

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

PETITIONER'S SUPPLEMENTAL BRIEF IN SUPPORT OF OPPOSITION TO
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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PETITIONER'S EXHIBIT LIST

Exhibit #	Description
EX1001	U.S. Patent No. 12,168,797 “the ’797 patent”
EX1002	Declaration of Carl A. Batt, Ph.D.
EX1003	U.S. Patent No. 9,921,154 “Jouvenot”
EX1004	U.S. Patent Provisional Application No. 61/507,082 (filed July 13, 2011) (Serge Saxonov, Simant Dube, John F. Regan, applicants) (“the ’082 Provisional”)
EX1005	Declaration of Kevin Struhl, Ph.D., <i>Bio-Rad Labs., Inc. v. Cal. Inst. Tech.</i> , IPR2024-01451, EX2001 (Dec. 30, 2024)
EX1006	Joseph R. Lakowicz, <i>Principles of Fluorescence Spectroscopy</i> (3d. 2006)
EX1007	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 11,827,921, <i>Bio-Rad Labs., Inc. v. Cal. Inst. Tech.</i> , IPR2024-01451, Paper 1 (Sept. 16, 2024)
EX1008	U.S. Patent No. 8,614,061 “Brabetz”
EX1009	U.S. Patent No. 12,168,797 Infringement Claim Charts from Infringement Contentions, served on July 2, 2025, <i>In re ChromaCode</i> , Case No. 5:23-cv-04823, N.D. Cal.
EX1010	Internet Archive WayBackMachine, Feb. 22, 2024, archived copy of Synbio Technologies, Precision and Accuracy with TaqMan Probes, https://synbio-tech.com/precision-and-accuracy-with-taqman-probes/ , https://web.archive.org/web/20240519044916/https://synbio-tech.com/precision-and-accuracy-with-taqman-probes/ , accessed Sept. 12, 2024.
EX1011	Pamela M. Holland, et al., “Detection of specific polymerase chain reaction product by utilizing the 5’ → 3’ exonuclease activity of <i>Thermus aquaticus</i> DNA polymerase,” <i>Proc. Natl. Acad. Sci. USA</i> , Vol. 88, pp. 7276-7280, August 1991 Biochemistry “TaqMan Paper”

Exhibit #	Description
EX1012	U.S. Patent Application Publication No. US 2008/0003649 A1 “Maltezos”
EX1013	U.S. Patent Application Publication No. US 2011/0250597 A1 “Larson”
EX1014	Complaint for Patent Infringement of U.S. Patent Nos. 12,168,797, filed on February, 18 2025, Dkt No. 1, <i>Cal. Inst. of Tech. v. Bio-Rad, Laby’s, Inc.</i> , Case No. 6:25-cv-01701, consolidated into <i>In re ChromaCode Litigation</i> , Case No. 5:23-cv-04823-EKL (N.D. Cal.).
EX1015	Shivaprasad H. Sathyanarayana and Lauren M. Wainman, “Chapter 2, Laboratory approaches in molecular pathology: the polymerase chain reaction,” <i>Diagnostic Molecular Pathology</i> , 2024
EX1016	Deposition of Kevin Struhl, Ph.D., <i>Bio-Rad Labs., Inc. v. Cal. Inst. Tech.</i> , IPR2024-01451 (July 24, 2025)
EX1017	U.S. Patent Application Publication No. US 2010/0227386 A1 “Neuzil”
EX1018	U.S. Patent Application Publication No. US 2003/0219754 A1 “Oleksy”
EX1019	U.S. Patent Application Publication No. US 2009/0239308 A1 “Dube”
EX1020	U.S. Patent Application Publication No. US 2009/0258414 A1 “Wittwer”
EX1021	U.S. Patent Application Publication No. US 2012/0100600 A1 “Slepnev”
EX1022	European Patent Specification 0,594,763 B1 “Lehnen”
EX1023	Nucleic Acids, https://www.genome.gov/genetics-glossary/Nucleic-Acids , updated September 2, 2025
EX1024	Introduction of Molecular Beacons, https://molecularbeacons.org/MB_introduction.html (downloaded July 10, 2024)

Exhibit #	Description
EX1025	Notice of Allowance from Prosecution File History of U.S. Patent No. 12,168,797, filed on November 18, 2024
EX1026	Final Rejection of U.S. Patent No. 12,168,797, filed on July 13, 2023
EX1027	Information Disclosure Statement noting Saxonov from Prosecution File History of U.S. Patent No. 10,068,051 filed on August 5, 2014
EX1028	Information Disclosure Statement from Prosecution File History of U.S. Patent No. 10,770,170 filed on March 7, 2018
EX1029	Information Disclosure Statement from Prosecution File History of U.S. Patent No. 11,827,921 filed on May 1, 2020
EX1030	Information Disclosure Statement from Prosecution File History of U.S. Patent No. 12,168,797 filed on July 13, 2023
EX1031	Declaration of Maria P Garcia, IP Research Librarian
EX1032	<i>University of British Columbia v. Caption Health, Inc., et al.</i> , No. 24-cv-03200-EKL, Slip Op. (N.D. Cal. Aug. 6, 2025)
EX1033	Plaintiffs California Institute of Technology and ChromaCode, Inc.’s Opening Claim Construction Brief for the ’797 Patent, filed on October, 29 2025, Dkt No. 160, <i>In re ChromaCode Litigation</i> , Case No. 5:23-cv-04823-EKL (VKD) (N.D. Cal.).
EX1034	Mingyong Han, et al., “Quantum-dot-tagged microbeads for multiplexed optical coding of biomolecules,” <i>nature biotechnology</i> , Volume 19, pp. 631-635, July 2001, “Han”
EX1035	The Examiner’s search terms and results from Prosecution File History of U.S. Patent No. 12,168,797 filed on July 13, 2023
EX1036	Order, filed on December 19, 2025, Dkt No. 178, <i>In re ChromaCode Litigation</i> , Case No. 5:23-cv-04823-EKL (VKD) (N.D. Cal.).
EX1037	Order Granting Joint Proposed Case Schedule, filed on September 22, 2025, Dkt. 151, <i>In re ChromaCode Litigation</i> , Case No. 5:23-cv-04823-EKL (VKD) (N.D. Cal.).

PO's supplemental brief on discretionary denial provides no new relevant information and otherwise fails to meaningfully rebut the undisputed facts presented by Petitioner. It is unclear why PO felt it necessary to burden the Director with yet additional briefing on the discretionary denial issue.

PO leads with a confusing summary of the procedural history of the district court litigation, contending that a stay of the district court case is "wholly inconsistent" with Petitioner's alleged earlier suggestion that the district court litigation ought to remain consolidated through expert discovery. *See* Paper No. 9 at 1. PO, however, never explains how or why Petitioner's arguments undermine a stay and otherwise ignores the actual status of the district court litigation and how it is currently structured.

In fact, as is undisputed, the district court case is structured so that the portion of the litigation pertaining to Bio-Rad's patent assertions against ChromaCode will proceed *before* PO's case against Bio-Rad based on the '797 patent, as reflected in the attached scheduling order. *See* EX1037. While Bio-Rad's case against ChromaCode is scheduled for trial in January 2027, there is *no trial date* with respect to PO's case against Petitioner based on the '797 patent. *See id.* at 6. The reason there is no trial date for the '797 patent is because PO informed the district court that the setting of a trial date might impact the likelihood of institution in this IPR. The district court agreed with this concern and accordingly declined to set a trial date:

MR. WALTER: I want to be very up-front about that. We do not want to propose a ChromaCode trial date now, and the reason is, is because – I don't know if you're aware, the way things are with PTAB. There's a trial date, we may not even be able to get an IPR off the ground.

THE COURT: I did hear about this. So, actually, I agree with that, as well. So we're going to hold off on that, just because – we can revisit the ChromaCode trial date, because we will have a case management conference after the claim construction hearing, per normal, even though the schedule has pretty much been set for much of this, but why don't we plan on doing it that way.

EX2017 at 48:8-20; *see also id.* at 41:18-19 (“That way, the concerns in terms of getting that further information regarding the IPRs will be there.”). Although PO attempts to characterize the foregoing as an “incomplete excerpt” and points to the subsequent exchange at 48:21-49:18 as somehow undermining Petitioner's position, the cited portion of the transcript just shows the district court rejecting yet an additional plea by PO for an early trial date. *See id.* at 48:21-49:18.

PO notably does not even attempt to address the fact that right before the holidays the district court ordered the parties to “file a joint statement addressing the status of the PTAB proceeding for the '797 patent and what impact, if any, an April 2026 hearing on the anticipated summary judgment motion may have on the PTAB proceeding.” EX1036. As Petitioner explained, this confirms that district court is focused on allowing this IPR to play out. The district court never would have asked

the parties to address this specific question if it did not have this concern and did not think that a stay would be possible.

With its opening brief, PO asserted “Petitioner has never moved for a stay of the parallel litigation nor indicated it would do so.” EX2011 ¶ 10. PO now doubles down and states “Petitioner has not indicated it will move to stay the parallel litigation, and indeed has actively sought just the opposite.” Paper No. 9 at 1. PO’s assertion that Petitioner seeks the “opposite” of a stay is questionable advocacy. As PO explained, Petitioner asserted to the district court that “the case might not keep going forward.” EX2017 at 36:4. Petitioner was clear that if IPR is instituted, it would seek a stay. As Petitioner explained, “[i]t might not make sense to go forward at that point. It might make sense to do a stay at that point.” *Id.* at 36:14-16.

In fact, this is likely in view of the district court judge’s prior decisions. *See, e.g., Inari Med., Inc. v. Imperative Care, Inc.*, No. 24-CV-03117-EKL, 2025 WL 2772596, at *5 (N.D. Cal. Sept. 29, 2025). PO never attempts to distinguish Petitioner’s cases, at most criticizing Petitioner’s reliance on them as “speculation,” a refrain that PO emphasizes in its brief. Yet, the transcript of the district court scheduling conference, the district court’s scheduling decisions, the district court’s request for briefing on how this IPR might be impacted by district court events, and the district court’s prior rulings are not speculation. They are rather hard evidence establishing that this case is likely to be stayed if IPR is instituted.

Supp. Brief ISO Opposition To Request For Discretionary Denial
U.S. Patent No. 12,168,797

Dated: January 9, 2026

By: /Derek C. Walter/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **PETITIONER'S
SUPPLEMENTAL BRIEF IN SUPPORT OF OPPOSITION TO REQUEST
FOR DISCRETIONARY DENIAL OF INSTITUTION AND EXHIBIT 1037**

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