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 No. IPR2025-00015
U.S. Patent No. 10,036,012

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SEAL CONFIDENTIAL INFORMATION SUBMITTED *IN CAMERA*

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Tecan opposes Petitioner's efforts that would allow *only Petitioner and the Board* access to the core documents that Petitioner relies upon for its motion to disqualify. The Board has made it clear: "to the extent that [a movant] intends to wield [evidence of communications] as a sword to support its disqualification motion, [that movant] cannot hide behind the shield of attorney-client privilege and refuse to reveal the specifics of the communication." *Agila Specialties Inc. v. Cephalon, Inc.*, IPR2015-00503, Paper 13, 5 (P.T.A.B. Aug. 19, 2015); *Fujifilm Corp. v. Sony Corp.*, IPR2017-01267, Paper 9, 5 (P.T.A.B. July 10, 2017). Petitioner seeks to do just that. Petitioner seeks the Board's blessing to submit its key evidence *in camera* and prevent Patent Owner from responding to those specific materials. This fundamentally prejudices Tecan and improperly abridges due process.

Allowing Petitioner to hide behind the shield of confidentiality would be particularly unwarranted here. Petitioner's conclusory arguments in support of this request only highlight the risks of allowing a party to hide behind confidentiality, rather than allow Tecan to respond to the substance of its claims. Petitioner does not even make a serious attempt to show how the necessary elements are met, and just assumes it is entitled to the relief it seeks. That is not the law, nor is it appropriate given the prejudice it would cause.

First, Petitioner fails to show that the information is "truly confidential." The conclusory description Petitioner provides on these materials suggest that these

communications are not necessarily confidential. Paper 27, 2-4. Instead, these materials appear to concern the disclosure of public information by Dr. Matz, one of the authors of the Meyer publication. *Id.* For example, Petitioner asserts that Dr. Matz answered questions and provided notes to figures in relation to Meyer. *Id.*, 3-4 (citing Exhibits 1091, 1093-94, 1096-98, and 1101 among others). Moreover, Petitioner asserts Dr. Matz circulated prior art to Petitioner. *Id.* at 3-4 (citing Exhibits 1091, 1095 among other). Based on Petitioner's representations, it does not appear that any of these materials are confidential. Rather, all of these are purely technical information or information from Dr. Matz about his publicly disclosed work and state of the art, and are not confidential. *See Koch Ref. Co. v. Jennifer L. Boudreau M/V*, 85 F.3d 1178, 1182 (5th Cir. 1996); *Cellular Commc'ns. Equip, Inc. v. HTC Corp.*, No. 6:13-cv-507, slip op. at 6–7 (E.D. Tex. Mar. 24, 2016) (being "asked to search for prior invalidating art" is "[p]urely technical information [and] is not confidential."); *Hewlett-Packard v. EMC Corp.*, 330 F. Supp. 2d 1087, 1097 (N.D. Cal. Aug. 10, 2004) (no disqualification where only alleged "confidential information" was "material contained in publicly available patents.").

Beyond this, Petitioner provides no specificity in its motion to seal. It suggests some of these materials reflect "Petitioner's litigation strategy." However, no explanation is provided as to what this means and what documents concern this "litigation strategy." In fact, Petitioner only asserts that description for a single

document—exhibit 1005. Paper 27, 4. Not only is this conclusory statement insufficient to show that the document is confidential, but it has no bearing on the other documents Petitioner seeks to hide from Patent Owner.

Importantly, Petitioner does not assert any privilege or work product protection. In fact, those words are never used in the its motion to seal. Instead, its position appears to be simply that Dr. Matz signed a consulting agreement so all discussions were confidential. However, courts have refused to assume confidentiality for all communications between counsel and an expert. *See Hewlett-Packard*, 330 F. Supp. 2d at 1094 ("[D]iscussions between parties or counsel and experts do not carry the presumption that confidential information was exchanged.").

In any case, Petitioner has already waived any confidentiality on these materials given their arguments and submissions. To the extent Petitioner relies on public representations about the content of those documents and their significance in its briefing, it cannot now claim the same materials are confidential. For example, Petitioner contends that Exhibits 1091, 1093-94, 1096-98, and 1101 relate to Meyer and its figures. Paper 27, 3-4. By relying on these materials and disclosing their content in public documents, they have waived any privilege or confidentiality protections.

<u>Second</u>, there is no explanation as to why disclosure would result in "concrete harm to Petitioner." Critically, Petitioner has not identified specific confidential

information that it shared with Dr. Matz. Paper 27, 4. Instead, Petitioner's arguments are again conclusory, suggesting nothing more than it would disclose Petitioner's "litigation strategy." However, this makes little sense as Petitioner's alleged discussion with Dr. Matz's amounted to less than 3 hours and concerned his public work. It simply does not follow that sharing what is already in the public record can harm Petitioner. Moreover, as explained above, this conclusory statement about one exhibit, Exhibit 1005, is insufficient to show harm to Petitioner for that document, let alone the other documents Petitioner describes in a different manner and seeks to hide from Patent Owner.

Third, the balance of equities strongly weighs against sealing these documents. Petitioner's arguments specifically relying on the redacted contents of these documents paired with limiting these documents to *in camera* review, is deeply prejudicial to Tecan. Denying Tecan the ability to review any evidence Petitioner relies upon is highly prejudicial to Tecan's ability to oppose Petitioner's motion and defend the patent. For example, Tecan needs the ability to review the evidence to explain why it is not relevant to this proceeding and otherwise respond to Petitioner's arguments. *Agila*, IPR2015-00503, Paper 13 at 4. Petitioner also asserts that parts of Dr. Matz's declaration that it seeks to exclude are inconsistent with his prior discussions. Paper 26, 3-4. However, without the underlying documents, Petitioner's arguments are so vague as to make these claims unintelligible. *In*

camera review here would violate Tecan's due process right "to submit rebuttal evidence, and to conduct such cross-examination [of any testimonial evidence] as may be required *for a full and true disclosure of the facts.*" *Belden Inc. v. Berk-Tek LLC*, 805 F. 3d 1064, 1080 (Fed. Cir. 2015) (emphasis added).

Petitioner's request to seal and related motion to disqualify also raise serious public interest concerns that merit more, not less disclosure to the public. Given the extreme relief Petitioner seeks—excluding the totality of Dr. Matz's testimony and similar testimony from a substitute declarant—there is a strong interest in an open record to truly assess whether any confidential information was shared with Dr. Matz and how it relates to the allegations in his declaration or the substitute declaration. For example, if the Petitioner seeks to use a short general background conversation with prior art author Dr. Matz about his own work as a pretext to exclude all relevant information concerning the prior art, it raises serious issues concerning gamesmanship in litigation and preventing the Board for receiving and assessing all relevant information. Petitioner's position also presents fundamental concerns about its duty of candor when filing its Petition. To the extent Petitioner had prior conversations with Dr. Matz that it disregarded when filing its Petition, the public would benefit from knowing of such inconsistencies in assessing the merits of Petitioner's invalidity challenge.

Permitting Petitioner to present secret, self-serving evidence while denying Tecan an opportunity to review such evidence contravenes the "Congressional mandate of an open record." 77 Fed. Reg. 48612, 48631 (Aug. 14, 2012). And it would violate statutory provisions that "require the Director [to] prescribe regulations providing that [IPR] . . . files 'shall be made available to the public.'" *Id.*; 35 U.S.C. § 316(a). Given the specific concerns raised here, the proper mechanism to protect any confidential information is to seek a protective order—not preclude the Patent Owner from reviewing evidence.

CONCLUSION

Patent Owner respectfully requests that the Board deny Petitioner's Motion to Seal and order Petitioner to provide Tecan with unredacted copies of the documents that Petitioner relies upon.

Dated: August 19, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SEAL CONFIDENTIAL INFORMATION SUBMITTED *IN CAMERA* was served on August 19, 2025 via email to Petitioner by serving the correspondence email addresses of record as follows:

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