

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GATOR BIO, INC.,
Petitioner,

v.

SARTORIUS BIOANALYTICAL INSTRUMENTS, INC.,
Patent Owner

IPR2025-00633
U.S. Patent No. 8,647,588

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	About Us - Gator Bio Website https://www.gatorbio.com/about/ (published by Gator Bio) (accessed June 10, 2025)
2002	About Us - Gator Bio Website (Archived February 5, 2021) https://web.archive.org/web/20210205214217/https://www.gatorbio.com/about/ (accessed June 10, 2025)
2003	Gator Bio Next Gen BLI Systems by CEO Hong Tan https://www.youtube.com/watch?v=2PFar48iu4Y (published by Gator Bio) (accessed June 10, 2025)
2004	Gator Bio Next Gen BLI Systems by CEO Hong Tan - Transcript https://www.youtube.com/watch?v=2PFar48iu4Y (published by Gator Bio) (accessed June 10, 2025)
2005	The History of BLI and introduction of the Next Gen Gator BLI System https://www.youtube.com/watch?v=l_8Kp0erMLY&list=PLRTGGJVdMP98S-0lvLZPtBofkuHdTUs0b&index=2 (published by Gator Bio) (accessed June 10, 2025)
2006	The History of BLI and introduction of the Next Gen Gator BLI System - Transcript https://www.youtube.com/watch?v=l_8Kp0erMLY&list=PLRTGGJVdMP98S-0lvLZPtBofkuHdTUs0b&index=2 (published by Gator Bio) (accessed June 10, 2025)
2007	Assignment of U.S. Patent Application No. 13/101,112 from Inventors to FortéBio
2008	Assignment of BLI patents to Sartorius
2009	Petition of IPR2023-00215 filed by Gator Bio against U.S. Pat. 8,305,585
2010	File History of U.S. Patent Application No. 11/423,669 (copies of prior art references omitted)
2011	File History of U.S. Provisional Application No. 60/690,325
2012	California Northern District – Past 5 Years

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Pursuant to the Director’s March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management (“Memorandum”), Patent Owner files this Request for Discretionary Denial of Institution.

I. Introduction

Hong Tan and Robert Zuk recognized a problem in the art and applied for, and obtained, a patent. Hong Tan and Robert Zuk assigned their “entire worldwide right, title, and interest in all inventions and improvements that are disclosed in” the patent to their own company FortéBio, the predecessor of Sartorius (Patent Owner). EX2007 at 3. Hong Tan and Robert Zuk then left FortéBio and later cofound Gator Bio (Petitioner) to develop an infringing product. Gator Bio still advertises its own product as being based on the technology that Hong Tan and Robert Zuk developed at FortéBio. EX2001, EX2003, EX2005. Gator Bio even lauds Robert Zuk as being a prolific inventor, based on his patents. EX2001. Now faced with infringement of Hong Tan’s and Robert Zuk’s assigned patent, Gator Bio is newly attempting to assert that the patent should never had issued.

Although assignor estoppel does not apply in *inter partes* reviews under 35 U.S.C. § 311(a) (*see Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 804 (Fed. Cir. 2018)), the Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a). It is not an appropriate use of Office resources where the inventors applied for and were issued a

patent, but, as is the case here, now advocate for its unpatentability.

Tessell, Inc., v. Nutanix, Inc., IPR2025-00322, Paper 14 at 2-3 (P.T.A.B. June 12, 2025).

This alone should be sufficient to discretionarily deny the Petition. However, there are many other factors that weigh in favor of discretionary denial including, for example, the fact that the challenged patent will expire 3 months from the date of a Final Written Decision (FWD), that the challenged patent has been in force for the past 11 years, and that Petitioner’s cofounders Hong Tan and Robert Zuk knew of the patent application leading to the challenged patent for at least 18 years.

II. BACKGROUND

A. Gator Bio, Inc. (“Gator Bio”), Hong Tan, and Robert Zuk

The petition was filed by Gator Bio, naming co-inventor Hong Tan as a real party-in-interest. Pet., 80. Petitioner Gator Bio was co-founded and is run by Hong Tan, its President and Chief Executive Officer (“CEO”), and Robert Zuk, its Chief Technology Officer (“CTO”). EX2001; EX2003; EX2005. The same Hong Tan and Robert Zuk are two of the inventors of U.S. Patent 8,647,588 (the “’588 Patent”). EX1004, 66.

In 2001, Hong Tan founded FortéBio (the original assignee of the ’588 Patent, and Sartorius’s predecessor in interest), where he served as CEO and CTO. EX2001; EX2003. At FortéBio, Hong Tan and Robert Zuk developed Octet® Bio-Layer

Interferometry Label-Free Detection Systems for Biomolecular Interactions Analysis (the “Octet system”), which allow for real-time, label-free analysis for the determination of kinetics, affinity, and antibody/protein quantitation. *Id.* The Octet system was released in 2006. EX2003.

In 2005, during development of the product, Hong Tan and Robert Zuk invented the present invention of the ’588 patent and applied for a patent as named inventors. EX1004, 66-67, 69; EX2011, 3. In pursuing the patent, Hong Tan and Robert Zuk signed declarations pledging to the U.S. Patent Office that they have “reviewed and understand the contents of... the claims” and indicated that they are the “original and first inventor(s) of the subject matter which is claimed.” EX1004 at 81. Hong Tan and Robert Zuk pledged that the statements were true to the best of their knowledge with willful false statements and the like being punishable by fine or imprisonment, or both. *Id.*

On the same day, Hong Tan and Robert Zuk assigned their “entire worldwide right, title, and interest in all inventions and improvements that are disclosed in” the patent to their own company FortéBio for value. EX2007, 3. Hong Tan and Robert Zuk pledged to “do all lawful acts... for securing, maintaining, and enforcing worldwide patent protection... and for vesting... the rights, titles, and interests herein conveyed.” *Id.* Hong Tan and Robert Zuk further pledged that they have “the rights, titles, and interests to convey as set forth herein, and covenants with

[FortéBio] that [they] ha[ve] not made and will not hereafter make any assignment, grant, mortgage, license, or other agreement affecting the rights, titles, and interests herein conveyed.” *Id.*, 2-3. Hong Tan and Robert Zuk pledged the same rights to “successors” of FortéBio. *Id.*, 2.

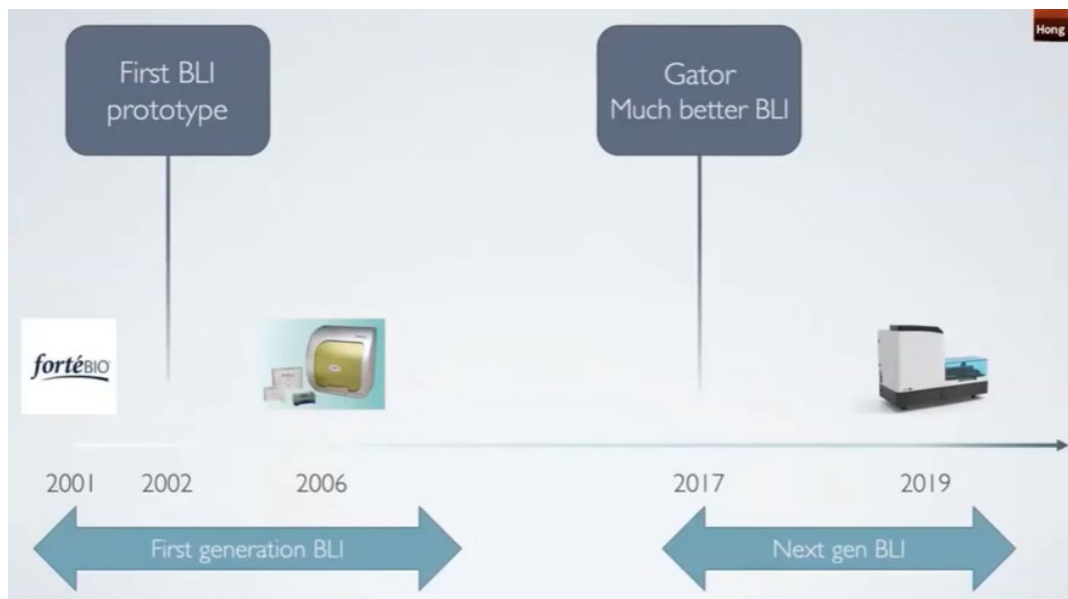
Gator Bio still accredits Hong Tan and Robert Zuk with “the creation of [BLI] at FortéBio.” EX2001; EX2003.

Hong Tan, PhD, Founder and Chief Executive Office of Gator Bio, spearheaded the creation of Bio-layer Interferometry technology (BLI) at FortéBio with the help of **Robert Zuk**, Founder and Chief Technology Officer at Gator Bio, in 2001. Upon realizing the growing importance for higher productivity, greater accessibility and new performance standards, together, they worked to take BLI technology to the next level. Building on their combined and extensive experience in engineering, biochemistry and high-volume manufacturing, Gator®, for next-generation BLI analysis, was born.

Gator Bio also advertises FortéBio “as the first biolayer interferometry technology company” and the Octet system as “the first BLI system.” EX2003. Gator Bio further provides that the Octet system was “well received” when it made its debut in 2006, and BLI then began to “expand globally” and to “receive world-wide acceptance.” EX2005.

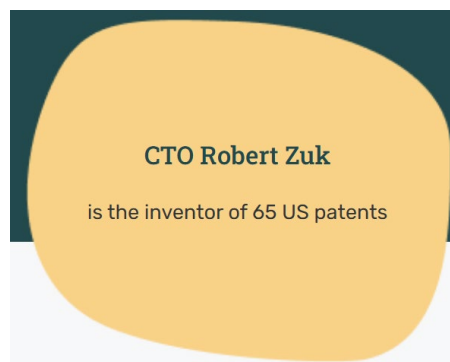
Shortly after leaving FortéBio, Hong Tan began working at Access Medical Systems, Ltd., where he currently serves as the CEO. Pet., 80. Access Medical Systems, Ltd. is also an admitted real party-in-interest and currently the parent company of Gator Bio. Pet., 80. Hong Tan and Robert Zuk cofounded Gator Bio and “decided to come back into this field” in 2017. EX2003. In 2019, Gator Bio

then began to sell an infringing line of devices. EX2003.



Gator Bio advertises its infringing line of products as being based on the Octet System of FortéBio. EX2001, EX2003. Gator Bio specifically refers to the Octet System of FortéBio as “First generation BLI” and its own products as “Next gen BLI.” EX2003.

Gator Bio also currently advertises that Robert Zuk is the “inventor of 65 US patents,” which would include the '588 Patent because he is a named inventor of the patent and is directed to BLI systems. EX2001.



Thus, Gator Bio credits Robert Zuk as a prolific “inventor”; at the same time, Gator Bio now attempts to convince the PTAB that the ’588 patent is not an invention. EX2001.¹

B. Claimed Invention

The ’588 Patent relates to a tip tray apparatus for packaging optical sensors used for fiber optic interferometry. EX1001, 1:19-22.

The inventors (including Hong Tan and Robert Zuk) identified a problem in the optical sensors of the prior art in the lack of a mechanism for packaging and holding discrete fiber optic sensors in a format that allows for easy use of the sensors. *Id.*, 2:29-38. Prior systems for holding fiber optic sensors were either in flow cell format or have sensors located as a part of the bottom of a microplate well, both of which require different pre-wetting and immobilization procedures. *Id.*, 2:19-23. In addition, the prior systems did not provide flexibility for users to arrange or configure the fiber optic sensors to customize the arrangement for immobilization. *Id.*, 2:23-25. Users did not have the option to simply remove and save unused biosensors but instead were forced to use an entire set of sensors for each experiment even if only a few were needed. *Id.*, 2:26-28.

¹ This is not the first time that Gator Bio has attempted to invalidate a Sartorius owned patent of Hong Tan or Robert Zuk at the PTAB. EX2009.

The inventors (including Hong Tan and Robert Zuk) solved this problem by designing (and claiming) a new optical sensing assembly and tip tray apparatus that improved on prior art systems.

III. Petitioner, including RPI Hong Tan, should not be allowed to challenge the '588 patent

As discussed at the outset, Hong Tan and Robert Zuk are named inventors on the '588 Patent, and Gator Bio was co-founded and is run by Hong Tan and Robert Zuk. In 2005, while developing products covered by the claimed inventions, Hong Tan and Robert Zuk applied for a patent as inventors to protect their inventions. EX1004, 70; EX2011. In their pursuit, Hong Tan and Robert Zuk signed declarations pledging to the U.S. Patent Office that they have “reviewed and understand the contents of... the claims” and indicated that they are the “original and first inventor(s) of the subject matter which is claimed.” EX1004, 81. On the same day, Hong Tan and Robert Zuk assigned their “entire worldwide right, title, and interest in all inventions and improvements that are disclosed in” the patent to their own company FortéBio for value. EX2007, 3. Indeed, the innovation of Hong Tan and Robert Zuk contributed to the “the first biolayer interferometry technology company” at FortéBio that produced “the first BLI system” (EX2005), and the technology was assigned to Sartorius (EX2008).

After letting FortéBio and Sartorius develop the BLI market to “expand globally” and to “receive world-wide acceptance”, Hong Tan, Robert Zuk, and Gator

Bio “decided to come back into this field” protected by the ’588 Patent. EX2003; EX2005.

Now faced with an infringement suit and in abrupt about-face, Hong Tan, Robert Zuk, and Gator Bio newly allege that the ’588 Patent is invalid; the very same patent that they 1) warranted as valid to the patent office, 2) warranted as valid to Sartorius’s predecessor, 3) admitted that they received value for in assigning the patent to Sartorius’s predecessor, 4) implicitly advertise on Gator Bio’s website as CTO Robert Zuk’s “US Patents”, and 5) receive value by avoiding competition from companies that respect the patent system and the validity of the ’588 Patent – based in part by representations made by Hong Tan and Robert Zuk during prosecution.

This is the exact situation the Supreme Court sought to prevent, based on equity and strength of the patent system rational, by preventing assignors from challenging the validity of their patents. *See Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298 at 2301, 2309 n.4 (2021).

The Director should address this “unfair dealing,” promote “patent policy goals,” and protect the public by exercising discretion under § 314(a) to deny institution given that the Supreme Court has reaffirmed the vitality and significance of the assignor estoppel doctrine to the strength of the patent system. *Id.*; *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (acknowledging § 314(a) imposes “no mandate to institute review”); *accord SAS Inst., Inc. v. Iancu*, 138 S.

Ct. 1348, 1356 (2018).

A. Gator Bio’s “unfair dealings”

The Supreme Court has repeatedly ruled that an assignor is not “at liberty to urge invalidity in a suit upon his own patent against a party who derives title to that patent through him.” *Minerva Surgical, Inc.*, 141 S. Ct. at 2304. The rule is “well settled” dating back to as early as 1880. *Id.* at 2302. “The principle of fair dealing as between assignor and assignee of a patent whereby the assignor will not be allowed to say that what he sold as a patent was not a patent had been part of the fabric of our law throughout the life of this nation.” *Westinghouse v. Formica*, 266 U.S. 342, 349 (1924).

Assignor estoppel is grounded in demand for consistency in dealing with others, specifically with representations about a patent’s validity. *Minerva Surgical, Inc.*, 141 S. Ct. at 2304, 2309. Selling a patent includes at least an implicit representation to the buyer that the patent at issue is valid through both an oath to the Patent Office and an assignment to a company. *Id.* The assignor later raising an invalidity action disavows that implied warranty and breaches norms of equitable dealing. *Id.* By saying one thing and then saying another, the assignor wants to profit doubly—by gaining both the price of assigning the patent and the continued right to use the invention it covers. *Id.* The present proceeding is a prime example of the concerns described by the Supreme Court, Hong Tan and Robert Zuk engaged

in improper unfair dealing by first assigning the patent, allowing the market to develop, and then seeking to continue to use the invention the '588 Patent covers. Petitioner's and the named inventors' "unfair dealings" warrants discretionary denial. *Id.*

B. The claims are narrower than those as declared valid by Hong Tan and Robert Zuk

Hong Tan and Robert Zuk executed the declaration and assignment with the filing of U.S. Patent Application No. 11/423,669 ("the '699 application"). EX1004, 81; EX2007, 3. During prosecution, claims 1-34 of the '669 Application were withdrawn in response to a restriction requirement. EX2010, 114-115. The original claim set from the '669 Application (EX2010, 216-221) was later filed in a divisional, as U.S. Application No. 13/101,112 (EX1004, 41-46) that granted as the '588 Patent.

During prosecution of the '112 application, independent claim 1 was narrowed and issued as claim 1 of the '588 patent. EX1004, 121, 148, 218, 236. Claim 1 of the '112 application (as also originally filed in the '669 application) is shown side-by-side against claim 1 of the '588 patent with language added during prosecution of the '112 application underlined.

Element	Claim 1 of the '699 Application ² (EX2010, 216)	Claim 1 in the '588 Patent (EX1001, 19:31-48)
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² At signing of declaration

[1PRE]	1. An apparatus for packaging an optical sensing assembly, the apparatus comprising	1. An apparatus for packaging an optical sensing assembly, the apparatus comprising
[1A]		<u>at least one discrete optical sensing assembly</u>
[1B]		<u>comprising an optical fiber and a transparent optical element having end faces and first and second reflecting surfaces formed on the end faces, the first and second reflecting surfaces separated by at least 50 nm,</u>
[1C]		<u>wherein the first reflecting surface comprises a layer of analyte binding molecules;</u>
[1D]	a substrate with a plurality of openings, each opening being configured for holding a discrete optical sensing assembly therein,	a substrate with a plurality of openings, each opening being configured for holding a discrete optical sensing assembly therein,
[1E]	the optical sensing assembly being positioned in the opening with a tip of the optical sensing assembly extending through the opening to be suspended from the substrate,	the optical sensing assembly being positioned in the opening with a tip of the optical sensing assembly extending through the opening to be suspended from the substrate,
[1F]	wherein the plurality of openings are arranged so the optical sensing assembly positioned therein avoids contacting another optical sensing assembly positioned therein.	wherein the plurality of openings are arranged so the optical sensing assembly positioned therein avoids contacting another optical sensing assembly positioned therein, <u>and</u>
[1G]		<u>wherein at least one opening holds an optical sensing assembly therein, with the tip of the optical sensing assembly extending through the opening.</u>

Thus, independent claim 1 of the '588 patent includes all limitations of the

originally filed claim 1 that Hong Tan and Robert Zuk warranted and assigned. Hong Tan and Robert Zuk declared to the U.S. Patent Office that they “reviewed and understand the contents of” claim 1 of the ’669 application and, importantly, indicated that they were the “original *and first inventor(s) of the subject matter which is claimed.*” EX1004, 81 (emphasis added). Hong Tan and Robert Zuk pledged to their own company (that they later sold and for which they received value) that they have “the rights, titles, and interests to convey” the invention of claim 1 of the ’669 application. EX2007, 3. Hong Tan and Robert Zuk further pledged to “generally do all lawful acts... desirable for securing, maintaining, and *enforcing worldwide patent protection...* and for vesting... the rights, titles, and interests herein conveyed.” *Id.* (emphasis added). Hong Tan and Robert Zuk continue to receive value from the ’588 patent by advertising it as one of the many patents that Robert Zuk invented. EX2001. Hong Tan and Robert Zuk also continue to receive value from the ’588 patent by deterring competitors that, unlike Gator Bio, respect the validity of the patent.

Equity demands that Hong Tan and Robert Zuk not be permitted to contend to the USPTO that the asserted claims are invalid as obvious because they warranted to the USPTO, among others, the validity of a broader version of the claims in the ’669 application. *See Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009) (explaining that a narrower dependent claim cannot be invalid as obvious

unless the broader independent claim is also obvious).

This case is a clear example of Hong Tan and Robert Zuk using the U.S. Patent Office to execute an “unfair dealing” in unjustly “saying one thing and then saying another... to profit doubly—by gaining both the price of assigning the patent and the continued right to use the invention it covers.” *Minerva Surgical, Inc.*, 141 S. Ct. 2298 at 2301, 2309.

C. Gator Bio’s in privity with Hong Tan and Robert Zuk

Hong Tan, the co-founder and CEO of Gator Bio, is listed as a real party-in-interest. Pet., 80. Robert Zuk also is in control of Gator Bio as a co-founder and CTO. EX2001. Equitable principles of fairness should apply to “prevent[] parties in privity with an estopped assignor from challenging the validity of the patent.” *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1379 (Fed. Cir. 1998).

D. Instituting IPR of Patent Inventors/Assignors Weakens the US Patent System

Not only is Hong Tan’s action an “unfair dealing”, but the Supreme Court held that the actions taken by him (directly or through Gator Bio) undercuts “confidence” in the patent system as a whole and discourages innovation. *Minerva Surgical, Inc.*, 141 S. Ct. at 2309 n.4.

Companies rely on the value of the certainty of a strong patent system when developing and investing in technology, and Congress has expressly intended to

strengthen investor confidence in the certainty of patent rights. *See* H.R. REP. NO. 96-1307(I) at 1 (1980) (intending to “promote industrial innovation by assuring the kind of certainty about patent validity which is a necessary ingredient of sound investment decisions.”).

As the Supreme Court held in *Minerva Surgical*, inventors often have the upper-hand and are especially likely infringers because of their knowledge of the relevant technology. 141 S. Ct. at 2309 n.4. The Supreme Court applied assignor estoppel to promote “some patent policy goals” in giving an assignee “confidence in the value of what they have purchased.” *Id.* The Supreme Court specifically found that “preventing [assignors] from raising an invalidity defense in an infringement suit... raises the price of patent assignments, and in turn may encourage invention.” *Id.* The Supreme Court recognized that the policy goals supporting assignor (and thus inventor) estoppel are critical:

When a person sells his patent rights, he makes an (at least) implicit representation to the buyer that the patent at issue is valid—that it will actually give the buyer his sought-for monopoly. In later raising an invalidity defense, the assignor disavows that implied warranty. And he does so in service of regaining access to the invention he just sold. As the Federal Circuit put the point, the assignor wants to make a representation at the time of assignment (to his advantage) and later to repudiate it (again to his advantage). By saying one thing and then saying another, the assignor wants to profit doubly—by gaining both

the price of assigning the patent and the continued right to use the invention it covers. That course of conduct by the assignor strikes us, as it has struck courts for many a year, as unfair dealing—enough to outweigh any loss to the public from leaving an invalidity defense to someone other than the assignor. (*Id.*) (internal citations and quotations omitted)

Id. at 2298-99.

This is especially true here. Gator Bio still credits Hong Tan and Robert Zuk with “the creation of [BLI] at FortéBio.” EX2001. Gator Bio advertises Robert Zuk as an “inventor” of 65 patents. EX2001. Hong Tan and Robert Zuk filed the patent application to address limitations of “current devices” and “a need for an easy mechanism for off-line incubation, pre-wetting, and immobilization.” EX1001, 2:29-67. At that time, Hong Tan, at the very least, executor of the Oath and Declaration described above, knew of the most relevant prior art that Gator Bio now relies on in its Petition. For example, Hong Tan is an author of the Yang reference (EX1006) and an inventor of WO854 (EX1008). The Chen reference (EX1009) was also commonly owned by FortéBio at the time of filing and discussed in the ’588 Patent. EX1001, Col. 1, Line 49. Hong Tan and Robert Zuk warranted the validity of the patents despite being fully aware of these prior art references at the time that they filed their patent application. EX1004, 81. Hong Tan and Robert Zuk appear to have reneged on the warranty when they – and the company it created – wanted

to practice the claimed invention. Hong Tan and Robert Zuk even applied their own prior art references in alleging that the patent that they warranted as valid should never have been granted.

This issue affects the value of the patent system as a whole. Allowing assignor/inventors, such as Hong Tan and Robert Zuk, to sell their rights in a patent with an assurance of validity and then invalidating the same patent undercuts certainty and confidence in the patent system. *Minerva Surgical, Inc.*, 141 S. Ct. at 2309 n.4. This is especially true here where Gator Bio is citing prior art that Hong Tan and Robert Zuk were not only aware of at the time of filing, but also discuss and improve over in describing their invention. EX1001, 2:29-38, 61-67. These “unfair dealings” creates uncertainty and likely reduces future investment of companies, like Sartorius, into developing technology and filing for patents, and could be potentially catastrophic to small businesses with substantial investment in patents.

The patent system should not be used for such harmful conduct to the detriment of the public’s confidence in the system, as held by the Supreme Court. *Minerva Surgical, Inc.*, 141 S. Ct. at 2309.

E. Gator Bio’s actions create fraud on the public and the marketplace

As discussed above, Gator Bio represented the technology embodying the ’588 patent as “the first BLI system” and as being “well received” and spurring global expansion and “world-wide acceptance.” EX2005. Gator Bio also advertised

the number of patents to Robert Zuk on their own website. EX2001. Hong Tan and Robert Zuk executed Declarations the public relied upon asserting they were the first inventors. EX1004, 81. Thus, Gator Bio, and its founders, profited off the '588 patent through advertising the innovation therein and by avoiding competition from companies that respected its validity. This deterrence likely succeeded in keeping competitors (other than the patent owner) out of the market until Gator Bio was able to release their own product. Gator Bio was aware of the patent since its very first filing but did not seek to invalidate the patent until it was asserted against them. Thus, not only does this “unfair dealing” hurt Satorius and the patent system, but it hurts competitors who did not enter the market based on Hong Tan and Robert Zuk’s warranty of validity to the patent office. This “unfair dealing” further directly hurts the public by hindering innovation and raising prices with the deterrence of competition.

F. The same “well settled” principles should apply to this invalidity proceedings in front of the PTAB

The Federal Circuit and the Board previously held that assignor estoppel does not preclude standing—the ability for an assignor to **file** an IPR—as IPRs are grounded in the language of 35 U.S.C. § 311(a). *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 804 (Fed. Cir. 2018); *Athena Automation Ltd. v. Husky Injection Molding Sys. Ltd.*, IPR2013-00290, Paper 18, at 12-13 (PTAB Oct. 25, 2013) (precedential). The issue here, however, is not one of standing, but one of equity

under the Director’s statutorily granted discretion to deny institution. *See* 35 U.S.C. §314(a). Here, the Director should exercise discretion under § 314(a) to affirm the policy rationales outlined by the Supreme Court, align USPTO practices with those of the district court and ITC concerning assignor estoppel, and maintain the strength and confidence in the US patent system.

Petitioner presumably filed this challenge based on an understanding that Petitioner cannot raise these invalidity challenges in the district court proceeding. Petitioner stipulates that the Petitioner would not pursue any ground that reasonably could have been raised in the petition in the corresponding district court action. EX1060, 2. However, these invalidity grounds raised in this petition are not available to the Petitioner in the district court under the “well settled” Supreme Court precedent. *Minerva Surgical, Inc.*, 141 S. Ct. at 2302. In other words, the stipulation of Petitioner is not waiving any rights that it has. Thus, the Petitioner is using this proceeding to side-step established Supreme Court policy in asserting invalidity of the ’588 patent at the PTAB. The Director should not allow the Patent challengers to circumvent well settled principles and reward that action with a lower burden of proof. As Judge Newman recognized in her dissenting opinion in *In re Cuozzo Speed Techs, LLC*, “the legislative record does not show a congressional intent that issued patents should be more readily invalidated in these [Patent Office] proceedings than in the courts.” 793 F.3d 1268, 1286 (Fed. Cir. 2015) (Newman, J., dissenting).

As stated by Acting Director Stewart:

Although assignor estoppel does not apply in *inter partes* reviews under 35 U.S.C. §311(a) (see *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 804 (Fed. Cir. 2018)), the Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a). It is not an appropriate use of Office resources where the inventors applied for and were issued a patent, but, as is the case here, now advocate for its unpatentability.

Tessell, Inc. v. Nutanix, Inc., IPR2025-00322, Paper 14, at 2 (P.T.A.B. June 12, 2025) (Stewart).

For these reasons, the PTAB should exercise its discretion under § 314(a) and deny institution. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (acknowledging § 314(a) imposes “no mandate to institute review”); *accord SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018).

IV. Existing board precedent and the factors set forth in the Memorandum strongly support discretionary denial

The Director issued the Memorandum to optimize the operation of the PTAB. Memorandum, 1. The Director has stressed that the PTAB should focus their limited resources on meritorious petitions, such as where the petitioner did not wait an extended period of time to file the petition. The Memorandum states:

consistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv.*, *General Plastics*, and *Advanced Bionics*) and the Consolidated Trial Practice Guide, the parties are

permitted to address all relevant considerations, which may include...

- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and Any other considerations bearing on the Director's discretion.

The Director will also consider the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA Proceedings, and other workload needs.

These processes aim to improve PTAB efficiency...

Memorandum, 2-3. As discussed below, these considerations weigh heavily in favor of discretionary denial of the Petition.

A. Settled Expectations of the Parties

It has been 19 years since Hong Tan and Robert Zuk filed a patent application on the claimed invention. EX1004, 69; EX2011, 3.³ Hong Tan and Robert Zuk

³ Based on the filing date of June 13, 2006 of U.S. Provisional Patent Application No. 60/690,325.

were fully aware of the application because they were inventors and executed declarations attesting knowledge of a non-provisional application filed a year later. EX1004, 81. The '588 patent issued over 11 years ago. EX1004, 274.⁴

Petitioner's knowledge of the patent application and failure to seek early review of the patent heavily favors discretionary denial of institution. *iRHYTHM Technologies, Inc. v. Welch Allyn, Inc.*, IPR No. 2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025) (discretionarily denying a petition based on the petitioner's knowledge of a pending patent application 12 years prior to challenging the validity of the resultant granted patent).

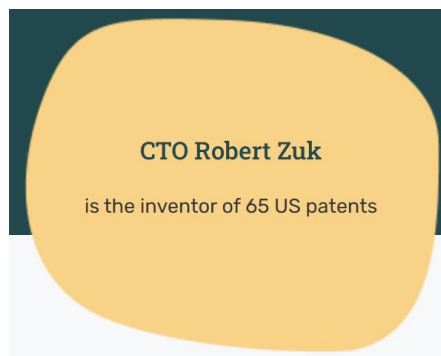
Both parties have conducted business as if the '588 patent is valid, and Hong Tan, Robert Zuk, and Gator Bio continue to benefit from this patent. For example, as discussed above, Gator Bio still promotes its business based on Hong Tan and Robert Zuk's prior successes with FortéBio. *See, e.g.*, EX2001 (excerpted below).

Hong Tan, PhD, Founder and Chief Executive Office of Gator Bio, spearheaded the creation of Bio-layer Interferometry technology (BLI) at FortéBio with the help of **Robert Zuk**, Founder and Chief Technology Officer at Gator Bio, in 2001. Upon realizing the growing importance for higher productivity, greater accessibility and new performance standards, together, they worked to take BLI technology to the next level. Building on their combined and extensive experience in engineering, biochemistry and high-volume manufacturing, Gator®, for next-generation BLI analysis, was born.

Gator Bio further advertises that Robert Zuk is an “inventor of 65 US Patents” on its own website – obviously, as one of the inventors of BLI, one of those patents

⁴ Based on a grant date of February 11, 2014.

must be the '588 patent. EX2001 (excerpted below). Internet archive shows that the website with these statements date back to at least February 2021 *See, e.g.*, EX2002.



Gator Bio's promotion of the number of patents that have Robert Zuk listed as an inventor provides strong evidence of Gator Bio's sophistication and continued monitoring of the BLI portfolio Hong Tan and Robert Zuk created, including the '588 Patent. EX2001. Indeed, this is not the first time that Gator Bio has attempted to invalidate a Sartorius patent of Hong Tan or Robert Zuk at the PTAB. EX2009.

Gator Bio has additionally benefited from the '588 Patent granted to Hong Tan and Robert Zuk by avoiding competition from other companies that respect the validity of the patent. Gator Bio benefited from a clear field of competitors as it developed its own product. Gator Bio laid in wait with its own prior art – art that the inventors set out to improve upon – only when it suited its needs.

At the same time, Sartorius spent considerable resources acquiring, pursuing, and maintaining the '588 Patent and continuing to develop its BLI technology. Sartorius filed a lawsuit against Gator Bio in the Northern District Court in March

2022 asserting patent infringement of a number of BLI patents.⁵ Petitioners did not file any PTAB proceedings challenging the '588 Patent in response to the patent litigation. The district court case was subsequently stayed in January 2023 pending the resolution of an ITC Investigation. It was not until after an amended complaint was filed adding the '588 patent that the Petition was filed.

At the time of filing the Petition, the '588 Patent had less than 2 years of patent term remaining.⁶ Importantly, the '588 Patent will have *less than 3 months of term* at the time that any final written decision (FWD) would issue.⁷ Gator Bio, Hong Tan, and Robert Zuk waited for 19 years from the first filing and 11 years from issuance of the '588 Patent.

Gator Bio first profited by Hong Tan and Robert Zuk assigning the patent to their own company, then profited by excluding competitors from the market, and finally attempting to profit one last time by coming into the market before the patent

⁵ Sartorius Bioanalytical Instruments, Inc. v. Gator Bio Inc. and Hong Tan, No. 5:22-CV-01417 (N.D. Cal.).

⁶ Based on a priority filing date of June 12, 2006, and 203 days of patent term extension.

⁷ Based on an expiration date of January 1, 2027, and an estimated FWD date of October 14, 2026.

expires. Gator Bio knew about the '588 Patent and waited for years to challenge its validity. That is until the patent was asserted against Gator Bio. This sort of gamesmanship is not the purpose of an IPR petition.

B. The '588 patent will expire less than 3 months after the FWD

From the PTAB's point of view, a lengthy trial on the validity of such a mature patent is clearly a waste of valuable resources. These limited resources of the PTAB should not be spent on a year-long trial on the validity of a patent that will have less than 3 months of term at the time that any FWD⁸ would issue.

The PTAB's resources should not be spent on a Petition involving one or more inventors challenging the validity of their own patent, a petitioner waiting 19 years to challenge the validity of a patent, and a patent that will expire less than 3 months after the FWD.

C. "Confidence in the value of" the patent system is a compelling economic interest

"Compelling economic... interests... and other considerations bearing on the Director's discretion" (Memo, 2-3) further weigh heavily in favor of discretionary denial.

As discussed in § III.D, the Supreme Court has established that allowing

⁸ Based on an expiration date of January 1, 2027, and an estimated FWD date of October 14, 2026.

inventors to challenge the validity of their own patents undercuts “confidence” in the patent system as a whole and discourages innovation. *Minerva Surgical, Inc.*, 141 S. Ct. at 2309 n.4. The Supreme Court found that the conduct is such an “unfair dealing - to outweigh any loss to the public from leaving an invalidity defense to someone other than the assignor.” *Id.* at 2309. Indeed, a trusted patent system is a critical pillar of a healthy economy. *See* H.R. REP. NO. 96-1307(I) at 1 (1980) (“certainty about patent validity... is a necessary ingredient of sound investment decisions.”).

D. No Change in law

There have been no material changes in the law or new judicial precedent relevant to the issues in this Petition issued since the issuance of the ’588 patent warranting reconsideration. This factor weighs heavily in favor of discretionary denial, as there is no reason to revisit the Examiner’s decision.

E. The petition improperly attempts to shift the burden of claim construction to the Board and PO

A petition requires “a statement of the precise relief requested for each claim challenged,” including “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). Petitioner has an affirmative burden to set forth how the challenged claims should be construed. *See Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01548, Paper 9 at 10 (P.T.A.B. Mar. 1, 2019). Failure to properly construe the claims is fatal to the petition. *See CallMiner, Inc. v. Mattersight Corp.*, IPR2020-00272,

Paper 8 at 13-14 (P.T.A.B. June 18, 2020) (declining institution because of Petitioner’s failure to set forth sufficient claim constructions). Petitioner failed to properly construe the claims.

The petition alleges that “Petitioner does not believe any terms need construction to resolve the issues presented here.” Pet., 18. However, Petitioner later acknowledges a disputed term in “an optical fiber” of feature [1B]. Pet., 75 (“to the extent WO854 does not explicitly describe an optical fiber”). These statements are clearly inconsistent because there would be no dispute to the construction of “an optical fiber” if no construction was “needed to resolve the issues.”

The lack of claim construction is tactical and allows Petitioner to argue that the cited references disclose an ambiguous “optical fiber.” It is well settled that, “[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Similarly, a *prima facie* case of obviousness requires the Petitioner to establish any difference(s) between the prior art and the challenged claims. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Thus, this strategy improperly leaves Petitioner’s claim interpretation entirely open-ended, expecting the Board (and Patent Owner) to perform the analysis for both anticipation and obviousness. This also contravenes the *O2 Micro* which obligates a court (or in this

case the Board) to construe a term to resolve any dispute. *See O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008). Thus, institution should be denied. *See CallMiner, Inc.*, IPR2020-00272, Paper 8 at 14.

F. The petition fails to establish a *prima facie* case of obviousness

Petitioners are further required to “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). Furthermore, the Director’s enumerated factors including “the strength of the unpatentability challenge” (Memo, 2) also weighs in favor of discretionary denial.

1. The petition lacks sufficient “particularity” to allege a combination of the prior art

The grounds of the petition are based on a motivation statement of “POSAs would have been motivated to package **BLI/RIfS probes such as those described in Yang (or alternatively WO854, Grounds 3-4) in a tip tray such as that described in Miles.**” Paper 2 at 26. The lack of particularity by recitations of “such as” appear to be strategic in an effort to avoid disclosures from each of the references that are inconsistent with the intended modification. Thus, the motivation is not relying on what is actually disclosed by the prior art reference, but the petition is based on a combination of any BLI/RIfS probe and any tip tray. This overly broad basis of the grounds would seemingly allow the Petitioner to duck and dodge

arguments by selectively ignoring actual disclosures in each of the cited references, and relying on any hypothetical BLI/RIfS probe and any hypothetical tip tray. Thus, this proposed modification would provide the Petitioner “voluminous and excessive” iterations of the grounds in combining any member of these two broad categories, as held to be improper in *Adaptics. Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019) (informative)) (denying institution based on “voluminous or excessive grounds”).

Similarly, the petition relies on a statement that “Miles’ teachings may be applied to BLI/RIfS probes by providing some structure on the proximal ends of the probes that allows them to attach to a corresponding assaying apparatus and that is further appropriately sized to prevent the probes from falling through the tray openings.” *Id.* 30-31. As seemingly acknowledged by the petition, Petitioner’s proposed combination would require a modification of the optical sensors of Yang or WO854 in “providing some structure.... to attach to a corresponding assaying apparatus and that is further appropriately sized to prevent the probes from falling through the tray openings.” *Id.*

However, Petitioner never actually establishes the bases for such a *prima facie* case of obvious but rather relies on vague and conclusory statements that a POSA would make “some” modification to the optical sensors of the prior art to perform functions consistent with the disclosed advantages. *Id.*

Thus, Petitioner does not provide sufficient particularity on how the combination of Miles and Yang or WO854 would meet each limitation, but relies purely on each reference individually in an improper piece-meal attack of the claims. This is illustrative in Petitioner addressing elements [1B]-[1C] by citing exclusively to Yang or WO854 without mention of Miles. Pet., 34-38, 74-77. Similarly, Petitioner addresses elements [1D]-[1G] by citing exclusively to Miles without mention of Yang or WO854. Pet. 38-42, 77.

Yet again, Petitioner is improperly leaving its position entirely open-ended, expecting the Board (and Patent Owner) to figure it out.

2. The petition fails to sufficiently address “an optical fiber” of element [1b]

As discussed in § IV.E, Petitioner acknowledges that “an optical fiber” is a disputed term but fails to provide “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3).

Indeed, in addressing “an optical fiber”, Petitioner first makes a broad general statement alleging that WO854 discloses that a second optical element 66 of WO854 has an index of refraction “consistent” with known glass and plastic optical fibers. Pet. 74. As apparently acknowledged by Petitioner, optical fibers require additional features other than an index of refraction “consistent” with known glass and plastic optical fibers. Pet. 75 (“to the extent WO854 does not explicitly disclose using an optical fiber”). Thus, Petitioner cannot rely on WO854 disclosing the disputed term

of “optical fiber” because the petition fails to provide sufficient clarity on how the optical fibers is to be construed, and how WO854 meets each and every element.

Petitioner then relies on an interpretation of a claim granted from a disclosure of WO854 as a disclosure in itself. Pet. 74-75. It is well settled that, “[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Claim scope can be construed broader than what is disclosed for prior art purposes. *Ex Parte Argembeaux* No. 2020-001727, Application No. 15/521,787, *3-5 (P.T.A.B. April 1, 2021) (finding that a scope of a patent claim is not an anticipatory disclosure); MPEP 2173.02(I) (“A broad claim is not indefinite merely because it encompasses a wide scope of subject matter provided the scope is clearly defined.”) As an illustrative example, a claim recitation of a light bulb may be broad enough to cover an LED light bulb because the LED light bulb is a member of the genus of light bulbs. However, a disclosure of a light bulb would not necessarily provide sufficient disclosure to anticipate an LED light bulb because the genus of light bulbs includes many other types of light bulbs that are not LED. Thus, the mere fact that an optical fiber may fall within the claim scope of the optical element of WO854 does not provide any evidence that the optical element provides each and every element of an optical fiber to provide anticipation.

Petitioner finally attempts to apply an obviousness rejection. Petitioner

specifically alleges that “POSAs also would have found it obvious to use an optical fiber, with a reasonable expectation of success, given that similar BLI/RIFS probes comprising an optical fiber were already known and disclosed in references such as Yang and Sun.” Pet. 75.

However, without having properly construed the claim, Petitioner fails to provide the difference(s) the second optical element 66 of WO854 and the claims at issue as required for a *prima facie* case of obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (requiring that the differences between the prior art and the claims at issue be ascertained as part of an obviousness analysis). Petitioner’s gamesmanship provides the Patent Owner and the Board very little guidance on how to address the alleged obviousness ground.

Furthermore, Petitioner fails to provide a motivation. It has been established that “a patent composed of several elements is not proved obvious merely by demonstrating that each of the elements was, independently, known in the prior art.” *KSR International Company v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727 (2007). It has been further established that “a reasonable expectation of success” and the fact that “an optical fiber were already known and disclosed” are not sufficient to prove obviousness. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art

to arrive at the claimed invention”).

Thus, the petition fails to provide a valid position of WO854 disclosing or rendering obvious “an optical fiber” of feature [1b].

These deficiencies establishing bases of their grounds cannot be resolved after the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“the statute envisions that a petitioner will seek an inter partes review of a particular kind—one guided by a petition describing ‘each claim challenged’ and ‘the grounds on which the challenge to each claim is based.’”)

G. Petitioner relies heavily on expert testimony to backfill the limitations including citing references not established as prior art

“The extent of the petition’s reliance on expert testimony” (Memo, 2) weighs in favor of discretionary denial. The Petition relies on the declaration Dr. Laird Forrest that is 117 pages long and includes 187 paragraphs to challenge 19 claims of the ’588 patent. *See* EX1002. The Petition cites to Dr. Forrest over 150 times⁹ for claims that Petitioner believes are a simple combination of elements. *See generally* Paper 1. This heavy reliance on Dr. Forrest’s declaration cuts against Petitioner’s arguments.

Petitioner relies heavily on Dr. Forrest’s modification *and* combination of

⁹ This count is based on a search for the term “Forrest” and omits any references back to Dr. Forrest’s testimony (e.g., “id.”).

disparate references. Petitioner goes further by relying heavily on Dr. Forrest's hindsight reasons why the modifications would have been made and further for reasons the references should be combined. *See supra* IV.E.1. Petitioner tacitly concedes the weakness of its position by proactively citing case law that a person of ordinary skill in the art "need not have 'physically combined' or 'bodily incorporated' the precise design[s] of [the prior art]"; this suggests that there are multiple points of modifications before the combination. *Id.*

Moreover, Dr. Forrest relies on at least two exhibits that the Petition failed to establish were proper prior art. For example, Dr. Forrest relies on EX1057 and EX1059 to provide evidence of optical fiber connectors that were "known" to support the modification of Yang and WO584 with "some structure on the proximal ends of the probes..." EX1002, ¶61 n. 101; Pet., 23, 28, 30-31. However, Petitioner fails to provide any support for EX1057 and EX1059 as being prior art to the '588 Patent. Indeed, EX1057 has a copyright date of 2019, well after the priority claim of the '588 patent. EX1057, 11 (excerpt reproduced below).

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The Petition's heavy reliance on expert testimony (with such testimony based on faulty reasoning) weighs heavily in favor of discretionary denial.

H. Institution should be denied under the *Fintiv* precedent

In *Apple Inc. v. Fintiv, Inc.*, the Board articulated six nonexclusive factors for

determining whether to institute an AIA post-grant proceeding where there is parallel district-court litigation. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”). Here, the Board should exercise its discretion to deny the Petition because the *Fintiv* factors support discretionary denial.

1. Factor 1 favors discretionary denial

Gator Bio has not requested a stay as a motion to dismiss is still pending. There is no indication that the court would grant a request for a stay in the event this proceeding were instituted because there are multiple other non-challenged patents asserted in the district court litigation. Therefore, this factor weighs in favor of denial.

2. Factor 2 slightly favors denial

Factor two weighs slightly in favor of discretionary denial. Patent Owner will seek an expedited district court litigation schedule as there is overlap between the discovery at issue in the ITC case and the pending district court litigation. As the average time to claim construction in the Northern District of California over the past five years is 17.5 months and the average time to trial is 20.8 months, it is possible that trial takes place in late 2026 or early 2027. EX2012. This could cause issues such as the parallel district court proceeding coming to a conflicting claim construction producing divergent results and administrative waste.

3. Factor 3 favors denial because significant investment has been made on these issues

The parties have already made significant investment on the technical subject matter in the prior ITC case culminating in a weeklong evidentiary hearing. The district court litigation asserts four patents three of which were subject of the ITC case. All four patents involve the BLI Systems and their methods of operation. As such, the parties have already invested heavily in discovery.

4. Factor 4 is neutral

As discussed above, unfair dealings should not be rewarded with an opportunity to challenge a patent in this venue where the petitioner could not do so in the district court litigation. As such, while there is no substantial overlap of the issues raised in the petition and the parallel proceeding, the Director should discretionarily deny the Petition.

5. Factor 5 favors denial because the parties involved in this IPR and the district court proceeding overlap

Factor five weighs in favor of denying institution because, Sartorius, Gator Bio, and Hong Tan are parties to the parallel litigation and in this proceeding. Pet., 80; *Fintiv II*, 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

6. Factor 6 favors denial because the Petition fails to demonstrate that one or more of the claims are unpatentable

As explained above, the petition fails to establish that the applied references are unpatentable at least because: (i) the petition fails to identify how acknowledged disputed claim features are construed (*see* § IV.E), and (ii) the various combinations

of references set forth in Grounds 1-4 fail to teach or suggest multiple features of the challenged claims (*see* § IV.F). Therefore, factor six favors denying institution. *Fintiv*, 15.

V. Conclusion

For the foregoing reasons, Petitioner's challenge is deficient, and institution should be denied.

Dated: June 16, 2025

Respectfully submitted,

/s/ Dipu Doshi

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CERTIFICATE OF WORD COUNT

The undersigned attorney for Patent Owner certifies that the foregoing contains 8,115 words in 14-point Times New Roman font according to the word count tool in Microsoft Word.

Dated: June 16, 2025

/s/ Dipu Doshi
Dipu Doshi (Reg. No. 60,073)

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on June 16, 2025, a true and correct copy of the foregoing BRIEF IN SUPPORT OF PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL including exhibits was filed with the Patent Trial and Appeal Board Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email addresses, as authorized in Petitioner’s Petition for *Inter Partes* (Pet., 81):

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Dated: June 16, 2025

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