

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 MOTION TO STRIKE

Petitioner QIAGEN Sciences, LLC files this authorized motion to strike¹ because Patent Owner's ("PO") Sur-Reply contains new evidence and arguments in violation of the Board's orders, regulations, and guidance. PO has no valid basis for including this new material and doing so is prejudicial to Petitioner as it lacks an opportunity to fully respond to the arguments and evidence had it been raised in a timely manner.

I. IPR2025-00026: TECAN'S SUR-REPLY RAISES FORFEITED ARGUMENTS²

The Board should strike two arguments in Tecan's Sur-Reply that it forfeited because it did not raise them in its POR, Tecan's argument that: (1) Schmitt's paragraph 99 does not disclose limitation 1.g of the '357 patent, and (2) McCloskey discloses "fundamentally limited" technology such that there would not have been a motivation to combine them with Schmitt.

A Patent Owner forfeits arguments raised for the first time in a sur-reply if those arguments could have been raised earlier in its Patent Owner Response. Indeed, the Trial Practice Guide (at 52) states that "the Board may decline to consider

¹ Petitioner has filed an identical motion to strike in each of IPR2025-00026, IPR2025-00028, and IPR2025-00029 as authorized by the Board. *See* IPR2025-00026, Paper 31; IPR2025-00028, Paper 30; IPR2025-00029, Paper 30

² All citations in this section are to IPR2025-00026.

arguments” that are not included in the patent owner response. The Board emphasized this in *Viant v Intent IQ*, IPR2024-00421, Paper 41, at 42 (P.T.A.B. October 14, 2025). There, the Board found that a patent owner’s argument raised for the first time in a sur-reply was forfeited because it was responding to arguments originally raised in the Petition. Other decisions similarly found such arguments forfeited. *See, e.g., PLR Worldwide Sales Ltd. v. Flip Phone Games, Inc.*, No. IPR2024-00209, 2025 WL 1191478, at *13 (P.T.A.B. Apr. 24, 2025); *Caterpillar Inc. v. Wirtgen Am., Inc.*, No. IPR2022-01278, 2024 WL 465543, at *21 (P.T.A.B. Feb. 6, 2024).

A. Schmitt Paragraph 99 (Paper 28 at 17-18)

Schmitt’s paragraph 99 states in part that “members of the same PCR ‘family’ are then grouped together by virtue of having a common (i.e., the same) SMI tag sequence. Sequences of uniquely tagged PCR duplicates are subsequently compared in order to create a PCR consensus sequence.” EX1007 at ¶99. QIAGEN argued in its Petition (at 45) that this paragraph discloses limitation 1.g, which requires that both the target and identifier sequences are used for identifying duplicates. It explained (at 45) that a “POSA would have known that, in order to generate a consensus read, the target sequences must be identical.” In its ID, the Board noted (at 8, 36) Petitioner’s reliance on paragraph 99 and found it persuasive, stating (at 38) “as Petitioner notes, Schmitt teaches reading target sequences, wherein ‘[t]he

sequences of uniquely tagged PCR duplicates are subsequently compared in order to create a PCR consensus sequence.’ (Ex. 1007 ¶ 99).”

Even though Petitioner relied on Schmitt paragraph 99 in its petition and the Board relied on this paragraph in its institution decision, Tecan ignored paragraph 99 in its POR, and its expert, Dr. Bustamante, also admitted that he also did not address paragraph 99. EX1034 at 23:18-23:20. Petitioner’s Reply pointed this out. Reply at 15 (“Tecan has waived its ability to respond to paragraph 99, which is dispositive of limitation 1.g.”). Tecan then addressed paragraph 99 for the first time in its Sur-Reply (at 17-18). The Board should strike Tecan’s Sur-Reply arguments regarding Schmitt paragraph 99 as forfeited because it had an opportunity to raise those arguments in its POR but chose not to. *See Viant*, Paper 41, at 42; *PLR*, 2025 WL 1191478, at *13; *Caterpillar*, 2024 WL 465543, at *21.

Tecan’s attempts to cure its improper response to paragraph 99 should be rejected. First, Tecan argues that it addressed paragraph 99 in its POR because the POR addresses paragraphs 85 and 98, which Tecan alleges contain “the same disclosures” as 99. Sur-Reply at 17. Tecan is wrong. The key part of paragraph 99 that both QIAGEN and the Board relied on is the portion discussing the creation of a “consensus sequence” (Pet. at 45; ID at 36, 38) is absent from paragraphs 85 and 98 of Schmitt (EX1007 at ¶85, 98) and was never discussed in the POR (at 30-32). Thus, the disclosure of paragraph 99 is meaningfully different from paragraphs 85

and 98. Second, Tecan (at 18) incorrectly alleges that QIAGEN's Reply "is the first time Petitioner has asserted that the claimed generation of a consensus sequence meets the identification of duplicates limitation." As noted above, this argument was in the Petition (at 45) and ID (at 35, 38).

B. Motivation to Combine (Paper 28 at 20-23)

QIAGEN's Petition (at 35-39) provided a detailed explanation why a POSA would have been motivated to combine Schmitt with McCloskey. The Petition (at 35-36 & 37-39) describes, *inter alia*, why Schmitt and McCloskey address the same technical problem and why a "POSA would have been motivated to combine *Schmitt* with *McCloskey*'s batch-stamp." The Petition (at 38) also explains that "a POSA would have been aware of *McCloskey*, particularly in light of *Schmitt*'s explicit citation to *McCloskey 2007*, and would have been motivated to select *McCloskey* given *McCloskey*'s disclosure of a batch-stamp, which allows *Schmitt*'s adaptor to be used in multiplex sequencing reactions."

In its POPR, Tecan argued in passing (at 23) that "Petitioner ignores the differences between the structure of the Schmitt and McCloskey adaptors and how they might, or might not, work if combined." The Board rejected this argument in its ID (at 33), explaining that "Patent Owner fails to explain or even identify what these differences are." The Board also found (ID at 32) that Schmitt's citation to *McCloskey 2007* was persuasive as to motivation to combine. Tecan's POR

arguments relating to motivation to combine (at 32-34) were focused almost exclusively on Tecan's argument that QIAGEN was engaging in impermissible hindsight. Similar to the POPR, the POR summarily alleged (at 33-34) that "Petitioner ignores the differences between the structure of the Schmitt and McCloskey adaptors," but again Tecan failed to provide any details regarding this argument despite the Board's criticisms in the ID. Indeed, the POR's motivation to combine section cites only the Petition; it does not cite Schmitt, McCloskey or any other exhibit.

In its Reply, QIAGEN noted (at 19) Tecan's failure to address Schmitt's citation to McCloskey 2007, explained (at 19-22) why QIAGEN did not rely on hindsight, and addressed (at 22-23) Tecan's argument that QIAGEN "ignore[d]" the differences between Schmitt and McCloskey by noting that QIAGEN provided un rebutted expert testimony explaining how the combination would work.

Tecan's Sur-Reply (at 20-23) argues for the first time that the Schmitt adaptor is incompatible with those in McCloskey and McCloskey 2007 because "Schmitt's inventive method relies on using adaptors with double-stranded target nucleic acid molecules in contrast to traditional single-stranded methods," which Tecan describes as "fundamentally limited." According to Tecan (at 21-22), both McCloskey and McCloskey 2007 are "example[s] of these traditional approaches that are 'fundamentally limited,'" and the Sur-Reply extensively cites both Schmitt and

McCloskey. The Board should strike the entirety of the motivation to combine section (at 20-23), as these arguments were raised for the first time in the Sur-Reply and could have been raised in the POR.

Tecan had every opportunity to raise these arguments earlier in the proceeding but chose not to. Indeed, the ID (at 33) specifically faulted Tecan for failing to explain the alleged differences between the adaptors of Schmitt and McCloskey. Despite this express criticism, the POR provided nothing new on this point, and QIAGEN's Reply does not raise any new arguments. It simply repeats arguments in the Petition and points out that Tecan mischaracterizes those arguments. By waiting until the Sur-Reply, Tecan prevented QIAGEN from offering rebuttal expert testimony or exhibits and from cross examining Tecan's expert regarding the Sur-Reply arguments. The Board's case law supports a finding that Tecan has forfeited these arguments. *See Viant*, Paper 41, at 42; *PLR*, 2025 WL 1191478, at *13; *Caterpillar*, 2024 WL 465543, at *21.

II. IPR2025-00028 AND IPR 2025-00029: TECAN IMPROPERLY SUBMITTED AND RELIED ON NEW EVIDENCE³

The Board should strike the new exhibits (EX2201-2212) submitted with Tecan's sur-reply along with portions of the sur-reply (at 9-10, 18-19, 26-28) and

³ All citations in this section are to IPR2025-00028 and IPR2025-00029.

Dr. Metzker's December 3 deposition transcript that rely on or relate to these new exhibits (EX2213 at 55-131).

It is well-established that sur-replies cannot be accompanied by new evidence or exhibits other than the deposition transcript of a reply witness. *See* 37 CFR § 42.23(b); 37 CFR § 42.121(e)(3); Trial Practice Guide (November 2019) at 73 (“The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness”), 80-81. The PTAB regularly enforces these regulations to strike new exhibits submitted with a sur-reply. *See, e.g., Ford Motor Co. v. Safe Driving Techs. LLC*, No. IPR2021-01446, Paper 28 at 80-83, (P.T.A.B. Mar. 10, 2023). Moreover, this Board repeated the instruction in its scheduling order: “***sur-reply may not be accompanied by new evidence.***” IPR2025-00028, Paper 8 at 6.

In an effort to avoid motion practice and further reliance on these new exhibits, Petitioner repeatedly warned PO during Dr. Metzker's deposition that the introduction of new, irrelevant exhibits and repeated questioning on materials outside the scope of Dr. Metzker's reply declaration was inappropriate. *See, e.g.,* EX2213 at 58:3-6; 60:13-20; 125:6-8. Despite this repeated warning, PO filed the new exhibits with its Sur-Replies (*see* EX2201-EX2213) and used them extensively in questioning Dr. Metzker.

PO attempts to justify this clear violation of the rules and the scheduling order by citing to *Ascend Performance v. Samsung SDI Co., Ltd.*, IPR2020-00349, Paper 53, at 12-13 (PTAB July 15, 2021) and arguing that PO was “entitled to impeach Dr. Metzker” and/or test his testimony. See EX2213 at 59:7-9. The Board should reject these excuses. First, *Ascend* was decided before the current version of 37 CFR § 42.23 and thus holds little relevance.⁴ After the current version of the rule went into effect, multiple Boards confirmed “Rule 42.23(b) provides a blanket prohibition on a patentee filing exhibits with a sur-reply.” *Netflix, Inc. v. Divx, LLC*, No. IPR2020-00511, 2021 WL 3599429, at *22 (P.T.A.B. Aug. 13, 2021); *Intel Corp. v. Parkervision, Inc.*, No. IPR2020-01265, 2022 WL 212407, at *30 (P.T.A.B. Jan. 21, 2022); *Intel Corp. v. Parkervision, Inc.*, No. IPR2020-01265, 2022 WL 212407, at *30 (P.T.A.B. Jan. 21, 2022).

Second, although there is no “impeachment” exception to Rule 42.23, PO’s allegation that it is using the exhibits for impeachment is incorrect. Impeachment is when a party “attack[s] the witness’s credibility.” FRE 607. PO cites to European Patent Office papers from 2015 in an attempt to allege that “Petitioner told the [EPO] that the use of a single target-specific primer for amplification, rather than a primer

⁴ Presumably, this is why the scheduling order in *Ascend* lacked the prohibition against new exhibits that appears here.

pair” differentiated the claimed method from the prior art. Paper 27 at 18-19 (citing EX2211). But this statement from an unrelated patent application does not attack Dr. Metzker’s credibility in this proceeding, where he opined that methods identical to the claimed methods “had been in use and were well proven to work.”⁵ *Id.* (citing EX1003). PO’s other sur-reply citations to new exhibits fare no better, as these exhibits are also not used for impeachment purposes. *See* Paper 27 at 9-10, 26-28.

Regardless, if PO wished to provide additional exhibits to attack the declarant’s credibility, the proper procedure was for PO to file a motion to leave before filing its sur-reply. *See, e.g., 3M Company v. Bay Materials, LLC*, IPR2022-01214, Exhibit 2091; *Ford Motor Co.*, No. IPR2021-01446, Paper 28 at 83. By following this procedure, PO would have avoided violating the scheduling order and given Petitioner an opportunity to make its case before the sur-reply was submitted and the prejudice to Petitioner had been committed.

PO’s introduction of a dozen new exhibits at the sur-reply stage is highly prejudicial to Petitioner and is the exact type of gamesmanship that Rule 42.23 was designed to prevent. By waiting until the last possible moment to try to introduce these exhibits, PO prevented Petitioner from having its expert respond to these

⁵ PO could have introduced this evidence in Dr. Metzker’s first deposition as it is attacking his ***petition*** declaration. This delay prejudices Petitioner.

exhibits or from introducing exhibits of its own to refute or provide context to PO's new exhibits. Indeed, the prejudice is particularly severe here because PO did not submit an expert declaration along with the new exhibits, despite many of the new exhibits being highly technical. This prevented Petitioner from cross examining PO's expert about the new exhibits, further prejudicing Petitioner.

Accordingly, each new exhibit (EX2201-2212) PO submitted should be struck. PO only cites to Exhibits 2202-03, 2205-06, 2210-12 in its sur-replies. The remaining uncited new exhibits are related to those cited in the sur-reply and should also be struck to prevent PO's further reliance on these exhibits. Further, exhibits not cited in the Papers cannot be relied on and the uncited, new exhibits should be struck for this additional reason. 37 C.F.R. § 42.6(a)(3); 37 C.F.R. § 42.22; *see also Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371 (Fed. Cir. 2023). Similarly, for Dr. Metzker's December 3 deposition transcript (EX2213), all portions of the deposition related to the new exhibits should be struck, including pages 55 to 131.

DATED: January 9, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 9, 2026, I caused a true and correct copy of the foregoing PETITIONER'S AUTHORIZED MOTION TO STRIKE to be served on counsel for Patent Owner via email at:

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