence relevant based on withdrawn testimony, and PO has not identified any arguments advanced at trial to which these exhibits are relevant. While PO correctly notes that

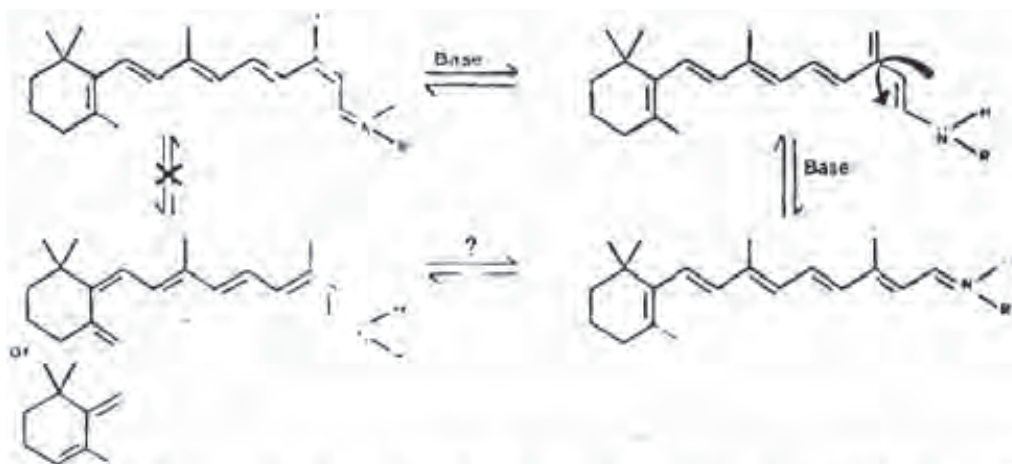
exhibits 2018, 2025, and 2033 were mistakenly included in the MTE, PO has not justified admissibility of any of the remaining exhibits, each of which should be excluded under FRE 401-403.

II. HUSSEIN (EX2015)

As argued in the MTE, PO has not established the authenticity of EX2015. In particular, the MTE pointed out that PO “claims that EX2015 is a paper published in 2018,” yet “no witness testimony has been provided to establish this proposition.” MTE, 3-4. PO asserts that exhibits 2048-2050 establish EX2015’s authenticity. Yet the Wiest declaration (EX2050) merely indicates that EX2049 (matching EX2015) was downloaded in 2024 from a website (shown in EX2048). This does not establish that EX2015 is the paper actually published in 2018. Indeed, as pointed out in the MTE (p. 3), the exhibit itself indicates that it is a different document, stating that it is an “author’s manuscript” rather than the “article published in final edited form” elsewhere. EX2015, 1; see EX2049, 1 (same). The 2024 website identified by PO does nothing to establish the content of the article published in 2018 in final edited form. Nor does the 2024 website provide any authentication that the information in EX2015 was publicly available before the critical date in 2007, the proposition for which EX2015 was relied upon in the POR (p. 5). PO’s opposition thus provides no basis for admissibility.

III. MOWERY (EX2077)

The MTE pointed out that EX2077 was an illegible copy of an original document. PO's supplemental evidence, EX2203, does not cure this illegibility, as its Fig. 5 is also illegible, as seen in EX2203, Fig. 5, reproduced below.



Pivoting from the illegible figure, PO now argues for the first time that the description in EX2077 identifies the structures in Fig. 5. Opp., 5-6. However, this attorney argument is short of testimonial support—PO's expert did not testify that the purported structures in his redrawn figure were deduced from the text quoted in the Opposition. See EX2052, Fig. 13 (asserting that it is a “redrawn” version of Fig. 5, but providing no explanation of how the illegible parts were filled in). Even if PO were permitted to fill in testimonial gaps with attorney argument, that does not resolve the issue of Fig. 5's illegibility; at minimum, reliance on the figure itself should be excluded under FRE 105.

IV. DEL PRIORE DECLARATION (EX2192)

PO concedes that Dr. Del Priore offered “opinions on ‘enzyme kinetics.’” Opp., 11. Dr. Del Priore admits he is not an expert on this subject (EX1069, 22:16-

19), yet PO asserts he is “qualified to opine on visual cycle enzyme kinetics.” Opp. 10. PO’s attempt to cast Dr. Del Priore’s testimony as not opining on the “broad category of enzyme kinetics” (*id.*) contradicts his own statements, which purported to describe “basic principles of enzyme reaction kinetics” and how “enzymatic reactions[] generally” proceed, subjects in which he lacks expertise. EX2192, ¶62.

PO attempts to deflect from this issue by arguing Dr. Del Priore’s qualifications to opine as a POSA or to opine on topics it says are not in dispute. Opp., 7-10. These arguments do not address Dr. Del Priore’s lack of requisite expertise to advance the opinions subject to the present motion. PO’s dispute regarding paragraphs 109, 175, 179, 210-11, 216, and 221 (Opp. 7 n.2) asserts that citations to the section containing paragraph 62 may find support from elsewhere, but PO does not explain how such support is found without paragraph 62.

PO’s complaint regarding particularity of objections is likewise unfounded. Petitioner timely objected to testimony outside of Dr. Del Priore’s expertise. Paper 25, 8-9. Subsequently, Dr. Del Priore conceded his lack of expertise on cross-examination. EX1069, 22:16-19. PO had an opportunity to address this deficiency on redirect, but it elected not to do so.

V. CONCLUSION

Accordingly, the identified exhibits should be excluded or limited to their proper scope.

Respectfully submitted,

Dated: March 18, 2025

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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 March 18, 2025, at the following electronic service addresses:

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