

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. IPR2024-01178

U.S. Patent No. 10,770,170 B2

**PATENT OWNER'S PRE-INSTITUTION SUR-REPLY AUTHORIZED
PURSUANT TO NOVEMBER 11, 2024 EMAIL**

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I. PETITIONER HAS FAILED TO SHOW SAXONOV IS PRIOR ART

It is Petitioner's burden to show—in the Petition—that the relied-upon materials from Saxonov were carried forward from Saxonov Provisional. Paper 6 at 30. Petitioner has failed to do so. *Id.* at 30-42. Petitioner argues that citing “seven paragraphs and a figure in Saxonov that are undisputedly among the material that is identically present in the provisional” and “Dr. Batt's declaration, which specifically cites [this material] in the provisional” is enough. Paper 7 at 1-2. This argument is unsupported by the law and the record. It should be rejected.

In particular, Petitioner's reliance on *Illumina, Inc. v. Ravgen*, IPR2021-01271 and *Mastercard, Inc. v. OV Loop, Inc.*, IPR2023-01289 is misplaced because both cases are inapposite. Paper 7 at 1-2. In *Illumina*, the petitioner showed the non-provisional and provisional disclosures “appear[ed] to be nearly identical.” *Illumina*, Paper 12 at 45. That is not the case here. Instead, the Saxonov Provisional omits several **key** paragraphs and figures upon which Petitioner repeatedly relies. *Lyft, Inc. v. Ikorongo Tech. LLC*, IPR2021-00423, Paper 10, at 16-17 (PTAB July 26, 2021) (petitioner did not meet its burden when it did “not explain sufficiently (let alone explain with particularity) how [] nine disparate pages in the [provisional] sufficiently support the relied-upon subject matter in the five cited paragraphs in [the non-provisional]”). And, in *Mastercard*, petitioner's parallel citations to the provisional were sufficient because the patent owner failed

to “identify what subject matter it contends is relied upon by Petitioner that lacks written description support from the...Provisional.” *Mastercard*, Paper 15 at 19. That is also not the case here. Instead, this case is far more akin to *Lyft*, because Petitioner here—just like the petitioner in *Lyft*—has utterly failed to meet its burden of explaining with particularity—in the Petition—how disclosure in the Saxonov Provisional supports its relied-upon subject matter in Saxonov. *Lyft*, Paper 10 at 16-17. Indeed, the Petition provides no citations to the provisional for multiple key relied-upon features. Paper 6 at 34-36. Instead Petitioner cites only Saxonov and refers to the Batt declaration that purportedly cites the provisional. Paper 7 at 1 (citing Pet. at 32-33; Batt Decl. ¶¶157-62). The Board has rejected such attempts to indirectly cite the provisional through declarations. *Fidelity Nat’l Info. Servs., Inc. v. DataTreasury Corp.*, IPR2024-00491, Paper 9 at 8 (PTAB Aug. 13, 2014) (“We decline to consider information presented in a supporting declaration, but not discussed sufficiently in a petition[.]”). Also, Petitioner’s citations to the provisional are neither “parallel” nor “concurrent” because the Saxonov Provisional **omits** the key cited subject matter from Saxonov altogether (discussed below). And Petitioner’s cites to the provisional now still fail to support Petitioner’s relied-upon subject matter from Saxonov. Paper 6 at §V.A.5; *infra* §II.

II. SAXONOV IS NOT PRIOR ART

Petitioner admits that a “handful of paragraphs” in Saxonov are not identical

to the Saxonov Provisional, but argues that the Petition “confirms” such material was carried forward. Paper 7 at 1-4. But, the Saxonov Provisional, Petition, and Petitioner’s own expert’s declaration tell a different story.

For example, Petitioner argues FIG. 10’s and ¶¶18, 76-79’s teaching of detecting three targets using just two colors, which yields eight distinct populations of droplets, is “present” in passages from the provisional “called out in the Petition in connection” with FIG. 10 or ¶¶18, 76-79. Paper 7 at 3-4 (citing Pet. at 12-13, 29, 41; EX1002 ¶¶145-54). These citations do not support Petitioner’s argument.

Petitioner also identifies 2:15-3:3 of the Saxonov Provisional as describing “detecting ‘two or more targets in a single partition,’ including by using only a single color channel.” Paper 7 at 3-4. Petitioner is simply wrong—2:15-3:3 of the provisional discloses nothing of the sort.

Petitioner’s other attempts to support Saxonov using its provisional similarly fail. For example, Petitioner seeks to tie Saxonov to its provisional by alleging the provisional teaches “‘eight clusters or populations of data, separated by intensity,’ just as in [Saxonov] Figure 10.” Paper 7 at 3 (citing EX1007 5:19-6:3). But, while Saxonov and its provisional both may nominally analyze “eight” clusters (four of which are not even shown in Saxonov’s FIG. 10), the *T3+ cluster* shown in Saxonov’s FIG. 10 is *not* disclosed in the Saxonov Provisional.

Petitioner contends that its “three” cites to the provisional at 5:19-6:3 “in the

overview of Saxonov” bolster its argument that FIG. 10 was unnecessary. Paper 7 at 3 (emphasis added). But the *content* of what is cited is more important than the few times Petitioner cites it in the prior art overview. And, here, the passage Petitioner cited does not teach the concepts illustrated in FIG. 10 upon which Petitioner relies. In particular, Petitioner relies on 5:19-6:3 for the proposition that the provisional teaches FIG. 10’s alleged disclosure of using two color channels to identify the “T3+” target. *Id.* But the citation Petitioner provides fails to do so. Instead, 5:19-6:3 discloses an assay “involv[ing] analysis of[: (i)] more than two targets in the same channel” to “generate eight clusters or populations of data, separated by intensity;” or (ii) “[t]hree targets, two in a first channel and one in a second channel[.]” Both of these examples merely disclose that two or more targets can be measured in *a single channel* using intensity. By contrast, Petitioner relies on FIG. 10 for its illustration of using data from both of the *two channels* simultaneously to identify the T3+ target in eight different populations. Pet. at 18.

Petitioner argues that “[n]one of the disputed material at FIGS. 9-10 and ¶¶17-18, 37, 76-79 is truly essential” to institution. Paper 7 at 2. That is simply not true. Indeed, Petitioner’s arguments *depend* on, at least, FIG. 10 and ¶¶76-78.

III. PO’S PORTRAYAL OF THE CLAIMS IS CONSISTENT

Petitioner argues PO “mischaracterizes the claims” in a manner that “is inconsistent with PO’s district court position.” Paper 7 at 5. Notably, Petitioner

does not dispute PO's characterization of Saxonov, but instead argues that PO now characterizes the claims as being limited to measuring multiple targets in a single droplet. But, PO never argued the '170 patent claims are *limited* as such. Instead, PO has argued that the '170 patent claims are *not* as limited as Saxonov's approach for many reasons. Paper 6 at 42-45. Petitioner's argument should be rejected.

IV. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

Petitioner's Reply disputes only *Fintiv* Factors 2 and 3, and provides no authority supporting its position for either factor. Paper 7 at 5. Factor 2 is not dispositive to the Board's *Fintiv* analysis; rather, the Board balances all factors. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5, 9 (PTAB Mar. 20, 2020). The Board should also reject Petitioner's Factor 3 argument, which is based on progress in the district court *to date*. Paper 7 at 5. Petitioner ignores PO's showing of significant investment (Paper 6 at 59-61) and the additional investment that *will be* made before an institution decision, including substantial fact discovery and potentially a *Markman* order. *T-Mobile USA, Inc. v. Wireless Alliance, LLC*, IPR2024-00607, Paper 16 at 11 (PTAB Sept. 10, 2024) (considering investment made up through the time of institution). The Board should deny institution.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on December 5, 2024, a copy of the foregoing PATENT OWNER'S PRE-INSTITUTION SUR-REPLY AUTHORIZED PURSUANT TO NOVEMBER 11, 2024 EMAIL was filed through the Patent Trial and Appeal Case Tracking System (P-TACTS) and was served via Federal Express and 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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