

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIO-RAD LABORATORIES, INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner

Case No. IPR2024-01451

U.S. Patent No. 11,827,921 B2

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(b)(1)**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.64(b)(1) and the Federal Rules of Evidence, Patent Owner California Institute of Technology (“PO”) submits the following objections to evidence filed by Petitioner with its Petition for *Inter Partes* Review. These objections are timely filed pursuant to 37 C.F.R. § 42.64(b)(1) within 10 business days of the institution of the trial. The Federal Rules of Evidence apply to these proceedings according to 37 C.F.R. § 42.62(a), and these rules form the basis of the objections contained herein.

Exhibit Number	Objections
EX1004	PO objects to EX1004 because, as set forth in detail in the Patent Owner Preliminary Response (Paper 8) and Preliminary Sur-Reply (Paper 10) and in the Board’s Institution Decision (Paper 11), EX1004 is not prior art under 35 U.S.C. § 102 and 35 U.S.C. § 311(b). Namely, the subject matter from EX1004 that Petitioner relies on was not carried forward from EX1004’s provisional application. Therefore, EX1004 is not relevant under Fed R. Evid. 401 and is inadmissible under Fed. R. Evid. 402.
EX1013	PO objects to EX1013 on the ground that it is not properly authenticated under Fed. R. Evid. 901, nor is it self-authenticating under Fed. R. Evid. 902. Petitioner provides no authenticating declaration whatsoever explaining what EX1013 is, how it was acquired, and how it was made. PO objects to EX1013 as inadmissible hearsay under Fed. R. Evid. 801–807. Petitioner relies on EX1013 to assert that “[d]uring the extension step of PCR, the exonuclease activity of the polymerase enzyme separates the fluorophore and quencher of bound probes are separated by cleaving the probe[.]...” Petition at 3–4. Because Petitioner is relying on EX1013 for the truth of the matter asserted, the exhibit is hearsay under Fed. R. Evid. 801. EX1013 does not fall into an exception to the rule against

Exhibit Number	Objections
	hearsay. Moreover, the apparent date on the document is used for the truth of the matter asserted. PO objects to EX1013 because it is not prior art under 35 U.S.C. § 102 and 35 U.S.C. § 311(b). For example, Petitioner has not demonstrated EX1013 qualified as a printed publication as of any particular date. Therefore, EX1013 is not relevant under Fed R. Evid. 401 and is inadmissible under Fed. R. Evid. 402.
EX1014	PO objects to EX1014 on the ground that it is not properly authenticated under Fed. R. Evid. 901, nor is it self-authenticating under Fed. R. Evid. 902. PO objects to EX1014 as inadmissible hearsay under Fed. R. Evid. 801–807. Petitioner relies on EX1013 to assert that “[d]uring the extension step of PCR, the exonuclease activity of the polymerase enzyme separates the fluorophore and quencher of bound probes are separated by cleaving the probe[.]...” Petition at 3–4. Because Petitioner is relying on EX1014 for the truth of the matter asserted, the exhibit is hearsay under Fed. R. Evid. 801. EX1014 does not fall into an exception to the rule against hearsay. Moreover, the apparent dates on the document are used for the truth of the matter asserted. PO objects to EX1014 because it is not prior art under 35 U.S.C. § 102 and 35 U.S.C. § 311(b). For example, Petitioner has not demonstrated EX1014 qualified as a printed publication as of any particular date. Therefore, EX1014 is not relevant under Fed R. Evid. 401 and is inadmissible under Fed. R. Evid. 402.
EX1036	PO objects to EX1036 on the ground that it is not properly authenticated under Fed. R. Evid. 901, nor is it self-authenticating under Fed. R. Evid. 902. Petitioner provides no authenticating declaration whatsoever explaining what EX1036 is, how it was acquired, and how it was made. PO objects to EX1036 as inadmissible hearsay under Fed. R. Evid. 801–807. Petitioner relies on EX1036 to assert that “two

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	strands with complementary sequences can be base-paired to form a double-stranded polynucleotide[.]..." EX1002, ¶32. Because Petitioner is relying on EX1036 for the truth of the matter asserted, the exhibit is hearsay under Fed. R. Evid. 801. EX1036 does not fall into an exception to the rule against hearsay. Moreover, the apparent dates on the document are used for the truth of the matter asserted. PO objects to EX1036 because it is not prior art under 35 U.S.C. § 102 and 35 U.S.C. § 311(b). For example, Petitioner has not demonstrated EX1036 qualified as a printed publication as of any particular date. Therefore, EX1036 is not relevant under Fed R. Evid. 401 and is inadmissible under Fed. R. Evid. 402.
EX1037	PO objects to EX1037 on the ground that it is not properly authenticated under Fed. R. Evid. 901, nor is it self-authenticating under Fed. R. Evid. 902. Petitioner provides no authenticating declaration whatsoever explaining what EX1037 is, how it was acquired, and how it was made. PO objects to EX1037 as inadmissible hearsay under Fed. R. Evid. 801–807. Petitioner relies on EX1037 when discussing "[t]wo common approaches...used in conjunction with probes having both a fluorophore and a quencher," and in particular the "molecular beacon" approach. EX1002, ¶41. Because Petitioner is relying on EX1037 for the truth of the matter asserted, the exhibit is hearsay under Fed. R. Evid. 801. EX1037 does not fall into an exception to the rule against hearsay. PO objects to EX1037 because it is not prior art under 35 U.S.C. § 102 and 35 U.S.C. § 311(b). For example, Petitioner has not demonstrated EX1037 qualified as a printed publication as of any particular date. Therefore, EX1037 is not relevant under Fed R. Evid. 401 and is inadmissible under Fed. R. Evid. 402.

Exhibit Number	Objections
EX1038	PO objects to EX1038 on the ground that it is not properly authenticated under Fed. R. Evid. 901, nor is it self-authenticating under Fed. R. Evid. 902. PO objects to EX1038 as inadmissible hearsay under Fed. R. Evid. 801–807. Petitioner relies on EX1038 when discussing “the workflow for performing dPCR using Petitioner’s droplet-based products.” Petition at 5–6. Because Petitioner is relying on EX1038 for the truth of the matter asserted, the exhibit is hearsay under Fed. R. Evid. 801. EX1038 does not fall into an exception to the rule against hearsay. Moreover, the apparent dates on the document are used for the truth of the matter asserted. PO objects to EX1038 because it is not prior art under 35 U.S.C. § 102 and 35 U.S.C. § 311(b). For example, Petitioner has not demonstrated EX1038 qualified as a printed publication as of any particular date. Therefore, EX1038 is not relevant under Fed R. Evid. 401 and is inadmissible under Fed. R. Evid. 402.
EX1002	PO objects to EX1002 and any testimony of Petitioner’s expert(s) under Fed. R. Evid. 701 and 702 to the extent EX1002 and such testimony relate to or rely on the above objected-to exhibits.

Date: April 10, 2025

Respectfully submitted,

SHEPPARD, MULLIN,
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on April 10, 2025, a copy of the foregoing PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE was filed through the Patent Trial and Appeal Case Tracking System (P-TACTS) and was served via E-Mail on the Petitioner at the following correspondence address provided by counsel of record for the Petitioner pursuant to 37 C.F.R. § 42.8(b)(4):

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