UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA INC.,
Petitioner

v.

MOLECULAR LOOP BIOSCIENCES, INC.,
Patent Owner

Case IPR2024-00965

U.S. Patent No. 11,768,200

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR AUTHORIZATION TO COMPEL TESTIMONY AND/OR DOCUMENTS

Patent Owner Molecular Loop Innovations LLC[1] ("Patent Owner") submits this Opposition to Petitioner Illumina Inc.'s, ("Petitioner") Motion for Authorization to Compel Testimony and/or Documents (Paper 12, "Motion").

I. Introduction

Petitioner attempts to remedy evidentiary deficiencies it should have addressed long ago. As early as February 2024, five months before the Petition, Petitioner was aware it needed the publication evidence it now seeks. On March 1, 2024, over a year before filing the Motion, arXiv stated that it would not give Petitioner evidence via an affidavit. EX1039 at 8. After filing the Petition in July 2024, and even after Patent Owner challenged Gloor's public availability in its Preliminary Response in October 2024, Petitioner never mentioned its intent to seek that evidence via subpoena until weeks after the Institution Decision, and ultimately filed the Motion more than a month after institution. Petitioner still needs to obtain any information it requests from arXiv and coordinate a deposition of an arXiv employee, creating unwarranted prejudice for Patent Owner in preparing its Response, due April 17, with the record on public availability—an issue on which Petitioner bears the burden—still not fully developed. The Motion provides no

[1] As indicated in the Updated Mandatory Notices filed February 27, 2025 (Paper 11), the Patent Owner in this proceeding is now Molecular Loop Innovations LLC.

reasonable justification for the burden Petitioner seeks to place on Patent Owner in having to respond to the not-yet-obtained additional evidence Petitioner seeks.

II. Petitioner's Delay Warrants Denial

Petitioner's Motion "is an attempt to obtain, and then submit … supplemental information" to support the public accessibility of prior art. *College Products, Inc., v. Intirion Corp.*, PGR2024-00003, Paper 28 at 3 (PTAB Sep. 9, 2024). Like the petitioner in *College Products*, Petitioner here "is *not* in possession of the supplemental information" it seeks to submit. *Id.* at 3 (emphasis in original). When the "submission of any information or evidence relating to public accessibility would inevitably occur more than one month after [the] Institution Decision," Petitioner must explain why it waited to obtain information pertaining to the public accessibility under 42.123(b). *College Products*, PGR2024-00003, Paper 28 at 8. Late submission of supplemental information requires the moving party to "show why the supplemental information reasonably could not have been obtained earlier." 37 CFR § 42.123(b). Petitioner's Motion should be denied because it fails to sufficiently explain (1) why Petitioner waited until a year after it learned arXiv would not provide an affidavit—and a month after the Institution Decision—to raise its subpoena request and (2) why Petitioner did not make additional earlier efforts to obtain the information Petitioner seeks.

First, Petitioner seeks discovery that it could have and should have sought much earlier. Petitioner was aware it needed documents and/or testimony from arXiv to address issues of public availability as early as February 2024—***more than a year ago, and nearly five months before it filed the Petition***. *See* EX1039. On October 31, 2024, Patent Owner filed its Preliminary Response, challenging the public availability of Gloor. On January 27, 2025, the Board issued its Institution Decision further alerting Petitioner to issues with its public availability evidence. Petitioner could have signified its awareness of the need for additional supporting documentation from arXiv and its intent to seek such support via subpoena much earlier, either in the Petition or at any other time prior to institution. At the very least, Petitioner could have made its request immediately after receiving the Institution Decision. Instead, Petitioner remained silent, waiting until February 17, 2025 to first mention a subpoena to Patent Owner, and then raised its request to the Board on February 26, 2025, a month after institution. *See* EX3001.

Petitioner's Motion does not justify why it should be allowed to submit the supplemental information it now seeks more than one month after the Institution Decision. For example, Petitioner does not explain why it waited 30 days past institution, the same length of delay that led to the denial in *College Products*, to request leave to file the Motion. *See College Products*, PGR2024-00003, Paper 28 at 3 (authorization requested May 10, 2024, 30 days after institution on April 10,

2024). Petitioner's justification is that arXiv would not provide an affidavit, s*ee* Motion at 1-3, but Petitioner was well aware of that ***over a year ago*** when arXiv declined to provide an affidavit in March 2024. EX1039 at 8.

Second, Petitioner insists it must compel testimony from arXiv but does not explain why it did not make additional efforts to obtain the information Petitioner now belatedly requests. That Petitioner's evidence might be insufficient does not justify Petitioner's request to compel and submit late supplemental information, particularly where Petitioner did not explore additional avenues to obtain such information. For example, Petitioner alleges that Gloor became publicly available through an email sent to arXiv subscribers but apparently made no attempt to obtain that email—whether from arXiv or Dr. Gloor or anyone else. And despite multiple email communications with arXiv, Petitioner never asked for the alleged email from arXiv and never inquired regarding what other data or documents might exist supporting Gloor's public availability, and thus necessarily did not inquire regarding what any such documents would show if they were available.

Petitioner's Motion is a delayed attempt to address evidentiary issues that Petitioner was aware of and could have addressed before it filed the Petition, and certainly well before its late Motion. Petitioner's late request to do so now should be rejected in view of Petitioner's unreasonable delay. And none of Petitioner's cited cases show otherwise. *See* Motion at 5 (citing *Canon*, *Apple*, and *Kaz*). None

of those decisions addressed a petitioner's delay in requesting discovery. None of the decisions even mentions 37 CFR § 42.123(b) (in contrast to *College Products*, as discussed above). And two of Petitioner's cited decisions ***were not even opposed by the patent owner***. *Apple Inc. v. Qualcomm Inc.*, IPR2018-01283, Paper 14, at 2 (PTAB Apr. 30, 2019) ("Patent Owner has elected not to oppose [Petitioner's] motions.") (alteration in original); *Kaz USA, Inc. v. Exergen Corp.*, IPR2016-01437, Paper 27, at 2 ("Patent Owner does not object to Petitioner's request.").

III. The Requested Discovery Is Not In The Interest Of Justice

The *Garmin* factors do not require granting the Motion. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013). The Federal Circuit has explained that "fail[ing] to explain why the same information could not be generated without additional discovery" provides sufficient grounds to deny a motion for additional discovery. *Arctic Cat Inc. v. Polaris Indus., Inc.*, 795 F. App'x 827, 831 (Fed. Cir. 2019).

A. Factor 1: Petitioner Made No Factual Showing Of Usefulness.

The Board has made clear "[t]he mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice." *Garmin*, IPR2012-00001, Paper 26 at 6. Furthermore, Petitioner "***should already be in possession of evidence*** tending to show beyond speculation that in fact

something useful will be uncovered." *Id.* Yet, Petitioner's Motion merely speculates that "arXiv is expected to have information regarding *Gloor's* date of public accessibility." None of the emails Petitioner provided between its counsel and arXiv identify specific documents or data that contain the information Petitioner seeks, nor did Petitioner ask about any such documents or data in its correspondence with arXiv that began over a year ago. Motion at 4; EX1039; EX1042.

B. Factor 2: Litigation Positions Are Not At Issue.

Petitioner acknowledges that Factor 2 does not apply here. Motion at 2.

C. Factor 3: Petitioner Ignored Other Means Of Discovery.

Petitioner appears to confuse Factor 3 by arguing "the most direct way to address Patent's Owner's challenge to public accessibility is through discovery from arXiv." Motion at 5. But Factor 3 does not involve the most "direct" means of discovery, instead it centers on "the ability of the requesting party to generate the requested information without need of discovery." *Garmin*, IPR2012-00001, Paper 26 at 6. Despite its claim that "Petitioner is unaware of any other means for obtaining this discovery," Petitioner's efforts to obtain that discovery from others already—including one author on the Gloor paper—suggests otherwise. For example, Petitioner alleges that Gloor became publicly available in an email announcement sent by arXiv to its subscribers in July 2010 but fails to explain why it could not submit that email. For author Dr. Gloor—who testified that he "became a registered

member of arXiv.org at least as of July 28, 2010" and that he "believe[s] arXiv.org sent email alerts to subscribers on July 29, 2010"—Petitioner does not explain why he did not provide the email sent to subscribers, despite submitting other emails he received from arXiv around the alleged publication date. EX1002, ¶¶ 12, 17. And Petitioner never requested that email from arXiv, which allegedly sent it, nor did Petitioner address whether it contacted any of the six other authors on Gloor.

D. Factors 4 and 5: Petitioner's Generic Requests Are Burdensome.

Factors 4 and 5 favor denying Petitioner's overly burdensome requests because of Petitioner's delay in seeking discovery and the undue prejudice it places on Patent Owner to respond to any forthcoming new evidence. As explained above in Section II, Petitioner's delay in seeking the relief in its Motion has been unreasonable. Petitioner still needs to obtain any documentary and testimonial information it requests from arXiv and coordinate the deposition of an arXiv employee that Petitioner seeks. With Patent Owner's Response due on April 17, Petitioner cannot justify the unwarranted prejudice to Patent Owner of having to respond to late supplemental information in the short amount of time available.

Petitioner was not diligent in seeking its requested discovery. Petitioner's burden of supporting the prior art status of its chosen references, which Petitioner failed to do and now seeks to remedy, did not arise for the first time at institution and may not be satisfied for the first time with late supplemental information.

Dated: March 14, 2025

Respectfully submitted,

/s/ Brian D. Matty

Brian D. Matty (Reg. No. 70,358)
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
Telephone: 212-351-3400
Facsimile: 212-351-3401
Email: bmatty@desmaraisllp.com

Counsel for Patent Owner Molecular Loop Innovations LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on March 14, 2025, a complete copy of the foregoing was served on counsel of record for Petitioner by filing this document through P-TACTS and by sending this document via electronic mail to the following addresses:

William B. Raich (Reg. No. 54,386)
Charles T. Collins-Chase (Reg. No. 78,019)
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001-4413
Tel: 202-408-4210
Fax: 202-408-4400
william.raich@finnegan.com
charles.collins-chase@finnegan.com

Dated: March 14, 2025

Respectfully submitted,

/s/ Brian D. Matty
Brian D. Matty (Reg. No. 70,358)
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
Telephone: 212-351-3400
Facsimile: 212-351-3401
Email: bmatty@desmaraisllp.com

Counsel for Patent Owner Molecular Loop Innovations LLC