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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

SEQUENOM REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(c)

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I. INTRODUCTION

On December 9, 2013, the Board instituted *inter partes* review ("IPR") of all claims of U.S. Patent No. 8,195,415 (Ex. 1001, "the '415 patent")[1] based on six of the sixteen unpatentability grounds presented by Sequenom ("Petitioner"). Paper 7. Specifically, the Board instituted IPR of claims 1-17 of the '415 patent on grounds 1-6 based on Lo II (Ex. 1002). Paper 7 at 21-22.

The Board, however, declined to institute IPR on additional grounds presented by Petitioner that were based not on Lo II, but on Lo I (Ex. 1003), a reference with an earlier filing date and different disclosure than Lo II. Specifically, the Board declined to authorize review on Petitioner's asserted grounds 11-16 based on Lo I, having a filing date of July 23, ***2007***, because those grounds are allegedly redundant to instituted grounds 1-6 based on Lo II, having a filing date of July 23, ***2008***. Paper 7 at 21. Yet, as explained by Petitioner, because the Patent Owner may present evidence that Lo II is not prior art to the '415 patent as of Lo II's filing date (*see* Paper 1 at 5), grounds 11-16 based on Lo I, having a one year-earlier filing date, are not redundant to the instituted grounds.

[1] All cited exhibits refer to the exhibits from Sequenom's Petition for *Inter Partes* Review, Paper 1.

Moreover, the disclosures of Lo II and Lo I differ, as do the facts and substantive arguments upon which their respective unpatentability attacks rely. And because the Patent Owner may, for example, present evidence that a claim element is not present in the art cited for the instituted grounds based on Lo II, when that same element is more clearly set forth in the art cited for the grounds based on Lo I, grounds 11-16 based on Lo I are not redundant to the instituted grounds.

Petitioner therefore requests reconsideration by the Board under 37 C.F.R. § 42.71(c) and modification of the Decision to Institute IPR of the '415 patent claims to include the additional grounds of unpatentability 11-16 based on Lo I.

II. LEGAL STANDARD

An IPR will be "instituted for a ground of unpatentability" when the Board decides that the evidence put forward in a petition "demonstrate[s] that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable." 35 U.S.C. § 314(a); 37 C.F.R. § 42.108.

Under 37 C.F.R. § 42.71(c), "[a] party may request rehearing on a decision by the Board on whether to institute a trial pursuant to paragraph (d) of this section." Section 42.71(d) provides in relevant part:

> A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically

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