

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 REPLY TO PETITIONER'S OPPOSITION TO
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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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

IPR2025-01546

PATENT OWNER’S REPLY TO PETITIONER’S
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Exhibit No.	Description
2020	Information Disclosure Statement filed for U.S. Patent Application No. 18/352,112, initialed December 30, 2023
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
2024	Declaration of Bernhard H. Weigl, Ph.D.
2025	<i>Curriculum Vitae</i> of Bernhard H. Weigl, Ph.D.
2026	File history of U.S. Patent No. 12,168,797
2027	Plaintiffs California Institute of Technology and ChromaCode, Inc.’s Opening Claim Construction Brief for the '797 Patent, <i>In re: ChromaCode Litigation</i> , Case No. 5:23-cv-04823, N .D. Cal.
2028	Plaintiffs California Institute of Technology and ChromaCode, Inc.’s Responsive Claim Construction Brief for The '797 Patent, <i>In re: ChromaCode Litigation</i> , Case No. 5:23-cv-04823, N .D. Cal.
2029	Joint Case Management Statement and Proposed Order, Dkt. 139, <i>In Re ChromaCode Litigation</i> , Case No. 5:23-cv-04823, N. D. Cal.
2030	Minute Order, Dkt. 141, <i>In re: ChromaCode Litigation</i> , Case No. 5:23-cv-04823, N .D. Cal.

IPR2025-01546
PATENT OWNER’S REPLY TO PETITIONER’S
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Pursuant to the Board’s January 5, 2026 authorization email, Patent Owner submits this reply in support of discretionary denial. EX3101. Petitioner has not indicated it will move to stay the parallel litigation, and indeed has actively sought just the opposite. The district court (1) has not indicated it would grant such a stay even if Petitioner requested it and (2) is extremely unlikely to do so. For these and all the reasons in PO’s opening brief, the Board should deny institution.

The parallel litigation resulted from consolidating—at Petitioner’s request: (1) a DJ action filed by PO’s licensee against Petitioner involving Petitioner’s patents (U.S. Patent Nos. 9,222,128 and 9,921,154), (2) PO’s action against Petitioner asserting the ’170 and ’921 Patents, and (3) PO’s assertion of the ’797 Patent. After consolidation, Petitioner argued both Petitioner’s and PO’s “[p]atents should **remain consolidated** ... through expert discovery.” EX2029 at 5–6 (emphasis added). Petitioner emphasized that the parties’ Rule 30(b)(6) notices covered both sets of patents and that the witnesses overlap. *Id.* As a result, Judge Lee denied PO’s request to sever out Petitioner’s unrelated patents from PO’s patents. *See* EX2030. Petitioner’s prior position against severance is wholly inconsistent with its present claim that it “might” seek a stay and that a stay is likely in the event the IPR is instituted. Paper 7 at 3. First, Petitioner did not seek to stay the litigation even though the Board instituted IPR for the ’921 Patent—thus, the suggestion that

IPR2025-01546
PATENT OWNER'S REPLY TO PETITIONER'S
OPPOSITION TO DISCRETIONARY DENIAL

Petitioner now “might” seek a stay is entirely irrelevant. Second, it is extremely unlikely that Judge Lee will undo consolidation of the case or stay the entire action, because the consolidated case includes PO’s ’170 Patent (that is not subject to IPR), the ’921 Patent (where a FWD is due shortly on March 27, 2026), and Petitioner’s completely unrelated ’128 and ’154 patents, and due to the case’s advanced nature. Paper 6 at 9–11. Accordingly, the Board should reject the argument that a stay “might make sense” if Petitioner even moves to stay. Paper 7 at 3.

Petitioner speculates that the district court’s decision to wait until March 11, 2026 to hold a trial-setting conference for PO’s patents was allegedly intended to assist Petitioner in circumventing discretionary denial here by flagging a willingness to stay the case if the Board institutes this IPR. Paper 7 at 4–5. This is pure speculation and should be rejected. The district court has made no comment whatsoever regarding whether a stay would be appropriate. Nor does Petitioner cite any authority supporting its argument that the court’s alleged desire of “permitting this IPR to play out” weighs against discretionary denial. *Id.* Furthermore, Petitioner relies on an incomplete excerpt from the court’s August 27, 2025 hearing transcript. *Id.* (citing EX 2017 at 48:8-20). What Petitioner omits is the discussion with PO’s counsel in which the court acknowledged that it should not rely on Petitioner’s then-unfiled IPR petition for the ’797 Patent as a basis to delay setting

IPR2025-01546
PATENT OWNER’S REPLY TO PETITIONER’S
OPPOSITION TO DISCRETIONARY DENIAL

trial in the case. EX2017 at 48:21–49:18. Instead, the court was clear that it was concerned only with “trying to get through [the case] schedule” and would hold a trial-setting hearing on March 11, 2026 to pick a trial date. *Id.*; EX2014 at 3. Notably, the trial-setting hearing will pre-date the Board’s March 23, 2026 deadline to institute the present IPR, which means that the court will likely set a trial date before the Board’s institution decision. This further favors denial.

Finally, the Board should “decline to speculate on how the district court might rule on a motion that has not been filed ... [and] assess this factor as neutral” at best. *Carrier Fire & Security Ams. Corp. v. Sentrilock, LLC*, IPR2021-00665, Paper 12 at 8 (PTAB Sept. 16, 2021); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (“declin[ing] to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here. This factor does not weigh for or against discretionary denial....”); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 14 (PTAB Dec. 1, 2020) (“Because the District Court has not ruled on the pending motion to stay, we determine that this factor does not weigh for or against denying institution....”).

For the reasons set forth above and in PO’s request for discretionary denial, the Board should exercise its discretion to deny institution of this IPR.

IPR2025-01546

PATENT OWNER'S REPLY TO PETITIONER'S
OPPOSITION TO DISCRETIONARY DENIAL

Respectfully submitted,

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IPR2025-01546

PATENT OWNER'S REPLY TO PETITIONER'S
OPPOSITION TO DISCRETIONARY DENIAL

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on January 7, 2026, a copy of the foregoing PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL was filed through the Patent Trial and Appeal Case Tracking System (P-TACTS) and was served via E-Mail on the Petitioner at the following email addresses provided by counsel of record for the Petitioner pursuant to 37 C.F.R. § 42.8(b)(4):

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