

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEGRATED DNA TECHNOLOGIES, INC.,
Petitioner,

v.

TECAN GENOMICS, INC.,
Patent Owner.

Case IPR2025-00015

U.S. Patent No. 10,036,012

**PETITIONER'S AUTHORIZED MOTION
TO DISQUALIFY DR. MIKHAIL MATZ**

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Petitioner moves to disqualify Dr. Mikhail Matz from offering testimony for Patent Owner based on a blatant conflict of interest. Before filing this IPR petition, Petitioner retained Dr. Matz to consult on the precise subject matter at issue here—the patent dispute between PO and Petitioner. Dr. Matz had confidential substantive discussions with Petitioner’s counsel about the issues in this proceeding spanning more than six months before and after the petition was filed. Before those conversations, Dr. Matz promised to keep his work confidential and “not work for any other person or organization in connection with [this] matter.” Ex. 1090 ¶ 9.

Dr. Matz brazenly disregarded his promises. To Petitioner’s surprise, on July 18, 2025, PO submitted a declaration from Dr. Matz, Ex. 2039, having retained him a few months ago, in May 2025. Ex. 1111.

Incredibly, it appears that Dr. Matz lied to PO as well. The night before this motion was due, PO produced a redacted copy of its agreement with Dr. Matz in which he stated that he has “no conflict of interest with respect to IDT” and that his “performance of expert services will not conflict with or violate any obligation [he] may have with anyone, including without limitation, IDT.” Ex. 1111.01-02.

The case law leaves no doubt that Dr. Matz must be disqualified because he had a confidential relationship with Petitioner and received confidential information from Petitioner relating to this proceeding. PO’s retention of Dr. Matz has and continues to harm Petitioner—he has been consulting for PO after consulting with

Petitioner on the same issues, which very likely means that Dr. Matz has already disclosed, knowingly or unknowingly, confidential information about Petitioner's strategy in this matter to PO. For these reasons, Dr. Matz should not be permitted to provide testimony adverse to Petitioner or consult further with PO in this matter.

I. Dr. Matz's Prior Confidential Consulting For Petitioner In This Matter.

PO sued Petitioner on October 6, 2023, asserting, among others, U.S. Patent Nos. 10,036,012 (Ex. 1001) and 10,876,108 (Ex. 1002).

On May 21, 2024, Petitioner contacted Dr. Matz via email. Ex. 1089. After a call confirming that Dr. Matz had no conflicts and was interested, *id.*, Petitioner's counsel and Dr. Matz signed a consulting agreement relating to "Patent Litigation Between IDT and Tecan Genomics," Ex. 1090. Among other things, Dr. Matz agreed: that his work would "be litigation mental impression work product," Ex. 1090 ¶ 1; that he had checked for "any relationships with the persons or organizations involved in this matter, including Tecan Genomics Inc." and was "not aware of any conflicts or interests or relationships that would preclude [him]," *id.* ¶ 6; that "[w]hether or not the engagement is terminated," he would "not work for any other person or organization in connection with the above-referenced matter or any substantially related matter," *id.* ¶ 9; and that "[t]he confidentiality [] obligations [] herein will continue after the engagement," *id.* In exchange, Petitioner agreed to pay Dr. Matz for his time at an hourly rate. *Id.* ¶ 3.

After receiving Dr. Matz's signed agreement, Petitioner's counsel posed detailed questions concerning Meyer, Ex. 1006, the reference on which this petition relies, IPR2025-00015, Paper 1, directed to the same subject matter as Dr. Matz's proffered testimony and, presumably, his conversations with PO. *Compare* Ex. 1091.001-2 *with* Ex. 2039 ¶ 48. Dr. Matz responded with a prior art reference and his thoughts on how to find other art. Ex. 1091 & attachment. On May 23, 2024, Dr. Matz spoke with Petitioner's counsel in an hour-long substantive videoconference, regarding, among other things, the Meyer reference, as documented by counsel's contemporaneous notes. Ex. 1092, Ex. 1093,¹ Ex. 1094.

Afterwards, Dr. Matz sent counsel another prior art reference. Ex. 1095.001 & attachment. He also provided a diagram that filled his wall-mounted whiteboard to illustrate the points he had discussed with counsel. Ex. 1096. He subsequently provided two revised and updated versions of the figure.² Ex. 1097; Ex. 1098. On

¹ This exhibit includes counsel's contemporaneous notes from Dr. Matz's initial call on May 21 and the follow-up, substantive call on May 23.

² On June 4, 2024, Dr. Matz sent an invoice reflecting his work to-date, including entries for "literature research," his hour-long "Zoom consultation," and his "scheme drawing." Ex. 1099. Petitioner's counsel promptly paid. Ex. 1100.

June 6, 2024, counsel sent Dr. Matz specific follow-up questions regarding the Meyer reference, and Dr. Matz provided a detailed response. Ex. 1101.

These discussions with Dr. Matz became the core of this petition. *Compare* Exs. 1096-1098 *with* Paper 1 at 40-42; *compare* Ex. 1101.001-2 *with* Paper 1 at 67; *compare* Ex. 1095.001 & attachment *with* Paper 1 at 69-72 (Ground 3). Concerningly, and in a further example of Dr. Matz’s duplicity, the testimony PO now offers contradicts Dr. Matz’s explanations to Petitioner in 2024. *Compare* Ex. 1101.001-2 *with* Ex. 2039 ¶ 41 (regarding extent of ligation); *compare* Ex. 1093 (“Wanted to . . .”) *with* Ex. 2039 ¶ 65 (“Our goal was precisely the opposite[.]”).

Having thoroughly discussed the Meyer reference with Dr. Matz, on October 4, 2024, Petitioner filed this petition asserting Meyer anticipates or renders obvious all challenged claims. In parallel, on October 18, 2024, Petitioner served its district court invalidity contentions, alleging invalidity based on, among other things, 35 U.S.C. § 102(g) prior invention by Dr. Matz’s lab group. Ex. 1102.006.

On November 12, 2024, Petitioner emailed Dr. Matz again, Ex. 1103, and on November 18, Dr. Matz spoke with Petitioner’s counsel for half an hour, Ex. 1104. On that call, counsel updated Dr. Matz on the litigation strategy in the two forums and discussed with Dr. Matz documentary evidence corroborating his prior invention. Ex. 1105. Petitioner then asked for the documents. Ex. 1106. Abruptly, and at 1:39 a.m. (central time) on November 22, 2024, Dr. Matz responded:

Well I have to say this doesn't sound like fun anymore.

This is not my fight. I'd greatly appreciate if you keep me out of this from now on.

Id. Petitioner followed up with Dr. Matz. Ex. 1107. Because the district court case is now stayed, Petitioner has not further pursued its requests in the meantime.

II. Dr. Matz Violated His Consulting Agreement.

Given Dr. Matz's confidentiality agreement and prior statements to Petitioner, it is astonishing that on Friday, July 18, 2025, PO submitted Dr. Matz's declaration, Ex. 2039, in support of its Patent Owner Response. Petitioner promptly informed PO of Dr. Matz's conflict, provided PO with a copy of Dr. Matz's consulting agreement, Ex. 1090, and informed PO that counsel for Petitioner "had multiple confidential communications with Dr. Matz concerning the subject matter of these proceedings," Ex. 1108.015-16.

PO responded that it has "an agreement with Dr. Matz" and stated that Dr. Matz had "confirmed" that "he had no conflict or related obligations before submitting the declaration in question." Ex. 1108.013. PO finally provided a redacted version of that agreement at 9:46 p.m. the night before this motion was due, Ex. 1110, which confirmed that Dr. Matz lied to PO about his conflict of interest with IDT, Ex. 1111.001-2.

The parties conferred on July 25 and reached an impasse after PO refused to provide any bases for opposing Dr. Matz's disqualification aside from questioning

whether the discussions Petitioner had with Dr. Matz were actually confidential and suggesting—without any legal citation—that even if they were, Dr. Matz should still be allowed to opine on issues he did not expressly discuss with Petitioner. *See* Ex.1108.001-5, Ex. 1110.001. The Board authorized the filing of this motion and the submission of supporting exhibits *in camera* on July 29. Ex. 3003.

III. The Law Compels Dr. Matz’s Disqualification.

The PTAB applies a two-prong test for disqualification: “(1) whether it is objectively reasonable for Petitioner to believe that it had a confidential relationship with [the witness]; and (2) whether Petitioner disclosed confidential information to [the witness] that is relevant to the current proceeding.” *Galderma S.A. v. Medy-Tox, Inc.*, PGR2019-00062, Paper 56 at 5. “Affirmative answers to both inquiries *compel* disqualification.” *Id.* (emphasis in original).

Both prongs are met here, as shown by Dr. Matz’s agreement with Petitioner alone. The confidential nature of the relationship between Petitioner and Dr. Matz is clear from the agreement’s first paragraph setting out detailed confidentiality restrictions. Ex. 1090. It is also clear from the face of that agreement that Petitioner disclosed confidential information to Dr. Matz that is relevant to the current proceeding—specifically “Patent Litigation Between IDT and Tecan Genomics.” *Id.* To the extent that there is any doubt about the second prong, Petitioner’s communications with Dr. Matz, submitted *in camera*, leave none. *Supra* § I;

Exs. 1091-1101, 1104-1105. Accordingly, Dr. Matz's disqualification is compelled.

A. PO Has Provided No Basis For Dr. Matz To Testify.

When the parties conferred, PO offered just two bases for opposing disqualification. Both are foreclosed by Board precedent.

First, PO disputed that Petitioner could have shared confidential information with Dr. Matz relating to these proceedings because "Dr. Matz's declaration concerns his own public disclosures and work." Ex. 1108.004. Notably, PO refused to provide its position on whether it considers its own conversations with Dr. Matz to be confidential. Ex. 1108.002, .007-10. Regardless, PO's argument that discussions between counsel and a consultant cannot be confidential if they relate to "public disclosures and work" was rejected in *Galderma*: "Although some of the information [Dr. Matz] discussed may have been in the public domain, it is clear that both Petitioner's counsel and [Dr. Matz] considered the underlying strategies related to how that information could be used in support of a patentability challenge as confidential and privileged." PGR2019-00062, Paper 56 at 8. As shown by Petitioner's agreement with Dr. Matz, and further confirmed by the confidential correspondence, Dr. Matz's and Petitioner's discussions went beyond publicly available material to include, among other things, the legal strategy for this matter. *Supra* § I & Exs. 1091-1101, 1104-1105.

Second, PO argued—without citation to any legal authority—that even if Petitioner did share confidential information with Dr. Matz, only the portions of Dr. Matz’s declaration that directly related to those confidential discussions should be excluded. Specifically, Tecan suggested that “as a starting point” “IDT [should] identify what portions of Dr. Matz’s declaration [] it believes reflects the alleged confidential information.” Ex. 1108.004. This argument, too, was rejected in *Galderma*: “[T]he second prong of the disqualification test does not require proof that the expert who is the subject of the disqualification motion must have actually disclosed or even relied upon the confidential information obtained from his prior employment during the scope of his new engagement.” PGR2019-00062, Paper 56 at 8. Rather, the Board concluded proof that “any confidential or privileged information [was] disclosed by the first party *to the consultant*” was sufficient for Petitioner to have “met its burden on both prongs” of the test for disqualification. *Id.* at 9 (emphasis in original). Here, the agreement and Petitioner’s *in camera* submissions prove that Dr. Matz received confidential information, and as in *Galderma*, “the facts compel [Dr. Matz]’s disqualification.” *Id.*

But even if PO’s proposed test were to control, contrary to the Board’s precedent, Dr. Matz’s testimony should nonetheless be excluded. Petitioner’s discussions with Dr. Matz touched on every aspect of the Meyer reference and thus on the entirety of his declaration. Exs. 1091-1101, 1104-1105. Indeed, as discussed

in detail above, *supra* § I, Dr. Matz was intimately involved in the formation of Petitioner’s strategy for these petitions, and it is impossible to disentangle Petitioner’s discussions with Dr. Matz from his declaration on behalf of PO.

B. Dr. Matz’s Duplicitous Conduct Is Unprecedented.

It is difficult to find examples of perfidy as egregious as Dr. Matz’s here. “[N]o one would seriously contend that a court should permit a consultant to serve as one party’s expert where it is undisputed that the consultant was previously retained as an expert by the adverse party in the same litigation and had received confidential information from the adverse party.” *Wang Lab’ys v. Toshiba*, 762 F. Supp. 1246, 1248 (E.D. Va. 1991). In such circumstances, “the conflict of interest is so obvious that disqualification is always required.” *Howmedica Osteonics v. Zimmer, Inc.*, 2007 WL 4440173, at *2 (D.N.J. Dec. 17, 2007).

The consultants in prior cases have been disqualified even when they had some excuse. *See, e.g., Wang*, 762 F. Supp. at 1247 (consultant had no agreement); *Howmedica*, 2007 WL 4440173, at *4 (consultant “not aware [] he had a confidential relationship”); *King v. DePuy Orthopaedics*, 2023 WL 5624710, at *8 (D. Ariz. Aug. 31, 2023) (consultant never entered a “written retention or consulting agreement” and “[did] not recall discussing any confidential information”); *Galderma*, PGR2019-00062, Paper 56 at 7-8 (prior consulting concerned a different patent); *In re Xyrem Antitrust Litig.*, 2022 WL 393208, at *5 (N.D. Cal. Feb. 9,

2022) (confidential information “only indirectly related to this litigation”); *Auto-Kaps v. Clorox*, 2016 WL 1122037, at *3-4 (E.D.N.Y. March 22, 2016) (consulted regarding a different product). Dr. Matz has none. *Supra* § II & Ex. 1108.

C. Patent Owner Will Not Be Prejudiced By Disqualification.

Potential prejudice to PO is not an element of the disqualification inquiry. *See Galderma*, PGR2019-00062, Paper 56 at 5. Regardless, PO will not be prejudiced by Dr. Matz’s disqualification because PO’s other expert, Dr. Bustamante, addresses all anticipation and obviousness issues.

D. Petitioner Has Been And Continues To Be Prejudiced.

To the extent Dr. Matz offers any non-duplicative, relevant testimony, it is substantially outweighed by prejudice to Petitioner. Dr. Matz cannot realistically compartmentalize the information received from Petitioner on the same issues on which he is now consulting and testifying for PO. *See Alien Tech. Corp. v. Intermec, Inc.*, 2007 WL 4261972, at *2 (D.N.D. Nov. 30, 2007).

* * *

For the above reasons, Petitioner respectfully requests that Dr. Matz be disqualified from testifying or further consulting with PO in this matter.

Dated: August 6, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. § 42.6(e)(1), a copy of the foregoing Petitioner's Authorized Motion to Disqualify Dr. Mikhail Matz was served via electronic mail on the following lead and back-up counsel of record for Patent Owner.

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