

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 10,036,012 B2)
IPR2025-00016 (Patent 10,876,108 B2)¹

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

MAJORS, *Administrative Patent Judge.*

ORDER
CONDUCT OF THE PROCEEDING
Granting Patent Owner's Request to Substitute Declaration of Dr. Eli Meyer
37 C.F.R. §§ 42.5, 42.53

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. Due to temporary unavailability, Judge Zhenyu Yang took no part in this Order.

I. BACKGROUND

On September 19, 2025, the Board granted Petitioner’s Motion to Disqualify Dr. Mikhail Matz. Paper 33 (Order Disqualifying Dr. Matz).² Pursuant to that Order, the Board found that Dr. Matz was conflicted from providing expert testimony on behalf of Patent Owner based, *inter alia*, on a prior (and surviving) confidential relationship between Dr. Matz and Petitioner related to these cases. *Id.* at 3. We, thus, prohibited Dr. Matz from further serving as a witness for Patent Owner in this proceeding and indicated that Dr. Matz’s Declaration (Ex. 2039) was excluded. *Id.* at 7.

Patent Owner opposed Petitioner’s Motion to Disqualify. Paper 29. But, as a fallback, Patent Owner offered to substitute a Declaration from Dr. Eli Meyer that would take the place of Dr. Matz’s Declaration. *Id.* at 7–9; Paper 32, 1–3, 5. Petitioner opposed the substitution and requested that, before allowing it, the Board require Patent Owner submit for *in camera* review any correspondence between Patent Owner and Dr. Matz after Patent Owner was made aware of Dr. Matz’s conflict, and any correspondence evidencing Dr. Matz’s role in Patent Owner’s subsequent retention of Dr. Meyer or in preparation of the substitute Meyer Declaration. Paper 31, 1–5 (“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.”). In our Order disqualifying Dr. Matz, we construed Patent Owner’s request to substitute Dr. Meyer’s

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

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Declaration as a cross-motion, and we ordered Patent Owner’s production of, *inter alia*, correspondence between Patent Owner and Dr. Matz after July 22, 2025, for *in camera* review by the Board—deferring a ruling on the requested substitution until the Board had an opportunity to consider the documents produced by Patent Owner. Paper 33, 5–8 (ordering Patent Owner to further submit a declaration attesting to its reasonable search and investigation for the correspondence responsive to the Order).

Having now considered the correspondence and supporting declarations filed by Patent Owner, we grant Patent Owner’s request to substitute the Declaration of Dr. Meyer (Ex. 2103). We explain below.

II. ANALYSIS

Patent Owner bears the burden of showing that it is entitled to the relief it has requested. 37 C.F.R. § 42.20(c).

In response to the Board’s September 19, 2025, Order, Patent Owner submits declarations from two of its attorneys in this matter—Linnea Cipriano (lead counsel) and Timothy J. Beavers.³ Paper 35 (Cipriano Decl.) and Ex. 2285. Patent Owner also filed over eighty exhibits for *in camera* review, which exhibits mostly comprise correspondence (e.g., emails, virtual-meeting invitations, etc.) between Patent Owner and Drs. Matz or Meyer. Exs. 2200–2285 (collectively the “*in camera* materials”).

After considering the declarations and *in camera* materials submitted by Patent Owner, we find that Patent Owner has shown that substitution of the Meyer Declaration is warranted. First, we are satisfied on this record

³ On October 1, 2025, Patent Owner filed an Unopposed Notice of Intent to Designate Provisionally-Recognized Mr. Beavers as Backup Counsel.
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that Patent Owner completed a reasonable search and investigation for correspondence in response to the Board's Order, and that Patent Owner has produced such correspondence. *See, e.g.*, Paper 35, 1–2 (representing that Patent Owner's counsel reviewed their emails, meeting calendars, and phone records to identify all responsive correspondence, and further interviewed Dr. Meyer to reasonably confirm the identification and production of all responsive communications between Drs. Matz and Meyer since July 22, 2025); Ex. 2285 (detailing, with citation to supporting documentary exhibits, counsel's multiple communications with Dr. Meyer to determine the full scope of correspondence that exists between Drs. Matz and Meyer relevant to this matter; providing a detailed timeline and summary of any known communications between Patent Owner, Dr. Matz, and Dr. Meyer from July 22, 2025, through September 24, 2025, and pairing the summary of each communication with a corresponding exhibit where applicable).

Second, after reviewing the declarations and underlying correspondence, we see no indication that any Petitioner-confidential information was passed from Dr. Matz to either Patent Owner or Dr. Meyer. This is excepting the *existence* of the prior consulting relationship between Petitioner and Dr. Matz, which Petitioner brought to Patent Owner's attention on or about July 22, 2025, and which Patent Owner then confirmed in subsequent discussion with Dr. Matz when Patent Owner reasonably sought to investigate Petitioner's claim for relief. Patent Owner represents, and we see no evidence to the contrary in the materials before us, that Patent Owner's investigation resulted in Patent Owner being exposed to any specific confidential information of Petitioner. *See, e.g.*, Paper 35, 2 ("I further confirm that neither Tecan nor its counsel received any confidential

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information or litigation strategy of Petitioner that may have previously been provided to Dr. Matz by IDT and/or Williams & Connolly LLP.”).

Lastly, the only relevant correspondence between Drs. Matz and Meyer of record is a short email string sent during a single day. Ex. 2284. We will not disclose the particular writings in that correspondence (because Patent Owner produced it only for *in camera* review and marked it as “Privileged and Confidential”). But reasonably characterized, that correspondence appears to us little more than an effort by Dr. Matz to introduce Dr. Meyer to Patent Owner’s counsel for potential future consulting in the matter. Here again, we see nothing in this correspondence that would show or suggest that Dr. Matz conveyed Petitioner’s confidential information to Patent Owner or Dr. Meyer. Dr. Matz’s limited involvement in helping Patent Owner retain a substitute declarant does not, at least on this record, justify preventing *Dr. Meyer* from testifying in this matter.

For the reasons above, we grant Patent Owner’s request for substitution. Patent Owner may rely on the substitute Declaration of Dr. Meyer (Ex. 2103). Petitioner may now take the deposition of Dr. Meyer at an appropriate time and place as a matter of routine discovery.

Patent Owner has not filed a motion to seal concerning the *in camera* materials that it submitted responsive to the Board’s September 19, 2025, Order. If Patent Owner intends to maintain those materials as confidential and available only for the Board’s review, Patent Owner must file a motion to seal within ten (10) days.

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III. ORDER

In consideration of the foregoing, it is:

ORDERED that Petitioner's Request to Substitute the Declaration of Dr. Eli Meyer for the Declaration of Dr. Mikhail Matz is *granted*;

FURTHER ORDER that Petitioner is now authorized to take testimony from Dr. Meyer by cross-examination (37 C.F.R. § 42.53); and

FURTHER ORDERED that Patent Owner shall, within ten (10) days of this Order, file a Motion to Seal covering the exhibits it submitted for *in camera* review in connection with its request for substitution.

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