

From: [Trials](#)
To: [Walter, Derek C.](#); [Trials](#)
Cc: [BioRad-Chromacode](#); [LegalTM-Caltech-IPR](#)
Subject: RE: BioRad v. ChromaCode - IPR2024-01451
Date: Friday, October 17, 2025 3:10:05 PM
Attachments: [image001.png](#)

Counsel: Patent Owner is authorized to file a 10-page motion to strike, and Petitioner is authorized to file a 10-page opposition to that motion, pursuant to the information (and filing schedule) provided by counsel below. No new evidence may accompany either brief.

In addition, taking account of the information provided below, the Board determines that additional briefing may be helpful in reaching a correct **claim** construction in this proceeding. Accordingly, Petitioner is authorized to file a 10-page Supplemental Claim Construction Brief limited to addressing the correct scope of the claim term "single sample volume" due one week from the date of the instant email authorization. Petitioner may file proposed Exhibits 1045 and 1056 in support of that brief. Patent Owner is authorized to file a 10-page Responsive Claim Construction Brief due two weeks from the date of the instant email; Petitioner is authorized to file a 5-page Reply Claim Construction Brief due three weeks from the date of the instant email; and Patent Owner is authorized to file a 5-page Sur-Reply Claim Construction Brief due four weeks from the date of the instant email. No new evidence may accompany the Responsive, Reply, or Sur-Reply briefing.

The Board will enter the instant email correspondence as an exhibit in this proceeding. No conference call is necessary.

Regards,

Andrew Kellogg,
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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

From: Walter, Derek C. <dwalter@jonesday.com>
Sent: Thursday, October 16, 2025 6:45 PM
To: Trials <Trials@USPTO.GOV>
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Subject: BioRad v. ChromaCode - IPR2024-01451

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Dear Honorable Board,

The parties write regarding two issues in the above-captioned matter.

First, Patent Owner respectfully requests authorization to file a motion to strike portions of Petitioner's Reply that advance arguments that go beyond responding to arguments raised in the Patent Owner Response. 37 C.F.R. §42.23(b). The parties have met and conferred, and Petitioner does not oppose Patent Owner's request for authorization but will oppose the motion to strike. If the motion is authorized, the parties propose a 10-page opening brief due one week from when the Board authorizes the motion, and a 10-page opposition due two weeks from when the Board authorizes the motion.

Second, pursuant to paper 23 in this matter, the parties provide the following development in the related matter styled *In re: ChromaCode Litigation*, No. 23-cv-04823-EKL (N.D. Cal.). Namely, on October 9, 2025, the district court issued an order granting-in-part and denying-in-part Patent Owner's motion for leave to amend its infringement contentions (the "Order"). The order is attached, and Petitioner will be filing the order as EX1045. Petitioner also wishes to file the transcript from the oral argument on Patent Owner's motion that led to the order as an exhibit to these proceedings. Petitioner will be filing that transcript as EX1046. Patent Owner objects to the filing of the transcript. The parties disagree as to the import of the Order and briefly state their respective positions below:

Petitioner's Position:

Petitioner submits that the Order is relevant to the construction of "single sample volume," which is an issue that the Board discussed in its institution decision, that Patent Owner raised in its Patent Owner's Response, and the Petitioner discussed in its reply. See Paper No. 11 at 33-34; Paper No. 17 at 25-26; Paper No. 20 at 9-11. Briefly, in its Patent Owner's Response, Caltech stated that it had proposed amendments to its infringement contentions that were intended to "clarify the claimed 'single sample volume' does not include a volume that is subsequently partitioned into droplets, but, consistent with the express claim language, is where the reaction occurs (e.g., a droplet or well)." See Paper No. 17 at 26. In its October 9 order, however, the district court ruled as follows, citing several portions of the oral hearing transcript:

Both sides appear to agree that ChromaCode's original contentions do encompass both the single droplet theory and the alternative pre-partition theory of infringement for the single sample volume limitation. See Dkt. No. 128 at 1, 4, 7; Dkt. No. 132 at 3 (Bio-Rad summarizing PTAB characterization of the parties' interpretation of the scope of "sample volume"); Dkt. No. 150 at 10:17-11:24, 14:18-15:7. Despite some ambiguity in its moving papers regarding the basis for amendment, ChromaCode clarified during the hearing that it lacks evidentiary

support for its contention that Bio-Rad meets the single sample volume limitation under the alternative pre-partition theory, and so ChromaCode no longer wishes to pursue that theory of infringement. Dkt. No. 150 at 12:16-13:5, 14:14-15:23. Moreover, ChromaCode conceded that the claim language can be interpreted to encompass both of its original theories of infringement, and it affirmed that it is not advocating a narrower claim construction—i.e. one that is limited to the single droplet theory. *See id.* at 12:6-13:5, 19:23-20:19, 21:24-22:8, 56:14-21. In these circumstances, the Court agrees that ChromaCode’s proposed amendments are correctly understood as eliminating one of two disclosed theories of infringement, without implying any change to the broader claim construction on which ChromaCode relied when it served its original contentions.

Order at 6; *see also id.* at 7 (“However, as ChromaCode concedes that it does not advocate a narrower claim construction, but only a narrower infringement theory, the proposed amendments will not have any impact on claim construction in this action, nor should they have any impact on proceedings before the PTAB.”). Thus, although the district court permitted Patent Owner to withdraw one of its infringement theories, the Court ruled that this was “without implying any change to the broader claim construction on which ChromaCode relied when it served its original contentions.” Indeed, as the District Court noted, “ChromaCode conceded that the claim language can be interpreted to encompass both of its original theories of infringement, and it affirmed that it is not advocating a narrower claim construction—i.e. one that is limited to the single droplet theory.” Bio-Rad respectfully submits that these proceedings in the district court negate any effort by Patent Owner to seek a narrowing construction of “single sample volume.”

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Patent Owner’s Position:

Both parties agree the Order falls within the Board’s General Order to “keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims[.]” Paper 23. As such, the parties agree to submit the Order as an exhibit to these proceedings. Patent Owner further notes that the Order is relevant with respect to how Patent Owner’s infringement contentions map the term “single sample volume”—which is recited by the challenged claims of the ‘921 patent—to accused products. The relevant portion of the Order relating to “single sample volume” appears on pages 3 to 7.

Although the parties agree that the Order should be submitted as an exhibit to these proceedings, they disagree over whether the parties should be permitted to characterize or argue about the relevance of the Order. Notably, Petitioner has insisted on filing this joint statement with competing positions, and attaching not only the Order, but also a transcript from the district court’s motion hearing that led to the Order, over Patent Owner’s objection to do so and without even offering to meet and confer on the issue. Petitioner appears to incorrectly believe that it is entitled to argue that the Order is allegedly relevant to how the Board construes the term “single sample volume.” However, neither party has ever asked for a construction of that term, whether in these proceedings or in the district court. The parties have neither submitted proposed constructions of the term nor briefing about those constructions to the Board or the district court. And, Magistrate Judge DeMarchi, who issued the Order, did not do so as part of claim construction in that case—indeed, claim construction for the ‘921 patent has long since passed. Petitioner has already had its

opportunity to argue about how the term “single sample volume” should be read in view of the ‘921 patent and the prior art in its Petition (Paper 1), its Preliminary Reply (Paper 9), and its Reply (Paper 20). The Board has not authorized, nor has Petitioner requested, any further briefing in this matter. As such, the Board should review and interpret the relevance of the Order without characterization or argument from either party, and Petitioner’s attempt to characterize or argue the relevance of the Order, or the related district court arguments from the motion hearing that led to the Order, should be rejected as an unauthorized and inappropriate supplemental brief. The Board should give them no consideration.

Although Patent Owner believes the Order speaks for itself, to the extent the Board requires any additional context about the Order’s relevance, particularly in view of Petitioner’s characterization and argument, Patent Owner notes that, in its Patent Owner’s Response, it stated that it had proposed amendments to its infringement contentions that were intended to “clarify the claimed ‘single sample volume’ does not include a volume that is subsequently partitioned into droplets, but, consistent with the express claim language, is where the reaction occurs (e.g., a droplet or well).” See Paper No. 17 at 26. In granting Patent Owner’s motion for leave to amend its infringement contentions, the district court “conclude[d] that [Patent Owner] may amend its infringement contentions to eliminate its alternative pre-partition theory of infringement for the single sample volume limitation of claim 1 the ‘921 patent, while retaining the previously-disclosed single droplet theory of infringement.” Order at 7. The Court further noted that “the proposed amendments will not have any impact on claim construction in this action, nor should they have any impact on proceedings before the PTAB.” *Id.*

No further characterization of the Order is required, and Patent Owner objects to Petitioner’s insistence on doing so.

In view of the above, Patent Owner respectfully disagrees with Petitioner’s argument that the district court proceedings “negate any effort by Patent Owner to seek a narrowing construction of ‘single sample volume’ because neither party has asked for a construction of that term, and the district court expressly noted that its Order should not “have any impact on proceedings before the PTAB.” *Id.*

To the extent the Board wishes to further discuss the above matters, the parties can be available for a teleconference anytime on October 22-24.

Respectfully,

Derek Walter
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Jesse Salen
Counsel for Patent Owner

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