

1 Tuesday, September 16, 2025

9:59 a.m.

2 P-R-O-C-E-E-D-I-N-G-S

3 --oOo--

4 THE CLERK: Now calling case 23CV04823EKL, In re
5 ChromaCode Litigation.

6 Counsel, if you could please state your appearance for
7 the record, beginning with the Plaintiff.

8 MR. SALEN: Good morning, your Honor. This is
9 Jesse Salen with Sheppard Mullin on behalf of the
10 Plaintiffs, And with me is my colleague Eric Gill.

11 THE COURT: Okay. Good morning. And you may
12 remain seated. Nobody needs to stand up. You can just
13 remain seated and speak into the microphone.

14 MR. SALEN: Thank you, your Honor.

15 MR. WALTER: Derek Walter of Jones Day for Bio-
16 Rad.

17 THE COURT: Okay. Good morning. And I hope your
18 computer still works after the water.

19 MR. WALTER: I think it does, yeah.

20 THE COURT: Okay. Excellent.

21 So we're here today on the Plaintiff's motion for leave
22 to amend their infringement contentions for -- I'm not sure
23 if it's all three or just the '170 patent and the '921
24 patent at this point, but I understand that amendments span
25 all patents at this point. Is that correct?

1 MR. SALEN: That's correct, your Honor.

2 THE COURT: Okay. So let me -- I have some
3 questions first for the Plaintiff since it's your motion.
4 And I wanted to begin with a question about the '051 patents
5 since I understand that, per the claim construction order,
6 the -- I don't know if it's all asserted claims or at least
7 -- at least one asserted claim is indefinite. So are any of
8 the proposed amendments relating solely to the '051 patent?

9 MR. SALEN: No, your Honor.

10 THE COURT: Okay. Good.

11 All right. Turning to the amendments themselves, I
12 would like to start with the single-sample volume issue.
13 And if you could clarify, which patents and claims does this
14 amendment relate to?

15 MR. SALEN: This amendment is for the '921 patent
16 claim, but all the claims, starting with the independent
17 claim, claim one --

18 THE COURT: But it's just the '921.

19 MR. SALEN: Yes.

20 THE COURT: Okay. Thank you.

21 And I had a little bit of difficulty matching the
22 references in the motion with the vast quantity of material
23 that I have because the citations in the motion didn't cite
24 to the docket number. I think I figured it out, but I'm not
25 sure. I'm looking at page -- pages -- page four of the

1 motion, which cite to an appendix C to your declaration, Mr.
2 Salen, and I wanted to make sure I had the correct part of
3 the contentions, the original contentions. So I'm -- I
4 think that maps to docket 127-3 at pages 19 to 20, which is
5 PDF pages 376 to 377. And if it's not, I need you to tell
6 me what it is that is the reference you're directing the
7 Court to that has the two existing alternative theories
8 regarding single-sample volume. So I'm sorry to put you on
9 the spot here, but it's fairly important for me to
10 understand what you're telling me.

11 MR. SALEN: Yeah, I think that's -- I think that's
12 right. And there's a Bates number. Let me --

13 THE COURT: A Bates number. Okay. Nothing has a
14 -- I have something at the bottom that says Bio-Rad Exhibit
15 1012.019. And then --

16 MR. SALEN: I'm sorry, I just want to make sure
17 I'm looking at the right page, your Honor. You said page
18 four of the motion?

19 THE COURT: Page four of your motion. So here,
20 I'll tell you exactly what I'm pondering.

21 So page four of the motion, Plaintiff's PICs asserted
22 infringement based on the single-sample volume being a
23 droplet. And then there's a citation.

24 "In the alternative, Plaintiff's PICs
25 allege that the detection performed in a

1 single-sample volume that is
2 subsequently partitioned into multiple
3 droplets."

4 And then there's a cite to the next page. And so I
5 think the cite goes -- well, I can't figure out exactly
6 where it goes, but I thought I figured out where it was in
7 the documents. So that's what I'm trying to figure out is
8 where do these assertions, these original assertions,
9 appear, so that I can then address the amendments?

10 MR. WALTER: I think I can help with one. I think
11 one of them -- this is Derek Walter.

12 THE COURT: Yes, thank you.

13 MR. WALTER: I think one Of them appears on the
14 page that has Bates label on the bottom, Exhibit 1012-020.

15 THE COURT: 020. Yeah, I have that one. That's
16 at the PDF page 377. I got that from --

17 MR. WALTER: That's the one.

18 THE COURT: I got that from the Defendant's
19 opposition.

20 And by the way, for future reference, it's super
21 helpful for me to have something, when these massive
22 exhibits are submitted, that says, here's the ECF docket
23 number reference at PDF page, you know, whatever hundred
24 page it is. That's really helpful for me to find those
25 things. So I'm just trying to make sure I have the text in

1 front of me that I'm to look at and to -- in comparing the
2 original with the amendment.

3 So, I'm sorry, Mr. Salen, have you located the correct
4 document?

5 MR. SALEN: I'm -- yeah, I'm trying now, your
6 Honor, I'm -- and I may -- so I think on page 19 of Exhibit
7 1, which -- to my declaration -- so I think --

8 THE COURT: Okay.

9 MR. SALEN: Mapping -- let me just have just
10 another minute.

11 THE COURT: Yeah. Okay. So I have Exhibit 1,
12 which --

13 MR. SALEN: These are the original infringement
14 contention.

15 THE COURT: Yeah. So I have -- I have the sealed
16 version in front of me, but I think this is the same. 1012.
17 Okay. Let me just make sure I'm looking at the same
18 document. No, these are kind of different things.

19 Okay. Well -- okay. If you want me to look at Exhibit
20 1 --

21 MR. SALEN: So -- yeah. So the -- so the cite
22 says, "Plaintiff's PICs asserted infringement based on a
23 single-sample volume being a droplet" And then the cite
24 that it goes back to, Exhibit 1, and that's page 19. It
25 starts on page 19 and it goes to page 20 is what's being

1 accused is the section of the manual that says, "Table 19
2 Assay Types Continued," and there -- so that -- that's
3 the --

4 THE COURT: Where's the contention? Because if
5 I'm looking at page 19 of your Exhibit 1, I see an excerpt
6 of Table 19 Assay Types Continued, but I don't see an actual
7 contention. So what is the contention?

8 MR. SALEN: Page 17.

9 THE COURT: Okay. Page 17. I'm looking for the
10 text. Okay. So -- I mean, to cut -- sort of to short
11 circuit this, Mr. Salen, what I'm looking for is where do I
12 see the two alternatives -- two alternative contentions that
13 you say that you have and that you're now saying, "Okay.
14 We're going to eliminate one and leave the other"?

15 MR. SALEN: Right, your Honor.

16 MR. GILL: Do you have the appendix for the '921
17 infringement contentions?

18 THE COURT: I have no idea unless you give me the
19 Bates number or the exhibit number to somebody's
20 declaration. So I just -- I need to know.

21 MR. WALTER: This is Derek Walter again.

22 THE COURT: Yeah.

23 MR. WALTER: I think the document you're looking
24 at is what Mr. Gill was referring to. That's the
25 infringement contention claim chart for the '921 patent.

1 THE COURT: Okay.

2 MR. WALTER: Page 19 is the single-sample volume
3 one. And so you do have that document in front of you.
4 They're just looking --

5 MR. GILL: The discussion starts at page 17. It's
6 claim element 1C. You'll see in the left hand column.

7 THE COURT: At page 17. I'm at Exhibit 1, page
8 17. And --

9 MR. WALTER: What you should -- this is Derek
10 Walter again.

11 THE COURT: I can tell you what I'm looking at.

12 MR. WALTER: What you should see is element 1C in
13 the claim chart on the left.

14 THE COURT: No, that's not Exhibit 1 to Mr.
15 Salen's declaration, so I'm looking at something else.

16 MR. WALTER: Are you looking at PDF page 374?

17 THE COURT: In the chambers copies that I have,
18 Exhibit 1 to Mr. Salen's declaration is document 128-2. In
19 the references that I have in the opposition brief, the
20 relevant claim charts are to docket 127-3. And I have
21 printed out for my convenience pages 376 and 377 of that PDF
22 as well as the pages of docket 127-6 that are alleged to be
23 the amendments with redlines and everything. So I have
24 those. I have those two things to compare to. I think I
25 may be missing something.

1 MR. WALTER: What Mr. Gill is pointing you to is
2 page 374 of 127-3, which you don't have because you only
3 printed out, like you just --

4 THE COURT: I got the binders from you all. So if
5 I don't have it in my binder, I don't know where it is. So
6 I have the chambers copies, and I gave up on the chambers
7 copies and just went to the PDF that I have electronically.
8 So -- okay.

9 So if you just give me the citation, and it looks like
10 it's pages 374 through 377, that's what I need to look at,
11 right? According to Mr. Walter and --

12 MR. WALTER: That's what I understand them to be
13 directing you to, yeah.

14 THE COURT: Okay. Do the Plaintiffs agree that's
15 what I should be looking at?

16 MR. SALEN: Yeah, I'm just confirming, your Honor.

17 THE COURT: Okay. Very good. I just want to make
18 sure I have the right thing. And I don't want to have our
19 whole argument be about this issue, but I do need to know
20 where I'm to look.

21 Okay. I'll let you confirm when you have a moment, but
22 my principal concern about this amendment is that if it were
23 the case that there were two distinct infringement theories
24 and the Plaintiffs were proposing to just, like, delete one,
25 okay, that would be one thing. But the way I understand

1 your briefing, putting aside the actual documentation that
2 we're trying to locate, is that you're actually changing the
3 infringement theory, not just deleting one. There's a
4 revision to the text that is proposed, and it's in the
5 section of your opening motion. At page seven, Plaintiffs
6 proposed removing all instances of "the detection is
7 performed in a single-sample volume that is subsequently
8 partitioned into multiple droplets" and replacing such
9 instances with "the analytes are amplified in the single-
10 sample volume, such as in a droplet or well." That's not
11 deleting and leaving the -- one -- you know, the second
12 alternative or the first alternative in there. It's
13 changing it. And I don't understand how I can construe what
14 you're proposing to do as simply removing one theory and
15 leaving one that's already disclosed. So can you help me
16 with that issue?

17 MR. SALEN: Sure, your Honor. And I think the
18 issue is there's two claim limitations at play -- at play
19 here. So there's the claim limitation for a single-sample
20 volume that starts at the beginning of claim one. And we've
21 alleged that that could either be the sample -- in the
22 original infringement contentions, as we said, we alleged
23 that could either be the entire -- the sample before
24 partitioning into droplets or after. But if you read the
25 whole claim -- and we've alleged both of those things, but

1 if you read the whole claim, there's a wherein clause at the
2 end of the claim, claim one, that says, "Wherein the
3 reaction is -- the reaction takes place or occurs within the
4 single-sample volume." And what we've learned during
5 discovery is that that's the only instance of -- in the Bio-
6 Rad devices where there's a -- where there's a -- where
7 there's a reaction. The reaction occurs in the droplets in
8 the accused products. So, yes, initially, the single-sample
9 volume could be read either way, and we've said that, and
10 that's with respect to the beginning of the single-sample
11 volume. But when you read it with respect to the wherein
12 clause at the end, there's really no ambiguity at this
13 point. Bio-Rad has known this the whole time. We've
14 learned this that -- or confirmed that there is no instance
15 where there's a -- where there's a reaction that occurs in -
16 - at least that we've seen any evidence of -- where there's
17 a reaction that occurs in the sample before it's partitioned
18 into droplets. It only occurs in the accused devices
19 afterwards.

20 So what we've done is said, well, based on that wherein
21 clause, you -- there's no point in having any text with
22 respect to single-sample volume that says that it can be a
23 whole -- the sample before partitioning. It has to be the
24 sample after partitioning.

25 THE COURT: So here's the problem I have is you

1 keep referring to the wherein clause. That's in the claim
2 and has always been in the claim and hasn't changed. So it
3 feels to me that maybe what you're doing is having a
4 different claim construction theory, not a different or a
5 eliminated infringement theory.

6 So the -- there's a difference between narrowing your
7 theories of infringement and narrowing your claim
8 construction theory. And that's what I think is the problem
9 is it -- at least that's what the Defendant argues is that
10 you're actually narrowing or changing your claim
11 construction theory. And what I wanted to put a fine point
12 on is let's say there was an amendment that you got to make
13 where you just deleted something that had been one of your
14 two alternative theories, and you stipulate that the claim
15 construction is as the PTAB stated it was, would that work?

16 MR. SALEN: Your Honor, I don't know that the PTAB
17 stated a claim construction, but we certainly don't have any
18 issue with arguing the invalidity -- we don't take any point
19 -- the Defendants argued in their IPR briefing and -- in the
20 petition, and also the PTAB recognized that there are two
21 different ways to read that claim. And we don't -- we're
22 not trying to narrow a claim construction in the IPR based
23 on our infringement contentions. What we're saying --

24 THE COURT: Yeah.

25 MR. SALEN: -- is that we don't have any evidence

1 that one of those two alternatives actually occurs in the
2 products. Those to us are different things. So we're not
3 trying to narrow something -- we're not trying to narrow
4 construction. We're adjusting the way we're reading that
5 claim.

6 THE COURT: Yes. Reading your -- the way you're
7 reading a claim is a claim construction. So what's the --
8 so I need to see where in your original infringement
9 contentions there are two theories. That's where I'm
10 getting stuck, because I -- right now, I just see one
11 theory, and I don't know where the two are, and I read your
12 amendment as not just deleting, but changing. So that's why
13 I'm having trouble following that argument. And the
14 justification that you give in your motion papers for why
15 you're doing that is -- sounds very claim constructiony
16 (sic). It refers to the where -- that's all right if that's
17 an adjective -- but it refers to the wherein clause. This
18 is a term that was not construed. And when I say what the
19 PTAB assumed was the quote from the institution order that's
20 reproduced in the parties' papers where the PTAB made a
21 reference to the interpretation of sample volume stating,
22 "Both parties agree that the '921 patent
23 contemplates both embodiments where the
24 sample volume is separated into droplets
25 and those where it is not. Further, the

1 parties agree that the single-sample
2 volume is not limited to an individual
3 droplet, but rather includes any type or
4 nature of volume such as a tube or
5 bottle."

6 And so that interpretation, I'm told, derived from, at
7 least in large part, the infringement contentions that were
8 then operative at the time. And so if that interpretation
9 remains, not just in the PTAB because we have nothing to do
10 with the PTAB, but in this case, that would be one thing.
11 But your argument to me is that it can't be true because of
12 the claim language. And that's where I'm getting hung up
13 on. It sounds like a new claim construction theory.

14 MR. SALEN: Yeah. Your Honor, I think the issue
15 is I'm saying that it can't be true, not based just on the
16 claim language, but based on what the products do. So
17 there's two different theories.

18 So if there were products that Bio-Rad had that had a
19 single-sample volume, in other words they did the reaction
20 inside of a tube and then partitioned it, then we could read
21 the claim on that product based on the claim language.
22 We're not saying that the single -- right. And then the
23 single-sample volume could be that pre-partitioned part, but
24 there's no product that does that, which is something that
25 we've confirmed in discovery, so the elimination of that

1 theory is what we're saying. So I'm -- I guess -- we're not
2 trying to say that -- we're not trying to reconstrue the
3 claim or construe the claim. And if there was -- there are
4 these two theories that are sitting there, so if the
5 Defendants at some point wanted to have that as a
6 construction, they certainly knew about both theories. They
7 argued them in the IPR, they argued both theories. If they
8 thought a construction was necessary, they could have argued
9 that. We're not saying that the claim doesn't -- the claim
10 says what it says. We think plain and ordinary meaning is
11 still fine for the claim language. What we're saying is
12 through discovery, we haven't found any instances where
13 theory A exists. We've only found instances where theory B
14 exists, so we're -- and, frankly, your Honor, we're not even
15 sure that this is something that needed to be amended
16 versus --

17 THE COURT: Okay.

18 MR. SALEN: -- something that an expert could have
19 just said in their expert report, "I found evidence of B.
20 We have that theory in the infringement contentions. We
21 didn't find evidence of A, which is the pre-partitioning
22 sample." And, your Honor, I think -- so what -- the
23 cites --

24 THE COURT: So where will I find the A and B
25 alternative theories precisely? Has your colleague managed

1 to --

2 MR. SALEN: Yes. So --

3 THE COURT: -- locate that?

4 MR. SALEN: -- Mr. Gill, can you give the cite,
5 please.

6 MR. GILL: Yes, it's Exhibit 1 to docket 127.

7 THE COURT: Okay. Give me -- you know what the
8 ECF thing at the top, the ECF header at the top, so what is
9 it? Do you know what it is? 127-something.

10 MR. GILL: The version I'm -- I have is not
11 scanned.

12 THE COURT: Okay.

13 MR. WALTER: The one he's looking -- this is Derek
14 Walker.

15 The one he's looking at I think is the one that was
16 filed under seal, and it doesn't necessarily have those.

17 THE COURT: Yeah, I'm looking at one -- I'm
18 looking at the one filed under seal, which should be totally
19 complete, so it does have it. It's -- it says 127-3 sealed,
20 for example. Is that the one I should be looking at? You
21 can see it on the docket. This is how we got them.

22 Okay. Docket 127, Exhibit 1. Let's do it that way.
23 What page?

24 MR. GILL: It's PDF page 374.

25 THE COURT: Yes. Okay.

1 MR. GILL: That's claim element 1C.

2 THE COURT: 374 through the -- spanning the --
3 through 377. And then the quoted language or the language
4 that you want me to look at for alternative one, let's say,
5 where is that?

6 MR. GILL: It's on page PDF 374.

7 THE COURT: Okay. And if you could just quote the
8 language, that would be great.

9 MR. GILL: Actually, it's PDF 377, your Honor.

10 THE COURT: Oh.

11 MR. GILL: It says,

12 "For all Bio-Rad infringing GD-PCR
13 assays and kits, the detection is
14 performed in a single-sample volume that
15 is subsequently partitioned into
16 multiple droplets."

17 THE COURT: Okay. And that's the --

18 MR. GILL: That's the pre-partitioning.

19 THE COURT: Okay. Okay. So that's the one you
20 want to jettison?

21 MR. SALEN: Correct, your Honor.

22 THE COURT: Okay. And where's the other one?

23 MR. GILL: It's on PDF page 384.

24 THE COURT: 384 of the same document?

25 MR. GILL: Correct.

1 THE COURT: Okay. That part I don't have out.
2 Okay. And just a moment, let me see if I can find it in
3 the --

4 MR. GILL: And also page 385, your Honor.

5 THE COURT: And what's the -- you know where it
6 has Bio-Rad X1012 dot something? What is that reference
7 that you're looking at for page 384?

8 MR. GILL: It's 027 at the end of that stamp.

9 THE COURT: 027. Okay. If I can find it.
10 Okay. So is it something that says table 12 at the
11 top? 404 options? No?

12 MR. GILL: It's where claim element 1E starts.

13 THE COURT: Yeah. Okay. So the thing I have, it
14 doesn't match your pagination.

15 MR. GILL: PDF page 384 of the same document we
16 were just looking at.

17 THE COURT: Yeah. Okay. So I don't have that one
18 printed out because that wasn't in my chambers copies that
19 you all provided me. So it's 1C?

20 MR. GILL: 1E.

21 THE COURT: 1E?

22 MR. GILL: 1C was the first one.

23 THE COURT: Okay. So where's -- so what is the --
24 just read me out the text, and I'll find it later.

25 MR. GILL: Says -- element 1E says,

1 "The analytes are amplified in the
2 single-sample volume. For example, the
3 single sample is partitioned into
4 individual droplets."

5 And then on PDF page 385, it says,

6 "Following droplet generation, the
7 sample is amplified in a thermal
8 cyclor."

9 THE COURT: This is in your original contentions?

10 MR. GILL: Correct.

11 THE COURT: Okay. So pages 384 to 385. And
12 that's what you want to keep?

13 MR. SALEN: Yes, your Honor.

14 THE COURT: Okay. So why are we making the
15 amendments that you describe at page seven of your motion?
16 Why don't we just excise the pre-partitioning alternative
17 and just leave the one at pages 384 and 385?

18 MR. SALEN: Your Honor, we're just trying to be as
19 clear as we can about what -- how we're reading the claims
20 for expert discovery, so that there's no argument that we
21 have. And that was it. We're just trying to make sure it's
22 clear.

23 THE COURT: Okay. All right. Let me just move on
24 and -- make sure I get an answer to the question about the
25 construction. So the construction that the PTAB assumed,

1 you would be fine adopting that for purposes of anything in
2 the case? The two embodiments are within the scope. So
3 whether it's invalidity or something, I -- what we -- what
4 I'm wondering is, is there an O2 Micro problem here where
5 you're ultimately going to end up asking the jury to
6 interpret it if you don't do something in advance?

7 MR. SALEN: I mean, we think plain and ordinary
8 meaning is the right --

9 THE COURT: But that doesn't tell me anything.
10 What does plain and ordinary meaning mean?

11 MR. SALEN: Yes, your Honor, is the answer. Yes.
12 We don't have a problem with the reading of the claim the
13 way that the PTAB has done it. We're not trying to undo
14 something --

15 THE COURT: Okay.

16 MR. SALEN: -- that's been done in invalidity.
17 We're just trying to clarify how we're reading the claim for
18 the infringement based on the evidence that we've seen in
19 the case.

20 THE COURT: Okay.

21 Now, I do need to ask about the diligence issue because
22 there really wasn't anything in the opening motion that
23 allowed me to evaluate diligence. There's some discussion
24 in the reply, but I was looking for it in the motion. So
25 why are you making this amendment now? When did you learn

1 of this issue? How can I possibly find this as an amendment
2 that is diligent?

3 MR. SALEN: I guess, your Honor, our position is
4 that we've disclosed both theories at the beginning of the
5 case, and it's not uncommon for -- as Plaintiffs learn
6 through evidence and discovery about their -- about what the
7 products actually do and don't do, which discovery is still
8 not closed, and we -- it won't close until March 15th --
9 we're still getting documents. But we haven't seen any
10 evidence of -- again, of theory A, so we're trying to narrow
11 -- I mean, I think we're doing this early. We're trying to
12 be as cautious as possible about giving notice to what we're
13 trying to read, from an infringement standpoint. Like I
14 said, the wherein clause that limits the claim the way it
15 does to the reaction occurring within a single-sample volume
16 has been there. Bio-Rad has known what its products do for
17 the entire case, and we're learning that there is no
18 instance where the products do the reaction before
19 partitioning, at least we haven't seen that. So we're
20 trying to narrow or conform our infringement contentions to
21 what the evidence shows, and we're still in the middle of
22 discovery. So I guess as far as diligence goes, it's hard
23 to prove a negative. Yeah.

24 THE COURT: Well, it requires me to accept and be
25 persuaded by your argument that what you're really doing is

1 eliminating one of two already disclosed infringement
2 theories based on the evidence, as opposed to changing your
3 interpretation of the claim. That's what it really requires
4 me to do, right? You agree?

5 MR. SALEN: Yes, your Honor, I agree with that.

6 THE COURT: Okay.

7 MR. SALEN: And that -- that's what we're saying
8 has happened.

9 THE COURT: Okay. Let's move on to the coding
10 tables issue. Again, which patent and which claims does
11 this amendment implicate?

12 MR. SALEN: So this is also the '921 -- all the
13 claims.

14 THE COURT: So all of the amendments or just the
15 '921? Apart from the Bates number issue.

16 MR. SALEN: And this one is also the '170, yeah.

17 THE COURT: Oh, the '170 also. Okay. All right.

18 And here, the argument is -- as I understand it -- is
19 that the Plaintiffs are trying to eliminate an inconsistency
20 in their infringement theories. Specifically, I'm told that
21 you wish to correct the exemplary coding table used to
22 normalize decimals instead of integers, clarifying the non-
23 degenerate aspect of the exemplary coding tables. What I
24 don't understand still, even having read through all this
25 material, is where did these coding tables come from?

1 MR. SALEN: They were -- they're just a way of
2 describing what the evidence shows. They weren't -- so the
3 evidence are what are called cluster plots or chromatograms.
4 They show signals in two axes where clusters of droplet
5 signals -- and you can see droplets at, you know, one
6 intensity level and then maybe at another intensity level,
7 and you can see that on two axes (indiscernible) clusters.
8 That's what the actual evidence shows. That's what the
9 documents show. What we were trying to do in the
10 infringement contentions is just to be helpful to -- just
11 instead of describing with words what those show, we were
12 trying to describe with a table showing how -- what --
13 basically converting what's in the chromatogram, what is in
14 that cluster plot to numbers in a table to make it very
15 clear what we were trying to accuse. And what we learned is
16 that we didn't describe the chromatograms properly. The
17 chromatograms show levels that are distinguished and that
18 were -- we had at number one, and really the level of the
19 cluster -- the center of the cluster was lower than one. It
20 was at, say, 0.8. So what we did is we went and we fixed
21 that.

22 THE COURT: Can I ask a question about that? So
23 I'm still hung up on, "We're describing what the evidence
24 shows." So the little cluster diagram, that comes from
25 somebody's document -- that comes from Bio-Rad's document --

1 MR. SALEN: That's correct.

2 THE COURT: -- right? The coding table does not
3 come from any document.

4 MR. SALEN: Correct.

5 THE COURT: So how is it a description of what the
6 -- what evidence does it describe?

7 MR. SALEN: It's describing the -- so you take the
8 center point of those clusters that are in the diagram, it
9 describes where that center point is in a numeric level -- a
10 numeric value.

11 THE COURT: I mean, are these numbers just kind of
12 made up, or was there like some calculation that's done?

13 MR. SALEN: It was -- they're not made up.
14 They're done visually by looking at the -- so if you look at
15 the cluster, there's a center in the cluster that -- and an
16 axis that has numbers on it. And we basically normalized
17 the scale. So if there -- so if there's like a scale of
18 like 2,000, like -- and there's one point at 1,000, one
19 point at 2,000, the point at 1,000 would have been one. The
20 point at 2,000 would have been two.

21 THE COURT: Okay.

22 MR. SALEN: And what happened is some of -- on the
23 cluster plots, there's 200 -- or like 800 instead of 1,000
24 was where the center of the cluster was. We had described
25 it as one originally. I'm saying that's not really one,

1 that's really 0.8. That's -- right, because -- if you
2 normalized it to the correct rate to the 2,000.

3 THE COURT: So who did the eyeballing? Your
4 expert?

5 MR. SALEN: Well, your Honor, our attorneys and
6 experts working together, yeah.

7 THE COURT: Okay. Because it -- I mean, it sort
8 of sounds like you figured out that what you did described
9 something that wouldn't infringe, and so then you did
10 something else that describe something that would infringe.
11 Is that fair?

12 MR. SALEN: I think it -- I don't think that's the
13 reasoning for it. The reason is because the way we had
14 described it just wasn't accurate, and we fixed that issue
15 to show. But if you read the words -- so the evidence is a
16 chromatogram. And if you read how we described it, we
17 described those cluster plots as showing a non-degenerate
18 encoding scheme. So the description -- so one option, I
19 guess, would be just to delete the coding tables completely,
20 right? We don't necessarily need those. That was just an
21 attempt to --

22 THE COURT: Yeah.

23 MR. SALEN: -- help describe or --

24 THE COURT: Okay.

25 MR. SALEN: Right, color what's in the -- what's

1 in the tables in the evidence.

2 So we tried to make them look more accurate. Another
3 option would be just to delete them in their entirety and
4 let the experts discuss what they -- what's in the tables.
5 But we're trying to give notice to the Defendants on how
6 we're reading the chromatograms, and there was an error.
7 That was as simple as that.

8 THE COURT: For how many of the accused
9 instrumentalities was this error made, all of them? So like
10 across the board?

11 MR. SALEN: There's, I believe, just one -- like a
12 -- yeah, but there's one -- I mean, there's not like a lot
13 of them. There's like a manual for how the software that
14 we're accusing works. The software works in -- on three
15 different digital PCR systems. It's the same software,
16 though, so it's the same user manual, the same references.
17 So yeah -- so it was across -- it was across the board, but
18 it was basically based on one set of evidence.

19 THE COURT: Okay. Isn't coding scheme an element
20 of the -- like, don't you have -- actually have to
21 disclose --

22 MR. SALEN: Yes.

23 THE COURT: What -- so I'm reacting to your
24 proposal, you could just delete this chart.

25 MR. SALEN: Yeah.

1 THE COURT: But isn't -- don't you have to show
2 that element, the coding scheme?

3 MR. SALEN: Yes. We're trying to explain what the
4 chromatograms do. That's the coding schemes in the
5 chromatograms themselves. The software creates the
6 chromatogram. So when we're accusing it of infringing and
7 mapping it to the claim --

8 THE COURT: I see.

9 MR. SALEN: -- it's in the chromatogram.

10 THE COURT: So you're saying the chromatogram
11 reflects the coding scheme?

12 MR. SALEN: Yes.

13 THE COURT: Okay. And does the manual say how a
14 user is to code? Because you could -- I could imagine, not
15 knowing anything about this technology, that someone who's
16 actually using these assays would be like, "It's going to be
17 really hard to distinguish between 0.8 and 0.9, so I'm just
18 going to call that one," right?

19 MR. SALEN: Yeah.

20 THE COURT: So --

21 MR. SALEN: Yes, the manual talks about creating
22 levels and thresholds for -- and there's lines that are
23 drawn in the chart -- in the chromatograms themselves that
24 show you where the -- these clusters either fall over a
25 threshold or under a threshold. So you set those

1 pictorially using a thresholding, and it'll show you a line
2 in the chromatogram when it's printed, and you can see where
3 the cluster then falls --

4 THE COURT: So is your --

5 MR. SALEN: -- either above the line or below it.

6 THE COURT: Is your proposed amendment intended to
7 reflect -- I mean, this is a system -- or a thing claim.
8 It's not a method, but --

9 MR. SALEN: No, it's a method.

10 THE COURT: The '071. Or is it also in the --
11 let's see --

12 MR. SALEN: The '170 is a method. The --

13 THE COURT: '170. But the --

14 MR. SALEN: Yeah, the '921 --

15 THE COURT: Is an assay.

16 MR. SALEN: Assay. So, basically, test.

17 THE COURT: Okay.

18 MR. SALEN: But the crux of the test is a method
19 of performing the test that's -- so the test, it reads like
20 a method claim.

21 THE COURT: So are you -- is your contention that
22 this is how the method is performed? Is that what your
23 amendment is -- so I'm just trying to understand, like, the
24 coding scheme is, like, this is the coding scheme that's
25 used or this is a coding scheme that could be used? I mean,

1 what is the contention exactly?

2 MR. SALEN: The contention is that the way the
3 chromatogram is coded is -- we're just trying to describe it
4 using numbers, and that was -- it --

5 THE COURT: Okay.

6 MR. SALEN: -- so the actual method that we're
7 accusing is in the chromatogram plot itself and how the
8 thresholding is done in that chromatogram.

9 THE COURT: Okay.

10 MR. SALEN: And that's what's explained in the
11 text of the -- and nothing is changed in the text. You
12 know, that's what's explained in the text.

13 THE COURT: But you just told me the text says --
14 I mean the text of your contentions.

15 MR. SALEN: Yeah, yeah, yeah.

16 THE COURT: The text of the manual says
17 (indiscernible) levels.

18 MR. SALEN: Right, yes. And we explain that --
19 right, that's what the manual says. That's what we're
20 accusing is that chromatogram and the leveling or
21 thresholding in the chromatogram to create the different --

22 THE COURT: Okay.

23 MR. SALEN: -- levels, yeah.

24 THE COURT: So -- okay. The question of diligence
25 again comes up here. And it wasn't clear to me when --

1 let's say it's an error in describing the chromatogram using
2 the coding tables with integers. When did you figure out
3 this error?

4 MR. SALEN: We figured it out when we were going
5 through to make the other amendment on the single-sample
6 volume, and we found this error as well. So that -- so
7 when --

8 THE COURT: And where is that?

9 MR. SALEN: -- we started doing that -- so --
10 that's not in the brief, your Honor.

11 THE COURT: Yeah. So there's no description of
12 how, when, why this change was made in the brief?

13 MR. SALEN: Right. And, your Honor, I guess our
14 argument is that we disclosed our theory in our original
15 infringement contentions again in text and using the
16 chromatograms, and the aid of this -- these tables was
17 simply to try to describe something. And when we discovered
18 we had described it incorrectly, we fixed it. But -- and I
19 understand that that --

20 THE COURT: Yeah.

21 MR. SALEN: -- part wasn't in the brief.

22 THE COURT: So how do you respond to the
23 Defendant's argument that had they known this was what you
24 were going to contend, there might have been a claim
25 construction argument they would wish to make or some

1 invalidity theory that they might wish to pursue? And it
2 doesn't matter that discovery remains open, right? It's
3 still -- the delta between the time of the original
4 contentions and now and the -- you know, if it's a change in
5 a theory of infringement, it can have implications, even if
6 it's a change in an explanation of the basis for the theory
7 of your infringement. So how do you respond to the
8 prejudice argument?

9 MR. SALEN: Yeah, I think a couple of ways, your
10 Honor. One, the evidence of infringement hasn't changed and
11 what we're accusing hasn't changed -- they're in those
12 chromatograms. So if they think there's an issue with --
13 that we're trying to accuse a chromatogram where it's
14 impossible to distinguish between two levels, they've known
15 about this since we gave them our infringement contentions
16 and showed them the chromatogram that we're accusing and
17 described it. We described it as being non-degenerate.
18 There's never been a -- there's never been an argument that
19 the -- about the claims requiring non-degenerate coding
20 schemes. That's always been the case. What we're saying is
21 that we -- that we're accusing a chromatogram that we're
22 saying shows a non-degenerate encoding scheme. We had an
23 error in how we described it using the -- that coding table,
24 but not how we described it using the text and the
25 infringement contentions that -- where we explained that

1 it's a non-degenerate coding scheme, that we said that the
2 evidence is from the chromatogram, that it's the leveling
3 that the -- and the thresholding that you do in a
4 chromatogram that creates a coding table. That's how the
5 product works. And to the extent that we found an error,
6 we've, you know, corrected it. We don't think it raises a
7 claim construction issue because they've had the evidence,
8 they know that, you know, non-degenerate or degeneracy was a
9 claim construction term that has been construed by the Court
10 now, so we have a construction on that, so we've had to
11 argue over what that means, and we got the construction from
12 the Court now on that, and we've made --

13 THE COURT: But you're not making the change
14 because of that construction because your construction was
15 adopted, right?

16 MR. SALEN: That's correct. Yeah. We're not
17 saying that that's what prompted the change, but the point
18 is the parties got to litigate what the term means.

19 THE COURT: But this issue didn't come up, the
20 difference between integers and decimals, in claim
21 construction, did it?

22 MR. SALEN: No, your Honor. But there's no -- I -
23 - yeah, that's the description of what's shown in the
24 chromatogram I guess is the point.

25 THE COURT: Okay.

1 MR. SALEN: So if the -- yeah, the chromatogram
2 doesn't show an integer or they think that it didn't show an
3 integer and they want a construction --

4 THE COURT: It just shows what it shows. It shows
5 things plotted.

6 MR. SALEN: It shows what it shows, yeah.

7 THE COURT: Okay. All right.

8 And what about possible invalidity theories that could
9 have been generated but were not because the theory had
10 always been, "We describe what's going on using integers,"
11 so all the prior art that was explored had to do with
12 integers for the coding scheme.

13 MR. SALEN: Your Honor, I'm not aware of any prior
14 art issue that talks about -- where the -- where there's a
15 coding scheme that looks like our table anyway or one way or
16 the other. There's not -- there's never been an argument
17 made that it's because there are integers in the table that
18 the prior art's reading on whether or not there's a
19 degenerate or non-degenerate encoding scheme. That's the
20 issue, and that's -- the prior art at issue is what we've --
21 in the entire case has had nothing to do with whether or not
22 those are integers or not. And I think the argument that
23 Bio-Rad has advanced as to why there's potentially a
24 validity issue is based more on enablement, not on prior
25 art. And they're saying, "Well, it's impossible or may not

1 be possible to distinguish between 0.8 and 0.9 or point" --
2 and that creates an enablement issue. And the response to
3 that is, we're not trying to distinguish between 0.8 and 0.9
4 in a coding table that we showed you as a representation of
5 what's in the chromatogram. We're trying to distinguish
6 between the actual levels that are in that picture that
7 we're saying you can distinguish between. And if when we've
8 said that in a text and we showed them the chromatogram, if
9 they think that there's an enablement problem, I mean their
10 product does this, so that -- I guess that's another issue
11 we're accusing the product of doing it, but I don't think
12 that it -- the enablement issue could have been brought up
13 already, and also as a preserve, they can still make that
14 enablement argument, so --

15 THE COURT: I mean -- look, to be candid, I mean
16 that doesn't strike me as very persuasive because -- let's
17 just focus on enablement. If you have integers, that's one
18 thing. If you have, like, fine discriminations between
19 decimal points that are separated by, you know, 0.1, that's
20 another. So for -- if it's just integers and it's the same
21 integer, then it would be easy to say, "Okay. You can't
22 distinguish between those two things that have the same
23 integer." And now it's decimals. So now can you -- can't
24 you? I mean, it seems like it's a different question that's
25 posed, even if we focus only on enablement. So I just don't

1 see how you can say it doesn't change anything, that they've
2 always known, right? I mean, the whole way that -- if it is
3 a method in both patents, essentially, then your whole
4 description of what constitutes an infringing method has
5 changed.

6 MR. SALEN: Your Honor, respectfully, I think the
7 issue is that it hasn't changed. The issue is that the
8 chromatogram itself is -- that, first of all, this is an
9 attempt to explain what's there. So you want to take
10 integers as one or 0.8, we can make them 100 and 80 or --

11 THE COURT: No, that -- I understand --

12 MR. SALEN: We -- the point -- no, I'm just saying
13 -- like, that's what we put in there, and only to try to
14 explain what --

15 THE COURT: Okay.

16 MR. SALEN: -- the chromatogram is showing. There
17 is a scale in the chromatogram. It's not one or 0.8. We
18 normalized that.

19 THE COURT: Sure.

20 MR. SALEN: It's in the thousands, right? There's
21 a signal that's in the thousands. And you can see the --
22 the clusters are. And the experts can certainly argue one
23 way or the other, "I can distinguish this cluster from this
24 cluster level, or I can't."

25 THE COURT: And you're saying you can make the

1 same argument whether we describe the coding scheme as ones
2 and zeros or as decimal points?

3 MR. SALEN: Could delete that table completely and
4 just use the words that are in the infringement contention
5 where we say, "Hey, the chromatogram shows infringement. It
6 shows a non-degenerate" --

7 THE COURT: Okay.

8 MR. SALEN: -- "encoding scheme because you can
9 level these things and set thresholds. The Bio-Rad device
10 lets you do that, and you can distinguish between the two
11 levels in that Bio-Rad device, and that's what the
12 chromatogram shows." So regardless of what's in that
13 attempt to describe it and what scale you use, whether it's
14 one and 0.8 or 100 and 80 or 1,000 and 800, you can
15 distinguish, because if you look at the picture, there's a
16 threshold and we can -- and we can say -- you can
17 distinguish between the cluster on the top and the cluster
18 that's below it. And that's what an -- and if an expert
19 disagrees with us, that theory has been there for them since
20 we submitted our infringement contentions in March of 20 --
21 was it 2024 or whenever the original contentions were
22 submitted.

23 THE COURT: Okay. All right. Let me move on to
24 the accused assays, the new instrumentalities that are to be
25 added.

1 Again, which patents and which claims?

2 MR. SALEN: '921, right?

3 MR. GILL: And '170.

4 MR. SALEN: '170.

5 THE COURT: '921 and '170?

6 MR. SALEN: Yeah.

7 THE COURT: Okay. And there are three assays that
8 are proposed to be added, two from Verily -- is that how you
9 say it?

10 MR. SALEN: That's correct.

11 THE COURT: Verily.

12 MR. SALEN: Yeah.

13 THE COURT: And then one, the Bio-Rad assay 3542.

14 So let me start with the Bio-Rad assay 3542. So,
15 again, there's not a description of the diligence aspect of
16 this in the motion papers, but I discerned from the reply
17 that the Plaintiff's argument is that there was an
18 interrogatory that would have required Bio-Rad to answer
19 identifying this 354 (sic) assay, but it did not. But at
20 the same time, it -- the allegations or the infringement
21 contentions are based on public information available about
22 this kit that is accused. So in accusing the kit, did you
23 not already accuse the assay?

24 MR. SALEN: We did, your Honor.

25 THE COURT: Okay. So is it just changing the

1 label, or is this assay used separately from the kit?

2 MR. SALEN: No, it -- it's just being more precise
3 in making sure we've accused all -- the product numbers the
4 way that Bio-Rad uses them as we've learned about it. So --

5 THE COURT: So the assay is within the kit and
6 only within the kit? It's not separate?

7 MR. SALEN: The assay is part of the kit.

8 THE COURT: Only. Like, it's only as part of this
9 kit?

10 MR. SALEN: The answer is yes, we believe so, as
11 part of the -- as part of this COVID test --

12 THE COURT: Okay.

13 MR. SALEN: -- and that assay is run as part of
14 the COVID test kit.

15 THE COURT: Okay.

16 MR. SALEN: I don't know that we have discovery
17 that -- so I don't want to misrepresent --

18 THE COURT: Yeah.

19 MR. SALEN: I don't know 100-percent for sure, but
20 from what we've seen, it's part of the -- part of the kit.

21 THE COURT: So when the original contentions were
22 filed accusing the kit --

23 MR. SALEN: Yeah.

24 THE COURT: -- were there contentions about an
25 assay within the kit?

1 MR. SALEN: No, your Honor. There -- no, not
2 about assay. I mean, the kit has assays in it, so we were
3 accusing the kit based on the product number. I guess I'm a
4 little -- like, there is an -- the assay is a test, and the
5 way we accused the kit, we accused the test that's
6 described.

7 THE COURT: Yeah, I know an assay --

8 MR. SALEN: Yeah.

9 THE COURT: -- is a test.

10 MR. SALEN: Yeah.

11 THE COURT: So if this test is within the kit --

12 MR. SALEN: Yeah.

13 THE COURT: -- and you say you've already accused
14 the kit --

15 MR. SALEN: Yeah.

16 THE COURT: -- here's where I'm getting hung,
17 "We've implicitly already accused this thing that we're now
18 explicitly accusing." So in order to do your infringement
19 contentions, you had to identify some tests -- some assay
20 that met the limitations of whatever claim it is. In that
21 kit, which assay were you accusing?

22 MR. SALEN: So the answer is the one that was --
23 the way the kit was described and the documentation we have
24 for the kit is the same -- is the same way that the assay
25 itself is described.

1 THE COURT: So it's the same assay? So the --

2 MR. SALEN: Yeah. Yeah. We understand it to be
3 the same, yes.

4 THE COURT: Okay. So all you're doing is saying,
5 "That assay that we accused in this kit, which we've already
6 done infringement contentions for, is also called assay
7 3542"?

8 MR. SALEN: Yes, your Honor. And even to take a
9 step back from there, because I think we're hung up in the
10 weeds on numbers a little bit, but nothing has changed in
11 the way we're accusing any of these things. The Bio-Rad
12 manual describes itself at a high level how to do all of
13 these tests and the multiplexing tests. And there -- and
14 what we've been doing is identifying specific test numbers
15 that actually do the thing we've already accused. It's the
16 method that's been -- so the method of running these tests
17 has already been accused. That theory has been explained.
18 We're not changing that theory. We're not -- right, the
19 same thing with the Verily assays.

20 THE COURT: Right. But one could say what you're
21 doing is expanding the case to include assays that you
22 should have known about but you didn't. And that's what I'm
23 -- that's why I'm hammering on this, because if you already
24 actually accused this assay -- you just called it something
25 else, the assay within this COVID kit -- that's one thing.

1 If it's like, "Oh, now there's a new -- there's another
2 assay that we didn't accuse, and we're now adding it to the
3 mix," of course that has implications for the rest of the
4 case. Maybe that's fine. Maybe it's just damages or
5 whatever, but that's what I'm trying to sort out, is this a
6 standalone assay that is being added or is it renaming
7 something that you've already accused?

8 MR. SALEN: From our perspective, it's renaming
9 something we've already accused.

10 THE COURT: Okay. And when did you learn that
11 this was -- you learn of the existence of this assay?

12 MR. SALEN: The number for it? The --

13 THE COURT: That you --

14 MR. SALEN: Yeah, yeah --

15 THE COURT: I mean, I'm not sure why you're -- why
16 we're doing what we're doing, but, nevertheless, when did
17 you learn that you had a thing to change?

18 MR. SALEN: So the -- during our review of
19 documents that -- and I understand this is publicly
20 available, so that's --

21 THE COURT: Okay.

22 MR. SALEN: Right. I'm not trying to -- but,
23 yeah, we learned about it during our review of documents,
24 that it's part of the same test kit we've already accused.

25 THE COURT: So -- okay. So it was public

1 information. You just looked at it again and said, "Oh, it
2 says 3542 assay on it." Is that what happened?

3 MR. SALEN: Yeah, that's -- not in the public
4 information, your Honor. In our documents that we received
5 from Bio-Rad. We looked at it as we were going through our
6 review and realized it. But I agree in retrospect that it -
7 - we could have identified the number earlier and we
8 didn't --

9 THE COURT: Okay.

10 MR. SALEN: -- but we had already accused the
11 test.

12 THE COURT: And when did you have the basis to
13 identify the number? That's what I'm trying to figure out
14 from the record.

15 MR. SALEN: Yeah, I don't know the exact date. It
16 was after we received documents from Bio-Rad. It's probably
17 sometime in the January or March time frame.

18 THE COURT: January of 2025?

19 MR. SALEN: Yeah.

20 THE COURT: Okay.

21 MR. SALEN: And I apologize, I -- that's what --
22 that's my best estimate.

23 THE COURT: All right. Let me just look real
24 quick.

25 MR. SALEN: But, again, nothing has changed from

1 what we're accusing.

2 THE COURT: I understand that argument.

3 Okay. Your reply says March 2025 --

4 MR. SALEN: Yeah.

5 THE COURT: -- after some third-party discovery
6 from some third-party, Biodesix.

7 MR. SALEN: Oh, bio -- yeah. Sorry, your Honor.
8 That -- I guess that -- I think that -- that's --

9 THE COURT: How did you discover that that entity
10 was practicing this assay?

11 MR. SALEN: Through documents that we subpoenaed
12 from Biodesix.

13 THE COURT: And it had the --

14 MR. SALEN: The numbering --

15 THE COURT: -- assay number on it --

16 MR. SALEN: That's correct.

17 THE COURT: -- as part of this kit?

18 MR. SALEN: We realized it's part of a kit. I
19 think it was -- it was identified by the assay number, not
20 the kit number in the documents we got from Biodesix. And
21 we --

22 THE COURT: But it was as part of the kit --

23 MR. SALEN: Yes, that's correct.

24 THE COURT: -- that they were using it? Okay.

25 All right. Thank you for clarifying that.

1 Okay. And now let's turn to the Verily assays. So
2 that is disclosed as you discovered these assays in January
3 of 2025 and perhaps even had the documents earlier, but for
4 whatever reason, January 2025 is the date where you figured
5 out that these two assays -- now, how do these two assays
6 differ, if they do, from any of the other assays that you've
7 accused?

8 MR. SALEN: Practically, they don't, your Honor.
9 They're -- they do the same things, and the way we're
10 accusing them is the same. We're just adding additional
11 uses of the Bio-Rad instrument that we're discovering
12 through third-party discovery.

13 THE COURT: Okay. So --

14 MR. SALEN: I think that's important, your Honor.
15 Just -- if I --

16 THE COURT: And, no, I understand the argument
17 that they're the same infringement theories --

18 MR. SALEN: Yeah.

19 THE COURT: -- right? But --

20 MR. SALEN: But can I -- I'm sorry.

21 THE COURT: Sure, go ahead.

22 MR. SALEN: I don't want to interrupt --

23 THE COURT: No, no, it's okay.

24 MR. SALEN: -- but I just wanted to just level set
25 -- because there's -- we're accusing for the '170 patent and

1 the '921 patent, and the '051, but for those two patents in
2 particular, because we're accusing -- we have an indirect
3 infringement theory. The indirect infringement is the
4 method of using a Bio-Rad device. Nothing is changed with
5 that. The Bio-Rad devices, there's three of them that would
6 be multiplexing. There's a QX600, the QX200, and the QX
7 ONE. Those devices can do both multiplexing and run these
8 assays, and they also have operational modes where they
9 don't do multiplexing, where they're using a single plex,
10 right? And because of that and because it's important for
11 us to understand the level to which these things are used,
12 and then indirect infringement is being done, we've been
13 subpoenaing third parties, we've been looking to find out
14 how many tests are actually run on these devices and how
15 much they're actually used to do the multiplexing. That's
16 the focus of the discovery. But none of these things are
17 different or deviate from the infringement theory or the way
18 the device itself describes the method of using it to run
19 multiplexing.

20 So as we add new assays as we found them in third-party
21 discovery, we don't think that there's anything there that's
22 groundbreaking or, you know, that the Defendant doesn't
23 already know about or understand how we're accusing it.
24 These are just things that we -- we've discovered that it's
25 used more, right, the infringement is a higher level. So

1 that's the point of the discovery. And, yes, the Verily
2 assays practice the method, the accused method, the same way
3 that any of the other assays we've already accused practice
4 the accused method. They're the same types of multiplexing
5 tests. So --

6 THE COURT: Okay. But the way this is supposed to
7 work under the patent local rules is that once you identify
8 a basis to amend, you're supposed to, first of all, be
9 diligent in doing that, and I don't know whether you have
10 been in seeking third-party discovery. But once you
11 identify, you're supposed to be diligent in seeking
12 amendments. It's two parts. And it's, like, really hard to
13 understand -- you know, you're arguing to me about the
14 prejudice part. You're saying there's absolutely no
15 prejudice, but it's really hard to get past the diligence
16 part, based on these facts.

17 MR. SALEN: Your Honor, I understand. I think the
18 biggest thing with Verily is we were really hoping to get a
19 -- we really thought we needed to depose them to understand
20 more about how the test work. We still haven't had that
21 deposition.

22 THE COURT: Why would you need to understand how
23 the tests worked if you're just telling me that it's exactly
24 the same as all the other tests? Like, so --

25 MR. SALEN: That's what we're accusing, your

1 Honor. We haven't had a chance to talk to Verily about it,
2 so -- and there -- and we want to make sure that -- we
3 wanted to confirm that that's how they were -- and complete
4 our discovery diligence. So we had documents we wanted to
5 ask an -- someone at Verily that knew how they were using
6 the test -- how they were using the QX600 to run these tests
7 on wastewater samples, to understand how that assay was
8 actually being implemented. The document shows something
9 that we think looks pretty close and -- but we wanted to get
10 more evidence of that through deposition. And when we
11 finally realized we weren't going to get a deposition in a
12 timely manner, we went ahead and just tried to amend anyway
13 to be -- you know, to preempt it based on what we do know.
14 But that was the point, we're still trying to get discovery
15 of Verily. And the --

16 THE COURT: But your contentions are based on
17 documents that you've had for a while.

18 MR. SALEN: They -- they're -- right now, they
19 are, and they will be -- hopefully, we confirm that through
20 the deposition testimony that we're expecting to get on
21 October 6.

22 THE COURT: Okay. And then the last category was
23 Bates numbers. And, fortunately, there's no dispute about
24 that, so we don't need to debate it.

25 I've asked you the questions that I wanted to ask based

1 on the briefing, but I want to give you an opportunity to
2 argue anything that you would like. I'll also give you a
3 chance to respond after --

4 MR. SALEN: Sure.

5 THE COURT: -- I've talked to Mr. Walter.

6 MR. SALEN: Sure. Thank you, your Honor.

7 I think just the follow-up point is I -- from our
8 perspective -- and I know there's been a lot of talk about
9 diligence and a lot of talk -- and trying to understand
10 that. And I guess, from our point of view, these are
11 refinements to our infringement contentions that we're
12 trying to make to be extra diligent and extra cautious.
13 These are things that -- each of these are things that were
14 disclosed -- at least the theories of which were disclosed
15 in our original infringement contentions. And, generally,
16 these are the types of changes that an expert might make
17 during expert discovery as they refine the theory based on
18 evidence and try to map infringement contentions that are
19 based on the infringement contentions to the evidence.
20 We've been, in our view, trying to give extra notice to Bio-
21 Rad and be ahead of the game, ahead of expert discovery,
22 make sure that we've given them every opportunity. We've
23 eliminated one theory of infringement with respect to the
24 small sample or single-sample volume. We've clarified
25 basically what is a typographical error in the coding table

1 descriptions, but haven't changed how we've accused the
2 chromatograms. Just -- those are still the evidence that
3 we're accusing, and we've been adding names for the assays
4 that we discovered that actually practice the accused
5 methods, although our theory hasn't changed. And I think
6 the -- we've cited several cases in our brief, and I -- that
7 say the adding -- when you don't change your theory and
8 you're simply adding products that are the same -- do the
9 same thing in the same way, that that's generally acceptable
10 under an amendment like we've done here, so -- even in the
11 Northern District.

12 THE COURT: Okay. Thank you. That's helpful.

13 Let me turn to Bio-Rad. And I would like to start with
14 the single-sample volume issue. And the -- as you under --
15 as you know, I'm trying to understand, like, what is the
16 "it" that's being changed, and I'm happy to hear from you on
17 that point. But I'm also interested in knowing Bio-Rad's
18 view of the question I posed to Plaintiff's counsel, which
19 is, if the principal concern is the impact on invalidity
20 arguments and claim construction, if there's a stipulation
21 that the claim is -- claim term is broad enough to encompass
22 both -- whatever was described to the PTAB as the parties',
23 you know, positions, both embodiments, why would there be
24 any prejudice?

25 MR. WALTER: Right.

1 THE COURT: So I'm interested in both those
2 things.

3 MR. WALTER: Okay. So let me take the first
4 question.

5 THE COURT: And can you speak into the microphone,
6 so I can -- or move it a little closer to you?

7 MR. WALTER: Let me move a little closer.

8 THE COURT: Thank you.

9 MR. WALTER: Let me take the first question, which
10 is what the "it" is. And I think if you look at page two of
11 their reply brief --

12 THE COURT: Okay.

13 MR. WALTER: -- this answers the question. What
14 they state there is,

15 "Indeed, Plaintiff's original
16 infringement contentions included
17 alternative interpretations of 'single-
18 sample volume,' a narrower one in which
19 the single-sample volume reads in a
20 droplet and a broader one in which the
21 single-sample volume is the solution
22 before being partitioned into droplets."

23 Okay. So -- you know, the question is, is this just a
24 change in the theory of what's being accused, or is it a
25 changing of the interpretation? We know from this that this

1 is a change in the interpretation. It's a change in the
2 construction of the claims, because we're talking about how
3 single-sample volume is interpreted. They originally
4 interpret it broadly. Now they want to whack the portions
5 of their contentions that have that broad interpretation and
6 go to the narrower one.

7 And so that is a change in the interpretation. So that
8 -- I think that does answer the question of what the "it"
9 is. It's not just the change in theory, it's a change in
10 how the claims are interpreted. And that would be a problem
11 for us for a whole host of reasons. We identified the
12 prejudice. The prejudice that you've looked at is the
13 prejudice in the IPR. That is -- you're right, that is a
14 big concern. We did an anticipation theory in an IPR based
15 on this interpretation, which they acknowledge was there.
16 And, you know, the concern for us -- we're at the point now
17 where the IPR is near an end. We can't do an IPR anymore,
18 okay? This is half of our IPR. It's an important part of
19 our case. The IPR is nearing an end. They have one more
20 paper, and then we have oral argument. That's where we're
21 at on IPR. The concern for us is that they'll be allowed to
22 narrow their interpretation, then they'll go running off to
23 the PTAB and say, "Hey, look, they presented this theory
24 based on this broad interpretation that was in our
25 infringement contentions, but the district court has just

1 let us narrow it. So they've blessed that narrowing, and so
2 that theory, that anticipation theory that was previously
3 presented based on the broad interpretation, you don't need
4 to look at that anymore because we've narrowed it." And so
5 that is a concern for us.

6 Okay. So now to your Honor's question, I think that
7 sort of a stipulation, that would help. That would help a
8 lot. That would go a long way. I don't think it's perfect
9 because, as Mr. Salen acknowledged, the Board didn't issue a
10 construction on that term. Okay.

11 THE COURT: Just made an assumption about or
12 described the interpretation that both parties seem to
13 share.

14 MR. WALTER: Yeah. And that was coming from the
15 infringement contention. So there's a little bit of
16 ambiguity. And like I said, it would help a lot. That
17 would be better than nothing. That would be better than
18 allowing them to amend and they can run off to the PTAB and
19 say, "Hey, look, our narrowing amendments have been
20 blessed." So that would help a lot, but it wouldn't remove
21 our concerns because there is some ambiguity. And I think
22 there was a good likelihood that when we got to the oral
23 argument, they would say, "Okay. What does this really
24 mean?" And I think there would be some backsliding on what
25 it really means. And that -- so that's what I would be

1 concerned about in that regard.

2 So that would be my response to the question you just
3 asked. I'm happy to take follow-up questions on that point.

4 THE COURT: Yeah. I mean, this is a very strange
5 scenario because, you know, my concern is not the IPR per
6 se. I recognize the prejudice argument based on the IPR, so
7 I'm not saying I'm ignoring that, but claim construction is
8 not my concern per se, right? That's Judge Lee's concern.
9 So the fact that the parties are using this proceeding
10 before me to kind of debate and contest the significance for
11 claim construction, not only here, but before the PTAB is a
12 little strange --

13 MR. WALTER: Right.

14 THE COURT: -- you know, in terms of should that
15 influence what I do, should that not influence what I do? I
16 do agree that the way that the Plaintiffs have described
17 what they are doing is literally, "We have a narrower
18 interpretation of this claim than -- we are adopting a
19 narrower interpretation to inform our infringement
20 contentions than what we had before or choosing the narrower
21 interpretation." So it is an interpretation of the claim
22 that is sort of the premise for the alternative infringement
23 theory. That's true. So this really only comes up in
24 evaluating prejudice, because I think you all may have a
25 problem because before the PTAB and before this Court, there

1 still is an answer about what does this claim mean? What
2 does this claim term mean? What is the correct
3 construction? And if that's still a question mark, that's a
4 problem, right? And I can't -- I'm not trying to engineer
5 an answer to that question. I'm just trying to understand
6 the prejudice implications of it, so --

7 MR. WALTER: Right. So let me try to address that
8 as best I can. Right now, there -- there's not a problem.
9 They have the broader interpretation. We've advanced a
10 theory based on the broader interpretation. The problem
11 only arises to the extent they're permitted to withdraw that
12 interpretation on their contentions. And the reason we have
13 a problem if they're allowed to do that is because then we
14 do have the O2 Micro issue that your Honor (indiscernible).
15 Okay.

16 And the reason that's a problem is because we would
17 have then at that point need to consider going back to Judge
18 Lee and asking to reopen claim construction. Now --

19 THE COURT: I think you have an O2 Micro problem
20 no matter what --

21 MR. WALTER: Well --

22 THE COURT: -- because if the idea is, "Well, our
23 experts are going to argue about it," well, you're just
24 going to be right back here.

25 MR. WALTER: Well, I think the issue is --

1 THE COURT: Well, not here, but right back with
2 this problem.

3 MR. WALTER: We may or we may not. And I -- and
4 the reason I say we may not is because if we're able to win
5 the IPR, then that patent won't be -- in all likelihood,
6 that patent won't be presented at trial because it'll be
7 held invalid. So then that problem would go away.

8 So there is -- you're right, there is a scenario where
9 we lose the IPR and then we do have to address it with Judge
10 Lee. But one thing is for sure -- you know, and -- I should
11 take that back. Even in the scenario where we lose the IPR,
12 remember it will be a stop --

13 THE COURT: Right.

14 MR. WALTER: -- from challenging validity. And so
15 this issue might go away even in that circumstance.

16 THE COURT: But you'll still have a claim
17 construction problem unless the PTAB says something, right?
18 And then -- I mean, you'll still have a claim construction
19 problem, but at least that will inform the interpretation.

20 MR. WALTER: We might not because, you know, I
21 think the reality is that the parties wouldn't be raising a
22 claim construction issue with the judge unless it's relevant
23 to an issue in the case.

24 THE COURT: I see.

25 MR. WALTER: And so --

1 THE COURT: Okay.

2 MR. WALTER: -- you know, if we get a decision
3 from the PTAB, it might not end up being relevant to an
4 issue in the case.

5 THE COURT: I see.

6 MR. WALTER: Now, one thing we do know is that if
7 they're granted permission to amend, then there will be an
8 issue because we'll have this concern about them going to
9 the PTAB and saying, "Hey," their narrower construction has
10 been blessed when that couldn't be further from the truth
11 because we haven't had an opportunity to address the issue
12 before Judge Lee. And so we would have --

13 THE COURT: Let me just -- let me just pause.

14 Is that your plan? That you get this amendment, and
15 then you go to the PTAB, and you say, "Oh, our narrower
16 interpretation and our narrower infringement theory has been
17 blessed, and we've been allowed to proceed, so we no longer
18 have this broader interpretation." Is that the plan?

19 MR. SALEN: No, your Honor, our -- nothing has
20 changed from how we're arguing in the IPR and nothing will
21 change how we've been arguing in the IPR.

22 THE COURT: When is your paper due?

23 MR. SALEN: Our surreply is due October 26th.

24 THE COURT: Okay.

25 MR. SALEN: 24th, sorry, yeah.

1 THE COURT: Okay. All right. Thank you.

2 I'm sorry to interrupt you.

3 MR. WALTER: No, I'm sorry. The reason I have a
4 reaction to that is because they've already been telling the
5 PTAB, "We're planning to amend."

6 THE COURT: Yeah. I mean, you could say whatever
7 you say, even if I haven't issued a decision, but I would,
8 one way or the other. So -- I mean -- yeah. Okay. So I
9 think it's really what I need to focus on is the nature of
10 the amendment. That's what really concerns me. Because if
11 it's a change in an infringement theory, that's one thing.
12 If it's a elimination of one of two theories, that's another
13 thing that could be independent of claim construction. So I
14 would not be issuing an order, for example, that said, "Oh,
15 I'm permitting this amendment because I agree that the claim
16 can only be interpreted in this way," right? That's the --
17 that's kind of where I'm thinking about this based on your
18 argument is even if I were to permit the amendment, and I'm
19 not saying I would, it would not be endorsing a particular
20 interpretation, because I don't think that's my role.

21 MR. WALTER: Right.

22 THE COURT: So -- okay. Mr. Walter, anything else
23 on the --

24 MR. WALTER: Yeah --

25 THE COURT: -- single sample.

1 MR. WALTER: -- I think what they're proposing,
2 you know, is actually rather bothersome. You know, they --
3 they've acknowledged that what they did in their original
4 contention was they proposed alternative theories, one that
5 was broader, one was a broad interpretation, one was a
6 narrow interpretation. And what they're suggesting is what
7 a plaintiff can do is they can present these different
8 theories, and then they can lie and wait, they can wait for
9 someone to do an IPR, they can do their invalidity
10 contentions, they can go through claim construction, and
11 then, you know, a year later, they can look at how things
12 have played out and then go back and snip out, you know,
13 what -- what's harmful to them.

14 THE COURT: But let's say -- can I just interrupt
15 you there? Because let's say, for example, that you all had
16 presented the single-sample volume term for construction to
17 Judge Lee and she had adopted this narrower interpretation,
18 okay. She had adopted it, and so the Plaintiff could only
19 advocate this narrower theory of infringement. You would be
20 in exactly the same place because they couldn't proceed on
21 their broader claim. They couldn't proceed. They could
22 only be allowed, had they disclosed it already, to proceed
23 to trial on the only viable infringement theory that was
24 left. And, in fact, they would have had grounds to amend
25 based on the claim construction that went -- that -- now,

1 we're -- this is a counterfactual because it hasn't
2 happened.

3 MR. WALTER: Right.

4 THE COURT: But in terms of sort of the outcome
5 that you're describing --

6 MR. WALTER: I think the issue is that we had no
7 reason to propose that --

8 THE COURT: I understand.

9 MR. WALTER: -- because they were adopting the
10 broader interpretation, so --

11 THE COURT: You know, and that -- that's what I
12 think is among the most powerful arguments that you have is
13 that you had no reason to raise this as a claim construction
14 issue because you understood that there was no disagreement
15 about the breadth and scope of this term. Had you had their
16 amended theory of infringement eliminating one and going
17 with a narrower one, then you could have -- you could have
18 raised it. And so the timing is a problem for that purpose.
19 And, you know, it's done, claim construction is done.

20 MR. WALTER: And I'll also add this. I think Mr.
21 Salen won't agree with me. I don't think Judge Lee was
22 going to be enthusiastic about doing more claim
23 construction. She's been very clear --

24 THE COURT: Oh, no judge is enthusiastic about
25 doing more claim construction, so that's true, probably,

1 but, you know, it may have to be done, depending on where
2 you end up. Just regardless of what I do, it may have to be
3 done, given that this term now has surfaced as an issue.
4 Perhaps you -- nobody anticipated it, but it may be an
5 issue.

6 Okay. Anything more in single-sample volume before we
7 move on to the coding tables issue?

8 MR. WALTER: No, your Honor.

9 THE COURT: Okay. Let me turn to that.

10 Okay. So I think I now understand better the answer to
11 the question of where did these coding tables come from.
12 They are meant as an interpretation of the chromatogram that
13 shows up in the documents. Okay.

14 So I would like to understand the response to the
15 argument that there really is no change in the accusation,
16 the infringement contention -- it's still these assays --
17 let me get the terminology right. I had never encountered
18 this before. These are not -- they produce non-degenerate -
19 - the assays produce non-degenerate results, so you can
20 distinguish between the different sample -- or the different
21 colored molecule. I'm going to butcher this, but you've
22 always understood that's their contention based on the
23 chromatogram, so what does the coding table matter?

24 MR. WALTER: Okay. So I think there's a couple of
25 points in response to this.

1 The first one is, if you look at their brief, the
2 allegation -- I just want to make sure we're --

3 THE COURT: Yeah.

4 MR. WALTER: -- and I think your Honor understands
5 this, but I want to make sure we're on the same page on
6 this. There are a lot of arguments in their brief that they
7 always said they were using -- they were accusing something
8 that was non-degenerate.

9 THE COURT: Yes.

10 MR. WALTER: And that's not surprising -- because
11 that's a claim term, so it's not surprising.

12 THE COURT: It has to be, right?

13 MR. WALTER: Yeah.

14 THE COURT: There have to be a -- but they didn't
15 just say, "We're accusing your assays or your method of
16 producing these non-degenerate outcomes." They said, "And
17 see this cluster plot which shows the non-degenerate
18 outcome."

19 MR. WALTER: Okay. So a couple of things on that.
20 I think you're right, the question is, what did they
21 actually accuse of being non-degenerate? So --

22 THE COURT: Okay.

23 MR. WALTER: -- first off, if you look at their --
24 if you look at even their updated infringement contentions,
25 there is not a real clear connection between those cluster

1 plots and the tables. It's not real clear. Now, it's even
2 less clear in their original infringement contentions. So
3 if you want to have a little history here, the background of
4 this is, when we got their original -- when we got their
5 proposed amended infringement contentions, they included
6 these tables where all the integer values had changed to
7 decimals. And I looked at that, and I said, "Guys, I have
8 no idea where this is coming from. Can you please explain?"
9 We got on the phone, we had a meet and confer, and they
10 said, "Well, here's what we're doing. We're doing this. We
11 -- we're using these cluster plots in some way. I said,
12 "Okay. Look, you're going to have to send me another set of
13 contentions because I don't understand that. That wasn't
14 clear before. It's still not clear now." And it's only
15 after I got their second set of proposed amended contentions
16 and I sat down with those cluster plots and I got out a
17 ruler that I said, "Okay. This must be what they're trying
18 to do." So the idea that we always knew --

19 THE COURT: But what did you think it meant?

20 MR. WALTER: What did I think it meant? What
21 are --

22 THE COURT: Yeah, what did you think the original
23 contentions meant --

24 MR. WALTER: Well, so --

25 THE COURT: -- when they showed the cluster plots

1 as evidence of that claim term being met?

2 MR. WALTER: Honestly, I thought that -- I thought
3 that they didn't have a clear understanding of what was
4 going on in these products and that they didn't understand
5 that we don't infringe, because what we have are these --
6 you know, we don't have, like, coding tables like they
7 contend we do. The way these assays are done is it's just
8 done empirically by trial and error process where the user
9 sits down and adjusts their (indiscernible) until they get
10 separations of these clusters. But there's no coding table
11 in the sense that they contend. And my belief was that they
12 didn't understand that, okay? And what they were going to
13 try to do was take these cluster plots and fit them into
14 these integer-style coding tables that fit within -- that
15 are alike what's in their patent. I think if you look --

16 THE COURT: I've seen the patent, yeah.

17 MR. WALTER: -- if you remember from our brief, we
18 showed their coding tables, there's zeros and ones, and
19 maybe there's some twos, but there are all these integer-
20 type things. And I always thought they were going to try to
21 fit these kind of cluster plots somehow into these integer-
22 style coding tables. And from my viewpoint, that was
23 something that never made a lot of sense, and I didn't think
24 we infringed. And so I think -- you know, your Honor asked
25 Mr. Salen a question at one point. You said something along

1 the lines of, "Look, it looks like you realized these don't
2 infringe, and now you want to change it." And I think
3 that's exactly what happened. You know, the notion that we
4 knew, no, we didn't know. I didn't know until after I sat
5 down and I saw these revised coding tables. I said, "What
6 is this? Please explain it to me." That's when I finally
7 understood what they were doing, and that was just a few
8 months ago. So --

9 THE COURT: Okay. So can I ask you or one of --
10 one side or the other to tell me exactly where I should be
11 looking in the original contentions to compare to the
12 amended contentions for the how it changed, you know, what
13 was -- because if you're just contending on behalf of the
14 Defendant, Mr. Walter, that the Defendant didn't appreciate
15 this theory of infringement, I want to really drill down on
16 what was said, because the Plaintiff say the opposite, they
17 say, "Our in theory of infringement was clearly disclosed
18 based on these cluster plots." So I would like to be able
19 to really, you know, have the correct document reference
20 that I can look at to compare and contrast, and either one
21 of you can supply that to me, whoever has it handy.

22 MR. WALTER: You know, I can give you one example,
23 okay, that I think is going to be helpful on this point.

24 THE COURT: And if it's in your brief, I apologize
25 if I missed it, but let me see.

1 MR. WALTER: It's not -- it's not in the -- it's
2 not in the brief, but I'm looking at one of their exhibits.

3 THE COURT: Okay.

4 MR. WALTER: It's DI127-6.

5 THE COURT: 127-6.

6 MR. WALTER: Yeah. And if you look at pages --
7 it's around page 533 to 534. And this is a good example,
8 because if you -- I think 534, 535.

9 THE COURT: This is the amended contentions,
10 right?

11 MR. WALTER: This is a redline --

12 THE COURT: Yeah, the -- right, the amendments.
13 Okay.

14 MR. WALTER: -- showing the changes they're
15 making.

16 THE COURT: Okay.

17 MR. WALTER: Okay. And what you can see on these
18 pages is that what they had not done before was they have
19 these contentions where they have the chromatograms linked
20 up to their new coding tables that are based on decimal
21 numbers. Now, they're in the same thing, and you're --
22 they're showing the coding table with their integer -- with
23 their decimal values alongside the chromatogram. That was
24 not present before. That's what's changed that's new. And
25 so this -- you know, from my perspective, this really is a

1 new theory. This is, "Okay. Our -- what we contend is
2 described in our patent and what we contend infringes are
3 not the integer-based coding tables like are in our patent,
4 but some other types of coding tables where you slap down a
5 ruler and you look approximately where those clusters are."
6 And then you get these decimal-based coding tables where, as
7 you pointed out, you have things that are separated by as
8 little as 0.1 unit, whatever that is. And that's the
9 infringement theory. That -- that's a totally new theory.

10 THE COURT: So -- okay. But normally when we have
11 a situation where we have infringement contentions that you
12 can't figure out what the basis for the theory of
13 infringement is, we have a proceeding where someone says,
14 "Inadequate disclosure." We don't just like wait until
15 expert -- I sort of disagree that in this district we just
16 wait for experts to explain. That's not how we do things
17 here. So how did we get to the point where Bio-Rad is
18 saying, "We have no idea what they're actually accusing, and
19 we only now see, and it's way too late."

20 MR. WALTER: We felt like we knew, we felt like
21 they were misunderstanding how the products work and they
22 were accusing us of infringing in a way that we could not
23 infringe. That's what we understood.

24 THE COURT: I see.

25 MR. WALTER: That's what we understood.

1 THE COURT: Okay. And is there anything that has
2 happened in the case that would reflect that view? Any
3 discussion of this issue? Any discovery, other discovery
4 around this issue that reflects Bio-Rad's, you know, sort of
5 what you just described to me that this is the assumption
6 that you made about what the theory was?

7 MR. WALTER: You know, I questioned our IPR expert
8 about this and the IPR --

9 THE COURT: I see.

10 MR. WALTER: -- I said how can this -- how can
11 this be degenerate, non-degenerate? How does this coding
12 table work? So I asked him about that.

13 THE COURT: But that's not discovery in this --

14 MR. WALTER: It's not discovery in this case, but
15 why would we ask for a claim construction? You know, right
16 now they've accused something that doesn't infringe. Why
17 would we go back to them and say --

18 THE COURT: I see.

19 MR. WALTER: -- can you please fix it, so that --

20 THE COURT: So you saw it, and you understood --
21 you're saying Bio-Rad saw this, understood it, and felt you
22 had a good non-infringement argument on this basis?

23 MR. WALTER: Yes.

24 THE COURT: Because the actual coding tables would
25 suggest there was not infringement because it was

1 degenerate --

2 MR. WALTER: Yes.

3 THE COURT: -- non-degenerate. And now we're
4 showing non-degenerate.

5 MR. WALTER: Yes.

6 THE COURT: Okay. All right. And do you have a
7 reference? I guess the redline would show me what was there
8 before, but do you have a corresponding reference for the
9 original contentions, just so I can see them clearly?

10 MR. WALTER: I can try to find that.

11 THE COURT: I assume it's 127-3 at around the same
12 place.

13 MR. WALTER: Well, the redline page number is
14 going to be -- the redline adds a lot to the page numbers,
15 so --

16 THE COURT: Yeah. Yeah. Yeah. Yeah. So maybe a
17 little earlier. Okay. I will look for it, just so I can
18 very clearly see what was there and what was around it.

19 I would like to move on to the accused assays issue.
20 Okay. So here I am told that the accused assays are
21 identical -- the new accused instrumentalities are identical
22 to what's already been accused and that as to the 3542
23 assay, Bio-Rad had an obligation to identify this distinctly
24 in its interrogatory answer and didn't. Now, these are all
25 things that are coming up in the reply brief. Bio-Rad

1 hasn't had a chance to address them, but they're by way of
2 explanation as to both why there was diligence and also why
3 there's no prejudice, in particular no prejudice, if they're
4 permitted to add these new accused instrumentalities to the
5 contentions. So if you could address the prejudice issue
6 first, that would be helpful.

7 MR. WALTER: Sure. So, you know, as you probably
8 gathered from our brief, you know, we spent less time on
9 prejudice with regard to this point. Frankly, their
10 argument to amend is better with regard to 3542. That's
11 their best argument in the case in this issue is to amend
12 with regard to 3542.

13 THE COURT: Because you agree that it is the assay
14 that's in this kit that's already accused?

15 MR. WALTER: No.

16 THE COURT: Oh, it's not?

17 MR. WALTER: Yeah. So I was a little surprised.
18 And I can give you a cite for that (indiscernible) laptop,
19 get some power -- They have different coding tables, so they
20 must be different. I'm not sure how much that moves the
21 needle on this, but for what it's worth, they're not the
22 same, they have different coding tables.

23 THE COURT: Regardless of the coding tables,
24 because those coding tables are their interpretation,
25 they're not something that Bio-Rad supplies in the first

1 place, but --

2 MR. WALTER: Yeah.

3 THE COURT: But if I look at whatever this kit is
4 that has the long name, this COVID kit, is the 3542 assay a
5 component of that kit?

6 MR. WALTER: I would have to double check to be
7 sure --

8 THE COURT: Okay. Well --

9 MR. WALTER: -- honestly. I would have to check
10 to make sure the targets are the same.

11 THE COURT: Okay. I didn't see in the opposition
12 that the contention was that it was not. That wasn't an
13 argument made in the motion.

14 MR. WALTER: Right.

15 THE COURT: Okay. So -- okay. So what about the
16 Verily assays.

17 MR. WALTER: The Verily assays, that is a
18 different situation.

19 THE COURT: And why is that different?

20 MR. WALTER: So the Verily assays are, I think,
21 actually primarily relevant to the '170 patent in this case.
22 The '170 patent, which you might not be aware of, the '170
23 patent requires a minimum number of targets. And --
24 specifically, it requires five targets.

25 THE COURT: Okay.

1 MR. WALTER: Okay. So it's a little different
2 than the '921 patent, which I think can go as low as two
3 targets. So this requires more than five targets. And I
4 think the Verily assay is one of the only things in the case
5 that might fit within that. Okay. So it's a little -- it's
6 a little different. I think they contend it would fall
7 within the '921 as well, but I think it's mostly about the
8 '170. So it is a little different. It's not just more of
9 the same.

10 The second point on that is this is a situation where I
11 think the failure of diligence really was very extreme. I
12 don't think they learned about this in January. I think
13 they learned about it earlier. The documents that they rely
14 upon to make their infringement allegations are the
15 documents that they got back in September 2024. So this
16 really is a failure of diligence and I think a really
17 extreme failure. And I -- you know -- and I know your Honor
18 focuses more on prejudice.

19 THE COURT: I'm doing both parts of what I'm
20 supposed to do --

21 MR. WALTER: Yeah.

22 THE COURT: -- diligence and prejudice. So I
23 think you all recall from my last order how that turned out.

24 MR. WALTER: Yeah.

25 THE COURT: So the argument on diligence that the

1 Plaintiffs make for the Verily assay is the documents
2 reflect the test could be used in an infringing manner, but
3 they wanted to confirm that it actually was. They haven't
4 been able to confirm that because there's been no deposition
5 testimony from the Verily witness who could either affirm or
6 deny that that's the case.

7 MR. WALTER: That's their argument. I --
8 frankly --

9 THE COURT: Well, I'm giving you an opportunity --

10 MR. WALTER: Yeah.

11 THE COURT: -- to respond because you didn't have
12 an opportunity since this showed up in the reply. So what's
13 the -- what's the response?

14 MR. WALTER: The response is that they've gotten
15 two rounds of -- two rounds of documents from these folks
16 going back to September, going back to January. They have
17 enough information from the documents. I mean, I think the
18 documents -- they've got full design specs for how the
19 document works. And so --

20 THE COURT: But is -- I don't have -- do I have
21 the documents in front of me? Like, what are the --

22 MR. WALTER: You do have -- I think you do have
23 the Verily assay documents in front of you.

24 THE COURT: Okay. And can you just point me in
25 the right direction to where I would look, because what I'll

1 be looking for --

2 MR. WALTER: Yes.

3 THE COURT: -- is do the documents say the test
4 works this way or the test can work this way? But you have
5 to -- you know, you can be up to five targets or five
6 targets up or something like that. Like, it doesn't have to
7 be five targets or at least five targets, but it can be that
8 way. And then the question is, does anybody use it in that
9 way?

10 MR. WALTER: I'll get you the cite momentarily.

11 THE COURT: Yeah. So if that's already disclosed,
12 that's one thing. If it's not -- if it's a can but we don't
13 know if it is -- I mean, if this is an indirect infringement
14 claim --

15 MR. WALTER: So I think what you should look at is
16 docket number 127-7. Okay. This is --

17 THE COURT: Yes.

18 MR. WALTER: This is the sealed Verily design
19 document.

20 THE COURT: Okay.

21 MR. WALTER: And what you'll see is this is
22 extremely detailed. It's got the chromatograms, it's got
23 everything they would have needed to make this allegation.

24 THE COURT: This is the Verily underlying
25 document?

1 MR. WALTER: This is the Verily underlying
2 document.

3 THE COURT: Okay.

4 MR. WALTER: It's got -- it walks through every
5 step of the assay.

6 THE COURT: Okay.

7 MR. WALTER: They -- they've acknowledged they've
8 been working with an expert. There really isn't an excuse
9 on this.

10 THE COURT: So -- and September 2024 is the
11 production date of that document?

12 MR. WALTER: This -- I couldn't tell you if this
13 is the September 24 or January.

14 THE COURT: Okay.

15 MR. WALTER: Whether it's September or January,
16 I'm not sure it makes much of a difference.

17 THE COURT: Okay.

18 MR. WALTER: Okay. But this is a very, very
19 detailed document. And --

20 THE COURT: Okay.

21 MR. WALTER: -- I think it -- I think it would be
22 a stretch to say we can't tell what's going on in these
23 assays without having a deposition.

24 THE COURT: Okay. Let's see. There was a
25 reference to possible impacts on claim construction or

1 invalidity or lost opportunity to address those things. Is
2 it really a lost opportunity to address claim construction
3 and invalidity if these late amendments are permitted? I
4 mean, what -- is there -- is that a concrete thing like some
5 of your other arguments, or is that just --

6 MR. WALTER: It's less concrete.

7 THE COURT: Okay.

8 MR. WALTER: I'm going to admit, you know --

9 THE COURT: That's fine.

10 MR. WALTER: -- their ability to amend with
11 respect to the products, this is much stronger for them than
12 it is with respect to the changes in --

13 THE COURT: Okay.

14 MR. WALTER: -- the claim interpretation of the
15 theory.

16 THE COURT: Okay.

17 MR. WALTER: So it's less concrete. But still,
18 you know, the fact remains, you know, as they're permitted
19 to amend, we're going to start getting into these documents
20 a lot more than we have, and maybe something will come up.
21 And, you know, we've lost the opportunity to do that in a
22 concrete way because it's been at least nine months and
23 probably more.

24 THE COURT: Okay. Anything else that you would
25 like to argue in support of the opposition?

1 MR. WALTER: I think you've -- I honestly think
2 you've covered most of the key points, and so I don't think
3 I want to add anything more --

4 THE COURT: Okay.

5 MR. WALTER: -- so thank you.

6 THE COURT: Great. Thank you.

7 Let me turn back to the Plaintiffs, if there's anything
8 you would like to reply to, happy to hear from you. In
9 particular, do you agree that the document that I should
10 look at is the one at -- the Verily document is the 127-7,
11 that's the principal document I should look at?

12 MR. SALEN: Yes, your Honor.

13 THE COURT: Okay. Great.

14 MR. SALEN: I think that one -- that one we agree.

15 THE COURT: Okay. Anything else?

16 MR. SALEN: Your Honor, just maybe briefly just
17 respond to just a --

18 THE COURT: Sure.

19 MR. SALEN: -- couple of points quickly.

20 So, first of all, with respect to the single-sample
21 volume, I just wanted to go back to that and say, with
22 respect to whether or not -- we've disclosed both theories
23 of the broader single-sample volume and the narrower single-
24 sample volume, and I just -- I say -- it would -- to us, it
25 would be prejudice to force us to meet a burden of proof in

1 proving infringement on a theory that we've now ruled out
2 based on discovery that the broader -- so this isn't about
3 claim construction -- and I know that we keep going back to
4 that -- but to us it's about what the evidence has showed
5 and how we're -- how we've accused. So we had two theories,
6 A and B, sort of like if you had a claim that said, "We
7 claim a car that runs on a power source," and the -- we know
8 that power sources could be either electric or gas, and we
9 discover during discovery there is no electric cars, there's
10 only gas cars, we would amend to say we're reading that
11 through -- we're now accusing only the gas cars --

12 THE COURT: Yes.

13 MR. SALEN: -- right?

14 THE COURT: That's right.

15 MR. SALEN: Not the --

16 THE COURT: But you wouldn't say to me at the same
17 time, "And we're reading the claim to only permit that
18 narrower accusation."

19 MR. SALEN: So, your Honor, I don't -- and I have -
20 - I don't think I've ever said that today. I don't
21 remember, did I say that we were only reading it to only
22 permit?

23 THE COURT: In the briefing.

24 MR. SALEN: In the briefing?

25 THE COURT: It says a narrower interpretation of

1 the claim. And it sounds very much like interpretation of
2 the claim.

3 MR. SALEN: I understand now where that's coming
4 from, your Honor.

5 THE COURT: Yeah, that's why --

6 MR. SALEN: I see the wording, yes.

7 THE COURT: -- I was concerned.

8 MR. SALEN: And I would like to, I guess, just go
9 back to the reason why we're -- and I'm trying to use the
10 right words and be artful here and not say interpretation or
11 reading, but the infringement theory is based on what we've
12 seen in the evidence. And, initially, it could have been
13 either single-sample volume is pre-partition or single-
14 sample volume is post-partition. And during discovery,
15 we've learned there is no evidence that we've seen of pre-
16 partition, only post-partition. We've indicated this theory
17 and argued that, as my colleague recognized, in the IPR
18 preliminary patent owner response, we've indicated that.
19 And a lot of this is based on that last claim limitation.
20 We don't think it requires interpretation. It's pretty
21 clear. It says, "Wherein the reaction occurs in the single-
22 sample volume." And because of that, since the reaction in
23 the Bio-Rad products occurs within droplets, we just don't
24 see another way to read that claim on the products.

25 THE COURT: So why didn't you raise this as a

1 claim construction issue before Judge Lee?

2 MR. SALEN: We didn't think there was a dispute
3 over it either. We thought that there -- we were trying to
4 discover what the evidence showed, and when we first gave
5 our infringement contentions, we didn't have all the
6 evidence. And we still don't, to be frank, but we think we
7 know a lot more about what the products are capable of or
8 not capable of now.

9 THE COURT: Okay.

10 MR. SALEN: And with respect to coding tables, I
11 think we've talked a lot about that. And, again, I think I
12 would just point out we're accusing the chromatograms. The
13 coding tables are just a descriptive -- a way to describe
14 them. If there's text -- and when you look at that
15 reference that Mr. Walter gave you, you'll see there's text
16 above the coding table that describes what was in the
17 chromatogram, and then uses the table as an example of how
18 we would interpret that, and there was an error there. And
19 if you deleted that coding table altogether, maybe that
20 would be an easier way to say, "We'll just take that out and
21 just accuse the chromatogram," but it seems that since there
22 was a misinterpretation or misunderstanding of what we're
23 accusing, which we thought we understood, and then it seems
24 like maybe we've made progress now in discovery and now both
25 side is understanding what's being accused. We did that

1 through the meet and confer process, your Honor. I don't
2 think that this is really something that needs --
3 necessarily needed to be amended, but we -- but we're trying
4 to be as clear as possible in that -- yeah.

5 And then with respect to --

6 THE COURT: And do you -- I'm sorry, before you
7 move on --

8 MR. SALEN: Yeah.

9 THE COURT: -- to the coding tables, do you agree
10 that the relevant portion of the amended -- with the
11 redlines -- the amended contentions are as Mr. Walter stated
12 127-6 at 533 to 535? Do you think that that's the relevant
13 portion I should focus on?

14 MR. SALEN: Yeah, I think there's multiple
15 examples, and I think that's --

16 THE COURT: Yeah, that's one. Okay.

17 MR. SALEN: -- that's an equal example of --

18 THE COURT: Okay. Great.

19 MR. SALEN: -- yes.

20 THE COURT: Thank you.

21 MR. SALEN: And then with respect to the products
22 and the Verily diligence -- and I would just point out that
23 -- and we talked about, hey, you could see in this
24 chromatogram that Verily is looking for more than -- you
25 know, five targets or more, and that's -- and -- but that's

1 not the only piece of evidence to meet the claim limitation.
2 We have to meet every -- the claim. The claim doesn't just
3 say five targets. We have to meet each of the limitations
4 in the claim, and I think, you know, from our point of view,
5 we wanted to be sure that we could read that. And we didn't
6 have -- those -- that document shows some detail. It
7 doesn't show all the detail, your Honor. Now you have the
8 document now and you can see, but it doesn't show -- it's
9 not confirmed that this is the test that's run -- there's --
10 we're trying to map that to which tests are actually being
11 run on the devices, and we don't know for sure how to -- or
12 we still don't know for sure how to map it necessarily to,
13 "They actually are running X number of the tests as
14 described in that document on the device." If they just
15 have, for example, a publication that says, "Hey, this is
16 how we want to run tests" and we don't know if they've been
17 running them or not or when they've been running them or how
18 they've been running them, then we have an issue. My
19 colleagues pointed out in the past that we took a deposition
20 of a -- in one case the Colorado Department of Health, you
21 know, trying to understand infringement of their products
22 and discovered that they hadn't run the products after the
23 issue date of the patent for the '921 patent, and therefore
24 we drop -- we didn't amend to add them because they're not
25 -- we understand that there is no infringement. We didn't

1 know that for sure, the documents say what they say, but we
2 needed to depose them to understand when they stopped
3 running that and that they don't infringe.

4 THE COURT: But is that the issue here with
5 Verily?

6 MR. SALEN: We don't know. We don't know when
7 they've been -- I mean, we want -- we don't know for sure.
8 We have documents that we think we understand, but there --
9 there's not very many of them, they're not very complete --

10 THE COURT: I'm sorry, let me ask a better
11 question. So is it for Verily that you don't know whether
12 they are doing it in the right time frame or not? Or is the
13 question, what exactly are you doing? Are you doing all the
14 things that are described in the document or just some of
15 them? And maybe they don't meet the limitation.

16 MR. SALEN: Well, I think it's more the latter,
17 but to -- I guess the point -- I was just making that as a
18 -- like a --

19 THE COURT: No, I understand --

20 MR. SALEN: Yeah, yeah. Yeah.

21 THE COURT: -- but I'm trying to understand what's
22 the -- what would be the point?

23 MR. SALEN: It's a latter -- it was a latter
24 issue. We know that they describe a test in documents, and
25 we know that they describe running certain tests in a

1 document with numbers and, like, names, but we're trying to
2 map the test that's in the document for what they actually
3 have been doing in practice, like in the real world, and we
4 haven't been able to ask a witness to tell us, "This is what
5 this document means and this is how many -- this is the
6 exact test we're running. We don't leave any steps out. We
7 do all these steps, and we do it -- and we've been doing
8 it." There's no, you know, 10 times on March and 15 times
9 in April, and we don't know how to map the --

10 THE COURT: But you only need one time within --

11 MR. SALEN: Well, we -- I -- we don't -- we --
12 again, we don't know how to map what's in the document
13 showing the test, that what's -- we don't know that --

14 THE COURT: But I mean -- but I'm sorry, but part
15 of the pitch for why amendment should be permitted is that
16 these are no different than all the other assays that are
17 accused. So on the one hand, that's the argument. On the
18 other hand, you're saying, well, you, you know, don't even
19 know whether they are or aren't doing all the steps. I
20 mean, it's hard to reconcile those two things.

21 MR. SALEN: Your Honor, if I may, I agree, those -
22 - this is -- that the pitch is that's because that test that
23 we saw the documentation for looks just like it came out of
24 the Bio-Rad manual. It looks like it's described in the bio
25 -- the Bio-Rad instructions tell you how to run the test

1 that way. And we've accused Bio-Rad devices of doing tests
2 that way for the '170 patent and the '921 -- for the '170
3 with five targets or more, and we're now trying to show in
4 this infringement that there's actually a lot of use of the
5 device to run the test in a way that infringes, and this is
6 evidence of that. We just wanted to be sure that there --
7 before we accuse them, that they're actually doing it. And
8 we were hoping to get a deposition.

9 And by the way -- this is part of the diligence story,
10 but when we were asking initially for a deposition right
11 after getting the document subpoena, that was around the
12 March of 2025 time frame. And at that point, discovery
13 technically -- there was a discovery close date on March --
14 I believe it was March 12th of 2025. And we had tried to
15 stipulate to expand the scope of fact discovery because
16 neither party had finished yet. We then filed a motion with
17 the court to open fact discovery. Verily refused to make a
18 witness available to us during that time because they said
19 fact discovery is closed. So we were waiting for that to --
20 we were hoping that we were going to be able to get a --
21 either a stipulation or a ruling from the court that would
22 have expanded fact discovery.

23 THE COURT: So fact discovery is closed right now
24 as we speak?

25 MR. SALEN: No, it -- after Judge Lee --

1 THE COURT: Did the claim construction.

2 MR. SALEN: -- issued an order just -- we had a
3 motion hearing on June 18.

4 THE COURT: Yes.

5 MR. SALEN: And during that hearing, she extended
6 fact discovery to July 31st. And then after claim
7 construction, at least as of --

8 THE COURT: Yeah, you have --

9 MR. SALEN: -- she ordered it to be in -- now it's
10 March 15, yeah.

11 THE COURT: So in the situation where you need a
12 third-party deposition and the third party is refusing,
13 there's a process, you come to me, right?

14 MR. SALEN: Your Honor, I agree with that, except
15 we felt that the only hurdle to it at that point was that
16 fact discovery was closed according to the witness. We
17 didn't agree that fact discovery was closed. Instead of
18 moving to compel and fighting -- and going through motions
19 practice on that, we thought we were going to be able to get
20 a quick ruling from Judge Lee that indeed fact discovery
21 hadn't been closed yet. And -- yeah, so --

22 THE COURT: When did -- did you notice the
23 witness' deposition for a particular date?

24 MR. SALEN: We did. I don't -- initially, we
25 issued -- I don't remember the --

1 THE COURT: And when did you issue the notice
2 approximately?

3 MR. SALEN: Approximately March of --

4 THE COURT: Okay.

5 MR. SALEN: March of 2025.

6 THE COURT: But not before?

7 MR. SALEN: Not before.

8 THE COURT: Okay. All right. Anything else on
9 the assays?

10 MR. SALEN: No, your Honor.

11 THE COURT: Okay. Great.

12 Thank you all for a very long argument. I appreciate
13 it. I appreciate the written papers as well. And I'm sorry
14 that I could not sort through the chambers copies better. I
15 know it's a lot of paper and you provided them to me as I
16 asked, but for some reason, I just couldn't locate things I
17 needed. But thank you for the on-the-fly references. I
18 will look back at the PDFs I have and make sure I'm looking
19 at the correct material, and I'll issue a written order.
20 Thank you very much.

21 MR. SALEN: Thank you, your Honor.

22 MR. WALTER: Thank you, your Honor.

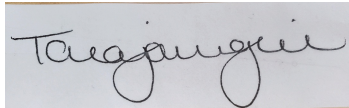
23 THE CLERK: Court is concluded.

24 (Proceedings adjourned at 11:37 a.m.)
25

CERTIFICATE OF TRANSCRIBER

I certify that the foregoing is a true and correct transcript, to the best of my ability, of the above pages of the official electronic sound recording provided to me by the U.S. District Court, Northern District of California, of the proceedings taken on the date and time previously stated in the above matter.

I further certify that I am neither counsel for, related to, nor employed by any of the parties to the action in which this hearing was taken; and, further, that I am not financially nor otherwise interested in the outcome of the action.

A rectangular box containing a handwritten signature in cursive script, which appears to read "Teagunzie".

Echo Reporting, Inc., Transcriber

Saturday, September 20, 2025