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 MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64(c)

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I. INTRODUCTION

Patent Owner moves to exclude Petitioner's Exhibits 1002 (selected paragraphs), 1017, 1023, 1028, 1032, 1033, 1041, 1043 (selected paragraphs), 1044, 1057, and 1059. Patent Owner also moves to exclude Exhibit 2005 for the manner in which Petitioner relies on it in its Reply. The grounds for the motion were filed and served in Patent Owner's Objections to Evidence (Papers 10 and 25).

II. ARGUMENT

A. Exhibit 1002 (First Declaration of Dr. Braun): exclusion of paragraphs 41–89, 93–126, 129–136, and 138–206

Patent Owner moves to exclude selected paragraphs of Exhibit 1002 (Dr. Braun's first declaration) under FRE 802 as inadmissible hearsay and (ii) FRE 702 and 703 for not meeting the standard for an expert to rely on hearsay. Paper 10, 1–5 (stating objections). The following paragraphs of Exhibit 1002 mirror the Petition nearly verbatim at the pages indicated:

Exhibit 1002	Duplicated Petition pages
¶¶ 41–63[1]	6–12 (Sections V.A and B)

[1] Paragraphs 43, 46, 50, 51, 53, 54, 56, and 58 of Dr. Braun's Declaration include direct quotes to long passages of U.S. Patent No. 9,855,302 (Ex. 1001) that are not included in the Petition; otherwise, the Declaration paragraphs and the Petition pages are nearly verbatim.

Exhibit 1002	Duplicated Petition pages
¶¶ 64–89[2]	13–21 (Section V.C)
¶¶ 93–126	21–34 (Section VI)
¶¶ 129–136, 138–166[3]	36–48 (Section VII)
¶¶ 167–174	50–52 (Section VIII.A)
¶¶ 175–176	57–58 (Section VIII.B)
¶¶ 177–178	58–59 (Section VIII.C)
¶ 179 (at least with respect to claims 1, 10, 11, and 18 in the claim chart)	52–59 (claim chart for claims 1, 10, 11, and 18)
¶¶ 180–188	59–62 (Section VIII.D)
¶¶ 189–190	67 (Section VIII.E)
¶¶ 191–192	68 (Section VIII.F)
¶¶ 193–194	68–69 (Section VIII.G)
¶ 195 (at least with respect to claims 1, 5, and 6 in the claim chart)	63–68 (claim chart for claims 1, 5, and 6)
¶¶ 196–206	69–73 (Section VIII.H)
¶¶ 207–208	79 (Section VIII.I)
¶¶ 209–210	79–80 (Section VIII.J)
¶ 211 (at least with respect to claims 1, 2, 3, and 7 in the claim chart)	73–78 (claim chart for claims 1, 2, 3, and 7)

[2] The Petition does not contain the text of the Declaration's paragraphs 68, 72, 76, much of which is directly quoting long passages of the prosecution history.

[3] The only substantive difference between Exhibit 1002 and the Petition in these paragraphs is this single clause that appears in ¶ 155 of Exhibit 1002 but not in the Petition, in the paragraph spanning pages 44–45: "Because of the highly unpredictable nature of cancer treatment in general, combined with the highly unpredictable nature of immune checkpoint inhibitors and different species of *Bifidobacterium*, ..."

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 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).

Large tracts of Dr. Braun's declaration, as detailed in the table above, simply reproduce the Petition verbatim or near verbatim. This word-for-copying suggests that Dr. Braun's testimony was provided to him by Petitioner, a suggestion reinforced by Dr. Braun's admission on redirect

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