

From: [Director PTABDecision_Review](#)
To: ["Jesse Salen"; Coke Stewart, Acting Under Secretary and Director; Martin Bader; Walter, Derek C.; Johnson, Matthew W.; LegalTM-Caltech-IPR](#)
Subject: RE: Bio-Rad Labs., Inc. v. CalTech - Case IPR2024-01451
Date: Wednesday, May 14, 2025 10:33:00 AM

Counsel,

A Decision Granting Institution in the above-referenced proceeding was issued on March 27, 2025. Any request for Director Review was due within 14 days of the Decision Granting Institution, or April 10, 2025. See 37 C.F.R. § 42.75(c)(1) and 37 C.F.R. § 42.71(d). Patent Owner's email, received on May 8, 2025, requesting the Director to reconsider the Board's decision is untimely and will not be considered.

Thanks.

IPR2024-01451
Ex. 3100

From: Jesse Salen <JSalen@sheppardmullin.com>
Sent: Thursday, May 8, 2025 4:55 PM
To: Coke Stewart, Acting Under Secretary and Director <Director@uspto.gov>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Martin Bader <MBader@sheppardmullin.com>; Walter, Derek C. <dwalter@jonesday.com>; Johnson, Matthew W. <mwjohnson@jonesday.com>; LegalTM-Caltech-IPR <LegalTM-Caltech-IPR@sheppardmullin.com>
Subject: Bio-Rad Labs., Inc. v. CalTech - Case IPR2024-01451

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Director Stewart,

In connection with IPR2024-01451, Patent Owner respectfully requests reconsideration of the March 27, 2025 decision instituting IPR, in view of the recently issued guidance regarding discretionary denials.

Patent Owner's Position

In particular, Patent Owner requests reconsideration given the following facts:

- Patent Owner has good cause to request review of the Board's institution decision at this time because the USPTO's new *Fintiv* guidance was only recently issued and the USPTO's FAQ explaining how that guidance should be applied was recently issued on April 25, and it appears that the Board did not apply the new guidance in this case.
- Petitioner extensively relied upon expert testimony in connection with the petition, including a 181-page declaration from Petitioner's expert.
- Reasonable disputes exist between the parties' experts on dispositive issues, suggesting

that the questions raised in the petition would be better resolved in an Article III court, which the parties are currently pursuing before the Northern District of California. As one example, the parties' experts disagree regarding whether the prior art discloses or renders obvious detecting combinations of multiple analytes in a single droplet.

- The parallel proceeding in the Northern District of California is well under way (a claim construction hearing was held on December 12, 2024 and a claim construction order is imminent), such that the court and parties have made significant investments in the parallel proceedings, and petitioner's challenge will still be adjudicated without any undue delay or prejudice. Additionally, in the parallel action, Patent Owner is also asserting two related patents for which the Board denied institution on the merits. See IPR2024-01177, IPR2024-01178. Patent Owner's claims based on those patents will need to be resolved in the parallel action, and given the overlap of issues, including alleged prior art, it would be far more efficient to litigate all of the related issues together in the parallel action rather than in two different forums (in the Northern District of California and before the Board), especially because Petitioner has not filed a motion to stay in the parallel proceeding.
- Approximately 4,700 ex parte appeals are pending before the PTAB, denying the Petition here would help conserve Board resources to address such appeals without prejudicing the petitioner.
https://www.uspto.gov/sites/default/files/documents/FY25_PTAB_Appeal_Statistics_December_2024.pdf
- Given that the Board's institution decision found that Fintiv Factors 4 and 5 weigh in favor of discretionary denial, Factors 1 and 6 are neutral, and only Factors 2 and 3 weigh against denial, the above considerations in view of the USPTO's recently issued guidance shift the overall analysis to favoring denial.

Accordingly, Patent Owner requests that the Director revisit the Board's institution and terminate the proceeding. Alternatively, if the Board believes additional briefing in view of the new Fintiv guidance would be helpful, Patent Owner respectfully requests that the Board issue an order setting a briefing schedule for such briefing.

Petitioner's Position

Patent Owner's unusual email requesting reconsideration of the Board's institution decision is procedurally improper, untimely, and unwarranted on the merits. Petitioner does not believe that Patent Owner's argumentative email is an appropriate vehicle for Patent Owner to advance its position, but nonetheless submits this response here because Patent Owner has confirmed that it would otherwise submit its request unilaterally.

As an initial matter, Patent Owner's request is untimely. The Board's institution decision came on March 27, 2025. Pursuant to 37 CFR § 42.71(d), Patent Owner should have made any request for rehearing within 14 days. We are now well-past that 14-day deadline, and there is no excuse for Patent Owner's untimeliness. Patent Owner points to the PTAB's recent guidance regarding Fintiv as justifying its belated request, yet the PTAB issued its new guidance regarding Fintiv **before** the institution decision on March 24, 2025 and March 26, 2025. Thus, at the time of the institution decision, Patent Owner was on notice as to how the PTAB would be addressing Fintiv and, if it

thought this provided a basis for a reconsideration request, was on notice and in position to make a timely request. But Patent Owner did not do so. This alone establishes that Patent Owner's request should be rejected.

As reflected in the attached email, Petitioner repeatedly asked Patent Owner if there was any authority that would justify its untimely request. Patent Owner, however, cited only cases where there was a **timely** request for rehearing, including several cases where there has not even been a decision to vacate institution.

As to the merits, this case is a poor candidate for discretionary denial under Fintiv. Most of the points Patent Owner makes are generic, such as its assertions regarding the pendency of many ex parte appeals, the use of expert testimony, and the presence of alleged "reasonable disputes." Patent Owner's heavy reliance on such generic considerations is a red flag that there is nothing about this particular case to warrant discretionary denial.

What few specifics Patent Owner points to fall far short. Patent Owner contends, for instance, that discretionary denial is warranted because the district court litigation is allegedly "well underway." This, however, is merely carefully-selected language to avoid revealing that the district court litigation is, in fact, in its earliest stages:

- No trial date has been set, and there is no schedule for any post-discovery deadlines.
- No claim construction order has issued.
- Discovery is in its earliest stages. Patent Owner just filed a motion to **extend** the district court discovery deadline.
- Patent Owner has produced no documents from its inventors.
- No depositions have been taken.
- No expert reports, let alone summary judgment briefs, have been submitted.

In short, even if Patent Owner's request were timely, the circumstances here are the exact opposite of those that warrant denial under Fintiv. To the extent the Director nonetheless contemplates Patent Owner's request for rehearing, Petitioner requests an opportunity to respond more fully to Patent Owner's arguments.

If it would be helpful, the parties can be available for a teleconference to discuss the above and can propose dates for such a conference.

Respectfully,

/Jesse A. Salen/
Counsel for Patent Owner
California Institute of Technology

/Derek Walter/
Counsel for Petitioner
Bio-Rad

Attention: This message is sent by a law firm and may contain information that is privileged or confidential. If you received this transmission in error, please notify the sender by reply e-mail and delete the message and any attachments.