

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QIAGEN SCIENCES, LLC,
Petitioner,

v.

TECAN GENOMICS, INC.,
Patent Owner

Case No. IPR2025-00026
U.S. Patent No. 11,098,357

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

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Rather than respond to certain unfavorable arguments, Petitioner seeks to suppress them on baseless procedural grounds. In IPR2025-00028/29, Petitioner hopes to exclude all arguments related to Petitioner's and its expert's prior statements that flatly contradict positions asserted for the first time in reply. Tecan's arguments and documents are not presented as substantive arguments, but to impeach and undermine the credibility of Petitioner's positions in these proceedings. The admission of such evidence is critical to the fairness of this proceeding and has been allowed by the Board in other proceedings. In IPR2025-00026, Petitioner seeks to improperly exclude arguments that Tecan addressed in its POR and addressed again in its Sur-Reply. These arguments are directly responsive to Petitioner's expanded arguments in reply and therefore proper. Neither of Petitioner's requests to strike has merit. The Board should have the benefit of the full record to evaluate the testimony and Petitioner's arguments in their true light.

I. IPR2025-00028 AND -00029: PETITIONER SEEKS TO SHIELD ITS PRIOR INCONSISTENT STATEMENTS¹

Petitioner improperly seeks to exclude the arguments and documents that demonstrate the inconsistencies between positions it adopted in its reply briefing and what it previously represented to courts, patent offices, and the public. Tecan presents these materials to impeach the credibility of Petitioner's expert and the

¹ Citations in this section are to the record of IPR2025-00028 and -00029.

positions that Petitioner now takes. Because these arguments were first raised in Petitioner's Reply, Tecan was only able to address them in its Sur-Reply.

A. The Objected-To Material Is Used to Challenge the Credibility of Petitioner's Positions

As an initial matter, Petitioner is incorrect that these materials were not used for impeachment purposes. Paper 31, 8-9. The materials and testimony Petitioner seeks to exclude are all offered to undermine the credibility of its arguments.

First, in seeking to defend Petitioner's copying of Tecan's inventions and praise for those same inventions, Petitioner claims for the *first time in its Reply* that its copied products are derived from Shapero's methods rather than Tecan's products. Paper 22, 24; EX2213.0069:18-70:5. However, as Tecan raised with Dr. Metzker at deposition, this claim contradicts years of statements made by Petitioner and Dr. Metzker. For example, EX2205-EX2207 are district court or Federal Circuit submissions that contain Dr. Metzker and Petitioner's claims that the copied inventions were "carefully designed" by Petitioner, EX2207.0011, and achieved something its competitors thought it could not—"produce a product with only one enrichment step," EX2206.0026, that "achieve[s] high specificity." EX2205.0068. Petitioner—represented then by the same counsel in these proceedings—did not attribute these products to Shapero. Instead, Petitioner took credit for developing products that they alleged defied industry expectations. Petitioner even touted the very same unexpected results in high target specificity that Tecan's patents achieved

and that Petitioner now disputes.

Tecan also confronted Dr. Metzker as to the fact that Petitioner's own patent publications (EX2209-EX2210, EX2212) and prosecution statements (EX2211) do not reference Shapero (or Jones), even though Petitioner now claims its products and technology are based on Shapero. EX2213.0100:10-130:5. EX2208 likewise reflects that the "inventors" of Petitioner's copied products described both Tecan and Petitioner's technologies in 2019 as "newer single primer technologies," entirely ignoring Shapero and Jones, contrary to Petitioner's claims here. EX2208.0001, 09; EX2213.0090:2-99:13.

The only exhibit Petitioner attempts to address with specificity, EX2211, also undermines the credibility of Petitioner and its expert's testimony. EX2211 shows that Petitioner, when seeking its own patent on the use of a single target-specific primer (and critically, after the claims challenged here were filed), admitted that the single primer was a "crucial" difference from "the standard prior art methods for amplifying polynucleotides, which require a forward and a reverse primer." EX2211.0002. Petitioner and Dr. Metzker now contend just the opposite, claiming that the prior art disclosed the single-primer methods developed by Tecan and copied by Petitioner. Paper 22, 1, 22-24; EX1003.¶¶99; EX1121.¶¶4-5; EX2213.0069:18-70:5. These prior statements directly undermine Petitioner's current positions. Dr. Metzker offered no explanation about these inconsistencies when confronted at

deposition, refusing to directly respond to the statements and their clear meaning.

Second, Petitioner argues for the first time in its Reply that prior art algorithms, like Primer3 and Miura, solved the off-target priming concerns raised by Tecan. Paper 22, 9; EX1121.¶25. But Dr. Metzker previously testified otherwise. Dr. Metzker's sworn testimony in 2021 explained that a POSA could not rely on these programs to assess mispriming and that they would instead need to do "real experimental assays" because "these programs can create misinformation and they can be inaccurate." EX2203.0070-71 (64:15-65:10), 72 (66:8-11). Because of these accuracy issues, Dr. Metzker testified then that he himself did not use these programs to assess mispriming, despite now claiming that a POSA would. EX2203.0072-73 (66:19-67:4). At his deposition in this case, Dr. Metzker confirmed that his prior testimony was given under oath. EX2213.0067:2-4. Petitioner cannot feign prejudice from the use of this prior testimony as Dr. Metzker gave it on behalf of Petitioner and was defended by the same counsel as in this proceeding. To allow Petitioner to add these contradictory arguments in reply and not allow Tecan to challenge the inconsistencies in Petitioner's claims would be unjust.²

² The other exhibits that Petitioner seeks to strike are provide for context. EX2201 and EX2202 provide context for EX2203-EX2207 and foundation for the questions asked of Dr. Metzker at his deposition, establishing that he had previously opined

B. The Board Has Allowed Admission of Deposition Exhibits for These Purposes

Petitioner's overly narrow reading of 37 CFR § 42.23(b) is erroneous. As § 42.23(b) states, a "sur-reply ... may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 CFR § 42.23(b). The very materials Petitioner seeks to strike are those provided as part of the deposition transcript. Such materials are permissible as the Board has previously confirmed: "if exhibits are introduced during a deposition for the purposes of testing the witness' testimony, a party should be able to submit those exhibits with the transcript, so the Board has the full context available in order to evaluate the testimony." *Ascend Performance Materials Operations LLC v. Samsung SDI Co., Ltd.*, IPR2020-00349, Paper 53 at 12 (PTAB July 15, 2021).

Unable to distinguish the reasoning in *Ascend*, Petitioner suggests that the substance of the rules have changed since the *Ascend* decision issued. Paper 31, 8. That is incorrect. While the text of § 42.23(b) was amended, the Office confirmed that this change "conforms to existing practice as stated in the TPG2018 and the CTPG." PTAB Rules of Practice, Final Rule Action, 2020 WL 7227395, 85 FR 79120-01, 79124 (F.R. Dec. 9, 2020); *see also* PTAB Rules of Practice, Notice of

on Petitioner's copied products. EX2203-EX2205 are sub-parts of a single submission in Petitioner's previous litigation.

Proposed Rulemaking, 2020 WL 2735325, 85 FR 31728-01, 31731 (F.R. May 27, 2020) (noting that these changes were “procedural in nature”). Notably, the language of the Trial Practice Guide has been consistent on this issue. *See* 2018 Trial Practice Guide at 14 (“TPG2018”). The Board has not enforced a categorical rule against the use of impeachment deposition materials as Petitioner contends. Multiple panels have considered exhibits introduced at the deposition of a reply witness for purposes of assessing witness credibility. *See Edwards Lifesciences Corp. v. Cardiovalve Ltd.*, IPR2021-00383, Paper 63 at 85-88 (PTAB July 18, 2022) (permitting new deposition exhibits used for impeachment, explaining that it is consistent with § 42.23(b) because the “exhibits are not being admitted as substantive evidence.”); *Canfield Scientific, Inc. v. Quantificare S.A.*, IPR2021-01518, Paper 61 at 44 n.20 (PTAB Mar. 9, 2023).³

Petitioner’s suggestion that Tecan should have sought leave to use these

³ In contrast to the exhibits struck in the *Netflix* decision, Dr. Metzker was either familiar with the exhibits and/or readily opined on their contents at his deposition. EX2213.0066:19-67:4, 73:12-74:1, 88:11-89:2, 99:8-13, 108:19-117:16, 119:8-124:6, 124:7-126:9, 127:4-130:6. The case here is instead analogous to *Edwards Lifesciences* and *Canfield* where materials used in the deposition were permitted. *Edwards*, Paper 63 at 87-88; *Canfield*, Paper 61 at 44 n.20.

impeachment documents is also misplaced. Paper 31, 9-10. Such a requirement is not only impractical, it would be highly prejudicial to Tecan. These impeachment materials respond to Petitioner's arguments presented for the first time in its Reply. Tecan had no way of predicting that Petitioner would take contradictory positions, so its first opportunity to challenge the testimony was at Dr. Metzker's deposition. Tecan did so using Petitioner's own public statements—with some even authored by Dr. Metzker or Petitioner's counsel. There is no precedent for requiring a party to disclose exhibits prior to a deposition, and such a requirement would defeat the purpose of cross-examination, allowing Petitioner to craft responses prior to the deposition. Petitioner and its expert should be held accountable for their inconsistent positions, rather than depriving the Board of these materials.

II. IPR2025-00026: TECAN'S ARGUMENTS ARE NOT NEW⁴

The arguments that Petitioner seeks to exclude are not new, as Tecan included the substance of each in its POR. Petitioner's objection to the arguments provided in Tecan's Sur-Reply essentially negates the purpose of a sur-reply. *Petitioner* expanded its arguments in its Reply, and Tecan responded to those positions.

Tecan's Arguments About Schmitt (Paper 28, 17-18). Tecan's POR explains that Petitioner has not identified any disclosure in Schmitt of using the target sequence for duplicate identification (limitation 1.g). Paper 19, 30-32. Tecan

⁴ Citations in this section are to the record of IPR2025-00026.

further explained that, unlike the '357 patent, Schmitt identifies duplicates through the use of the SMI tag sequence alone, and not the target sequence as required by the challenged claims. *Id.* Tecan specifically addresses this issue in connection with the consensus sequence disclosures that Petitioner relied upon in its petition. *See e.g.*, Paper 2 at 44-45 (citing paragraphs 85 and 98).

Petitioner's critique seems to be that Tecan did not explicitly cite paragraph 99 in the POR, despite explicitly discussing its substance. This argument is meritless. Paragraph 99 is a continuation of the consensus sequence process described in Paragraph 98, which Tecan addressed in its POR. EX1007.0032-33; Paper 19, 30-32. Paragraph 99 adds nothing on this issue, simply repeating that the duplicates are identified by only using the SMI tag. *See* EX1007.0032-33. Moreover, Paragraph 99 recites the same SMI tag identification recited in Paragraph 85, which again was distinguished in Tecan's POR. Paper 19, 30-31 ("Because the use of SMI tags (or 'double-stranded SMI sequences') allows every molecule to be uniquely labeled prior to PCR duplication, true PCR ***duplicates may be unambiguously identified by virtue of having a common (i.e., the same or identical) SMI sequence.***"). Petitioner's arguments improperly place form over substance and have been rejected by other panels. *See Medtronic, Inc. v. Barry*, IPR2015-00780/83, Paper 48 at 4 (PTAB May 13, 2016) ("We do not read *CBS Interactive* to bar Patent Owner from citing to testimony that is consistent with or

provides context to arguments already made by Patent Owner ... as long as the cited testimony does not ‘expand’ the arguments made in the Patent Owner Response.”).

Moreover, if anything, the Reply is the first time that Petitioner argued “paragraph 99 by itself is sufficient to demonstrate disclosure of limitation 1.g.” Paper 23, 15. This argument is not in the Petition, where Petitioner relied on paragraphs 85 and 98 to show the alleged identification of duplicates. Paper 2, 44-45. Petitioner only cited Paragraph 99 as *further* support for the earlier identification disclosed in Paragraphs 85 and 98. While Petitioner’s argument fails for the reasons addressed in Tecan’s POR, there is nothing improper about Tecan responding to this new reply argument in its Sur-Reply. To the extent Petitioner is allowed to expand its arguments, Tecan is permitted to respond. *See Streck, Inc. v. Ravgen, Inc.*, IPR2021-01577, Paper 62 at 88 (PTAB Apr. 18, 2023) (“It is true that Petitioner submitted Exhibit 1014 with its Petition and that Patent Owner did not cite it until its Sur-Reply. However, the points raised by Patent Owner about Exhibit 1014 respond to certain of Petitioner’s arguments raised for the first time in its Reply.”).

Tecan’s Motivation to Combine Arguments (Paper 28, 20-23). Again Tecan’s arguments are not new, and Petitioner’s arguments highlight that if anything, it is Petitioner, not Tecan, that improperly added arguments. Tecan explained in its POR that Petitioner’s conclusory allegations about a motivation to combine are insufficient and ignore the differences in adaptor structure between

McCloskey and Schmitt. Paper 19, 33-34.

The motivation to combine argument in the Petition alleges only that (1) both references concern barcodes to distinguish redundant sequences, and (2) Schmitt references another article written by McCloskey. Paper 2, 37-39. Neither argument provides a motivation to combine McCloskey's adaptors with Schmitt. As Tecan explicitly stated in its POR, "Petitioner ignores the differences between the structure of the Schmitt and McCloskey adaptors and how they might, or might not, work if combined." Paper 19, 33.

In reply, Petitioner expands its arguments beyond what was in the Petition. Paper 23, 19-23. Petitioner adds new arguments about the similarity in disclosures of Schmitt and McCloskey and further points to alleged evidence of a reasonable expectation of success to claim that it did not ignore the differences between the adaptor structures. Tecan responded to these expanded arguments in its Sur-Reply and demonstrated why the statements did not address Tecan's arguments on the differences of the adaptors of these references. Paper 28, 20-23.

Tecan's arguments are not new, and the Board should not strike them. Petitioner's position would unfairly allow Petitioner to get a free hand to expand upon its arguments while prohibiting Tecan from responding to those arguments. The Panel should reject Petitioner's attempt to reduce the sur-reply to nothing more than a repetition of a patent owner's response.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on January 16, 2026, a copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE** was served by email, as follows:

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