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 AUTHORIZED SUR-REPLY IN OPPOSITION TO MOTION TO DISQUALIFY DR. MIKHAIL MATZ AND MOTION TO SEAL

IDT proliferates unfounded issues in an effort to deprive Tecan and the Board of testimony central to this case. Despite Tecan offering a substitute for Dr. Matz, at IDT's request, following the procedure in *Galderma*, IDT now demands that new conditions be met. These demands are pure gamesmanship and lack any legal basis. IDT throws around various allegations, but these collapse on closer inspection and, if anything, ironically raise serious questions about IDT's own conduct. IDT misapplies regulations on supplemental information in an attempt to shift its burdens to Tecan. IDT's reckless allegation that it would be an ethical issue for Tecan to discuss the present motion with its own witness is without legal support, as the single case on which it relies is on its face distinguishable from IDT's allegations.

IDT's contrived "objections" do not hold water. Dr. Meyer declared *under penalty of perjury* that he "relied on [his] own personal knowledge and information that is publicly accessible" and that his "testimony only concerns [his] opinions and the public materials in the Meyer publication." EX2103.0003. Dr. Meyer affirmed that he had "not spoken with Dr. Matz about [his] opinions or the substance of [his] declaration." *Id.* There is no basis to any of IDT's latest "objections," which instead reveal the lengths to which IDT will go to prevent the Board from seeing its IPR misstatements in their true light. Ultimately, IDT lacks any support for its attempt to use an alleged confidential relationship with one prior art author—based on no more than a few hours' worth of work—to disqualify testimony from ***another*** author with

whom IDT has never communicated and who may be deposed by IDT. It would be highly prejudicial to Tecan, and contrary to the interests of justice, for the Board to be deprived of the testimony of either witness.

I. IDT Fails to Identify Any Support for its Extreme Request to Exclude Relevant Evidence From the Authors of the Meyer Reference

At no point in its Reply does IDT provide factual or legal support for the new "concerns" it raises. Instead, IDT relies exclusively on unsubstantiated and frivolous allegations that cannot justify the extreme and prejudicial remedy it seeks.

IDT willfully misconstrues the standard for substitution. IDT filed a motion to disqualify and therefore carries the heavy burden to exclude evidence. *See* 37 C.F.R. § 42.20(c). Rather than seek a solution, IDT improperly seeks to shift the burden and create a new "standard" with no legal basis in an attempt to impede Tecan's proposed compromise. Tecan has already addressed the concerns in IDT's motion. Tecan offers a substitute declarant willing to adopt wholesale the declaration submitted with Tecan's Response and does so to resolve the "issues" that IDT raised with Dr. Matz. This is precisely the procedure in *Galderma*, the core precedent that IDT relies upon for its motion. IDT's reliance on 37 C.F.R. § 42.123(b) and *Changer v. Copperhead* are entirely misplaced. Dr. Meyer's substitute declaration is not "supplemental" to information in the record—it is substantively identical to Dr. Matz's existing declaration.

In any case, Tecan's witness substitution is undeniably in the interests of

justice. Denial of the substitution would inflict immense prejudice on Tecan, who, at no fault of its own, diligently retained one of only two individuals who can testify as to the relevant portions of the prior art reference. If Dr. Meyer were not permitted to testify in Dr. Matz's place, then Tecan, the Board, and the public will all be deprived of this crucial, highly probative information. The proposed substitution will not prejudice IDT. IDT has been on notice of these opinions since Tecan's Response, and the proposed substitute declaration does not materially differ from that of Dr. Matz. IDT has not made any allegation that it has ever spoken to Dr. Meyer. The testimony offered does not and cannot implicate IDT's confidential information as it concerns publicly disclosed work by Dr. Meyer. It is in the public interest for the Board to consider the testimony of prior art authors, especially where the testimony demonstrates the material inaccuracies raised by the Petition.

Communications with Dr. Matz. IDT attempts to impose restrictions that would prevent Tecan from communicating with its own retained witness about any topic whatsoever. There is simply no legal support—nor any practical need—for such an artificial restriction. In the lone case to which IDT points, the court itself recognized that the facts there were altogether different from IDT's current allegations. In *Erickson v. Newmar Corp.*, the court explained that "[t]he present case, however, does not involve an expert who changed sides and used confidential information," but instead "is about an attorney who offered a monetary inducement

to an expert witness prior to the expert giving his testimony." 87 F.3d 298, 301 (9th Cir. 1996). That is not the case here. Nor is Dr. Matz a consultant for IDT. As IDT concedes, any alleged consultancy between IDT and Dr. Matz ended in November 2024. EX1107. Because Tecan had no awareness of any alleged prior engagement letter or obligations, it engaged Dr. Matz and submitted a declaration from him as part of Tecan's Response. Any "concerns" with Tecan speaking with Dr. Matz were purely tactical—and not raised until *weeks after* IDT first indicated any concerns regarding Dr. Matz. *See* EX2104.0008. Tecan promptly confirmed that it had *never* received any confidential information from Dr. Matz. EX2105.0003.

Critically, IDT cites to no legal authority for the bizarre proposition that Tecan is prohibited from communicating with its own declarant. IDT's position makes no sense. IDT, apparently by design, would render it impossible even to respond to a disqualification motion. IDT's position is squarely contradicted by the central case upon which it relies, *Galderma*. In opposing a motion to disqualify, the patent owner coordinated with the challenged witness and submitted testimony from the witness concerning his prior relationship with the petitioner. PGR2019-00062, Paper 43 at 3. No issues arose as to the propriety of that coordination. In fact, the submission of testimony from challenged experts is typical, and no such concerns have previously been raised or sustained. *See, e.g.*, *Fujifilm Corp. v. Sony Corp.*, IPR2017-01267, Paper 9 at 4; *Agila Specialties Inc. v. Cephalon, Inc.*, IPR2015-00503, Paper 13 at 3.

Dr. Meyer's Declaration Is Not Objectionable. Dr. Meyer's declaration concerns his own ***public*** work that he has sworn is accurate and for which he will sit for a deposition. EX2103.0003. He testified that he did not discuss the substance of the declaration or his opinions with Dr. Matz. *Id*. IDT has raised *no valid basis* to exclude this testimony. IDT suggests that contact between Dr. Meyer and Dr. Matz should disqualify Dr. Meyer, but IDT again provides no legal basis for such a proposition. Nor does IDT raise any issues warranting disqualification or exclusion.

IDT's Request for Discovery is Meritless. IDT's request for Tecan to submit information regarding its communications with its experts is a blatant fishing expedition. Dr. Meyer declared under penalty of perjury that *he did not discuss* the substance of his opinions with Dr. Matz. EX2103.0003. This is more than sufficient to resolve IDT's unwarranted "concerns" regarding Dr. Matz's prior consultation with IDT. Submission of Tecan's communications would not provide any information relevant to the current dispute.

II. The Motion to Seal Should be Denied

IDT still fails to establish the basis for sealing documents. Paper 30 at 1-3. This is IDT's burden to show, and its conclusory allegations are insufficient. IDT's Reply does not even attempt to remedy its failure. Rather, IDT's conclusory arguments highlight its unfair use of confidentiality as a sword and shield. IDT's motion should be denied and the under-seal materials shared with Tecan.

Dated: September 3, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S AUTHORIZED SUR-REPLY IN OPPOSITION TO MOTION TO DISQUALIFY DR. MIKHAIL MATZ AND MOTION TO SEAL** was served on September 3, 2025, via email to Petitioner by serving the correspondence email addresses of record as follows:

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