UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENOME & COMPANY,
Petitioner,

v.

THE UNIVERSITY OF CHICAGO,
Patent Owner.

PGR2019-00002
Patent 9,855,302 B2

PATENT OWNER'S OBJECTIONS TO REPLY EVIDENCE UNDER 37 C.F.R. § 42.64(b)(1)

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Pursuant to 37 C.F.R. § 42.64(b)(1) and the Federal Rules of Evidence ("FRE"), as applied by the Patent Trial and Appeal Board pursuant to 37 C.F.R. § 42.62, Patent Owner submits the following objections to evidence filed by Petitioner with its Reply (Paper 23). These objections are timely filed within five (5) business days of the due date of the Reply (November 11, 2019).

Patent Owner reserves the right to present further objections to this or additional evidence submitted by Petitioner, as allowed by the applicable rules or other authority, including without limitation upon conclusion of cross-examination of Dr. Jonathan Braun.

Exhibit 1041 (Fares)

Exhibit 1041 is inadmissible under FRE 401 and 402 for lack of relevance. Exhibit 1041 recites "published at ascopubs.org on May 17, 2019" (Ex. 1041 at 1, left-hand margin) and includes the year "2019" in its footer. Thus, Exhibit 1041 indicates that it was not available until 2019, which is after the effective filing date in this case. Exhibit 1041 also lacks relevance because Petitioner does not cite this Exhibit in its Reply. Patent Owner objected to the introduction of this exhibit during Dr. Mani's deposition. Ex. 1042, 37:18–38:13.

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Exhibit 1043 (Reply Declaration of Dr. Braun)

Exhibit 1043 is inadmissible to the extent it is relied upon as evidence of the truth of the matters asserted therein, because it is hearsay under FRE 802 and does not meet the standard for an expert to rely on hearsay under FRE 702 and 703. For example, at least the following paragraphs of Exhibit 1043 mirror the Reply nearly verbatim:

Exhibit 1043	Duplicated from Reply pages
¶¶ 41, 43–44	10–11
¶¶ 57–63	12–13 (Section II.B.2)
¶¶ 64–66	13–15 (Section II.B.3)
¶¶ 72–77	15–17 (Section II.B.4)
¶¶ 78–83	18–19, 21 (Section III.A)
¶¶ 84–85, 87–89	21–24 (Section III.B)
¶¶ 90–92	24–25 (Section III.B.1)
¶¶ 93–98	25–27 (Section III.C)

Although an expert may rely on hearsay in certain circumstances, "[a]n expert who simply repeats the hearsay of the client who retained him, without any independent investigation or analysis, does not assist the trier of fact in understanding matters that require specialized knowledge"—in such circumstances, the expert's testimony does not qualify for an exception. *Arista Records LLC v. Usenet.com, Inc.,* 608 F. Supp. 2d 409, 424–29 (S.D.N.Y. 2009) (excluding portions of an expert's testimony under FRE 702 where the expert did not investigate facts himself and merely restated the views of the

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party hiring him). In other words, an expert relying on hearsay may not "simply transmit that hearsay" to the factfinder and instead "must form his own opinions by applying his extensive experience and reliable methodology to the inadmissible materials," as "simply repeating hearsay evidence without applying any expertise whatsoever . . . allows [a party] to circumvent the rules prohibiting hearsay." *United States v. Mejia,* 545 F.3d 179, 197–98 (2nd Cir. 2008) (internal quotation marks and citations omitted). Therefore, the statements of Dr. Braun's Reply Declaration (Exhibit 1043) that mirror the Reply should be excluded as inadmissible hearsay.

Exhibit 1043 is also inadmissible to the extent it is relied upon as expert witness testimony because it does not satisfy the requirements of FRE 702. For example, Dr. Braun's statements that are verbatim recitations of the Reply's arguments are attorney argument and do not provide "scientific, technical, or other specialized knowledge [that] will help the trier of fact to understand the evidence or to determine a fact in issue" as required by FRE 702(a), and they are not "the product of reliable principles and methods" as required by FRE 702(c). Thus, Dr. Braun's reply declaration testimony is inadmissible under FRE 702.

In addition, at least paragraphs 1–9, 14, 20–22, 57–58, 63–64, 72, 77–

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78, 81, 84, 87, 93–94, and 99 of Exhibit 1043 are inadmissible under FRE 401 and 402 because they lack relevance to this proceeding, as the Reply does not refer to or cite these paragraphs.

The following paragraphs of Exhibit 1043 are also inadmissible because, as cited in the Reply, they constitute an improper circumvention of the word count limit: paragraphs 23–30 (465 words), which are cited together in the Reply at 9, note 6; paragraphs 31–42 (750 words), which are cited together in the Reply at 10, note 7; paragraphs 45–51 (442 words), which are cited together in the Reply at 11; and paragraphs 67–71 (317 words), which are cited together in the Reply at 15. These paragraphs are cited with little or no explanation in the Reply and are therefore incorporations-by-reference in violation of 37 C.F.R. § 42.6(a)(3). *See Cisco Systems, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12, 7–10) (informative) ("we will not consider arguments that are not made in the Petition, but are instead incorporated by reference to the cited paragraphs [of the expert declaration]"). The passages thus incorporated total 1,974 words, which, when combined with the Reply certified word count of 5,457 (Reply 29) causes the Reply to exceed the word limit of 5,600 words (37 C.F.R. § 42.24(c)(1)) by 1,831 words, or 33% of the allowed limit.

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