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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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),

Patent Interference No. 105,922 (DK)

Decision – Request for Rehearing
Bd.R. 125(c)

Before, FRED E. MCKELVEY, RICHARD E. SCHAFER, and DEBORAH KATZ, *Administrative Patent Judges.*

KATZ, Administrative Patent Judge.

SEQUENOM EXHIBIT 1024

Lo requests that we reconsider an Order entered 7 April 2014 (Paper 103, at 2)[1], denying authorization to file a motion for judgment based on alleged unpatentability under 35 U.S.C. §§ 102 and 103 of the claims of Fan's involved '415 patent. (Lo Request for Rehearing ("Request"), Paper 104.) An *inter partes* review ("IPR") panel of the Board denied institution of review of claims in the involved Fan patent, 8,195,415 ("the '415 patent") based on allegations of unpatentability over the Lo provisional application 60/951,438 ("the '438 provisional application") (*see* IPR2013-00390, Papers 7 and 14[2]). Therefore, Lo reasons that it should not be denied an opportunity in this interference for judgment on that basis.

To prevail on a request for rehearing, a party bears the burden of specifically identifying all matters the party believes to have been misapprehended or overlooked and the place where the matter was previously addressed in a motion, opposition, or reply. Bd. R. 125(c)(3).

In this interference, Lo listed a

> motion for judgment on the ground that Party Quake's involved claims are unpatentable under 35 U.S.C. §§ 102 and 103 in view of the following prior art references:
>
> 1. Yuk-Ming Dennis Lo et al., "Diagnosing Fetal Chromosomal Aneuploidy Using Massively Parallel Genomic Sequencing," US

[1] Lo also requests reconsideration of the Decision on Motions (Paper 101) in this interference. (Request, Paper 104, at 1:2.) Because (1) Lo does not refer to any portion of that Decision or point out what we may have misapprehended or overlooked in rendering that Decision and (2) that Decision does not discuss patentability of the Fan '415 claims under 35 U.S.C. § 102 or § 103, we do not reconsider that Decision.

[2] Paper 7 and Paper 14 of IPR2013-00390 have been made of record as Ex. 3001 (Paper 7) and Ex. 3002 (Paper 14).

> 2009/0029377, filed 23 July 2008 and published 29 January 2009, which claims benefit of (and incorporates by reference) Provisional Application No. 60/951,438, filed 23 July 2007; [followed by a list of 10 other references].

(Lo List of Proposed Motions, Paper 16 at 1:11-17.) Contrary to Lo's assertions in its request for rehearing (Request, Paper 104, at 1:7-10 and 5:4-7), Lo did not include the '438 provisional application in the list of prior art on which, if authorized, it would challenge the patentability of Fan's claims. Thus, a request for authorization to file a motion for unpatentability based on that provisional application was not misapprehended or overlooked when the Order of 7 April 2014 was issued. For this reason alone, Lo's request for rehearing is denied.

Even if Lo had previously requested authorization for a motion based on the '438 provisional application, Lo's arguments are not persuasive. *Inter partes* review of the Fan '415 patent was instituted on the grounds of anticipation and obviousness over U.S. Patent Application Publication 2009/0029377 ("the '377 publication"; "Lo II") but review was denied for patentability challenges based on '438 provisional application ("Lo I"). (*See* IPR2013-00390, Paper 7, Ex. 3001.) Lo argues that it should have an opportunity to present an attack on patentability based on the earlier '438 provisional application in either the IPR or the interference. According to Lo, Fan cannot antedate the earlier filing date of the provisional application and therefore an opportunity to attack the Fan '415 claims before the Board is appropriate. (Request, Paper 104, at 1:19-2:8.)

The IPR panel of the Board considered Lo's arguments regarding the different filing dates of the Lo '377 publication and '438 provisional application when it reconsidered its Decision to institute *inter partes* review. (IPR2013-00390, Paper 14, Ex. 3002.) Specifically, the IPR panel stated:

> Sequenom's [a licensee of the Lo application] 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 [provisional Application 60/951,438] and Lo II [patent application publication 2009/0029377], as Sequenom itself acknowledges, *see* [Petition] 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.

(*Id.* at 4.) Thus, Lo, represented by licensee Sequenom, will have an opportunity in the IPR to rely on the earlier filing date of the '438 provisional patent to challenge Fan's claims where the disclosure of the provisional and published applications are the same.

Furthermore, Lo does not explain, with specificity, the basis on which the '438 provisional application itself can be considered prior art, as opposed to merely providing an effective patent defeating date for Lo II. Lo states that "[t]he statutory bases under 35 U.S.C. §102 and/or §103 for Lo's arguments based upon these two references [including the '438 provisional application] against the claims of the '415 patent are distinct, as fully explained by Lo in co-pending IPR2013-00390 . . . ."[3] (Request at 1:15-18.) Lo includes no further explanation *on the record before us* in this interference to support the statutory basis for asserting an unpublished, provisional application as prior art. *See Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1250, n.2 (Fed. Cir. 2008) (quoting *United States*

[3] The "as fully explained by Lo in copending IPR2013-00390" is an attempt to incorporate arguments from another paper in another proceeding into the Request. Bd. R 106(b)(3); Standing Order, ¶ 106.2 (Paper 2, page 19).

v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991) ("Judges are not like pigs, hunting for truffles buried in briefs.")). Thus, Lo fails to provide a persuasive reason why authorization of such a motion would be appropriate at this time.

We are not persuaded that any matter was misapprehended or overlooked in the Order of 7 April 2014. We also are not persuaded Lo has been improperly denied an opportunity to pursue the unpatentability of Fan's claims over the prior art.[4] Accordingly, the denial of a renewed request for authorization to file Lo's proposed motion for unpatentability under 35 U.S.C. §§ 102 and 103 was not an abuse of discretion under Bd.R. 125(c)(5).

Lo's request for rehearing is DENIED. The Order of 7 April 2014 (Paper 103) is not modified.

[4] Lo also indicated that Sequenom has filed an additional petition for *inter partes* review challenging the claims of the Fan '415 patent over provisional application 60/951,438. (Request, Paper 104, at 3, n. 2; *see* IPR2014-00337.) No paper from IPR2014-00337 has been submitted as evidence in this interference. Bd. R 154(a). We therefore decline to consider arguments based on papers filed in IPR2014-00337. We additionally observe that we cannot have misapprehended or overlooked an argument based on a paper or evidence not before us.

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