

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

NATERA, INC., )  
)  
*Plaintiff / Counter Defendant,* )  
)  
v. )  
)  
ARCHERDX, INC., ARCHERDX, LLC and )  
INVITAE CORP. )  
)  
*Defendants / Counter Claimants.* )

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C.A. No. 20-125 (GBW)

**JURY TRIAL DEMANDED**

**DEFENDANTS' COUNTERSTATEMENT OF FACTS IN OPPOSITION TO  
PLAINTIFF'S MOTION FOR SUMMARY JUDGEMENT OF NO INVALIDITY BASED  
ON IMPROPER INVENTORSHIP (D.I. 441 at 12-23).**

Dated: October 25, 2022

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and ArcherDX, LLC*

**I. RESPONSE TO NATERA'S ALLEGEDLY UNDISPUTED FACTS**

No.	Natera's "Fact"	Defendants' Response	Defendants' Evidentiary Support
1.	None of the named inventors, added inventors, removed inventors, assignee Natera, or any third party dispute the inventorship of the '814, '172, '482 and '220 Patents as currently listed on the face of these patents. No inventor testified that he or she did not believe he or she was an inventor. No individual not named an inventor testified that he or she believed he or she was in fact an inventor.	Disputed. For instance, Lane Eubank and Phillippe Lacroute, who gave testimony confirming that they are inventors, were removed as inventors, while Allison Ryan and Milena Banjevic, gave testimony establishing that they could not possibly be inventors, were added as inventors.	<i>See, e.g.</i> , Ex. 1 (Eubank Tr.) at 61:17-62:13; Ex. 2 (Lacroute Tr.) at 40:20-25, 41:14-22, 43:14-20, 69:2-20, 69:25-70:4, 73:1-8, 74:16-75:8, 77:7-12; 166:6-167:13; D.I. 444-23 at 111:15-113:19; .I. 444-18 at 114:10-115:4; D.I. 444-17 at 48:9-49:10; D; D.I. 444-19 at 116:8-118:23; D.I. 444-16 at 163:12-165:6; D.I. 444-20 at 66:12-67:4; D.I. 444-21 at 133:17-134:4; D.I. 444-5 at 246:11-247-24; D.I. 444-22 at 103:9-22; D.I. 444-3 at 239:6-240:1; D.I. 444-24 at 134:21-135:8.
2.	The Patent Office rules and underlying statutes permit applicants to correct inventorship errors of patents and pending applications. Natera sought to correct, and did correct, the inventorship in the issued '814, '172, '482 and '220 Patents in compliance with all of the PTO's requirements as set forth in 37 C.F.R. § 1.324.	Disputed in part. Natera's filing to change inventorship was not in compliance with requirements set forth in 37 C.F.R. § 1.324 due to the omission of inventors.	<i>See, e.g.</i> , D.I. 441 at 15-22; D.I. 444-17 at 48:9-49:10; D.I. 444-18 at 114:10-115:4; D.I. 444-19 at 116:8-118:23; D.I. 444-16 at 163:12-165:6; D.I. 444-20 at 66:12-67:4; D.I. 444-21 at 133:17-134:4; D.I. 444-5 at 246:11-247-24; D.I. 444-22 at 103:9-22; D.I. 444-3 at 239:6-240:1; D.I. 444-23 at 111:15-113:19; D.I. 444-24 at 134:21-135:8.
3.	With respect to the '814, '172, and '220 Patents, each of the named inventors, added inventors and assignee Natera, submitted a signed statement under 37 C.F.R. § 1.324 agreeing to change the inventorship of these patents "in adding Johan Baner,	Undisputed.	

No.	Natera's "Fact"	Defendants' Response	Defendants' Evidentiary Support
	Milena Banjevic, Allison Ryan and Zachary Demko and removing Joshua Babiarz, Tudor Pompilin Constantin, Lane A. Eubank, Huseyin Eser Kirkizlar and Onur Sakarya as named Inventors of this patent."		
4.	With respect to the '482 Patent, each of the named inventors, added inventor Bernhard Zimmermann, and assignee Natera, submitted a signed statement under 37 C.F.R § 1.324 agreeing to the change of inventorship of the '482 Patent in "adding Bernhard Zimmermann as a named Inventors [ <i>sic</i> ] of this patent."	Undisputed.	
5.	The PTO issued certificates of correction.	Undisputed.	
6.	Defendants' improper inventorship claim is not supported by corroborating evidence. Natera identified and produced documents that corroborate its inventorship claim. Defendants did not evaluate any corroborating Natera documents, such as laboratory notebooks, in evaluating inventorship. Defendants' expert Dr. Cooper only relied on select testimony excerpts (and resumes in some cases) and did not review laboratory notebooks or any Natera document in his inventorship evaluation.	Disputed. Defendants presented corroborating evidence on inventorship in the form of inventor testimony, including the inability of inventors to explain their attestations and the omission of Natera employees whose work does correspond to the alleged invention.	<i>See, e.g.</i> , D.I. 444-17 at 48:9-49:10; D.I. 444-18 at 114:10-115:4; D.I. 444-19 at 116:8-118:23; D.I. 444-16 at 163:12-165:6; D.I. 444-20 at 66:12-67:4; D.I. 444-21 at 133:17-134:4; D.I. 444-5 at 246:11-247-24; D.I. 444-22 at 103:9-22; D.I. 444-3 at 239:6-240:1, D.I. 444-23 at 111:15-113:19; D.I. 444-24 at 134:21-135:8.; D.I. 419-10 ¶¶ 945-47; D.I. 391-2, Ex. 5 at 48:4-50:18.

No.	Natera's "Fact"	Defendants' Response	Defendants' Evidentiary Support
7.	The removed Natera inventors joined Natera after the filing of the priority patent application in November 2011. Joshua Babiarz joined Natera in December 2012, Tudor Constantin in January of 2013, Lane Eubank became a Natera employee in January 2014, Huseyin Kirkizlar joined Natera in May or June 2012, and Onur Sakarya in early 2014.	Disputed in part and irrelevant. The '814, '172, '482 and '220 are not entitled to claim the benefit of Natera's November 2011 application. Therefore, the mere fact that certain individuals joined Natera in 2011 or later does not preclude them from being inventors.	<i>See, e.g.</i> , D.I. 419-10 ¶¶ 50-67; D.I. 433-3, Ex. 28 at 8:11-19; Ex. 29 at 10:16-11:2 & Exh. 1; Ex. 30 at 12:3-17; Ex. 31 at 18:17; Ex. 32 at 14:20-21.

## **II. MATERIAL FACTS ON WHICH THERE REMAIN A GENUINE ISSUE REGARDING INVALIDITY BASED ON IMPROPER INVENTORSHIP**

### **A. Natera Dramatically Changed The Inventorship On Its Patents Eighteen Months Into Litigation**

1. Named inventor Zachary Demko, a patent agent and who is in charge of Natera's intellectual property function at the time of the alleged inventions, testified that Natera does its best to identify the right inventors. *See, e.g.*, D.I. 444-16 at 20:12-14, 105:10-107:7, 108:3-109:15, 142:17-143:8.

2. In June 2021, Natera filed petitions with the Patent Office to change the inventorship on the '814, '172, and '220 patents. *See, e.g.*, Ex. 3 ('127 Request for Inventorship Correction), Ex. 4 ('814 Request for Inventorship Correction), Ex. 5 ('220 Request for Inventorship Correction).

3. For three of the patents, Natera sought to add Johan Baner, Milena Banjevic, Allison Ryan, and Zachary Demko as inventors. *See, e.g., id.*

4. For three of the patents, Natera sought to remove Joshua Barbiarz, Tudor Constantin, Lane Eubank, Huseyin Kirkizlar, and Onur Sakarya as inventors. *See, e.g., id.*

5. None of the inventors who were added or removed were able to explain their attestations to the Patent Office at deposition. *See, e.g.*, D.I. 444-17 at 48:9-49:10; D.I. 444-18 at 114:10-115:4; D.I. 444-19 at 116:8-118:23; D.I. 444-16 at 163:12-165:6; D.I. 444-20 at 66:12-67:4; D.I. 444-21 at 133:17-134:4; D.I. 444-5 at 246:11-247-24; D.I. 444-22 at 103:9-22; D.I. 444-3 at 239:6-240:1, D.I. 444-23 at 111:15-113:19; D.I. 444-24 at 134:21-135:8.

### **B. A Reasonable Jury Could Find The Omission Of Dr. Lacroute As Sufficient To Invalidate The '220 Patent**

#### **1. Expert Testimony Corroborates Dr. Lacroute's Contributions To The Invention**

6. Dr. Phillippe Lacroute worked at Natera on algorithms for primer design to avoid

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