

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. IPR2024-01451

U.S. Patent No. 11,827,921 B2

**PATENT OWNER'S PRE-INSTITUTION SUR-REPLY AUTHORIZED
PURSUANT TO JANUARY 16, 2025 EMAIL**

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I. PETITIONER'S MISLEADING AND UNTIMELY ATTEMPT TO REDO CLAIM CONSTRUCTION TO SALVAGE ITS LARSON INVALIDITY GROUND SHOULD BE REJECTED

Neither party has asked the Board, or the district court in the parallel proceeding, to construe the term “single sample volume.” Yet now, in an apparent attempt to redo claim construction in a way that would purportedly salvage Petitioner's invalidity Grounds based on Larson (which is all of them), Petitioner misleadingly responds to phantom arguments that PO never made. Moreover, Petitioner makes this request for the first time in its Reply. Petitioner's request should be rejected both procedurally and because it is meritless.

As its foundational Reply argument, Petitioner contends that PO made arguments about the breadth of a claim term: “single sample volume.” Petitioner does so in an apparent attempt to create a false tension among PO's explanations of Larsons' teachings, the intrinsic record, and PO's alleged claim interpretation from its preliminary infringement contentions.¹ In doing so, Petitioner tries to convince the Board that PO is reading the challenged claims too narrowly. Paper 9 at 1. But PO is not reading the challenged claims too narrowly, and indeed did not even

¹ Petitioner's contention that PO's infringement contentions are “final” is misleading. (Paper 9 at 3, fn 1). N.D. Cal. L.R. 3-6 provides that a PO can amend infringement contentions upon a showing of good cause, for various reasons.

make the arguments that Petitioner alleges. Petitioner's exercise is misleading and irrelevant.

As a case in point, Petitioner alleges that PO "contends that Larson does not meet the requirement in the '921 patent claims' [*sic*] that multiple targets be amplified in a 'single sample volume' because Larson teaches droplets having only a 'single analyte' and 'expressly teaches excluding' droplets with multiple analytes." Paper 9 at 1. But PO did not even **address** the '921 Patent claim limitation "that multiple targets be amplified in a 'single sample volume,'" because there are many other distinctions over Larson. *See* Paper 8 at 43–54, 59–62.

Indeed, Petitioner ignores the points of distinction over Larson that PO did make, particularly the arguments that Larson teaches identification of a single analyte within a droplet, and that a POSA reasonably would have understood this is Larson's principle of operation. *Id.* at 43–47 (citing EX1017, ¶¶141, 172; EX2001, ¶¶68, 100–02). PO contrasted Larson's teachings to the '921 Patent's measurement of cumulative optical signals using a coding scheme, and argued that Larson does not teach or suggest such a system. *Id.* at 44–45 (citing EX2001, ¶¶103–05). Petitioner's Reply does not dispute any of these arguments.

Instead, Petitioner incorrectly contends that "PO seeks to exclude from the ['921] claims systems like Larson's wherein the 'single sample volume' comprises a collection of droplets that each have, for instance, one analyte." Paper 9 at 1. But

PO did not make this argument either. Larson does not teach or suggest analyzing multiple targets in a single droplet, and for at least this reason does not anticipate or render obvious the claims of the '921 Patent. PO does not need to, and is not trying to, carve “a collection of droplets” out of the '921 Patent claim scope to try to avoid Larson, as Petitioner alleges.

In fact, PO agrees with Petitioner that the “single sample volume” is “*not* limited to an individual ‘droplet,’ but rather includes any type or nature of volume, such as a ‘tube or bottle.’” Paper 9 at 1 (emphasis in original). PO also agrees with Petitioner that the “specification contemplates both embodiments where the sample volume is separated and those where it is not,” and that the “inventors of the '921 contemplated *requiring* no separation of the ‘single sample volume’ but decided against it.” Paper 9 at 2 (emphasis in original). Thus, Petitioner’s own positions underscore the irrelevancy of its newly raised arguments.

II. PETITIONER FAILED TO MEET ITS BURDEN OF SHOWING SAXONOV IS PRIOR ART

As the POPR explains, Petitioner’s invalidity arguments in Grounds 3 and 4 rely heavily on FIG. 10 and ¶¶ 18 and 78–79 of Saxonov (“the disputed disclosure”), but do not meet Petitioner’s burden to establish the disputed disclosure was “carried over” from the Saxonov Provisional. Paper 8 at 29–42. This is no different from IPR2024-01177 and IPR2024-01178 (the '921 Patent’s

parents), where the Board denied institution because those Petitions failed to establish that Saxonov meets the “carried over” requirement. *See* Paper 10 in both IPRs. For the same reasons, and for the reasons stated in the POPR for the ’921 Patent, the Board should also deny institution here.

Moreover, Petitioner predicates its Reply arguments on the false allegation that “[a]ll of PO’s arguments about this material boil down to the contention that the [Saxonov] provisional does not disclose the analysis of three or more targets in a single droplet.” *Id.* at 4 (*citing* Paper 8 at 40–41). But on pages 40–41 of the POPR, PO merely pointed out how and at what pages the Petition relies upon the disputed disclosure. PO never contended “that the [Saxonov] provisional does not disclose the analysis of three or more targets in a single droplet.” Indeed, if the POPR had made such a “contention,” Petitioner easily could have cited and quoted it. Instead, Petitioner invents an argument to set up yet another false tension, and then uses that false tension to belatedly try to repair holes in its Petition.

Petitioner also attempts to argue in its Reply—for the first time and without the Board’s authorization—that Saxonov ¶¶ 20 and 41 support the disputed disclosure and were carried over from the Provisional. Paper 9 at 5; EX3001. But a Reply may not be used as a do-over to fix mistakes in the Petition. IPR2024-01177, Paper 10 at 23; *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that

petitioners ... adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”). Here, not only does Petitioner make its new argument about the Provisional’s support for the disputed disclosure, but also, tellingly, does not even attempt to argue that it made such argument in its Petition. For at least these reasons, Petitioner has not carried its burden of showing Saxonov is prior art.

III. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

Petitioner’s Reply disputes only Factors 2 and 3, providing no authority supporting its position. Paper 9 at 5. Factor 2 is not dispositive; the Board balances all factors. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5, 9 (PTAB Mar. 20, 2020). The Board should reject Petitioner’s Factor 3 argument, which is erroneously based on progress in the litigation *to date*. Paper 9 at 5. Petitioner ignores PO’s showing of significant investment (Paper 8 at 65–66) and the further investment that *will be* made before institution, including substantial discovery and likely a *Markman* order. *T-Mobile USA, Inc. v. Wireless Alliance, LLC*, IPR2024-00607, Paper 16 at 11 (PTAB Sept. 10, 2024). Further, given that the Board has now denied Petitioner’s IPRs in the ’921 Patent’s parents also at issue in the litigation, the litigation is highly likely to proceed. 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 February 6, 2025, a copy of the foregoing PATENT OWNER'S PRE-INSTITUTION SUR-REPLY AUTHORIZED PURSUANT TO JANUARY 16, 2025 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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