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Paper 33
Entered: September 19, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEGRATED DNA TECHNOLOGIES, INC.,
Petitioner,

v.

TECAN GENOMICS, INC.,
Patent Owner.

IPR2025-00015 (Patent 10,036012 B2)
IPR2025-00016 (Patent 10,876,108 B2)[1]

Before GEORGIANNA W. BRADEN, ZHENYU YANG, and TIMOTHY G. MAJORS, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Disqualify Mikhail Matz as Patent Owner's Expert Witness
37 C.F.R. § 42.20

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[1] This Order addresses identical issues in two related cases. We exercise our discretion to issue one Order to be entered in each case. The parties are not authorized to use this style heading in their papers.

I. BACKGROUND AND PROCEDURAL POSTURE

Pursuant to Board authorization (Ex. 3004), Integrated DNA Technologies, Inc. ("Petitioner") filed a Motion to Disqualify Dr. Mikhail Matz (Paper 24,[2] "Motion to Disqualify" or "Mot."), as an expert witness for Tecan Genomics, Inc. ("Patent Owner") and a Motion to Seal confidential information submitted to the Board for *In Camera* review (Paper 25, "Motion to Seal" or "Mot. to Seal"). Patent Owner filed Oppositions to both the Mot. to Disqualify and the Mot. to Seal. Papers 27 ("Opposition" or "Opp. to Disqualify"), 28 ("Opp. to Seal"). With our authorization (Ex. 3006), Petitioner then filed a Reply in support of its Motions (Paper 29), to which Patent Owner filed a Sur-Reply in Opposition (Paper 30).

For reasons explained in detail below, we agree with Petitioner.

II. ANALYSIS

In order to decide whether Dr. Mikhail Matz ("Dr. Matz") must be disqualified, we apply a two-prong test. That test, as applied in this case, asks: (1) whether it is objectively reasonable for Petitioner to believe that it had a confidential relationship with Dr. Matz; and (2) whether Petitioner disclosed confidential information to Dr. Matz that is relevant to the current proceeding. *See Galderma S.A. v. Medy-Tox, Inc.*, PGR2019-00062, Paper 56 at 5 (PTAB Feb. 25, 2021); *see also Fujifilm Corp. v. Sony Corp.*, IPR2017-01267, Paper 9 at 2 (PTAB July 10, 2017) (applying the same two-prong test); *Agila Specialties Inc. v. Cephalon, Inc.*, IPR2015-00503, Paper

[2] The parties filed similar papers in each of the proceedings. We refer to those filed in Case IPR2025-00016 for convenience.

13 at 4 (PTAB Aug. 19, 2015) (applying the same two-prong test). As Petitioner recognizes, "[a]ffirmative answers to both inquiries compel disqualification." Mot. 6 (quoting *Galderma*, PGR2019-00062, Paper 56 at 5) (emphasis omitted). Petitioner, as the party seeking disqualification, bears the burden of establishing that both prongs of the test are met. *See* 37 C.F.R. § 42.20(c).

We begin by addressing the question of whether Petitioner had an objectively reasonable belief it had a confidential relationship with Dr. Matz. Petitioner provides a consulting agreement between itself and Dr. Matz, titled with the current parties' names, and directed to this specific case. *See* Ex. 1090. The consulting agreement indicates that Petitioner's work with Dr. Matz would be confidential and that Dr. Matz would not disclose or discuss the information with anyone outside of Petitioner, unless it was a written report provided to a court or other tribunal. *Id.* ¶¶ 1, 2. The agreement further states "you will not work for any other person or organization in connection with the above-referenced matter or any substantially related matter, unless authorized by [Petitioner]. The confidentiality, records disposition, and data security obligations discussed herein will continue after the engagement ends." *Id.* ¶ 9. The record supports Petitioner's position that it had a confidential relationship with Dr. Matz.

We next address whether Petitioner disclosed confidential information to Dr. Matz that is relevant to the current proceeding. Petitioner provides the following evidence: (1) a consulting agreement between itself and Dr. Matz, titled with the current parties' names, and directed to this specific case; (2) multiple emails between Petitioner and Dr. Matz discussing in detail this

specific case, the patent at issue, and the prior art reference co-authored by Dr. Matz that is asserted in the present proceedings; (3) calendar entries reflecting multiple meetings between Petitioner and Dr. Matz along with contemporaneous meeting notes; (4) a paid invoice for Dr. Matz's services; and (5) white board drawing directed to the subject of these proceedings. *See* Exs. 1089–1107.[3]

Patent Owner contends that Petitioner's Motion to Disqualify is unsubstantiated and frivolous. Sur-Reply 1–2. According to Patent Owner,

> Petitioner's aim appears to be nothing more than keeping the Board in the dark as to misstatements it made in its Petition regarding the contents of [the] Meyer [reference]. Rather than simply cross-examine the author on his sworn testimony, Petitioner concocts a false pretext for its motion based on a few hours of background conversation *where Dr. Matz, not Petitioner*, allegedly shared information about his public disclosures in Meyer to preclude this testimony in its entirety.

Opp. to Disqualify 2. Patent Owner then argues that Petitioner fails to meet its burden because it refused to show its confidential information to Patent Owner for purposes of this Motion. Sur-Reply 1–2. Patent Owner asserts that Petitioner must provide specificity as to the *confidential* information that *Petitioner shared with Dr. Matz*, and that general allegations are insufficient. Opp. to Disqualify 6. Despite Patent Owner's opposition to Petitioner's Motion to Disqualify Dr. Matz, it nonetheless offers to substitute Dr. Matz's Declaration (Ex. 2039) with a substantially identical declaration

[3] Many of these exhibits were submitted in full to the Board for *in camera* review, reflecting Petitioner's contention that such exhibits contain confidential and privileged litigation strategy and work product. Petitioner also filed redacted versions of those exhibits that are available to the public.

signed by Dr. Eli Meyer (Ex. 2103, "Meyer Decl.").

Several emails submitted by Petitioner for *in camera* review by the Board demonstrate that Petitioner provided its litigation strategy and confidential case theories to Dr. Matz. *See* Exs. 1091, 1101, 1105. These emails also disclose the discourse between Petitioner and Dr. Matz regarding those theories and strategies. Thus, the record supports Petitioner's contentions that Petitioner disclosed confidential information to Dr. Matz that is relevant to the current proceeding.

Accordingly, the two-prong test for disqualification is met. Petitioner's request to disqualify Dr. Matz from testifying or further consulting with Patent Owner related to these proceedings is granted.

We next address Patent Owner's request to substitute a Declaration signed by Dr. Meyer for the one submitted previously by Dr. Matz.[4] Patent Owner submitted a copy of Dr. Meyer's Declaration for review with track changes to show the differences in comparison to Dr. Matz's Declaration. *See* Ex. 2101. The substance of the two declarations is virtually identical.

Petitioner argues that (1) if Patent Owner continued to correspond and exchange information with Dr. Matz after Patent Owner was notified of the conflict by Petitioner, and/or (2) if Dr. Matz was involved in recruiting Dr. Meyer[5] or in the preparation of Dr. Meyer's Declaration, then the

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[4] Although Patent Owner did not expressly seek or obtain from the Board authorization to move to substitute the Matz and Meyer Declarations, to expedite handling of this dispute, we construe Patent Owner's request as reflected in its opposition papers as comprising a cross-motion to substitute.

[5] We note that Dr. Meyer is the former graduate student of Dr. Matz and co-author with Dr. Matz on the prior art reference at issue in the current proceedings.

Declaration is tainted by Patent Owner's ethical violations and the substitute Declaration should not be allowed. Reply 3–4. Therefore, Petitioner seeks to have Patent Owner submit all "correspondence and notes of any oral communications with Dr. Matz since July 22, 2025 for *in camera* review to evaluate (1) whether Patent Owner continued to consult with Dr. Matz, and (2) whether Dr. Matz was involved in Patent Owner's retention of Dr. Meyer and/or any aspect of the preparation of his declaration." *Id.* at 5.

Patent Owner disagrees with Petitioner and argues that Petitioner is attempting to restrict Patent Owner from "communicating with its own retained witness about any topic whatsoever." Sur-Reply 3. Patent Owner further argues that it never received any confidential information from Dr. Matz. *Id.* at 4 (citing Ex. 2105, 3). And, according to Patent Owner, Dr. Meyer declared under penalty of perjury that *he did not discuss* the substance of his opinions with Dr. Matz. *Id.* at 5 (citing Ex. 2103, 3). Therefore, Patent Owner contends that Petitioner's requests for Patent Owner's "communications with its experts is a blatant fishing expedition." *Id.*

Yet, Patent Owner fails to address the fact that despite already having a signed Consulting Agreement with Petitioner (Ex. 1090), Dr. Matz signed a Consulting Agreement with Patent Owner stating he had "no conflict[s] of interest with respect to [Petitioner], QIAGEN, or their affiliates and that your performance of expert services will not conflict with or violate any obligation you may have with anyone, including without limitation, IDT, QIAGEN, or any of their affiliates" (Ex. 1111 at 1).

Accordingly, based on the multiple emails detailing Petitioner's confidential information provided to Dr. Matz and the fact that Dr. Matz

knowingly signed conflicting Consulting Agreements and, based on evidence available in the record, did not inform either Petitioner or Patent Owner of Dr. Matz's conflict, we agree with Petitioner that additional information is warranted. Therefore, we order that all correspondence since July 22, 2025 between (1) Patent Owner and Dr. Matz, (2) Patent Owner and Dr. Meyer, and (3) Dr. Meyer and Dr. Matz regarding this case (including without limitation Dr. Meyer's or Dr. Matz's Declarations) be submitted for *in camera* review by the Board. Regarding No. 3, the Board expects Patent Owner's counsel to undertake reasonable efforts to investigate and obtain such correspondence (if it exists) directly from Dr. Meyer. Additionally, we order that Patent Owner submit a signed declaration under oath confirming that all known correspondence identified by Patent Owner's reasonable search and investigation has been submitted as required under this order.

The Board defers its ruling on Patent Owner's request to permit substitution of the Meyer Declaration until the Board has had an opportunity to review *in camera* the correspondence that Patent Owner is required to submit pursuant to this Order.

III. ORDER

In consideration of the foregoing, it is:

ORDERED that Petitioner's Motion to Disqualify Dr. Mikhail Matz as Patent Owner's Expert Witness is *granted*;

FURTHER ORDER that Dr. Mikhail Matz's Declaration and testimony is excluded from the proceedings;

FURTHER ORDERED that Petitioner's Motion to Seal Confidential Information Submitted for *In Camera* Board Review is *granted* and Exhibits 1091, 1093–1101, 1103, and 1105 will be sealed;

FURTHER ORDERED that all correspondence since July 22, 2025 between Patent Owner and Dr. Matz related to this proceeding be submitted for *in camera* review by the Board no later than Friday, September 26, 2025;

FURTHER ORDERED that all correspondence since July 22, 2025 between Patent Owner and Dr. Meyer related to this proceeding be submitted for *in camera* review by the Board no later than Friday, September 26, 2025;

FURTHER ORDERED that all correspondence since July 22, 2025 between Dr. Meyer and Dr. Matz related to this proceeding be submitted for *in camera* review by the Board no later than Friday, September 26, 2025;

FURTHER ORDERED that Patent Owner submit a signed declaration under oath that all known correspondence has been submitted as required under this Order no later than Friday, September 26, 2025;

FURTHER ORDERED that the parties shall stipulate to extended deadlines for the submission of Petitioner's Reply Brief to Patent Owner's Response (Paper 21); and

FURTHER ORDERED that no deposition of Dr. Meyer shall proceed until further notice from the Board.

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