

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIO-RAD LABORATORIES, INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner

Case No. IPR2025-01546

U.S. Patent No. 12,168,797 B2

**PATENT OWNER'S REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION**

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EXHIBIT LIST

Exhibit No.	Description
2001	Director's Memo on Interim Processes for PTAB Workload Management, dated March 26, 2025
2002	U.S. Patent No. 11,827,921
2003	U.S. Patent No. 10,770,170
2004	U.S. Patent No. 10,068,051
2005	<i>ChromaCode Inc. v. Bio Rad Laboratories, Inc.</i> , Case No. 2-23-cv-08417, Dkt. 1 (CDCA Oct. 5, 2023)
2006	<i>ChromaCode Inc. v. Bio Rad Laboratories, Inc.</i> , Case No. 2-23-cv-08417, Dkt. 34 (CDCA Dec. 7, 2023)
2007	<i>ChromaCode Inc. v. Bio Rad Laboratories, Inc.</i> , Case No. 2-23-cv-08417, Dkt. 12 (CDCA Oct. 13, 2023)
2008	<i>California Institute of Technology v. Bio-Rad Laboratories, Inc.</i> , Case No. 5-25-cv-01701, Dkt. 1 (NDCA Feb. 18, 2025)
2009	<i>In re: ChromaCode Litigation</i> , Case No. 5-23-cv-04823, Dkt. 121 (NDCA June 18, 2025)
2010	<i>In re: ChromaCode Litigation</i> , Case No. 5-23-cv-04823, Dkt. 124 (NDCA July 2, 2025)
2011	Declaration by Jesse Salen
2012	Bio-Rad, Inc.'s Invalidity Contentions, served on August 13, 2025
2013	<i>In Re ChromaCode Litigation</i> , 5-23-cv-04823, Dkt. 125 (NDCA July 22, 2025)
2014	<i>In Re ChromaCode Litigation</i> , 5-23-cv-04823, Dkt. 151 (NDCA Sept. 22, 2025)
2015	<i>In re: ChromaCode Litigation</i> , Case No. 5-23-cv-04823, Dkt. 160 (NDCA Oct. 29, 2025)
2016	<i>In re: ChromaCode Litigation</i> , Case No. 5-23-cv-04823, Dkt. 160 (NDCA Oct. 29, 2025)
2017	<i>In Re ChromaCode Litigation</i> , 5-23-cv-04823, Dkt. 152 (NDCA Sept. 26, 2025)
2018	Case Timing Statistics for Northern District of California, exported from Docket Navigator on November 7, 2025
2019	Notice of Allowance for U.S. Patent No. 10,068,051, mailed July 11, 2018
2020	Information Disclosure Statement filed for U.S. Patent Application No. 18/352,112, initialed December 30, 2023

Exhibit No.	Description
2021	Notice of Allowance for U.S. Patent No. 10,770,170, mailed May 4, 2020
2022	Notice of Allowance for U.S. Patent No. 11,827,921, mailed October 23, 2023
2023	Notice of Allowance for U.S. Patent No. 12,168,797, mailed November 18, 2024

I. INTRODUCTION

Patent Owner California Institute of Technology (“PO”) respectfully requests that the Director deny institution of Bio-Rad Laboratories, Inc.’s Petition challenging claims 1-2, 5-11, 13-15, and 18 (“the challenged claims”) of U.S. Patent No. 12,168,797 (“the ’797 Patent”). Paper 2; EX2001.

PO initiated district court litigation against Petitioner in October 2023 based on claims that Petitioner infringes three patents related to the ’797 Patent. In response, Petitioner filed three IPR petitions, two of which the Board denied on the merits. Then, shortly after the ’797 Patent was issued, and more than nine months ago, PO filed a lawsuit in the Northern District of California asserting that Petitioner infringes the challenged claims. In June 2025, the lawsuit for the ’797 Patent was consolidated with the 2023 action.

Petitioner delayed seven months after being sued to file the present Petition despite the patent being related to the three patents asserted in the 2023 action. While Petitioner delayed, the parallel litigation substantially advanced. PO and Petitioner have exchanged infringement and invalidity contentions, deposed witnesses, produced hundreds of thousands of documents, and engaged in extensive third-party discovery. After the Petition was filed, the parties exchanged damages contentions, filed *Markman* briefs, and took more depositions. The court will hold a *Markman* hearing next month (in December 2025) and has indicated it will issue a *Markman* order well before the Board’s institution deadline. While there is one

instituted IPR (IPR2024-01451), Petitioner has never moved to stay the district court litigation, even though it could have done so long ago. So, the district court trial will include the related patents, and the same alleged prior art used in the grounds here (Jouvenot¹ and Larson). Finally, it is highly likely the district court will hold a trial by March 2027, around or before the deadline for a Final Written Decision (“FWD”). For these and other reasons below, the *Fintiv* factors weigh heavily in favor of denial.

In addition, the considerations set forth in the Director Memo also weigh heavily in favor of denial. Discretionary denial is also appropriate under §325(d) because the Petition relies extensively on references the Examiner considered during prosecution—yet Petitioner has not demonstrated clear error.

Accordingly, institution should be denied.

II. BACKGROUND

A. The '797 Patent

The '797 Patent is a part of a patent family that includes U.S. Patent Nos. 10,770,170 (“the '170 Patent”), 10,068,051 (“the '051 Patent”), and 11,827,921 (“the '921 Patent”), all of which PO asserted or is asserting in the parallel litigation. *Infra*

¹ Jouvenot is a continuation-in-part of the Saxonov reference asserted against the '051, '170, and '921 Patents. Jouvenot and Larson were examined by the same examiner who reviewed and allowed the '051, '170, '921, and '797 Patents.

EX2019; EX2021; EX2022; EX2023.

§II.B; EX1001, (63); EX2002, (63). The Board denied institution of IPR for both the '051 Patent and the '170 Patent, but instituted IPR for the '921 Patent. *Infra* §II.B.

These patents all share the same specification. EX1001; EX2002; EX2003; EX2004.

The '797 Patent's asserted claims are directed to a PCR testing system that detects electromagnetic signals at emission wavelengths corresponding to different types of fluorophores labelling different analytes being tested. EX1001, claim 1, 9:22-49, 32:18-40, 35:48-58. A processor controlled analyzer of the system receives and decodes cumulative signals emitted during PCR testing to detect the presence of the analytes in a sample. *Id.*, claim 1.

B. The Parallel District Court Litigation and Related IPRs

In October 2023, ChromaCode, Inc., PO's former exclusive licensee, initiated an infringement action against Petitioner in the Central District of California, alleging that Petitioner infringes the '051 and '170 Patents. EX2005; EX2007. PO joined the case as a plaintiff, the lawsuit was transferred to the Northern District of California, and ChromaCode and PO also asserted the '921 Patent. EX2006; EX2007; EX2011 at ¶11. Petitioner then filed IPRs against the asserted patents, but the Board declined to institute IPR for the '051 and '170 Patents, and instituted IPR for the '921 Patent.² *Bio-Rad Labs., Inc. v. Cal. Inst. of Tech.*, IPR2024-01177,

² The district court later issued a claim construction order finding the '051 Patent's claims indefinite, which PO disputes and reserves the right to appeal. EX2013.

Paper 10 (PTAB Jan. 29, 2025), IPR2024-01178, Paper 10 (PTAB Jan. 29, 2025), and IPR2024-01451, Paper 11 (PTAB Mar. 27, 2025).

On February 18, 2025, shortly after the '797 Patent was issued, PO filed an action against Petitioner in the Northern District of California for infringement of the '797 Patent. EX2008. On June 18, 2025, the district court consolidated that action with PO's other pending infringement suit and stressed that the case would move forward "expeditiously." EX2009; EX2010, 29:19-23.

On July 2, 2025, PO served its '797 Patent infringement contentions. EX2011 at ¶4. On August 13, 2025, Petitioner served its invalidity contentions, asserting that the challenged claims of the '797 Patent are invalid based on 42 references. EX2012 at 2-4; EX2011 at ¶4. The combinations of the 11 ground references that are the subject of the Petition here are essentially the same as asserted in Petitioner's contentions. *Compare* EX2012 at 2-19, Appxs. A, B *with* Paper 1 at 25-26. The parties exchanged damages contentions in October 2025. EX2011 at ¶4.

Fact discovery opened in January 2024 and has progressed significantly since. EX2011 at ¶5. The parties have produced more than 291,000 documents and deposed nine witnesses, with two more scheduled for early December. *Id.* Additionally, PO and ChromaCode have served subpoenas to 25 third parties, resulting in third-party productions of almost 9,000 documents.

The parties completed claim construction briefing for the '797 Patent on November 17, 2025. EX2011 at ¶12. Petitioner deposed PO's technical expert on November 10. *Id.*, ¶6. The district court will hold a technology tutorial on December 5, 2025 and a claim construction hearing on December 18, 2025. EX2014 at 2. The court expects to issue a claim construction order within two to four weeks of the hearing (EX2017, 29:11-18), and fact discovery is scheduled to close the later of March 15, 2026 or 60 days from the date of such order. EX2014 at 2.

Petitioner is also asserting patents against ChromaCode, and the court has bifurcated the case following the close of fact discovery, with Petitioner's patent trial scheduled for January 2027. EX2014 at 6. A trial on PO's patents, including the '797 Patent, will follow soon after. EX2017, 30:11-21, 44:1-19. The case schedule provides a clear indication of how the court plans to stagger the two trial schedules. EX2014. For example, the close of expert discovery for Petitioner's patents is set for as early as June 26, 2026, and for PO's patents is set for as early as September 9, 2026—approximately 75 days apart. *Id.* at 4-5. The deadline for a summary judgment hearing for Petitioner's patents is set for as early as September 16, 2026 and for PO's patents is set for as early as November 13, 2026—approximately 60 days apart. *Id.* at 4-6. Because the two schedules are staggered by around 60-75 days, PO expects the trial date for the '797 Patent to fall between March 11 and

March 28, 2027, or even earlier if Petitioner's case against ChromaCode is resolved via settlement or summary judgment. EX2011 at ¶¶7-9; EX2014 at 4-6, nn. 3, 4.

Petitioner has never moved for a stay of the parallel litigation or indicated it would do so. EX2011 at ¶10. Indeed, a stay is unlikely given that the Board already denied institution of Petitioner's IPRs challenging the asserted '051 and '170 Patents. *Bio-Rad Labs.*, IPR2024-01177, Paper 10 and IPR2024-01178, Paper 10.

C. Expected Schedule for this IPR

Petitioner did not file the present Petition until September 15, 2025—almost seven months after PO filed its complaint. Paper 2; *supra* §II.B. The Petition asserts 14 grounds based on combinations of 11 references, all of which Petitioner's invalidity contentions also rely upon. Paper 2 at 25-26; EX2012 at 2-19, Appxs. A, B. On September 23, 2025, the Board accorded the Petition a filing date of September 15, 2025. Paper 3. As such, any institution on the merits would occur by March 23, 2026, and the Board would issue a FWD by March 23, 2027.

III. ARGUMENT

A. *Fintiv* Weighs Heavily in Favor of Denial

The Director should deny the Petition under *Fintiv* because each factor favors denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).

1. Factor 1: There Is No Evidence the District Court Will Stay the Parallel Litigation if the Petition Were Instituted

Petitioner has not moved for a stay of the parallel litigation, and there is no evidence it will do so. EX2011 at ¶10. Thus, this factor favors denial. *Luxshare Precision Indus. v. Amphenol Corp.*, IPR2022-00132, Paper 10 at 9 (PTAB May 3, 2022). Moreover, even if the Board institutes IPR, it is unlikely the district court will stay the litigation given that the Board declined to institute IPR for the '051 and '170 Patents and the '170 Patent is also asserted in the parallel action, which is proceeding quickly, with fact discovery scheduled to close before the institution deadline in this proceeding. EX2014 at 2. As such, a stay would not meaningfully simplify issues for the district court and is unlikely to be granted. *Finjan, Inc. v. Blue Coat Sys., Inc.*, No. 15-cv-03295-BLF, 2016 WL 7732542 at *4 (N.D. Cal. July 25, 2016).

Accordingly, this factor weighs in favor of discretionary denial.

2. Factor 2: The District Court Trial Will Likely Be Completed Before the Projected Final Written Decision Deadline

First, based on the scheduling order, the trial on the '797 Patent will likely occur in March 2027, or even earlier. Indeed, if Petitioner's patent claims against ChromaCode resolve through settlement or summary judgment (which is highly likely), then PO's patent case will likely be tried in January 2027 (the date for which Petitioner's patent trial is currently scheduled). EX2014 at 4-6, nn. 3, 4; EX2017, 30:11-21, 44:1-19. Thus, trial will likely occur before or around the FWD deadline of March 23, 2027. EX2011 at ¶¶7-9.

Second, and consistently, statistics for the Northern District of California indicate a trial date of March 2027, based on the December 18, 2025 claim construction hearing date. EX2011 at ¶7; EX2014 at 2. In the parallel action, the court indicated it would issue a claim construction order between January 1 and January 15, 2026. EX2014 at 2; EX2017, 29:11-18. In the Northern District of California, the time from a claim construction order to trial is generally about 14-15 months (median time of 14.0 months and average time of 14.9 months). EX2011 at ¶7; EX2018. Because the court plans to issue a claim construction order by January 15, 2026, it is statistically likely for the trial to take place by March 2027, which aligns closely with the estimate based on the staggered case schedule as discussed above—around the same time as the projected FWD. EX2011 at ¶¶7-9; EX2018.

Third, “[e]ven though a district court trial date that occurs after a projected [FWD]” reduces the likelihood for conflicting decisions, the “benefit does not outweigh the efficiencies gained by avoiding parallel proceedings” when “the difference in timing is not significant.” *Samsung Elecs. Co. v. VB Assets, LLC*, IPR2025-00870, Paper 11 at 2 (Director Oct. 10, 2025). Here, the estimated trial date is at most about a month after the FWD deadline, so any benefit that could be gained from the IPR “does not outweigh the efficiencies gained” by avoiding

duplicative work. *See id.* The work of the Board and the district court for the '797 Patent would be duplicative, and moreover, may yield divergent results.³

Accordingly, the second *Fintiv* factor weighs in favor of discretionary denial.

3. Factor 3: There Will Have Been Significant Investments in the Parallel Litigation by the Institution Deadline

The parties and district court have invested significantly in the litigation, inclusive of over 21 months of discovery, deposing nine witnesses (including an expert), with two more planned for early December; production of more than 291,000 documents; exchanges of multiple sets of infringement, invalidity, and damages contentions; filing of claim construction briefs; a claim construction tutorial and hearing, with a subsequent claim construction hearing on the '797 Patent, which has also been fully briefed, scheduled for December 18, 2025, and for which the district court intends to issue an order by January 15, 2026; and more. EX2011 at ¶¶5-6, 12; EX2017, 29:11-18. In such situations, the Board and the Director have routinely found this factor favors denial.

For example, in *10X Genomics, Inc. v. President and Fellows of Harvard Coll.* the Board denied institution because the parties had exchanged infringement and invalidity contentions and completed claim construction briefing, and the court had

³ Nonetheless, should the IPR be instituted on the merits, the trial on the '170 Patent will still need to take place regardless of a stay of PO's claims regarding the '797 Patent. This makes a stay unlikely and also makes IPR of the '797 Patent inefficient.

held a claim construction hearing. IPR2023-01299, Paper 15 at 18 (PTAB Mar. 7, 2024). Here, the parties have similarly exchanged infringement and invalidity contentions and completed claim construction briefing. EX2014 at 2; EX2011 at ¶12. And the district court has scheduled the claim construction hearing for December 18, 2025 and intends to issue a claim construction order before January 15, 2026—all before the institution deadline. *Id.*; EX2017, 29:11-18; *see* Paper 3.

In *Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC*, the Director issued a discretionary denial where “the parties ha[d] made meaningful investment in the district court proceeding...[and] ha[d] exchanged infringement and invalidity contentions, ...conducted over seven months of fact discovery, and a *Markman* hearing [was] scheduled to occur before the due date for an institution decision.” IPR2025-00223, Paper 9 at 2 (Director June 12, 2025). Besides the similarities discussed above, here, PO and Petitioner have also invested significantly in the district court proceedings, having conducted over 21 months of fact discovery—three times as long as in *Advanced Micro Devices*. *Id.*; EX2011 at ¶5.

Further, in *Elong Int'l USA Inc. v. Feit Elec. Co.*, the Director similarly denied institution where “a *Markman* hearing was scheduled for [before the institution decision], and fact discovery [wa]s scheduled to close soon.” IPR2025-00258, Paper 16 at 2 (Director June 25, 2025). Similarly here, fact discovery is expected to close

by or soon after the March 23 institution deadline, in March 2026. EX2014, 2; *supra* §II.B (later of March 15, 2026 or 60 days from *Markman* order).

Petitioner's lack of diligence also supports denial. For example, in *Glob. Tel*Link Corp. v. HLFIP Holding, Inc.*, the petitioner's delay of more than eight months to file the Petition supported denial because had the petitioner been diligent, "that diligence could [have] potentially mitigate[d] some of the investments in parallel proceedings that are at issue." IPR2021-00444, Paper 14 at 22-23 (PTAB July 22, 2021). The same is true here. Petitioner waited almost seven months to file its Petition. Paper 2; *supra* §II.B-C. During this delay, the district court case marched forward, with significant investment by the district court and parties to date, and with even more before the institution deadline, and yet more before the FWD deadline. Petitioner's delay is even more striking because Petitioner previously filed three IPR petitions challenging other members of the '797 Patent's family using the same ground references that are at issue here or references related thereto. The main ground references are Petitioner's own patents, so Petitioner cannot blame its significant delay on a need to search for new prior art.

Accordingly, the third *Fintiv* factor weighs in favor of discretionary denial.

4. Factor 4: There Is Significant Overlap Between the Issues Raised in the Petition and Those in the Parallel Litigation

"[B]ecause the identical claims are challenged based on the same prior art in both the Petition and in the District Court, this factor weighs in favor of discretionary

denial in this case.” *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020).

The patentability issues alleged in the Petition mirror those in the parallel case, and addressing patentability here would be highly duplicative of the district court's work and yield potentially divergent results. *Id.* Petitioner cites essentially the same combinations of references for each challenged claim in both its IPR grounds and its invalidity contentions. *Compare* Paper 2 at 25-26 with EX2012 at 2-19, Appxs. A, B. Moreover, this factor favors denial because Petitioner has not filed a *Sotera* stipulation. *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01293, Paper 18 at 15 (PTAB March 9, 2023). Further, in the litigation, Petitioner asserts invalidity based on 31 additional references, as well as §101 and §112, none of which are (or could be) raised in the Petition. EX2012 at 5-41; *Shenzen Tuozhu Tech. Co., LTD v. Stratasys, Inc.*, IPR2025-00354, Paper 11 at 2-3 (Director June 12, 2025).

Accordingly, the fourth *Fintiv* factor weighs in favor of discretionary denial.

5. Factor 5: Petitioner and PO Are Both Parties in the Parallel Litigation

Because PO and Petitioner are both parties in the litigation, this factor strongly favors denial. *Fintiv*, IPR2020-00019, Paper 11 at 13-14; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020).

6. Factor 6: No Other Circumstances Justify Institution

“[I]f the merits of the ... petition are a closer call, then that fact has favored denying institution when other factors favor[]denial....” *Fintiv*, Paper 11 at 15. That

is precisely the case here—as explained in Section III.B.1 below, the Petition's merits are weak. Moreover, when the other *Fintiv* Factors favor denial, the Director “need not decide whether the merits ... are particularly strong because it would not impact [the] ultimate determination under §324(a).” *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 12 (PTAB. May 2, 2022). So even if Petitioner argues the merits are not weak (they are), institution should still be denied given the other factors. Accordingly, this factor weighs in favor of discretionary denial.

B. Other Considerations Weigh in Favor of Denying Institution

The Director should also deny the Petition because the other considerations raised in the Director Memo strongly favor denial.

1. Petitioner's Unpatentability Challenge Is Weak

Petitioner's Ground 1 relies entirely on obviousness over Jouvenot, though confusingly referring to Larson, and ultimately falls back on Dr. Batt's declaration to fill the many gaps in the prior art. *Compare* Paper 2 at 25, 28 *with id.* at 31, 36. Ultimately, Petitioner fails to meet its burden to show that Jouvenot, alone or in view of Larson or any of the other cited references, renders the challenged claims obvious, as summarized below and as Petitioner will show in the POPR.

Claim 1 of the '797 Patent is directed to a system for detecting up to M analytes using 4, 5, or 6 colors (C) and corresponding fluorescence intensities (F), per the formula $M = C * \log_2(F+1)$. EX1001, claim 1. The system applies a

“decoding matrix” to a cumulative signal to, as a result of the formula, unambiguously detect the presence of up to M analytes. *Id.*, claim 1, 21:46-23:38.

Regarding Ground 1, Petitioner is gravely confused about what the “decoding matrix” even is, reflecting the weakness of Petitioner’s challenge. First, the ground references provide only the most rudimentary teaching of the most basic example of multi-analyte detection—they detect only two targets using one color. Paper 2 at 37-38. Additionally, the Petition erroneously refers time and again to **encoding** matrices as being **decoding** matrices. *See, e.g.*, Paper 2 at 40 (pointing to Table 8 as being “the only exemplary decoding matrix for Claim 1 in the ’797 patent,” while Table 8 states it is an “[e]xample of encoding method”); 41 (same error for “Contentions Matrix”). Misrepresenting encoding matrices as decoding matrices vastly and inappropriately oversimplifies the complexities of unambiguously distinguishing dozens if not hundreds or even thousands of different combinations of analytes per the claimed invention. As will be explained in the POPR, increasing the number of channels from one to four, five, or six is not merely duplicative, as Dr. Batt alleges, because it vastly increases the dimensions of the intensity-color space that needs to be analyzed in order to detect all possible combinations of analytes across all of those colors. EX1002 ¶¶133, 138, 139, 143-147. Moreover, to the extent Petitioner’s grounds rely on Larson, the Petition fails even to **acknowledge** Larson’s extensive teachings about the disadvantages of multiple occupancy droplets—especially

droplets containing more than two analytes—let alone explain why such teachings would have led a POSITA to distinguish combinations of more than *five* analytes from each other, as claimed. Paper 1 at §XI; EX1001, claim 1.

Ground 2 adds Lehnert to Ground 1 as an afterthought, but this does not cure Ground 1's many deficiencies. Paper 2 at 68-70.

Accordingly, this consideration weighs in favor of denial.

2. Petitioner Relies Excessively on Expert Testimony

Petitioner's reliance on expert testimony favors denial. EX2001 at 2. If the petition uses expert testimony to fill in the gaps of the prior art, this consideration favors denial. *See iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2-3 (Director June 6, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 at 2 (Director June 27, 2025).

Here, the Petition relies *extensively* on Dr. Batt's testimony in an attempt to fill the vast gaps in the prior art. Although Dr. Batt alleges that "Jouvenot's Figure 4 presents the same mathematical scheme claimed in the '797 Patent," he admits that this figure merely shows two analytes in a single color ($M=2$, $C=1$). EX1002, ¶90. To bridge the gap between Jouvenot's simplistic scheme and the vastly more complex arrangement the '797 Patent claims (*e.g.*, $M>C$ where $C=4, 5$, or 6), Dr. Batt backfills with his own opinions using the '797 Patent as a roadmap. EX1002 at ¶¶85-88, 113, 125-129, 143-147. But this is improper hindsight. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Accordingly, this consideration weighs in favor of denial.

3. Institution Would Unnecessarily Increase the PTAB's Workload

Where some of the patents asserted in district court were denied institution, “addressing all of the challenged patents in the district court proceeding would be the fastest and most efficient resolution....” *Samsung*, IPR2025-00870, Paper 11 at 2-3 (quotation marks omitted).

Here, PO has asserted four patents in the parallel litigation, and Petitioner has challenged these patents in separate IPRs. EX2011 at ¶11; Paper 2; *Bio-Rad Labs.*, IPR2024-01451, Paper 11, IPR2024-01177, Paper 10, and IPR2024-01178, Paper 10. And while the asserted '921 Patent is currently subject to IPR, the Board denied institution for the asserted '051 and '170 Patents. Thus, at a minimum, the district court case will proceed to trial on the '170 Patent such that there will be no efficiencies gained by instituting IPR on the '797 Patent. This is particularly true where Petitioner's inexcusable delay in challenging the '797 Patent has led to significant investments in the underlying litigation. Instituting IPR on the '797 Patent would also “increase[] the risk of inconsistent outcomes among patent family members and risks the inefficiencies of parallel proceedings on invalidity” given that all the district court patents are in the same family, which favors denial. *Compare Samsung Elecs. Co.*, IPR2025-00870, Paper 11 at 2-3 with *Samsung Elecs. Co.*, IPR2025-00870, Paper 8 at 16-17.

Further, denial favors efficiency because Petitioner's invalidity arguments in the parallel litigation are even broader than those here. Namely, Petitioner's invalidity contentions list 42 references, which includes all 11 ground references along with purported prior art that cannot be addressed here—e.g., products and prior inventions—as well as subject matter eligibility, written description, enablement, and indefiniteness attacks. EX2012 at 2-41; Paper 2 at 25-26. The parallel action is thus vastly more suitable for evaluating all of Petitioner's challenges in view of all available evidence. Denying the Petition allows the parties to focus on Petitioner's complete set of challenges in the parallel proceeding and avoids burdening the Board with issues that will be more fully resolved in the parallel litigation.

Under these circumstances, especially considering the significant time and resources that the parties and the district court have invested and will continue to invest in the parallel litigation, addressing all the challenged patents in the district court “would be the fastest and most efficient resolution of the Parties’ many disputes.” *Samsung*, IPR2025-00870, Paper 11 at 3.

Accordingly, this consideration weighs in favor of denial.

4. “Settled Expectations” Are Not a Factor Here

IPRs challenging recently issued patents may be denied where, as here, other considerations favor denial. *Klein Tools, Inc., v. Milwaukee Elec. Tool Corp.*, IPR2025-01018, Paper 14 at 2-3 (Director Oct. 10, 2025) (denial appropriate where there were no strong settled expectations but a FWD was unlikely before the parallel

litigation ended and there was insufficient evidence to prove the proceeding was likely to be stayed); *Fujirebio Diagnostics, Inc., Quanterix Corp.*, IPR2025-01060, Paper 13 at 2-3 (Director October 17, 2025) (discretionary denial appropriate where there were no settled expectations but Petitioner failed to demonstrate material error under *Advanced Bionics*). Accordingly, “settled expectations” are not a factor here.

C. Discretionary Denial Is Appropriate Under § 325(d)

Under *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8-10 (PTAB Feb. 13, 2020), the Director determines “whether the same or substantially the same art previously was presented to the Office...” and if so “whether the [P]etitioner has demonstrated that the Office erred in a manner material to ... patentability.” *Id.* This analysis favors denial here.

1. Petitioner Presents the Same or Substantially the Same Prior Art That Has Previously Been Presented to the Office

Under *Becton, Dickinson* factors (a), (b), and (d), the Examiner already considered the same and similar art. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9-10 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)). Namely, in allowing the challenged claims, the Examiner considered the Petition’s primary ground reference, for the only challenged independent claim, Jouvenot, and also considered secondary references Larson and Brabetz. The applicant filed several IDSs, one listing Jouvenot and Brabetz. EX2020 at 7; *id.* at 3. The same IDS cites U.S. Patent No. 9,441,266 to Larson,

which is a continuation of the Larson ground reference. *Id.* at 3. The Examiner considered these references, initialing them in the IDS. *Id.* at 3, 7.

Per *Ecto World, LLC and SV3 v. RAI Strategic Holdings, Inc.*, “[c]hallenging the claims using the same prior art that was previously presented on an IDS is sufficient to satisfy the first part of ... *Advanced Bionics*.....” IPR2024-01280, 2025 WL 1528304 at *2 (PTAB May 19, 2025); *Biocon Pharma Ltd. v. Novartis Pharms. Corp.*, IPR2020-01263, Paper 12 at 9 (PTAB Feb. 16, 2021) (finding that an Examiner considered a reference “because it is listed on the IDS and the Examiner signed the IDS with the statement ‘all references considered except where lined through.’”). All of Petitioner’s grounds and analysis for all claims rely on Jouvenot, Larson, and/or Brabetz. Accordingly, for all grounds, “the same or substantially the same art previously was presented to the Office.” *Advanced Bionics*, Paper 6 at 8.

Ground 2-2(f) also relies on Lehnen. Paper 2 at 68-70. But Petitioner fails to explain why Lehnen is not cumulative to Jouvenot and Larson, especially given that Petitioner cites Lehnen for essentially the same progression of intensities as purportedly taught by Jouvenot and Larson. Paper 2 at 68-70; EX2012, Appx. A at 1, 16 (purported intensities of 0, 1, 2), 19 (purported intensities of 0, 1, 2).

2. Petitioner Has Not Demonstrated That the Office Erred

Part two of *Advanced Bionics* addresses *Becton, Dickinson* factors (c), (e), and (f) requiring that petitioners demonstrate the Office “erred in a manner material to the patentability.” IPR2019-01469, Paper 6 at 8. Here, Petitioner has not

demonstrated that the Examiner materially erred by allowing the challenged claims over Jouvenot. Indeed, Petitioner has not even attempted to satisfy *Advanced Bionics*, nor can Petitioner do so. Paper 2. Per *Ecto World*, it is the Petitioner's burden to show material error. 2025 WL 1528304 at *3 (“[P]etitioner must provide an analysis even when the asserted prior art is on an IDS, but the Examiner did not apply the reference.”); *TankLogix, LLC v. SitePro, Inc.*, IPR2025-00761, Paper 10, at 2-3 (PTAB Sept. 3, 2025). Yet here, as in *Ecto World*, Petitioner provides no analysis as to how the Office allegedly erred. 2025 WL 1528304, at *3 (“[G]eneralized statements as to the strength of [the] Petition fail to identify sufficiently a material error. Ordinarily, that would mean a denial of institution.”); *Agamatrix, Inc. v. Dexcom, Inc.*, IPR2018-01715, Paper 10, at 10, 13-14 (PTAB Feb. 19, 2019). And, for the reasons in Section III.B.1 above and in PO's forthcoming POPR, Petitioner has not demonstrated that the previously presented art teaches the challenged claims, or that no reasonable examiner could have found otherwise. See *Ecto World*, 2025 WL 1528304, at *3 (citing *Advanced Bionics*, IPR2019-01469, Paper 6 at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office [materially] erred.”))).

Thus, *Advanced Bionics* and *Becton, Dickinson* favor denial.

IV. CONCLUSION

For at least these reasons, the Director should deny institution.

Respectfully submitted,

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Jesse A. Salen/

Jesse A. Salen (Reg. No. 72,209)
Counsel for Patent Owner
California Institute of Technology

Date: November 24, 2025

12275 El Camino Real, Suite 100
San Diego, CA 92130
Tel: (858) 720-8900
Fax: (858) 509-3691

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on November 24, 2025, a copy of the foregoing document, and Exhibits 2001-2023, were served via E-Mail on the Petitioner at the following correspondence address provided by counsel of record for the Petitioner pursuant to 37 C.F.R. § 42.8(b)(4):

Derek C. Walter (lead counsel)
JONES DAY
555 California Street, 26th Floor
San Francisco, CA 94104
dwalter@jonesday.com
BioRad-Chromacode@jonesday.com

Matthew W. Johnson
JONES DAY
500 Grant Street, Suite 4500
Pittsburg, PA 15129
mwjohnson@jonesday.com

Dated: November 24, 2025

/Jesse Salen/
Jesse Salen (Reg. No. 72,209)
Counsel for Patent Owner
California Institute of Technology

12275 El Camino Real, Suite 100
San Diego, CA 92130
Tel: (858) 720-8900
Fax: (858) 509-3691