

Filed on behalf of Junior Party

Paper No. \_\_\_\_

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, UNIVERSITY  
OF VIENNA, AND EMMANUELLE CHARPENTIER**  
Junior Party

Applications 15/947,680; 15/947,700; 15/947,718; 15/981,807;  
15/981,808; 15/981,809; 16/136,159; 16/136,165; 16/136,168; 16/136,175;  
16/276,361; 16/276,365; 16/276,368; and 16/276,374,

v.

**TOOLGEN, INC.,**

Senior Party  
Application 14/685,510

Patent Interference No. 106,127 (DK)

**CVC MISCELLANEOUS MOTION 5  
(Motion to Exclude)**

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**TABLE OF AUTHORITIES**

**Cases**

*Horta v. Sullivan*,  
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**Other Authorities**

37 C.F.R. § 41.152 ..... 1

37 C.F.R. § 41.155(b)(1)..... 1

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Fed. R. Evid. 802 ..... 2

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1 **I. Statement of Precise Relief Requested**

2 CVC moves the PTAB to exclude evidence ToolGen cited to support its Motions and  
3 Oppositions to CVC’s Motions. Specifically, CVC moves to exclude Exhibit 1283 as lacking  
4 authentication and Exhibit 1593 as hearsay and double hearsay. The evidence and material facts  
5 supporting this motion are listed in Appendices A and B, respectively.

6 **II. Argument**

7 The Federal Rules of Evidence govern the admissibility of evidence in an interference. 37  
8 C.F.R. § 41.152. Additionally, the Standing Order (Paper 2) provides rules for the proffer and  
9 admission of exhibits. The evidence this Motion seeks to exclude violates the Federal Rules of  
10 Evidence and the Standing Order.

11 **A. Overview**

12 Listed below are the evidence (exhibits) that CVC moves to exclude, along with the bases  
13 for exclusion, and citations to where ToolGen relies on the evidence.

Ex. No.	Exhibit Description	Basis	Where Cited
1283	Dana Carroll, Issues in CRISPR-Cas Editing, YOUTUBE, 32:42–32:57 (Nov. 4, 2017), <a href="https://www.youtube.com/watch?v=5bHKz142FHs">https://www.youtube.com/watch?v=5bHKz142FHs</a> .	FRE 901: Lack of Authentication	ToolGen Opp. 3, pp. 9, 16, A2-7 and A2-9
1593	Jennifer Doudna Interview, “I have to be true to who I am as a scientist.” <i>The Guardian</i> , July 2, 2017	FRE 801, 802, 805: Hearsay; Double hearsay	ToolGen Opp. 1, pp. 21, A2-10; Doudna Dep. Tr. (Ex. 1520) at 198-199 and 210

14 The reasons for excluding Exhibits 1283 and 1593 are discussed in further detail below.

15 **B. Objections Preserved on the Record**

16 ToolGen served these exhibits on July 15, 2021. CVC timely objected on July 22, 2021,  
17 under 37 C.F.R. § 41.155(b)(1), on the bases now presented as reasons to exclude the evidence.  
18 MF 1. ToolGen did not offer any supplemental evidence to address CVC’s objections.

1           **C.     *Exhibit 1283 is a Purported YouTube Video that Lacks Authentication***

2           Exhibit 1283 is a video clip presumably extracted from YouTube. It purports to show, in  
3 one window, Dr. Dana Carroll giving a lecture on various CRISPR topics, juxtaposed with  
4 untitled graphics and drawings in a different window. MF 4. Under Rule 901(a), ToolGen, as the  
5 proponent of this video clip, “must produce evidence sufficient to support a finding that the item  
6 is what the proponent claims it is.” Fed. R. Evid. 901(a). But, ToolGen failed to authenticate this  
7 video. ToolGen has not provided substantiating testimony regarding the origin of this video  
8 through any witness. MF 4. For example, there is no evidence regarding who posted this video  
9 and when, whether it was edited, and whether it accurately portrays Dr. Carroll’s opinions or  
10 understandings, especially with respect to the purposes for which ToolGen cites it. MF 6.  
11 ToolGen gives no explanation as to who extracted the video from the internet and provides no  
12 metadata to establish its origins. MF 6. ToolGen did not ask Dr. Carroll to authenticate the video  
13 during his deposition. MF 5. The unauthenticated video lacks adequate context and foundation,  
14 and may not be relied upon for any purpose. Accordingly, the Board should exclude Exhibit  
15 1283.

16           **D.     *Exhibit 1593 is a Third-Party Interview that is Not Admissible Evidence for the***  
17           ***Truth of the Matters Asserted Therein***

18           Exhibit 1593 purports to be a published interview of Jennifer Doudna conducted by a  
19 third-party. MF 3. ToolGen cites this interview as purported evidence of the CVC inventors’  
20 timing, difficulty, challenges, and knowledge relating to their invention of CRISPR-Cas9 in  
21 eukaryotes. *See* Paper #718, ToolGen Opp. 1, 21, A2-10. The interview is double hearsay (a  
22 third-party’s out-of-court statement recounting a party’s out-of-court statement) and being used  
23 for an improper purpose (the truth of the matters asserted therein). *See* Fed. R. Evid. 801

1 (defining hearsay); 802 (prohibiting the admission of hearsay); 805 (defining and precluding  
2 double hearsay). No hearsay exception applies to this statement. It is inadmissible.

3         The cited publication is an edited excerpt of a longer interview, as evidenced by  
4 bracketed text within Dr. Doudna’s responses and other expository remarks. *See Ex. 1593*. The  
5 editing, as well as the original drafting of the questions, were formulated to “capture the interest”  
6 of the intended audience, rather than to present a historical account of facts for the purposes of  
7 resolving intellectual property rights. *See New England Mut. Life Ins. Co. v. Anderson*, 888 F.2d  
8 646, 650 (10th Cir. 1989). Dr. Doudna’s answers to the questions were simplified and intended  
9 for the layperson—not a fact-finder in a legal proceeding. They therefore lack the traditional  
10 indicia of reliability that form the basis for various hearsay exceptions. *See, e.g., Ohio v. Roberts*,  
11 448 U.S. 56, 65 (1980).

12         That ToolGen purports to rely on inventor statements given during the interview does not  
13 save it from being inadmissible hearsay. *See id.*, 650 (excluding newspaper account containing  
14 purported admissions by the defendant concerning her role in her husband’s death); *Horta v.*  
15 *Sullivan*, 4 F.3d 2, 8 (1st Cir. 1993) (excluding newspaper account that purported to quote a  
16 defendant police chief about events giving rise to a civil suit). Rather, these interviews were  
17 “intended, after all, to capture the interest of ... readers, who might otherwise have little interest”  
18 in the story of the development of CRISPR. *New England Mut. Life*, 888 F.2d at 650. There is no  
19 hearsay exception for a published interview, even one with a party to the proceeding.

20         Furthermore, even if Dr. Doudna’s statements were construed to fall within the  
21 statements against interest or admissions of a party exceptions to the prohibition on hearsay, they  
22 are nonetheless hearsay *within hearsay* that must be excluded. Fed. R. Evid. 805 (providing that  
23 “hearsay within hearsay” is admissible only “if each part of the combined statements conforms  
24 with an exception to the rule”). Out-of-court statements that have been curated by a third-party

1 for other purposes are not admissible to prove the sequences of events, the motivations,  
2 intentions, and expectations of the inventors. SO ¶ 152.2.1. That is especially true where, as here,  
3 the interviewee has testified under oath in this proceeding and been subject to ToolGen’s cross-  
4 examination. MF 2. Dr. Doudna’s sworn testimony in this proceeding is a far more reliable  
5 source of pertinent information than an interview intended to capture the interest of readers who  
6 might otherwise have little interest. There is therefore no prejudice to ToolGen in excluding this  
7 exhibit and no reason to consider this exhibit probative. As such, Exhibit 1593 should be  
8 excluded.

9 **III. Conclusion**

10 The PTAB should grant CVC’s Miscellaneous Motion, exclude the evidence listed in  
11 CVC’s chart presented in Section II.A. above.

12

13

Respectfully submitted,

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14

**APPENDIX A: EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
1283	Dana Carroll, Issues in CRISPR-Cas Editing, YOUTUBE, 32:42–32:57 (Nov. 4, 2017), <a href="https://www.youtube.com/watch?v=5bHKz142FHs">https://www.youtube.com/watch?v=5bHKz142FHs</a> .
1520	Deposition Transcript of Dana Carroll, Ph.D., The Regents of the University of California v. ToolGen, Inc., Interference No. 106,127, June 17, 2021
1570	Deposition Transcript of Jennifer Doudna, Ph.D., The Regents of the University of California v. ToolGen, Inc., Interference No. 106,127, July 8, 2021.
1593	Jennifer Doudna Interview, “I have to be true to who I am as a scientist.” The Guardian, July 2, 2017.
2023	Declaration of Jennifer Doudna, Ph.D.
2348	Declaration of Dana Carroll, Ph.D.
2540	Junior Party’s Objections to Evidence, Patent Interference No. 106,127 (July 22, 2021)



1                                   **APPENDIX B: STATEMENT OF MATERIAL FACTS**

2           1.       Exhibits 1283 and 1593, were first submitted with ToolGen’s July 15, 2021  
3   Oppositions. CVC timely objected July 22, 2021. Ex. 2540.

4           2.       Drs. Jennifer Doudna and Dana Carroll submitted sworn declarations in this  
5   proceeding, *see* Exs. 2023 and 2348, and were subject to ToolGen’s cross-examination, *see* Exs.  
6   1520 and 1570.

7           3.       Published excerpts from an interview with Dr. Doudna submitted as Exhibit 1593  
8   are being offered for the truth of the matters asserted therein, such as the inventors’ knowledge  
9   and expectations regarding CRISPR-Cas9’s functionality in eukaryotes. *See* Paper #718,  
10   ToolGen Opp. 1, 21, A2-10; Ex. 1570, 198-199 and 210.

11          4.       The purported YouTube video featuring Dr. Carroll submitted as Exhibit 1283  
12   was not authenticated by any ToolGen witness.

13          5.       ToolGen did not ask Dr. Carroll about Exhibit 1283 during his deposition, nor did  
14   ToolGen ask him to authenticate the exhibit. *See* Ex. 1570.

15          6.       There is no evidence in the record regarding who posted this video (Ex. 1283),  
16   when it was posted, who extracted it to make it an exhibit, when it was extracted, whether it was  
17   edited, and whether it accurately reflects Dr. Carroll’s statements and understanding.

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **JUNIOR PARTY'S MISCELLANEOUS MOTION (Motion to Exclude)** is being filed via the Interference Web Portal by 8:00 PM Eastern Time on September 17, 2021, pursuant to an agreement between the parties, and thereby served on the attorney of record for the Senior Party pursuant to ¶ 105.3 of the Standing Order. Pursuant to the agreement between the parties, the foregoing was also served via email by 11:00 PM Eastern Time on counsel for the Senior Party at:

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