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 IPR2025-00016
Patent 10,876,108 B2

IDT'S AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

PO sought Director Review for two reasons, alleging that (1) institution "conflicts with important policy directives;" and (2) the Board abused its discretion.[1] Paper 11 ("Req."). The Director authorized this Response. EX3100.

I. The Institution Decision Was Appropriate.

A. *Parallel Proceedings*. The challenged patent, EX1002, is one of five asserted by PO against IDT in district court.[2] IDT timely requested IPR of all asserted claims of all asserted patents and filed a motion to stay the district court litigation. At that time, the district court case was in early fact discovery and claim construction had not begun. Despite PO opposing the stay, very little happened in the ensuing months: PO put off document production for months (before requesting an extension for substantial completion), the parties forwent claim construction, and no depositions were noticed.

Given these facts, it was not surprising that PO did not raise any *Fintiv* arguments in its POPR, *see* Paper 6. That strategic decision precludes raising them for the first time here, as the Director's procedures are clear: "The Director will not

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[1] PO also has argued a *separate* Panel abused its discretion by instituting IPR of 3 other patents. *E.g.*, IPR2024-01502, Paper 11. Allegedly, lightning has struck twice.

[2] PO asserted 4 of those patents against QIAGEN. QIAGEN filed separate petitions for IPR of those patents. IDT is not a party in those proceedings, nor QIAGEN here.

consider . . . new arguments not part of the official record." USPTO, *Director Review Process* at 3.E (last modified Feb. 5, 2025).

Regardless, to the extent PO's reference to the parties' "parallel litigation," Req. at 5, had any relevance to "policy considerations" underlying Institution, the issue has now been mooted. On May 19, 2025, the district court entered stipulated stays of both the IDT and QIAGEN litigations.

Nor should the Director credit PO's complaint that it is "unduly burden[ed]" because IPR petitions have been filed by two companies—it chose to sue both of them. PO's citation, Req. at 6, to the Trial Practice Guide's discussion of a situation in which a single entity files multiple petitions challenging the same patent does not apply to this situation of independent defendants each filing a single petition.

B. *Expert Testimony.* PO asks the Director to vacate and reverse the Board's Institution decisions on both patents in this family, citing the Board's recent "FAQs" that note, "[1] as a matter of efficiency, [2] extensive reliance on expert testimony and/or [3] reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court." Req. at 3.

The Board's guidance does not support PO's bid for a do-over: (1) PO's request does not promote "efficiency," (2) neither the Petition nor the Board "extensive[ly] rel[ied] on expert testimony," and (3) what PO characterizes as a "reasonable dispute[] between experts" over data analysis is actually its own

disagreement with the Board's determination that Meyer disclosed on its face that its method resulted in the enrichment of certain sequences.

First, PO's request that the Board throw out all the work it has already done "so that an Article III court can fully vet the credibility of these expert witnesses," Req. at 5, is the opposite of efficient. At this juncture, the PTAB has devoted significantly more resources to these issues than the district court, which has not held any hearings or rendered any substantive decisions. The Board has already found there is a "reasonable likelihood" at least one of the claims of each of the asserted patents is unpatentable, which would narrow—or moot entirely—the district court proceedings. Yet PO implores the Director to vacate and reverse the Board's decision so that the district court can start at square one, thereby burdening not only the Court and the parties, but also witnesses and third parties, with everything required to litigate a damages claim on highly technical issues from fact discovery through a jury trial, concerning patents that have a "reasonable likelihood" of being invalid.

Second, contrary to PO's representations, the Board made clear that its decision rested on the teachings of Meyer, the anticipating reference, and not on Dr. Sims' testimony alone. *E.g.*, Paper 7 at 16-23. In any event, PO's argument goes too far because of course IPR petitions rest on expert testimony. The guidance quoted by PO at 3 makes clear that "the Board may consider expert testimony,"

FAQ 21, and it does so routinely, particularly in cases involving highly technical subject matter. IDT here offers Dr. Sims' testimony to provide technical background regarding the field of DNA sequencing, which combines both biochemistry and data analysis, and to illustrate and explain—at a sequence level—what occurs at each step of the Meyer method. EX1085 at 97-124. Notably, PO's expert does not dispute the accuracy of those step-by-step explanations and illustrations, showing that there are not substantial factual disputes regarding expert testimony.

Third, PO mischaracterizes the question of whether Meyer disclosed "enrichment" as a matter of conflicting expert testimony regarding "how to interpret the sequencing data disclosed in Meyer," Req. at 4, ignoring that when the Board rejected PO's assertion that "Meyer does not disclose enrichment," it relied on the disclosures of Meyer—not Dr. Sims' opinions about Meyer. The Board expressly found that "contrary to [PO's] assertion" that "Meyer does not disclose enrichment," Meyer "specifically discloses" finding the sequence of interest in 16% of reads, "slightly more than the expectation (~10%)." Paper 7 at 19.

C. "*Weakness*." PO claims the fact that the Board instituted IPR of all claims and all grounds based on a single reference shows a "lack of strength," Req. at 8. To the contrary, the Board's finding that Petitioner established "a reasonable

likelihood" that a single reference anticipates the primary claim of the patent is a testament to the strength of the Petition.

II. The Board Did Not Abuse Its Discretion.

PO's argument that the Board "abused its discretion" amounts to nothing more than a listing of the Board's factual determinations against it. Req. at 8-12.

First, PO appears to argue that the Board's finding that Meyer discloses "enrich[ing] for the nucleic acid sequence of interest," is somehow inconsistent with its observation that the method is "directed toward improving the error rate of sequencing reads." Req. at 8-9. PO searches for inconsistency where there is none. The Board specifically found that in Meyer, the "claimed enrichment" was responsible for the improved error rate: Meyer "reduc[es] read artifacts by increasing the proportion of 3' end fragments in the total read." Paper 7 at 19.

Second, PO claims the Board abused its discretion because it disagreed with PO's factual arguments for why Meyer does not disclose the "sequence of interest" and "enriching" limitations. Req. at 9-12. But PO simply requests reconsideration of issues already considered and resolved against it. *See*, *e.g.*, Paper 7 at 18-23. The Board expressly concluded that, on the questions of whether Meyer discloses "a 'sequence of interest,'" and "amplifying . . to enrich," it found "Petitioner's arguments more persuasive than Patent Owner's arguments." *Id.* at 18.

For the foregoing reasons, Director Review should be denied.

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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 IDT'S Authorized Response to Director Review Request was served via electronic mail on the following lead and back-up counsel of record for Patent Owner.

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