

Filed on behalf of: **Party Lo**

Paper \_\_\_\_\_  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HEI-MUN CHRISTINA FAN and STEPHEN **QUAKE**  
Junior Party  
(Patent 8,195,415)

v.

YUK-MING DENNIS **LO**, ROSSA WAI KWUN CHIU, and KWAN CHEE CHAN  
Senior Party  
(Application 13/070,266)

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Patent Interference No. 105,922 (DK)  
(Technology Center 1600)

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**LO REQUEST FOR REHEARING**

SEQUENOM EXHIBIT 1023

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1    **I. Statement of Relief Requested**

2           Party Lo (“Lo”) requests reconsideration of the PTAB’s Decision (Paper 101) and  
3    Order (Paper 103) entered on 7 April 2014, which deny Lo authorization to renew its  
4    request to file its deferred motion for judgment that the claims of Party Fan’s involved  
5    U.S. Patent 8,195,415 (“the ’415 patent”) are unpatentable under 35 U.S.C. §§ 102 and  
6    103 in view of the disclosure of two references: (1) U.S. Patent Application Publication  
7    2009/0029377 (“the ’377 publication”), filed 23 July 2008, and (2) the ’377 publication’s  
8    priority application, U.S. Provisional Application No. 60/951,438 (“the ’438 provisional”),  
9    filed 23 July 2007, taken alone or in combination with one or more of the listed  
10   references. See Paper 16, at 1-2.

11           In its Motions List, Lo sought authorization under 35 U.S.C. §§ 102 and 103  
12    based on the ’377 publication, which is the published version of Lo’s parent application  
13    12/178,181, filed 23 July 2008, priority of which has been accorded to Lo in this  
14    interference, and Lo’s earlier-filed provisional application, the ’438 provisional, priority of  
15    which was not accorded to Lo. The statutory bases under 35 U.S.C. §102 and/or §103  
16    for Lo’s arguments based upon these two references against the claims of the ’415  
17    patent are distinct, as fully explained by Lo in co-pending IPR2013-00390 (“the ’415  
18    IPR”).

19           Because the PTAB expressly denied institution in the ’415 IPR of Lo’s arguments  
20    based upon the ’438 provisional, and because Party Fan (“Fan”) has asserted a  
21    conception date in this interference as early as 18 December 2007, which would, if  
22    proven, antedate the ’377 publication, but not the ’438 provisional, the PTAB should  
23    reconsider its decision and permit Lo to file a motion for judgment on the grounds that  
24    Fan’s involved claims are unpatentable under 35 U.S.C. § 103 in view of the ’438

1 provisional, taken in combination with one or more of the references identified in Lo's list  
2 of proposed motions. Furthermore, in view of Fan's priority statement filed in this  
3 interference, Fan is limited to its asserted earliest corroborated conception date of "as  
4 early as 18 December 2007." This date, while earlier than the effective prior art date of  
5 the '377 publication, is not earlier than the effective prior art date of the '438 provisional.  
6 While Fan is precluded in this interference from asserting a date of invention antedating  
7 the '438 provisional, there is no such constraint on Fan in the '415 IPR. For this reason,  
8 the priority phase of this interference is the proper forum for resolution of this issue.

9 **II. Statement of Facts Relevant to the Request**

10 On 3 May 2013, the PTAB declared this interference. Paper 1. Count 1, the sole  
11 count of the interference, corresponds to claim 1 of the '415 patent, and the PTAB  
12 designated claims 1-17 of the '415 patent as corresponding to the Count. Paper 1, at 4-  
13 5. At the beginning of the motions phase, Lo requested authorization to file a motion for  
14 judgment on the ground that Fan's involved claims are unpatentable under 35 U.S.C.  
15 §§ 102 and 103 in view of the '377 publication, filed 23 July 2008, either alone or in  
16 combination with other cited art. Paper 16, at 1-2. That request expressly included  
17 reliance on the disclosure of the '438 provisional based on its earlier filing date, 23 July  
18 2007. *Id.* The PTAB deferred Lo's requested motion, but authorized Lo to renew its  
19 request for the deferred motion following resolution of the parties' motions for benefit.  
20 Paper 18, at 3.

21 In its priority statement, Fan asserted a conception date as early as  
22 18 December 2007. Paper 24. Lo, in its priority statement, relied upon the filing date of  
23 its first filed nonprovisional application, Application No. 12/178,181, filed 23 July 2008.  
24 Paper 21.

1 On 26 June 2013, Lo filed IPR2013-00390 (the '415 IPR) challenging the  
2 patentability of claims 1-17 of the '415 patent.<sup>1</sup> Lo presented unpatentability grounds 1-  
3 10 under §§ 102 and 103 based on the '377 publication, alone or in combination with  
4 other references. Lo also presented separate unpatentability grounds 11-16 under  
5 § 103 based on the '438 provisional in combination with other references. IPR Paper 1,  
6 at 3-5. On 9 December 2013, the PTAB instituted review of the '415 patent claims  
7 solely on grounds 1-6 based on the '377 publication, which grounds argued the claims  
8 were unpatentable under 35 U.S.C. § 102(e) and § 103. IPR Paper 7, at 21-22. The  
9 PTAB denied review as to grounds 7-16, of which grounds 11-16 were based on the  
10 '438 provisional and argued the claims were unpatentable under § 103, as redundant to  
11 the instituted grounds. *Id.* Lo filed a Request for Rehearing (IPR Paper 9), arguing  
12 against the finding of redundancy, which the PTAB denied based on the rationale that  
13 the '377 publication and the '438 provisional have the same effective filing date for  
14 common disclosure. IPR Paper 14, at 4.<sup>2</sup>

15 On 7 April 2014, the PTAB in this interference denied Lo authorization to file its  
16 deferred motion for judgment that the claims of the '415 patent are unpatentable under

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<sup>1</sup> Sequenom is the petitioner in IPR2013-00390, and is an identified real party-in-interest in this interference.

<sup>2</sup> On 9 January 2014, Petitioner Sequenom filed a motion for joinder and a second IPR petition, IPR2014-00337, challenging the claims of the '415 patent as unpatentable under 35 U.S.C. § 103 based on the '438 provisional in combination with one or more of the listed references. That IPR petition is currently pending and has not been acted on by the PTAB.

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