

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QIAGEN Sciences, LLC,
Petitioner,

v.

Tecan Genomics, Inc.,
Patent Owner.

IPR2025-00026

U.S. Patent No. 11,098,357

**PETITIONER'S AUTHORIZED RESPONSE TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

Tecan's only basis for requesting Director Review is that discretionary denial is allegedly appropriate because an unrelated party, Integrated DNA Technologies, Inc. ("IDT"), also has filed an IPR petition against the '357 patent. *See generally* Paper 11 ("Request"). Tecan claims that addressing two petitions will be inefficient and unfair to Tecan, as Tecan will have to submit twice as many filings, participate in twice as many depositions, and defend its patent at two oral arguments. Req. at 4-5. But that is a situation entirely of Tecan's own making. Tecan chose to file separate patent infringement suits asserting the '357 patent against both QIAGEN and IDT—two unrelated companies with unrelated accused products. Tecan's claims of unfairness in defending against two separate IPRs filed by these same two unrelated entities has no basis.

As a threshold matter, the Request is procedurally improper, and Tecan waived it because Tecan's POPR did not argue for discretionary denial based on the fact that two unrelated parties (QIAGEN and IDT) filed IPRs directed to the same patent. This failure prohibits Tecan from raising this issue for the first time here. USPTO, *Director Review Process* at 3.E (last modified Feb. 5, 2025) ("The Director will not consider ... new arguments not part of the official record.").

The Request is also substantively deficient. The Board's *General Plastic* analysis determines when discretionary denial should be granted where multiple petitions are filed against a single patent. Tecan, however, urges the Director to

grant its request without applying this analysis, completely ignoring the arguments on this exact issue that QIAGEN raised in its petition. Pet. at 62-63. Tellingly, Tecan does not cite a single Board opinion in support of its Request. Tecan's arguments instead rely on (1) an erroneous reading of the Trial Practice Guide (November 2019) and (2) a passing reference to how the processes set forth in the Acting Director's March 26 memorandum ("March 26 Memo") aim to "improve PTAB efficiency." Req. at 1, 3-5. Absent is any authority supporting the discretionary denial remedy Tecan seeks.

First, the inquiry of whether multiple petitions warrant discretionary denial is controlled by the *General Plastic* factors, which QIAGEN raised in its petition and which Tecan failed to address in both its POPR and Request here. The *General Plastic* factors do not, in any way, support discretionary denial, because QIAGEN and IDT are different entities with no relationship, whereas *General Plastic* is directed to multiple petitions by related parties. Pet. at 62-63 (citing *Qualcomm Inc. v. Monterey Research, LLC*, No. IPR2020-01493, 2021 WL 861760, at *7 (P.T.A.B. Mar. 8, 2021)). Tecan ignores the entire foundation of *General Plastic* and instead expands it to something it is not, a general claim that multiple petitions cannot exist on a single patent because that would create inefficiency and unfairness. Req. at 3-5. But the *General Plastic* factors directly account for these considerations: "The factors set forth above, in our view, represent a formulation of relevant

considerations that permit the Board to assess the potential impacts on both the *efficiency* of the inter partes review process and the *fundamental fairness* of the process for all parties.” *Gen. Plastic Indus. Co., Ltd. v. Kaisha*, No. IPR2016–01357, 2017 WL 3917706, at *8 (P.T.A.B. Sept. 6, 2017) (emphases added). All of the purported inefficiency and unfairness that Tecan raises are thus subsumed in the *General Plastic* factors, which in this case weigh against discretionary denial. Pet. at 62-63. Tecan’s Request should thus be rejected on *General Plastic* alone. See *Qualcomm*, 2021 WL 861760, at *7-8 (declining discretionary denial where multiple petitions were filed by different parties).

Second, the Trial Practice Guide does not support Tecan’s arguments. Tecan cites (at 3, 5) to page 59 of the Trial Practice Guide, which addresses “Parallel Petitions Challenging the Same Patent.” That section, however, is specific to multiple petitions *filed by the same petitioner*. Indeed, that section states that:

multiple petitions by *a petitioner* are not necessary in the vast majority of cases...In such cases two petitions by *a petitioner* may be needed...three or more petitions by *a petitioner*...if *a petitioner* files two or more petitions...The Board encourages *the petitioner* to use a table to aid in identifying the similarities and differences between petitions.

Trial Practice Guide at 59-60 (emphases added). The guidance regarding how multiple petitions may create a “substantial and unnecessary burden” on the Board,

as well as raise “fairness, timing, and efficiency concerns,” is thus specific to the situation where a single petitioner has filed multiple petitions. *Id.* at 59. That is not relevant here because no single party has filed multiple petitions on the same patent. The Trial Practice Guide fails to support discretionary denial.

Third, the March 26 Memo does not support discretionary denial. This memo outlines a new procedure for raising and determining discretionary denial issues and includes a list of considerations that the parties may address, including those set forth in *General Plastic*. March 26 Memo at 1-2. Tecan cites (at 1) the March 26 Memo as if it provides new justification for its Request, but it does no such thing. The issue of whether multiple petitions should result in discretionary denial is set forth in *General Plastic* and its progeny, Pet. at 62-66, which the March 26 Memo cites and refers to as a consideration “enumerated in existing Board precedent.” March 26 Memo at 2. The March 26 Memo did not change the law on discretionary denials regarding multiple petitions, which is the sole basis for Tecan’s Request, and does not support Tecan’s position. Indeed, the only portion of the March 26 Memo that Tecan cites is the statement that the procedures “aim to improve PTAB efficiency,” but that has been a goal of the Board for several years. *See, e.g., Gen. Plastic*, 2017 WL 3917706, at *8. The March 26 Memo thus does not support Tecan’s Request.

Fourth, the March 26 Memo confirms that “[t]he strength of the unpatentability challenge” can be considered in a discretionary denial determination,

March 26 Memo at 2, and QIAGEN's unpatentability challenge is particularly strong here. As the Board found, QIAGEN has shown that it is reasonably likely that claim 1, the sole independent claim, is anticipated by one prior art reference and separately rendered obvious by two other references, none of which were cited during prosecution. Paper 8 ("ID") at 25, 38. Notably, Tecan did not separately argue the validity of any dependent claim in its POPR and Tecan's Request here does not include any merits based arguments. This stands in stark contrast to the similar requests for Director Review that Tecan filed in the IDT IPRs. *See, e.g.*, IPR2024-01506, Paper 11 at 7-11; IPR2024-01504, Paper 11 at 8-13.

Fifth, discretionary denial would be fundamentally unfair to QIAGEN, not Tecan. QIAGEN and IDT have no relationship, did not coordinate on their IPR petitions, and raise completely different prior art and arguments. *Compare* Pet. at 17-58, *with* IPR2025-01504, Paper 1 at 24-70. Independent parties are entitled to pursue their own invalidity case against Tecan. If discretionary denial were granted here, QIAGEN would be foreclosed from participating in the IPR process entirely despite its timely-filed IPR simply because Tecan chose to sue two separate companies for patent infringement of the same patent and both companies chose to file IPRs challenging the commonly asserted patent.

Tecan's Request should be denied for the reasons explained above.

DATED: June 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 5, 2025, I caused a true and correct copy of the foregoing to be served on counsel for Patent Owner via email at:

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