

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QIAGEN Sciences, LLC,
Petitioner,

v.

Tecan Genomics, Inc.,
Patent Owner.

IPR2025-00028

U.S. Patent No. 10,036,012

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

Patent Owner (“PO”) seeks Director Review of the Institution Decision (“ID”) on three grounds, each lacking merit. Paper 11. Review should be denied.

The Panel Properly Applied § 325(d) in Finding Material Error. The Panel did not abuse its discretion in finding that QIAGEN demonstrated material error in the Examiner’s allowance for its improper reliance on Dr. Brooks’ Declaration. As an initial matter, PO (at 2-3) is incorrect that the Board erred by declining to “confirm[] that the first prong of *Advanced Bionics* is satisfied.” Under *Advanced Bionics*, discretionary denial is appropriate only if both the same or substantially the same prior art or arguments were previously presented **and** the petitioner has failed to show material error. IPR2019-01469, Paper 6, at 7 (Feb. 13, 2020). Here, the Board correctly found that regardless of whether the first prong was met, QIAGEN demonstrated the Examiner committed material error. Moreover, even if the Board had reached these issues, QIAGEN’s petitions demonstrated how Shapero differs from Jones (Pet., 57-59), including providing “experimental results that demonstrate [the] high target specificity achieved by the [Shapero] method, which is absent in Jones.” (Pet., 38-43, 57). This evidence “directly rebuts the alleged skepticism and unexpected results set forth in the Brooks declaration” (Pet., 57) and is the basis for Petitioner’s motivation to combine. ID, 9-11.

The Board also did not abuse its discretion in finding that “the Examiner erred in exclusively relying on Dr. Books’ declaration’ to withdraw the obviousness

rejection based on Jones and Tucker.” ID, 16 (citing Pet. 58). As QIAGEN showed (Pet., 38-42) and the Board found (ID, 16), “when unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.” *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991). The Board (ID, 16) also cited *In re Kao*, 639 F.3d 1057, 1069 (Fed. Cir. 2011), which states “the Board, in considering the evidence of unexpected results, should determine whether there is a nexus between the unexpected [results] and aspects of the claimed invention not already present in the prior art.” Applying this, the Board determined “it is unclear what Dr. Brooks considered to be the closest prior art when he alleged unexpected results”—a finding PO does not challenge. ID, 16. Instead, PO focuses on the fact that the Board also considered nexus and alleges that this was procedurally improper. But under *Kao*, the issue of nexus is bound up with the closest prior art—it is impossible to assess nexus if the closest prior art is not identified first. The failure of the Brooks declaration to identify the closest prior art was squarely presented in the Petition (at 38-43, 56-60) and was the basis for the Board’s finding that the Examiner committed material error. ID, 14-16. There is nothing procedurally improper with the Board’s analysis. Moreover, the Panel’s findings that Dr. Brooks failed to consider the closest prior art are by themselves sufficient to demonstrate material error by the Examiner.

PO (at 4) separately alleges that “Dr. Brooks’ testimony was relevant to

whether a person of ordinary skill would have had the motivation to modify the prior art with a reasonable expectation of success in doing so” but the Brooks declaration makes no mention at all of motivation to combine. And the Board did not abuse its discretion in rejecting PO’s attempt to recharacterize the Brooks declaration, which explicitly states it is directed to unexpected results and industry skepticism, into one directed to motivation to combine.

Multiple Petitions by Separate Defendants Do Not Warrant Denial. As a threshold matter, PO waived its argument regarding multiple IPRs by failing to raise this issue in its POPR. *Director Review Process* at 3.E (last modified Feb. 5, 2025) (“The Director will not consider ... new arguments not part of the official record.”). In any event, PO’s complaints about “undue burden” from defending against two IPRs are entirely self-inflicted and legally baseless. PO chose to sue QIAGEN and IDT in separate patent infringement actions—it cannot now complain that both defendants exercised their statutory rights to file petitions. The *General Plastic* factors, which QIAGEN addressed in its Petition (at 59-60), control the inquiry. PO completely ignored these factors in both its POPR and this Request. Even so, the *General Plastic* factors weigh strongly against denial where, as here, QIAGEN and IDT are unrelated entities who filed different petitions with different prior art and arguments. *See Qualcomm Inc. v. Monterey Research, LLC*, IPR2020-01493, Paper 18, at 15-16 (Mar. 8, 2021) (no discretionary denial where unrelated petitioners filed

separate petitions). PO's reliance on the Trial Practice Guide is misplaced. The section PO cites addresses "multiple petitions by a petitioner"—emphasis on the singular—and discusses scenarios where "a [single] petitioner files two or more petitions." Trial Practice Guide, 59-60. This guidance is inapplicable where independent defendants each file a single petition. Similarly, the March 26 Memo provides no support for PO's position; it merely incorporates existing *General Plastic* precedent. March 26 Memo at 2. Moreover, the district court proceedings are now stayed, (see Paper 12), mooted any parallel proceeding concerns.

The Limited Role of Expert Testimony Supports Institution. PO's expert testimony argument distorts both the record and the applicable guidance. PO's request that the Board throw out all the work it has already done "so that an Article III court can fully vet the credibility of these expert witnesses," (at 7), is the opposite of efficient. The Board has invested substantial time and effort analyzing these technical issues, while the district court proceedings remain in their infancy with no substantive rulings or hearings to date. The Board already found there is a "reasonable likelihood" at least one claim of each asserted patent is invalid, which would narrow—or moot entirely—the district court proceedings. Yet PO asks the Director to reverse the Board's decision so that the district court can begin to address these issues, burdening the Court, involved parties, witnesses, and third parties, regarding patents that have a "reasonable likelihood" of being invalid. Moreover,

there was no **extensive** reliance on expert testimony. The Board's decision rested on the prior art's teachings, and not on Dr. Metzker's testimony. ID, 19-27. In any event, PO's argument goes too far because IPR petitions almost always rely on expert testimony. PO incorrectly argues that the Panel refused to "engage with the factual disputes between the experts." In reality, the Board followed 37 C.F.R. § 42.108(c) by taking into account PO's expert's conflicting statements, but simply found them unconvincing. ID, 19-27.

The Panel's Factual Findings Were Sound and Procedurally Proper. *First*, PO argues (at 13-14) that the Board "fail[ed] to reach a conclusion" on "whether the Petition sufficiently established that a POSA would have been motivated to use Shapero's MARA library preparation method ... with NGS technology." The ID directly contradicts this: "On this record ... we find [QIAGEN] has shown adequately a motivation to combine the Shapero's enrichment method with Delseny's NGS technology." ID, 25-26. *Second*, PO claims "the Panel [did] not consider the prior art as a whole in its assessment" (at 14) because it did not credit PO's argument regarding Syvänen. But PO had to admit (at 14) the Panel did consider Syvänen but found it unpersuasive in light of other evidence. *Third*, regarding PO's final argument (at 15), PO does not point out any abuse of discretion. Rather, it states that the Panel accepted QIAGEN's arguments over PO. *Id.* This is not a reviewable issue; PO simply disagrees with the Panel's decision to institute.

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 PETITIONER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE SUBMITTED BY PATENT OWNER to be served on counsel for Patent Owner via email at:

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