

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

U.S. Patent No. 10,876,108

**PETITIONER'S AUTHORIZED REPLY IN SUPPORT OF
MOTION TO DISQUALIFY DR. MIKHAIL MATZ AND
MOTION TO SEAL**

The facts relating to Petitioner's motion to disqualify are uncontested: (1) Petitioner had a preexisting consulting relationship with Dr. Matz wherein he agreed not to consult for any other party in this matter; (2) Petitioner confidentially discussed the art and arguments at issue in these petitions with Dr. Matz; and (3) Dr. Matz breached his contract, lied to PO about it, and consulted with PO on this same matter and issues. Petitioner's motion to disqualify observed that there were few examples of a disqualification as clearly warranted as this. Mot. at 2, 9-10; Ex. 1090 ¶ 9. PO's opposition does not attempt to dispute this or to distinguish those cases. Opp. at 5-7. Dr. Matz should be disqualified and his declaration expunged.

PO seeks leave to substitute a declaration from Dr. Eli Meyer, Dr. Matz's former graduate student. There is reason to believe this new declaration was not procured independently of Dr. Matz and that PO has improperly continued to consult with Dr. Matz *after* learning of his confidential relationship with Petitioner. Three live disputes remain: (1) whether PO improperly kept working with Dr. Matz after being told of his work for Petitioner, (2) whether Dr. Matz helped procure Dr. Meyer's testimony in violation of Dr. Matz's agreement with Petitioner, and (3) whether PO may continue to consult with Dr. Matz. PO's proposed substitution should only be permitted if PO has not been continuing to consult with Dr. Matz and if Dr. Meyer's declaration is truly independent of Dr. Matz's work for PO. PO should also be forbidden from consulting with Dr. Matz going forward.

I. PO Apparently Did Not Stop Consulting With Dr. Matz After July 22.

Petitioner consulted on this matter with Dr. Matz, Exs. 1091-1101, 1104-1105, and Dr. Matz is prohibited from consulting with PO, Ex. 1090 ¶ 9. By July 22, PO knew of Dr. Matz's prior work for Petitioner. Ex. 1108.0015-16.

As the parties tried to resolve the issues, Petitioner reiterated: "We trust that Goodwin and Tecan have not been continuing to consult with Dr. Matz since we raised this issue." Ex. 2104 at 8. Instead of agreeing, PO responded: "We also continue to disagree that our communications with Dr. Matz are relevant to your motion." *Id.* at 7. Petitioner asked again: "Has Tecan stopped consulting with Dr. Matz?" Ex. 2106 at 8. PO's response ignored this. *Id.* at 7. Petitioner repeated: "It is important for us to know that after we raised this issue you have stopped substantively communicating with Dr. Matz." *Id.* at 6. PO stonewalled: "We do not agree that there is any prejudice to IDT, nor do we understand your specific concerns regarding Dr. Matz." *Id.* at 4.

Twenty-two days after Petitioner first raised the issue, PO finally agreed to stop communicating with Dr. Matz (temporarily), only because Petitioner indicated it would oppose PO's request for an extension without that promise. *Id.* at 1-2; *see* Ex. 3004. The parties' efforts to resolve these issues broke down for good when PO refused to provide, among other things, "A log of communications between Tecan or its counsel and Dr. Matz since July 22, 2025." Ex. 2105 at 2, 5.

II. PO's Inappropriate Communications With Dr. Matz After July 22 Would Render a Substitute Declaration Improper.

Petitioner does not seek to “deprive the Board” of relevant evidence. It has consistently maintained it does not oppose a substitute declaration *if properly obtained*. Exs. 2105 at 2-5; 2104 at 5; 2106 at 8. Petitioner would agree to substitution of Dr. Meyer *if* Dr. Matz was not involved in procuring his testimony *and if* PO had ceased speaking with Dr. Matz, both of which PO refuses to confirm.

PO has the burden of showing substitution by Dr. Meyer “would be in the interests-of-justice,” 37 C.F.R. § 42.123(b), § 42.20(c); *Changer v. Copperhead*, IPR2017-00341, Paper 17 at 6. “There is a scarcity of case law on the issue of ex parte contact with expert witnesses, possibly because the violation seldom happens.” *Erickson v. Newmar Corp.*, 87 F.3d 298, 302 (9th Cir. 1996). After all, “an attorney violates an ethical duty when the attorney has ex parte contact with the opposing party’s expert witness.” *Id.* These concerns were not addressed in *Galderma* where the disqualified expert had not been retained by opposing counsel in the same case.

Despite this basic ethical principle, PO has apparently continued to talk to Dr. Matz and has refused to commit to not do so permanently. Without citing any authority, PO suggests this ethics violation can be excused because it “never received any confidential material from Dr. Matz,” Ex. 2105 at 1, an assertion it asks the Board to take on blind faith. Even if this were an exception—and it is

not—PO’s assertion is cold comfort as PO contends that none of Petitioner’s conversations with Dr. Matz were confidential, Opp. at 4-7, even though the consulting agreement says otherwise, Ex. 1090 ¶ 1. Nor is Dr. Matz’s “represent[ation] [that] he would provide no third-party confidential information to Tecan or Goodwin,” Opp. at 3, worth the paper it is written on. In the same document, he lied to PO, representing he had “no conflict of interest with respect to IDT,” Ex. 1111.0001-02.

If PO violated the ethics rules and had communications with Dr. Matz *after July 22* when it learned of Dr. Matz’s prior agreement, the substitution would not be in the interests of justice and the Board should not sanction such conduct by permitting PO to now substitute Dr. Meyer’s testimony for Dr. Matz’s. 37 C.F.R. § 42.123(b), § 42.12; *see Apple Inc. v. Voip-Pal.com, Inc.*, 976 F.3d 1316, 1323 (Fed. Cir. 2020) (§ 42.12 “affords the Board discretion to impose sanctions” and “does not limit the Board to the eight listed sanctions”). Further, any involvement by Dr. Matz in recruiting Dr. Meyer or in the preparation of his declaration—in violation of Dr. Matz’s consulting agreement with Petitioner—also warrants denying PO’s substitution motion. *Id.*; Ex. 1090 ¶ 9. While Dr. Meyer states that he has “not spoken with Dr. Matz about my opinions or the substance of this declaration,” Ex. 2103 ¶ 1, PO notably has *not*, despite repeated requests, stated that Dr. Meyer has not spoken with Dr. Matz regarding this *case*.

Petitioner respectfully requests the Board require PO to submit its correspondence and notes of any oral communications with Dr. Matz since July 22, 2025 for *in camera* review to evaluate (1) whether PO continued to consult with Dr. Matz, and (2) whether Dr. Matz was involved in PO's retention of Dr. Meyer and/or any aspect of the preparation of his declaration. If PO discussed the substance of the case with Dr. Matz after July 22 and/or Dr. Matz was involved in PO's retention of Dr. Meyer or the preparation of his declaration, the Board should deny PO's request to submit Dr. Meyer's declaration as a replacement.

III. The Motion to Seal Should Be Granted.

PO's opposition to the Motion to Seal effectively requests reconsideration of the Board's prior order, Ex. 3003, granting Petitioner leave to submit evidence *in camera*. PO cites no case holding that a party must reveal its confidential communications in support of a motion to disqualify and the Board routinely permits *in camera* review. *E.g.*, *Galderma*, PGR2019-00062, Paper 56 at 4; *Sanofi-Aventis U.S. LLC v. Regeneron Pharms., Inc.*, IPR2017-01884, Paper 43 at 1.

Finally, PO has expressed "concerns with Petitioner's duty of candor." Opp. n. 3. This is a serious but spurious allegation—Petitioner has submitted to the Board *all* of its communications with Dr. Matz, belying any notion that it has withheld information, while PO has refused to reveal what it has said to Dr. Matz and when.

Dated: August 26, 2025

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 Petitioner's Authorized Reply in Support of Motion to Disqualify Dr. Mikhail Matz and Motion to Seal was served via electronic mail on the following lead and back-up counsel of record for Patent Owner.

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