
From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Wednesday, August 13, 2025 3:10 PM
To: Padro, John P; Beavers, Timothy James
Cc: IDT-Tecan-IPRs; DG-Goodwin-Tecan
Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

John,

I think your concerns are misplaced. I've made a small tweak to the proposed message to the Board. And yes, we have not communicated with Dr. Matz while this dispute has been pending, and we will not communicate with him while this dispute is pending.

Dear Honorable Board,

On August 6, Petitioner filed a motion to disqualify Dr. Maz, one of Patent Owner's witnesses in the above-captioned proceedings, and a related motion to seal. Patent Owner's oppositions are currently due on Thursday, August 14.

Patent Owner is exploring the feasibility of withdrawing Dr. Matz and submitting a similar declaration from a substitute expert, thus potentially avoiding the need for the Panel to decide Petitioner's motion to disqualify, but it requires additional time to assess and confer with opposing counsel. Patent Owner requests that its deadline to file its oppositions to these motions be extended by five days, to Tuesday, August 19.

Patent Owner conferred with Petitioner. Petitioner maintains that it is important that this issue be resolved promptly to facilitate any resulting discovery and the timely filing of its Replies, but given that the requested extension is only five days **and Patent Owner's representation that it will cease communicating with Dr. Matz regarding the substance of this case until this issue is resolved**, Petitioner does not oppose this request.

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Padro, John P <JPadro@goodwinlaw.com>
Sent: Wednesday, August 13, 2025 2:20 PM
To: Fletcher, Thomas <TFletcher@wc.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Tom,

We are concerned that IDT is seeking manufacture any reason to oppose a reasonable 5-day extension. Even though this extension is specifically designed to try and resolve the issues raised by *Petitioner*, we would have expected that such an extension could quickly and easily be agreed to as professional courtesy, one that we have previously extended to IDT.

To your questions:

- The engagement letter with this specific provision was provided to you on August 5. Moreover, as we discussed and explained in writing at that time, and since, we generally disagree as to the need and relevance of these materials.
- The restrictions are as follows (and as you requested): After notifying Dr. Matz of the following, we will not discuss the substance of this case with him until the resolution of these issues. In exchange, please confirm that you will also abide by the same restrictions and will not contact Dr. Matz.

Again, please confirm our agreement and that we can send the following.

Dear Honorable Board,

On August 6, Petitioner filed a motion to disqualify Dr. Maz, one of Patent Owner's witnesses in the above-captioned proceedings, and a related motion to seal. Patent Owner's oppositions are currently due on Thursday, August 14.

Patent Owner is exploring the feasibility of withdrawing Dr. Matz and **submitting a similar declaration from a substitute expert supplemental evidence**, thus potentially avoiding the need for the Panel to decide Petitioner's motion to disqualify, but **it requires additional time to assess and confer with opposing counsel is not yet in a position to do so**. Patent Owner requests that its deadline to file its oppositions to these motions be extended by five days, to Tuesday, August 19.

Patent Owner conferred with Petitioner. Petitioner maintains that it is important that this issue be resolved promptly to facilitate any resulting discovery and the timely filing of its Replies, but given that the requested extension is only five days, Petitioner does not oppose this request.

From: Fletcher, Thomas <TFletcher@wc.com>

Sent: Wednesday, August 13, 2025 1:40 PM

To: Padro, John P <JPadro@goodwinlaw.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>

Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>

Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

John,

I'm having problems with two parts of your email. You haven't given us your engagement letter with Dr. Matz – you gave us an inexplicably redacted version. But more importantly, what is "this restriction"? We think you should not be talking to him about this case.

Tom

Thomas S. Fletcher
Williams & Connolly LLP

680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Padro, John P <JPadro@goodwinlaw.com>
Sent: Wednesday, August 13, 2025 1:35 PM
To: Fletcher, Thomas <TFletcher@wc.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Tom,

As set forth in our engagement letter with Dr. Matz (which you have seen), Tecan made clear to Dr. Matz that it does not want any potential third-party confidential information. And without getting into the merits raised in your motion, we simply note that your unsupported insinuations to contrary are not well taken and not productive.

In any case, we have no issue agreeing to applying this restriction to the case more broadly. Please confirm we have an agreement on these restrictions, and we can send the original revised message below.

Dear Honorable Board,

On August 6, Petitioner filed a motion to disqualify Dr. Maz, one of Patent Owner's witnesses in the above-captioned proceedings, and a related motion to seal. Patent Owner's oppositions are currently due on Thursday, August 14.

Patent Owner is exploring the feasibility of withdrawing Dr. Matz and **submitting a similar declaration from a substitute expert supplemental evidence**, thus potentially avoiding the need for the Panel to decide Petitioner's motion to disqualify, but **it requires additional time to assess and confer with opposing counsel is not yet in a position to do so**. Patent Owner requests that its deadline to file its oppositions to these motions be extended by five days, to Tuesday, August 19.

Patent Owner conferred with Petitioner. Petitioner maintains that it is important that this issue be resolved promptly to facilitate any resulting discovery and the timely filing of its Replies, but given that the requested extension is only five days, Petitioner does not oppose this request.

Regards,

John Padro



Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7349
f +1 212 428 6751
JPadro@goodwinlaw.com



From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Wednesday, August 13, 2025 1:03 PM

To: Padro, John P <JPadro@goodwinlaw.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

John,

Your note below steamrolls right past our concern. Our concern is that Dr. Matz has access to our confidential information. Your consulting with him risks disclosure of that. It may have been one thing for you to speak with him when you may not have known that fact. But now you do (and have known since we raised this issue). We think any consultation on the substance of this matter by Tecan with Dr. Matz since we raised this issue is highly inappropriate. That is our specific concern.

As I understand your representation below, you want to “notify him of the following” and you are only promising to refrain from communicating with him about the *motion*, not the *case*. We view that as unacceptable.

If I’ve misunderstood the scope of your interactions, we can revisit this. Otherwise, you need to revise our position:

Petitioner understands from conferring with Patent Owner that Patent Owner has continued to consult with Dr. Matz concerning the substance of this matter despite Petitioner’s objections. Petitioner therefore maintains that it is urgent that this matter be resolved promptly to prevent the disclosure of its confidential information and therefore opposes the requested extension.

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Padro, John P <JPadro@goodwinlaw.com>
Sent: Wednesday, August 13, 2025 12:02 PM
To: Fletcher, Thomas <TFletcher@wc.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Tom,

We do not agree that there is any prejudice to IDT, nor do we understand your specific concerns regarding Dr. Matz. That said, after notifying him of the following, we will not discuss the substance of your motion with him until the resolution of these issues. In exchange, please confirm that you will also abide by the same restrictions and will not contact Dr. Matz.

In addition, your revisions misstate our position, and we corrected it below. If there are no further edits, we will send this out shortly.

Dear Honorable Board,

On August 6, Petitioner filed a motion to disqualify Dr. Maz, one of Patent Owner's witnesses in the above-captioned proceedings, and a related motion to seal. Patent Owner's oppositions are currently due on Thursday, August 14.

Patent Owner is exploring the feasibility of withdrawing Dr. Matz and **submitting a similar declaration from a substitute expert supplemental evidence**, thus potentially avoiding the need for the Panel to decide Petitioner's motion to disqualify, but **it requires additional time to assess and confer with opposing counsel is not yet in a position to do so**. Patent Owner requests that its deadline to file its oppositions to these motions be extended by five days, to Tuesday, August 19.

Patent Owner conferred with Petitioner. Petitioner maintains that it is important that this issue be resolved promptly to facilitate any resulting discovery and the timely filing of its Replies, but given that the requested extension is only five days, Petitioner does not oppose this request.

Regards,

John Padro



Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7349
f +1 212 428 6751
JPadro@goodwinlaw.com



From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Wednesday, August 13, 2025 11:03 AM
To: Padro, John P <JPadro@goodwinlaw.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

Lest there be any confusion, I meant "delayed resolution of this issue prejudices IDT." I am not switching sides in this case.

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Wednesday, August 13, 2025 11:00 AM
To: 'Padro, John P' <JPadro@goodwinlaw.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

John,

It is important for us to know that after we raised this issue you have stopped substantively communicating with Dr. Matz about this case. If that is not true, delayed resolution of this issue prejudices Tecan. But if you can represent that you've stopped communicating with him while this issue is being resolved, we could sign onto the following version of an email to the Board:

Dear Honorable Board,

On August 6, Petitioner filed a motion to disqualify Dr. Maz, one of Patent Owner's witnesses in the above-captioned proceedings, and a related motion to seal. Patent Owner's oppositions are currently due on Thursday, August 14.

Patent Owner is exploring the feasibility of withdrawing Dr. Matz and submitting supplemental evidence, thus potentially avoiding the need for the Panel to decide Petitioner's motion to disqualify, but is not yet in a position to do so. Patent Owner requests that its deadline to file its oppositions to these motions be extended by five days, to Tuesday, August 19.

Patent Owner conferred with Petitioner. Petitioner maintains that it is important that this issue be resolved promptly to facilitate any resulting discovery and the timely filing of its Replies, but given that the requested extension is only five days, Petitioner does not oppose this request.

Let us know,

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Padro, John P <JPadro@goodwinlaw.com>
Sent: Wednesday, August 13, 2025 10:48 AM
To: Fletcher, Thomas <TFletcher@wc.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Tom,

While it sounds like you may not oppose the extension, we appreciate you getting back to us on your final position on the extension (and any proposed edits to the correspondence to the Board) as soon as possible. Given the deadlines tomorrow, we would like to send something to the Board no later than 1 PM ET.

We will further apprise you as we assess a potential declaration from Dr. Meyer.

John Padro



Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7349
f +1 212 428 6751
JPadro@goodwinlaw.com



From: Padro, John P
Sent: Wednesday, August 13, 2025 10:23 AM
To: Fletcher, Thomas <TFletcher@wc.com>; Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Tom,

At this point, we are still looking at whether a declaration from Dr. Meyer is a potential solution and we have not withdrawn Dr. Matz's declaration. Given this, we don't have more information on the questions you've raised, which we can further consider during the extension.

That said, we don't believe getting your position (whether you oppose or not) on a 5-day extension to potentially resolve the issue for the Board should be that difficult to consent to. However, to the extent you cannot agree to the extension, we can note that in the proposed message to the Board. Again, we ask that you not further delay the extension request while the parties investigate potential solutions to your motion regarding Dr. Matz.

I will give you a call in a few minutes to discuss your position on the extension.

John

From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Wednesday, August 13, 2025 9:47 AM
To: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

TJ,

We have several questions about your proposed request for an extension and your proposed substitution of evidence, and we are available to confer today. In the interim, here are a few issues that we think will be important to whether we can work something out.

- Has Tecan stopped consulting with Dr. Matz? When was the last time Tecan substantively consulted with Dr. Matz?
- What does “substantially the same” mean? We view the Matz declaration as tainted, and we do not think it would be appropriate for it to be given to Dr. Meyer with the prompt “do you agree with this?” How will Tecan ensure that any testimony from Dr. Meyer is independent of Dr. Matz?

Regards,

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Tuesday, August 12, 2025 10:46 PM
To: 'Beavers, Timothy James' <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

TJ,

We are conferring with our client in the morning. If you have a draft of the email you want to send the Board regarding your extension request, it would be helpful to have it in advance of that call.

Thank you,

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Sent: Tuesday, August 12, 2025 6:57 PM
To: Fletcher, Thomas <TFletcher@wc.com>

Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>

Subject: RE: IPR2025-00015 and IPR2025-00016

Hi Tom,

We have been following up with our client on your suggestion about submitting an alternative declarant to Dr. Matz. While we disagree with your concerns regarding Dr. Matz, we believe we may be able to provide a substitute declarant, specifically Dr. Eli Meyer. We propose that in exchange for IDT withdrawing its motion, Patent Owner would seek leave to file an unopposed motion to substitute the declaration and update the record to account for this new declaration. The substitute declaration would be substantially the same as Dr. Matz's declaration. This will eliminate the issues for the PTAB, address your concerns regarding Dr. Matz, and avoid significant prejudice to Tecan. Please let us know your position on this.

Given Tecan's Thursday deadline, we intend to seek a short extension on our opposition to your motion to disqualify until Tuesday so that we can confirm the viability of this proposed compromise. We will also hold off on further emailing the Board regarding the redacted Matz materials for now. Please let us know if you agree to this extension.

Thank you,
TJ

Timothy Beavers
he/him/his



Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7208
f +1 212 355 3333
TBeavers@goodwinlaw.com



From: Fletcher, Thomas <TFletcher@wc.com>

Sent: Monday, August 11, 2025 9:02 PM

To: Beavers, Timothy James <TBeavers@goodwinlaw.com>

Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>

Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

TJ,

If you wish to send this message to the Board, you can. We remain available to speak about any of these issues.

Regards,

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Sent: Monday, August 11, 2025 5:46 PM
To: Fletcher, Thomas <TFletcher@wc.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Hi Tom,

On the privilege log issue, our concern is Petitioner has not clearly asserted the basis for withholding these materials. For example, your motion to seal asserts these materials are confidential but does not mention privilege or work product (or raise any allegations as to those protections). This is why we had previously discussed a privilege log. We continue to maintain our objections on this procedure and your assertions.

We will further consider your point regarding expanding Dr. Bustamante's declaration or some alternative declaration. That said, we do not agree that the context you have provided makes it such that Dr. Matz's declaration should be excluded, especially given the prejudice to Tecan. This is why again we seek more information.

Below are our additions to the message to the Board (along with your additions). We also correct the current date for our response, which you listed as Wednesday but is actually Thursday. If you have anything further, please let us know as we plan to send this message later today.

Thank you,
TJ

Dear Honorable Board,

Patent Owner's Request & Position:

Petitioner relies extensively on redacted materials in its Authorized Motion to Disqualify Dr. Mikhail Matz. *See e.g.* Paper 26 at 3-4 (citing Exs. 1091, 1093, 1094, 1095, 1096, 1097, 1098, 1099, 1101, 1103, 1105). However, these materials have not been provided to Patent Owner, whose response to this motion is due on Thursday, August 14, 2025. As a result, Patent Owner cannot fully respond to Petitioner's arguments and Patent Owner respectfully requests that the Board:

1. Require Petitioner to provide unredacted copies of all the documents they rely upon in their motion or, alternatively, permit Patent Owner to file a motion seeking discovery of these materials. To the extent these are not produced, Petitioner should be precluded from relying on

these materials. Patent Owner is prepared to treat these materials as highly confidential outside counsel eyes only and stipulate to a protective order to those ends.

2. Extend the deadline for Patent Owner's response to Petitioner's motion until 7 days after Petitioner's production of these materials (or the resolution of this issue).

As a result of Petitioner's heavy reliance on redacted communications, Patent Owner is unable to fully respond to Petitioner's contentions that Dr. Matz received confidential information relevant to the proceeding that would support the alleged basis for disqualifying him. *See e.g.* Paper 26 at 2-4. For example, Petitioner claims that its "discussions with Dr. Matz became the core of [the] petition" and invites the Board to compare its redacted exhibits to the Petition. Petitioner goes on to make various allegations about the subject matter of what was discussed in those communications and how it allegedly supports their motion for disqualification. Paper 26 at 4. Petitioner also challenges the accuracy of Dr. Matz's Declaration (EX2039) based on redacted materials. *Id.* However, none of the materials they rely upon have been provided to Patent Owner, despite several requests.

Patent Owner cannot fully respond to Petitioner's claims because the core parts of what Petitioner relies upon are redacted in their entirety. *See e.g.*, Exs. 1093, 1096, 1097, 1098, 1105. As the Board found in *Agila*, a party cannot be permitted to use these confidential or privileged materials as both a sword and a shield. *Agila Specialties Inc. v. Cephalon, Inc.*, IPR2015-00503, Paper 13 at 5 (P.T.A.B. Aug. 19, 2015) ("[T]o the extent [a party] intends to wield a [] communication (or any other communication between [that party] and [an expert]) as a sword to support its disqualification motion, [that party] cannot hide behind the shield of attorney-client privilege and refuse to reveal the specifics of the communication."). Allowing the reliance on these materials without any disclosure to Patent Owner deprives Patent Owner of sufficient notice and the opportunity to be heard on the merits of the arguments. It deprives Patent Owner of due process including the ability to fairly test Petitioner's unilateral assertions. Moreover, to the extent Petitioner claims that this information is reflected in the public filings, Petitioner has waived any claim of privilege or confidentiality to the materials. It cannot selectively choose which materials to disclose and which to not. **Ultimately, it is Petitioner's burden to prove that Dr. Matz received confidential information and that the allegedly confidential information is related to this case. Dr. Matz's disclosure of information about his own public work is plainly insufficient to carry this burden. Without the actual documents or specific allegations, Patent Owner is deprived of due process and cannot directly respond to the allegations made by Petitioner.**

Patent Owner does not seek an indefinite extension but asks that the materials be produced no later than the end of this week (or sooner if possible). This will have no effect on the remaining schedule, where Petitioner's reply is due on October 10.

In addition, the only communications at issue here are those that the Petitioner has relied upon and made an issue by its arguments. This is for good reason as the standard for a motion to disqualify concerns the information he received from Petitioner – not Patent Owner.

Petitioner's position:

Petitioner opposes these requests.

Patent Owner ignores that the Board granted Petitioner's request to submit these exhibits *in camera*, Ex. 3003, making its request now effectively a request for reconsideration. The Board's Ex. 3003 decision was consistent with the Board's practice in *Galderma S.A. v. Medy-Tox, Inc.*, PGR2019-00062, Paper 56

at 4. Patent Owner ignores this authority. Patent Owner instead cites *Agila*, which is inapposite for several reasons, including that the consulting agreement was with a third party, related to a different case on different subject matter, and there was no request for *in camera* review. IPR2015-00503, Paper 13 at 5.

Patent Owner's request would exacerbate the exact prejudice Petitioner is trying to remedy by filing this motion: the disclosure of its confidential litigation strategy to its adversary. It would be highly prejudicial and contrary to law. Patent Owner has cited no case, and Petitioner is aware of none, that holds that a party must reveal to opposing counsel the substance of its confidential communications with an expert in support of a motion to disqualify. To the contrary, the Board and other tribunals routinely permit parties to submit such evidence *in camera*. *E.g.*, *Galderma*, PGR2019-00062, Paper 56 at 4; *King v. DePuy Orthopaedics*, 2023 WL 5624710, at *8 (D. Ariz. Aug. 31, 2023). As the cases cited in Petitioner's motion demonstrate, Patent Owner does not need to be in a position to pick apart the precise communications between Petitioner and Dr. Matz—the existence of the confidential relationship with Dr. Matz alone requires disqualification.

Petitioner also opposes Patent Owner's request for an indefinite extension of the briefing schedule. This dispute needs to be resolved in a timely matter so that any depositions can be taken and the Petitioner's Replies submitted on schedule. The prejudice to Petitioner from Dr. Matz working with Patent Owner is already great and compounding daily. Tellingly, Patent Owner still cites no case, and Petitioner is aware of none, permitting an expert to switch sides in the *same litigation*. To the contrary, courts routinely disqualify experts under far less egregious facts, as explained in the motion.

The Board should maintain its prior order, Ex. 3003, and require Patent Owner's response, if any, to be filed on **Thursday**.

To the extent that the Board is inclined to grant Patent Owner's request, Petitioner requests that the Board likewise require Patent Owner to provide Petitioner with unredacted versions of its agreements, communications with Dr. Matz, and notes thereof to permit an assessment of Dr. Matz's sharing of Petitioner's confidential information with Patent Owner.

Timothy Beavers
he/him/his



Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7208
f +1 212 355 3333
TBeavers@goodwinlaw.com



From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Monday, August 11, 2025 2:12 PM
To: Beavers, Timothy James <TBeavers@goodwinlaw.com>

Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

Hi TJ,

I'm not sure we're joining issue on the log point, but yes, the Motion to Seal outlines why we think the materials that we redacted are appropriately redacted. Dr. Matz was a consultant for us. Communications with non-testifying experts are afforded substantial protection under the Federal Rules. The work he generated at our direction is attorney work product. Our notes of our conversations with him reflect attorney mental impressions, which is the most protected category of material under the law. If this is not what you're asking about, I'm available to discuss from 4 pm to 5:30 pm eastern.

As for your proposed outreach to the Board and your email below, we struggle to see how a narrowed or revised declaration from Dr. Matz could work because he is the problem. If you wanted to supplement Dr. Bustamente's declaration, I could imagine a world in which that might work, and we remain open to discussing it.

In the interim, if you maintain that you need to email the Board this afternoon, here is our position on the requests you shared this weekend:

Petitioner opposes these requests.

Patent Owner ignores that the Board granted Petitioner's request to submit these exhibits *in camera*, Ex. 3003, making its request now effectively a request for reconsideration. The Board's Ex. 3003 decision was consistent with the Board's practice in *Galderma S.A. v. Medy-Tox, Inc.*, PGR2019-00062, Paper 56 at 4. Patent Owner ignores this authority. Patent Owner instead cites *Agila*, which is inapposite for several reasons, including that the consulting agreement was with a third party, related to a different case on different subject matter, and there was no request for *in camera* review. IPR2015-00503, Paper 13 at 5.

Patent Owner's request would exacerbate the exact prejudice Petitioner is trying to remedy by filing this motion: the disclosure of its confidential litigation strategy to its adversary. It would be highly prejudicial and contrary to law. Patent Owner has cited no case, and Petitioner is aware of none, that holds that a party must reveal to opposing counsel the substance of its confidential communications with an expert in support of a motion to disqualify. To the contrary, the Board and other tribunals routinely permit parties to submit such evidence *in camera*. *E.g.*, *Galderma*, PGR2019-00062, Paper 56 at 4; *King v. DePuy Orthopaedics*, 2023 WL 5624710, at *8 (D. Ariz. Aug. 31, 2023). As the cases cited in Petitioner's motion demonstrate, Patent Owner does not need to be in a position to pick apart the precise communications between Petitioner and Dr. Matz—the existence of the confidential relationship with Dr. Matz alone requires disqualification.

Petitioner also opposes Patent Owner's request for an indefinite extension of the briefing schedule. This dispute needs to be resolved in a timely matter so that any depositions can be taken and the Petitioner's Replies submitted on schedule. The prejudice to Petitioner from Dr. Matz working with Patent Owner is already great and compounding

daily. Tellingly, Patent Owner still cites no case, and Petitioner is aware of none, permitting an expert to switch sides in the *same litigation*. To the contrary, courts routinely disqualify experts under far less egregious facts, as explained in the motion.

The Board should maintain its prior order, Ex. 3003, and require Patent Owner's response, if any, to be filed on Wednesday.

To the extent that the Board is inclined to grant Patent Owner's request, Petitioner requests that the Board likewise require Patent Owner to provide Petitioner with unredacted versions of its agreements, communications with Dr. Matz, and notes thereof to permit an assessment of Dr. Matz's sharing of Petitioner's confidential information with Patent Owner.

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Williams & Connolly LLP
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Washington, DC 20024
(202) 434-5497

From: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Sent: Monday, August 11, 2025 1:08 PM
To: Fletcher, Thomas <TFletcher@wc.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

Hi Tom,

As we discussed during our prior meet-and-confer, our understanding was that you would provide a log on a document-by-document basis that identifies the reasons for withholding these materials (and the others that have been partly withheld). Ex. 1109 does not provide that. However, in the interest of time, please confirm the only basis for withholding these materials is set forth in your motion to seal in camera documents. If that is not true, please explain your position.

As we discussed previously, both at the prior meet-and-confer and by email, we continue to disagree on these issues.

- Petitioner relies on both its alleged engagement letter but also the substance of its alleged communications with Dr. Matz. For those communications, Petitioner has redacted the very material it purports to rely on. Having now put those materials as the basis for your motion and made numerous arguments as to the content and relevance of those materials, you cannot shield those materials. This is the quintessential circumstances where materials are hidden and used as a sword and shield. It also raises fundamental due process concerns.
- As we previously discussed, we also disagree with your interpretation of *Agila* and its applicability here.
- We also continue to disagree that our communications with Dr. Matz are relevant to your motion, which concerns alleged information you shared with him and the communications you have identified.

- Our position remains the same that the parties should work to come up with an alternative remedy that does not deprive the PTAB of this clearly relevant information—we are looking into alternative measures to resolve this issue, but note, we are limited in doing so given the materials you have redacted. For example, we think that potential remedies could include narrowing or revising the declaration to address specific issues if needed.

We have now raised these concerns numerous times without resolution. Please provide your position for the Board by 2 PM ET so that we can assess whether the parties need to discuss the issues again at 4 PM ET.

Thank you,
TJ

Timothy Beavers
he/him/his



Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7208
f +1 212 355 3333
TBeavers@goodwinlaw.com



From: Fletcher, Thomas <TFletcher@wc.com>
Sent: Monday, August 11, 2025 8:53 AM
To: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: RE: IPR2025-00015 and IPR2025-00016

EXTERNAL

TJ,

I write in response to your weekend email.

1. You asked about the log. We provided a log of our communications with Dr. Matz as Exhibit 1109. For the communications that were not produced in full, we provided redacted versions, which give all the to/from/date/subject information associated with a log. We do not understand what additional information you need.

We are available to confer at 4 pm. Please circulate a dial in.

2. We disagree that we must provide you those unredacted versions of our confidential communications with Dr. Matz. IDT has been and continues to be prejudiced by your consulting with Dr. Matz in this matter. As explained in our motion to disqualify, there is no basis to compound that prejudice by providing Tecan even more of IDT's confidential information.

Your reliance on *Agila* is misplaced for the reasons we explained previously. In *Agila*, the consulting agreement concerned an unrelated matter, unlike here, where Dr. Matz's consulting indisputably related to the same matter. In *Agila*, there was also a question of whether the relationship ran to the relevant entity, unlike here, where Dr. Matz's consulting agreement is with IDT and its counsel in this matter. In *Agila*, the movant provided no information or documents about the subject matter of the prior consulting, unlike here, where Dr. Matz's agreement clearly sets out the subject matter of the consulting as do the redacted documents we have provided. And finally, in *Agila*, there was no request to provide the Board the relevant information *in camera*, unlike here, that request has already been granted.

There is no "sword vs. shield" issue. Our consulting agreement, which you have in full, provides the basis for Dr. Matz's disqualification. The communications have been submitted to the Board *in camera*, as authorized by the Board, to the extent that the Board seeks further evidence of the substantive nature of the relationship between Petitioner and Dr. Matz.

Over these past few weeks, you have not directed us to any case suggesting that the specific content of our communications with Dr. Matz is relevant to the scope of relief here. If you are aware of any such case, we would be happy to consider it.

We note that you have not provided the substance of any of your communications with Dr. Matz, and refused to provide a copy of your agreement with him for several days. To the extent you contend that the substantive content (as opposed to the substantive nature) of the parties' communications is relevant (it is not), the scope of your communications with Dr. Matz are equally relevant, and Goodwin and Tecan should provide all of their communications with Dr. Matz relating to this matter (including an unredacted retainer, any email or written communications, and the notes of any video- or teleconferences). Please let us know if you are willing to do that.

3. We trust that Goodwin and Tecan have not been continuing to consult with Dr. Matz since we raised this issue—to the extent that you have, please let us know immediately.

4. Your email mentions other proposals. We remain open to hearing them. As noted above, we can be available at 4 pm today. If you nevertheless insist in contacting the Board, we will provide an insert for the email stating our position opposing the request.

Regards,

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Sent: Saturday, August 9, 2025 12:47 PM
To: Fletcher, Thomas <TFletcher@wc.com>

Cc: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>; DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>

Subject: Re: IPR2025-00015 and IPR2025-00016

Hi Tom,

We have not received the privilege log that you agreed to provide. Please provide that immediately.

In addition, we have reviewed your submission, which confirms our earlier concerns regarding IDT's reliance on redacted information in its Motion to Disqualify. As we discussed on the prior meet-and-confer, Tecan cannot properly assess nor defend against IDT's claims based on the information currently available to it. Moreover, your brief contains a variety of allegations that were not previously disclosed, nor can we assess the basis for these allegations given your refusal to provide unredacted versions of these materials. As we previously discussed, we remain willing to treat these materials as OCEO, but we will need access to these materials to respond to your brief. Given this, we plan to submit the below request to the Board to access the redacted materials filed with IDT's motion. Please let us know if you have anything further to add by 4 PM ET on Monday, August 11.

In addition, we continue to review your allegations and will let you know if we have further questions or proposals.

Thank you,
TJ

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Dear Honorable Board,

Petitioner relies extensively on redacted materials in its Authorized Motion to Disqualify Dr. Mikhail Matz. *See e.g.* Paper 26 at 3-4 (citing Exs. 1091, 1093, 1094, 1095, 1096, 1097, 1098, 1099, 1101, 1103, 1105). However, these materials have not been provided to Patent Owner, whose response to this motion is due on Thursday, August 14, 2025. As a result, Patent Owner cannot fully respond to Petitioner's arguments and Patent Owner respectfully requests that the Board:

1. Require Petitioner to provide unredacted copies of all the documents they rely upon in their motion or, alternatively, permit Patent Owner to file a motion seeking discovery of these materials. To the extent these are not produced, Petitioner should be precluded from relying on these materials. Patent Owner is prepared to treat these materials as highly confidential outside counsel eyes only and stipulate to a protective order to those ends.
2. Extend the deadline for Patent Owner's response to Petitioner's motion until 7 days after Petitioner's production of these materials (or the resolution of this issue).

As a result of Petitioner's heavy reliance on redacted communications, Patent Owner is unable to fully respond to Petitioner's contentions that Dr. Matz received confidential information relevant to the proceeding that would support the alleged basis for disqualifying him. *See e.g.* Paper 26 at 2-4. For example, Petitioner claims that its "discussions with Dr. Matz became the core of [the] petition" and invites the Board to compare its redacted exhibits to the Petition. Petitioner goes on to make various allegations about the subject matter of what was discussed in those communications and how it allegedly supports their motion for disqualification. Paper 26 at 4. Petitioner also challenges the

accuracy of Dr. Matz's Declaration (EX2039) based on redacted materials. *Id.* However, none of the materials they rely upon have been provided to Patent Owner, despite several requests.

Patent Owner cannot fully respond to Petitioner's claims because the core parts of what Petitioner relies upon are redacted in their entirety. See e.g., Exs. 1093, 1096, 1097, 1098, 1105. As the Board found in *Agila*, a party cannot be permitted to use these confidential or privileged materials as both a sword and a shield. *Agila Specialties Inc. v. Cephalon, Inc.*, IPR2015-00503, Paper 13 at 5 (P.T.A.B. Aug. 19, 2015) (“[T]o the extent [a party] intends to wield a [] communication (or any other communication between [that party] and [an expert]) as a sword to support its disqualification motion, [that party] cannot hide behind the shield of attorney-client privilege and refuse to reveal the specifics of the communication.”). Allowing the reliance on these materials without any disclosure to Patent Owner deprives Patent Owner of sufficient notice and the opportunity to be heard on the merits of the arguments. It deprives Patent Owner of due process including the ability to fairly test Petitioner's unilateral assertions. Moreover, to the extent Petitioner claims that this information is reflected in the public filings, Petitioner has waived any claim of privilege or confidentiality to the materials. It cannot selectively choose which materials to disclose and which to not.

Petitioner opposes this request.

Timothy Beavers

he/him/his

Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7208
f +1 212 355 3333
TBeavers@goodwinlaw.com

On Aug 4, 2025, at 11:32, Fletcher, Thomas <TFletcher@wc.com> wrote:

EXTERNAL

TJ,

We see no need to email the Board.

IDT will file redacted versions of all confidential exhibits it files in camera in support of its motion on Wednesday, August 6. Although you have identified no basis to request any further information or articulated why a “log” of these documents is not duplicative of the redacted versions of the exhibits, to avoid burdening the Board with a dispute, IDT also will provide a log of its communications with Dr. Matz on Wednesday, August 6.

If you have any questions about any of this, please give me a call,

Tom

Thomas S. Fletcher
Williams & Connolly LLP
680 Maine Ave. SW
Washington, DC 20024
(202) 434-5497

From: Beavers, Timothy James <TBeavers@goodwinlaw.com>
Sent: Friday, August 1, 2025 4:31 PM
To: IDT-Tecan-IPRs <IDT-Tecan-IPRs@wc.com>
Cc: DG-Goodwin-Tecan <DG-GoodwinTecan@goodwinlaw.com>
Subject: IPR2025-00015 and IPR2025-00016

Counsel,

As the parties discussed on July 25, 2025, Patent Owner continues to have concerns with the *in camera* submission on these issues. As a result, we intend to send the Board the following request. Please let us know if you have anything to add by COB Monday.

Thank you,
TJ

Dear Honorable Board,

In light of the Board's grant of Petitioner's request to file exhibits *in camera* to support its motion to disqualify, Patent Owner requests that Petitioner be required to provide Patent Owner by August 6 with a privilege log and redacted copies of all documents filed *in camera*.

Despite several requests, Petitioner has not identified to Patent Owner the allegedly confidential information or documents it contends were shared with the expert. Allowing these materials to be submitted to the Board *in camera*, without any disclosure to Patent Owner, would not provide Patent Owner sufficient notice or the opportunity to be heard on the merits of the arguments, and it would deprive Patent Owner of due process in this dispute and any ability to fairly test Petitioner's unilateral assertions. As the Board found in *Agila*, a party cannot be permitted to use these confidential and privileged materials as both a sword and a shield. *Agila Specialties Inc. v. Cephalon, Inc.*, IPR2015-00503, Paper 13 at 5 (P.T.A.B. Aug. 19, 2015) ("[T]o the extent [a party] intends to wield a [] communication (or any other communication between [that party] and [an expert]) as a sword to support its disqualification motion, [that party] cannot hide behind the shield of attorney-client privilege and refuse to reveal the specifics of the communication.").

Patent Owner is prepared to treat these materials as highly confidential outside counsel eyes only and stipulate to a protective order to those ends. Patent Owner also reserves the right to seek more materials if Petitioner's submission appears incomplete.

Petitioner opposes this request.

Timothy Beavers
he/him/his

<image001.png>

Goodwin Procter LLP
The New York Times Building
620 Eighth Avenue
New York, NY 10018
o +1 212 459 7208
f +1 212 355 3333
TBeavers@goodwinlaw.com

<image002.png>

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<image006.png>

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