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Paper 14
Entered: January 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEQUENOM, INC.
Petitioner

v.

THE BOARD OF TRUSTEES OF
THE LELAND STANFORD JUNIOR UNIVERSITY
Patent Owner

Case IPR2013-00390
Patent 8,195,415 B2

Before LORA M. GREEN, FRANCISCO C. PRATS, and SCOTT E. KAMHOLZ, *Administrative Patent Judges.*

PRATS, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
of Decision to Institute *Inter Partes* Review
37 C.F.R. § 42.71

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I. STATEMENT OF THE CASE

A. *Statement of the Case*

On June 26, 2013, Sequenom, Inc. ("Sequenom") filed a petition ("Pet.") to institute an *inter partes* review of claims 1-17, of US Patent 8,195,415 B2 ("the '415 patent"; Ex. 1001). Paper 1. In a decision entered December 9, 2013, we instituted *inter partes* review of claims 1-17, based on a number of the grounds of unpatentability proposed in the petition. Paper 7 ("Decision"). Our Decision also denied institution as to a number of other grounds proposed in the petition, as being redundant in light of the grounds on which review was instituted. *Id.*

In requesting rehearing, Sequenom contends that the denied grounds are not redundant as to the grounds on which review was instituted, and that review also should have been granted as to the grounds designated as redundant. Paper 9, 1-2 ("Req. Reh'g").

For the reasons stated below, we deny Sequenom's request to rehear the decision to institute *inter partes* review of claims 1-17 of the '415 patent.

II. STANDARD OF REVIEW

When rehearing a decision on a petition to institute an *inter partes* review, the Board "will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). The party requesting rehearing has the burden of showing the decision should be modified, and "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." 37 C.F.R. § 42.71(d).

"An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial

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evidence, or represents an unreasonable judgment in weighing relevant factors." *Lacavera v. Dudas*, 441 F.3d 1380, 1383 (Fed. Cir. 2006), citing *Star Fruits S.N.C. v. United States,* 393 F.3d 1277, 1281 (Fed. Cir. 2005).

III. ANALYSIS

Sequenom contends that, while our Decision instituted review of claims 1-17 on grounds of anticipation and obviousness based on the "Lo II" reference,[1] we also should have instituted review on the proposed obviousness grounds based on the "Lo I" reference,[2] because Lo I has an earlier filing date. Req. Reh'g 1. Sequenom explains that, because the earliest effective filing date of the '415 patent is September 20, 2008, only two months after Lo II's filing date, Sequenom, therefore, "included additional unpatentability grounds 11-16 based on Lo I, which has a priority date of July 23, 2007, a whole year earlier than Lo II's filing date . . . ." *Id.* at 4-5.

Thus, Sequenom contends, because evidence showing that Lo II is not prior art to the '415 patent "might not eliminate the non-instituted unpatentability grounds 11-16 based on Lo I given Lo I's one-year earlier effective prior art date . . ., [the] grounds of unpatentability based on Lo I and Lo II do not necessarily stand or fall together and are, therefore, not redundant grounds." *Id.* at 5. In particular, Sequenom contends, the Board "has held a distinction in effective filing dates to be a legitimate reason to authorize review based on a reference having an earlier filing date in granting a request for rehearing under 37 C.F.R. § 42.71(c)." *Id.* at 6, citing *Illumina, Inc. v. Trustees of Columbia Univ.*, IPR2012-0007, Paper 54, 13 (PTAB May 10, 2013).

[1] US Patent App. Pub. No. 2009/0029377 A1 (filed Jul. 23, 2008) (Ex. 1002).
[2] US Provisional Patent Application 60/951,438 (Ex. 1003).

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Sequenom contends that our Decision "also overlooked that the disclosures of Lo I and Lo II differ and, accordingly, the facts and substantive arguments of grounds 11-16 based on Lo I differ from grounds 1-6 based on Lo II." Req. Reh'g 7. In particular, Sequenom notes, the instituted grounds based on Lo II included anticipation grounds, whereas the grounds based on Lo I included only obviousness grounds. *Id.* Thus, Sequenom, argues, because the issues involved in anticipation and obviousness "do not necessarily stand or fall together[,]" the grounds based on Lo I are not redundant to the proposed grounds based on Lo II. *Id.* at 8.

Sequenom's arguments do not persuade us that our Decision misapprehended any point of fact or law. As to the alleged different filing dates of Lo I and Lo II, as Sequenom itself acknowledges, *see* Pet. 37, Lo II expressly claims the benefit of Lo I under 35 U.S.C. § 119(e), and, indeed, incorporates by reference the entire contents of Lo I. Ex 1002 ¶ 1. Thus, Lo II has the same effective patent-defeating date as Lo I for disclosure that the two references have in common.

Also, Sequenom does not direct us to any specific discussion in the petition explaining the relative strengths and weakness of the grounds based on Lo I compared to the grounds based on Lo II. Sequenom's conjecture as to what evidence of prior invention Stanford might file is too speculative a basis on which to distinguish its challenges.

IV. CONCLUSION

Having considered Sequenom's request for rehearing, we are not persuaded, for the reasons discussed, that Sequenom has shown that our Decision

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misapprehended or overlooked any point of law or fact advanced in the petition, such that the Decision can be considered an abuse of discretion.

V. ORDER

For the reasons given, it is hereby ORDERED that Sequenom's request for rehearing is *denied*.

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