UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QIAGEN SCIENCES, LLC,
Petitioner,

v.

TECAN GENOMICS, INC.,
Patent Owner.

IPR2025-00027
U.S. Patent No. 11,725,241

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

Page

I. Procedural Background 2

II. The Petition Should Be Denied Because It Creates Significant Inefficiencies.....3

III. Conclusion 6

TABLE OF AUTHORITIES

Page(s)

Statutes

35 U.S.C. § 316 4

Other Authorities

CONSOLIDATED TRIAL PRACTICE GUIDE 2

PTAB Workload Management Memorandum (March 26, 2025) 1

Patent Owner Tecan Genomics, Inc. ("Tecan") requests Director Review of the Institution Decision, which granted Petitioner QIAGEN Sciences, LLC's ("QIAGEN") petition.[1] The Panel's decision is ripe for Director Review because it raises important issues of law and policy, as it raises several issues regarding denial of petitions outlined in Acting Director Stewarts' recent comments on workload management and considerations for discretionary denial.

Acting Director Stewart's March 26 Interim Procedures for PTAB Workload Management Memorandum ("March 26 Memo") emphasizes the role of discretionary denial in "improv[ing] PTAB efficiency." March 26 Memo at 3. Denial is appropriate here because multiple petitions have been filed against the patent at issue in this proceeding, contrary to the Board's guidance that multiple petitions create inefficiencies and fairness concerns. Institution of this proceeding reduces PTAB efficiency because it adds to the burdens of the PTAB and unduly burdens Tecan.

Tecan requests that the Director grant Review of the Institution Decision, vacate the Panel's decision granting institution, and deny the Petition.

[1] The Panel also granted institution in IPR2025-00026 for substantially the same reasons, and Tecan is filing a parallel request in that proceeding.

I. Procedural Background

As explained in the Petition and Preliminary Response, the parties are involved in parallel litigation. *Tecan Genomics, Inc. v QIAGEN Sciences, LLC et al.*, No. 1:23-cv-01115-GBW (D. Del.). Tecan also asserted an overlapping set of patents against another defendant, Integrated DNA Technologies, Inc.'s ("IDT"). *Tecan Genomics, Inc. v. Invitae Corp., et al.*, No. 1:23-cv-1114-GBW (D. Del.). While the two litigations have different captions, QIAGEN and IDT have coordinated to jointly address scheduling and other disputes. The defendants have also coordinated their litigation strategies and asserted a common interest privilege as a result of that coordination.

QIAGEN filed this petition along with three other IPR petitions on the statutory 1-year deadline, despite the ongoing litigation and exchange of initial contentions and discovery substantially before this deadline. *QIAGEN Sciences, LLC v. Tecan Genomics, Inc*., IPR2025-00026, Paper 2 (PTAB Oct. 10, 2024); IPR2025-00027, Paper 2 (PTAB Oct. 10, 2024); IPR2025-00028, Paper 2 (PTAB Oct. 10, 2024); IPR2025-00029, Paper 2 (PTAB Oct. 10, 2024). QIAGEN's petitions came on the heels of another five petitions that IDT separately filed a week before. *Integrated DNA Technologies, Inc. v. Tecan Genomics, Inc*., IPR2024-01502, Paper 1 (PTAB Sept. 30, 2024); IPR2024-01504, Paper 1 (PTAB Sept. 30,

2024); IPR2024-01506, Paper 1 (PTAB Sept. 30, 2024); IPR2025-00015, Paper 1 (PTAB Oct. 4, 2024); IPR2025-00016, Paper 1 (PTAB Oct. 4, 2024).

IDT's IPR2024-01506 challenges the same claims of the patent that are at issue in this proceeding, and the Board instituted that proceeding on April 21, 2025. *Integrated DNA Technologies, Inc.*, IPR2024-01506, Paper 7.[2] Two overlapping but different panels are considering QIAGEN's and IDT's petitions. APJs Katz, Yang, and Majors are considering QIAGEN's petition. APJs Braden, Yang, and Majors are considering IDT's petition.

II. The Petition Should Be Denied Because It Creates Significant Inefficiencies

The Board should take into consideration that both QIAGEN and IDT have filed parallel petitions challenging the same claims of the challenged patent, and deny this petition. As the Board has repeatedly confirmed, multiple, parallel petitions can lead to undue burden on the Board and patent owners. CONSOLIDATED TRIAL PRACTICE GUIDE at 59 (2019) ("Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the

[2] Tecan has requested that the Director review all institution decisions related to IDT's and Qiagen's petitions challenging Tecan's patent so the Director may review the overlapping proceedings as a whole.

patent owner and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C. § 316(b).”). Allowing both QIAGEN and IDT to proceed with their challenges of this patent leads to duplicative efforts by the Board and is unfair to Tecan.

If both QIAGEN’s and IDT’s petitions move forward, two different PTAB panels will be forced to separately consider the patentability of the same claims of the challenged patent. This will force two panels to analyze different prior art, consider the testimony of different experts, and review separate briefing, all to assess the same set of challenged claims. The parallel proceedings are on different schedules, meaning that the Board will hear separate arguments, approximately three weeks apart. The Board will further be forced to issue separate final written decisions addressing the same challenged claims—with the possibility of inconsistent findings. For example, the two panels will consider different claim construction issues, which will impact the scope of the claims and likely lead to different results. This duplication of work—especially where it increases the risk of conflicting results—directly contradicts the Board’s efforts to promote efficiency. Exercising discretion to deny the Petition here allows the Board to streamline the IPR process and conserve resources by minimizing unnecessary redundancies.

Further, allowing QIAGEN’s petition to proceed in parallel with IDT’s petition raises fairness concerns and unduly burdens Tecan. The Board has stressed

that "multiple petitions by a petitioner are not necessary in the vast majority of cases." TRIAL PRACTICE GUIDE at 59. Nothing about the challenged claims requires multiple petitions. QIAGEN asserted eight grounds of invalidity, challenging sixteen claims of the patent. Neither QIAGEN nor IDT sought extra pages for its argument or made any allegation that multiple petitions were necessary. These petitioners, however, get the benefit of two bites at the apple with each bearing the cost of only one. These parties circumvented the guidance cautioning against multiple petitions and avoided having to justify why multiple petitions are necessary here. Tecan, on the other hand, will be submitting twice as many filings, participating in twice as many depositions, and defending the patent's validity at two different oral arguments that are less than three weeks apart. Like the Board, Tecan will be forced to unfairly duplicate efforts to face both petitions in parallel.

Further, having two different but overlapping panels consider QIAGEN's and IDT's petitions could lead to unfair cross contamination between the records of the two proceedings. If both proceedings move forward, each petitioner separately has the burden of showing that the challenged claims are unpatentable based on the record in that proceeding. Here, there is a high likelihood that the record of one proceeding will inadvertently impact the Board's consideration of the record in the other proceeding. Despite every effort by the APJs to consider the record properly, it is impossible to simply ignore information once it is learned. Tecan will be

entirely unaware of any such inadvertent cross contamination among the panels, and therefore, will not have an opportunity to be heard on those issues and will not be able to sufficiently present its positions. Because the risk of unfairness to Tecan is high, the Board should exercise its discretion and deny the Petition, either allowing the parties to proceed with this dispute in district court or at the least address the validity of this patent in a single proceeding.

III. Conclusion

For the foregoing reasons, Tecan respectfully requests that the Director grant Review of the Institution Decision, vacate the Panel's decision granting institution, and deny the Petition.

Date: May 28, 2025

Respectfully submitted,

/Linnea Cipriano/

Linnea Cipriano (Reg. No. 67,729)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Phone: (212) 813-8800
Fax: (212) 355-3333
lcipriano@goodwinlaw.com

Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE WITH PAGE LIMITS

I hereby certify that Patent Owner's Request for Director Review complies with the page-count limitation because it does not exceed fifteen pages, excluding the parts of the document exempted by 37 C.F.R. § 42.24(a).

Date: May 28, 2025

Respectfully submitted,

/Linnea Cipriano/

Linnea Cipriano (Reg. No. 67,729)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Phone: (212) 813-8800
Fax: (212) 355-3333
lcipriano@goodwinlaw.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Patent Owner's Request for Director Review was served on May 28, 2025, by electronic mail to:

David L. Bilsker (Reg. No. 39,611)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
50 California Street, 22nd Fl.
San Francisco, CA 94111
Tel: (415) 875-6432
Fax: (415) 875-6700
davidbilsker@quinnemanuel.com
Qe-qiagen-tecan@quinnemanuel.com

Matthew A. Traupman (Reg. No. 50,832)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Ave., 22nd Floor
New York, NY 10010
Tel: (212) 849-7322
Fax: (212) 849-7100
matthewtraupman@quinnemanuel.com

Tara Srinivasan (Reg. No. 77,091)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
50 California Street, 22nd Fl.
San Francisco, CA 94111
Tel: (415) 875-6600
Fax: (415) 875-6700
tarasrinivasan@quinnemanuel.com

Landon A. Smith (Reg. No. 79,248)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
300 W. 6th Street
Austin, TX 78701
Tel: (737) 667-6116
Fax: (737) 667-6110
landonsmith@quinnemanuel.com

Andrew E. Naravage (*pro hac vice* to be applied for)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
50 California Street, 22nd Fl.
San Francisco, CA 94111
Tel: (415) 875-6432
Fax: (415) 875-6700
andrewnaravage@quinnemanuel.com

John Yang (*pro hac vice* to be applied for)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
3100 McKinnon St, Suite 1125
Dallas, TX 75201
Tel: (469) 902-3600
Fax: (469) 902-3610
johnyang@quinnemanuel.com

Date: May 28, 2025

Respectfully submitted,

/Linnea Cipriano/

Linnea Cipriano (Reg. No. 67,729)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Phone: (212) 813-8800
Fax: (212) 355-3333
lcipriano@goodwinlaw.com

Counsel for Patent Owner