

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

Patent No. 8,195,415

Issued: June 5, 2012

Filed: January 29, 2010

Inventors: Hei-Mun Christina Fan, et al.

Title: NONINVASIVE DIAGNOSIS OF FETAL ANEUPLOIDY BY
SEQUENCING

Inter Partes Review No. IPR2014-00337

**PETITIONER'S MOTION FOR JOINDER TO RELATED INSTITUTED
INTER PARTES REVIEW**

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 & 42.122(b), Petitioner Sequenom, Inc. (“Sequenom” or “Petitioner”), hereby files this Motion for Joinder with its Petition For *Inter Partes* Review (IPR2014-00337) of claims 1-17 of U.S. Patent No. 8,195,415 (the “’415 Patent”). The motion seeks to join this Petition with the *inter partes* review of the same patent, IPR2013-00390, that was instituted on December 9, 2013. This motion and the petition are timely filed.

I. Statement of Material Facts

1. On June 27, 2012, Sequenom was served with a complaint alleging infringement of the ’415 patent. That suit is currently pending in the U.S. District Court for the Northern District of California, captioned *Verinata Health, Inc., et al. v. Sequenom, Inc.*, No. 3:12-cv-00865-SI (N.D. Ca.).

2. On June 26, 2013, Sequenom filed a Petition for *Inter Partes* Review of claims 1-17 of the ’415 patent, which was designated IPR2013-00390.

3. In IPR2013-00390, Petitioner relied on published U.S. Patent Application Publication No. 2009/0029377 to Lo *et al.* (“*Lo II*”) as a primary reference to argue that the claims of the ’415 patent are anticipated and were obvious in view of other prior art.

4. In IPR2013-00390, Petitioner also relied on U.S. Provisional Patent Application No. 60/951,438 to *Lo et al.* (“*Lo I*”) as a primary reference to argue that the claims of the ’415 patent were obvious in view of other prior art.¹

4. On December 9, 2013, the Board instituted trial in IPR 2013-00390 on all claims of the ’415 patent. *See* Ex. 1017 at 21. The grounds of unpatentability that review was instituted on were based on the *Lo II* reference. *See, e.g., id.* The Board denied as being “redundant” the asserted grounds of unpatentability based on *Lo I. Id.*

5. On December 23, 2013, in IPR2013-00390, Petitioner filed a Request for Rehearing under 37 C.F.R. §§ 42.71(c) requesting reconsideration and modification of the decision to institute review of the ’415 patent claims to include the grounds of unpatentability based on *Lo I. See, e.g.,* Ex. 1018 at 1-2.

6. In the Request for Rehearing, Petitioner explained that *Lo I* has an earlier filing date than *Lo II* and thus the grounds of unpatentability asserted based on *Lo I* are not redundant to the instituted grounds based on *Lo II. Id.* at 7-10.

¹ The *Lo I* reference is incorporated by reference by published U.S. Application No. 2009/0029377 (*Lo II*), which makes that application prior art under 35 U.S.C. 102(e) as of the filing date of the *Lo I* provisional application (*i.e.*, July 23, 2007) as to the contents of the *Lo I* provisional application.

Petitioner also argued that the facts and arguments underlying the respective grounds of unpatentability based on *Lo I* and the instituted grounds based on *Lo II* are not redundant. *Id.* at 10-11.

7. The Board has not yet ruled on Petitioner’s Request for Rehearing.

8. IPR2014-00337 requests institution of *inter partes* review of the same claims as those that are the subject of IPR2013-00390, relies on declaration evidence from the same expert used in the -00390 proceeding, and advances claim constructions that have already been advanced in the petition requesting the -00390 proceeding.

II. Argument

A. Joinder Will Provide the Board with the Opportunity to Consider Highly Relevant Grounds of Unpatentability that Are Not Redundant to the Grounds of Institution in IPR2013-00390

Petitioner submits that joinder of this Petition with the instituted proceeding IPR2013-00390 is fully warranted. *See Abb Inc. v. Roy-G-BIV Corporation*, IPR2013-00286, Paper 14 at 4.

First, the present Petition involves the same parties, the same patent, the same claims, and substantially similar, although not identical, grounds of unpatentability. A joined proceeding that includes the grounds of the present Petition can and should be conducted on the same schedule and will involve the same parties as the existing instituted proceeding.

Second, joinder will serve the interests of justice as it will ensure that all identified patentability questions related to the claims of the '415 Patent will be resolved in a single proceeding. In particular, joining the present Petition to the existing proceeding will ensure that patentability issues raised by the related teachings of *Lo I* and *Lo II* will be addressed in this single proceeding.

In instituting trial on the basis of the -00390 petition, the Board declined to institute grounds based on the *Lo I* reference, finding *Lo I* to present grounds that are redundant with the grounds the Board found to be sufficient based on the *Lo II* patent. But the *Lo I* reference is not cumulative or redundant to *Lo II*, at least because *Lo I* has a filing date of July 23, 2007, which is one year earlier than *Lo II*'s filing date of July 23, 2008.

During the co-pending interference proceeding involving the '415 patent and applications of the Petitioner, *i.e.*, Interference No. 105,922, the '415 patent Patent Owner represented that it intends to prove a conception date of December 18, 2007, for the subject matter of the count, which is claim 1 of the '415 patent. Ex. 1014 at 2. This “priority statement” was filed on July 31, 2013, and was not available to Petitioner when Petitioner filed its petition in IPR2013-00390. *Id.*

The December 18, 2007 conception date alleged by Patent Owner, if proven with sufficient evidence, could antedate *Lo II*. But by identifying December 18, 2007 as its conception date in the concurrent '922 interference proceeding, Patent

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