

Paper No. \_\_\_\_\_  
Filed August 14, 2014

Filed on behalf of: Sequenom, Inc.

By: Michael J. Wise (mwise@perkinscoie.com)  
Patrick D. Morris (pmorris@perkinscoie.com)  
Perkins Coie LLP  
1888 Century Park East, Suite 1700  
Los Angeles, CA 90067-1721  
Telephone: (310) 788-3210  
Facsimile: (310) 788-3399

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 IPR2014-00337  
Patent 8,195,415

---

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

**TABLE OF CONTENTS**

I. INTRODUCTION ..... 1

II. BACKGROUND ..... 3

III. LEGAL STANDARD ..... 5

IV. ARGUMENT ..... 6

    A. Lo I Qualifies as Prior Art under 35 U.S.C. § 102(e) ..... 6

    B. Sequenom Will Suffer Prejudice if It Cannot Rely on Lo I and  
        Other Prior Art References Cited in the Petition ..... 11

V. CONCLUSION..... 13

## TABLE OF AUTHORITIES

### Cases

<i>Ex Parte Argasinski</i> , Appeal 2008-3200, Decision on Appeal, 2009 WL 460669 (B.P.A.I. Feb. 24, 2009).....	1, 7, 9, 10
<i>Focal Therapeutics, Inc. v. Senorx, Inc.</i> , IPR2014-00116, Paper 8, 2014 WL 1651257 (P.T.A.B. Apr. 22, 2014) .....	2, 7, 10
<i>Ex Parte Gilde</i> , Appeal 2011-012641, Decision on Appeal, 2014 WL 1154004 (P.T.A.B. Mar. 20, 2014).....	2, 7, 10
<i>Ex Parte Green</i> , Appeal 2010-002449, Decision on Appeal, 2011 WL 5116559 (B.P.A.I. Oct. 25, 2011).....	<i>passim</i>
<i>Lacavera v. Dudas</i> , 441 F.3d 1380 (Fed. Cir. 2006) .....	5-6
<i>Ex parte Yamaguchi</i> , 88 U.S.P.Q. 2d 1606 (B.P.A.I. 2008) .....	<i>passim</i>

### Statutes

35 U.S.C. § 102(e) .....	<i>passim</i>
35 U.S.C. § 103 .....	4, 6
35 U.S.C. § 111(b) .....	6
35 U.S.C. § 111(b)(5).....	8-9
35 U.S.C. § 119(e) .....	4, 8
35 U.S.C. § 122(b) .....	1, 6, 8
35 U.S.C. § 122(b)(2)(A)(iii) .....	8

TABLE OF AUTHORITIES  
(continued)

Page

**Regulations**

37 C.F.R. § 1.14(a)(1)(iv) .....	9
37 C.F.R. § 1.14(a)(1)(iv)-(vi) .....	8
37 C.F.R. § 1.211(a).....	9
37 C.F.R. § 42.71(c).....	5
37 C.F.R. § 42.71(d) .....	1, 5

## I. INTRODUCTION

Petitioner Sequenom, Inc. ("Sequenom") requests a rehearing under 37 C.F.R. § 42.71(d) regarding the Board's July 16, 2014 Decision Denying Institution of *Inter Partes* Review (Paper 11). The Board denied Sequenom's petition "because Lo I [a provisional patent application] is neither a patent nor an application for patent published under 35 U.S.C. § 122(b)" so the Board concluded that Lo I "does not qualify under 35 U.S.C. § 102(e) as prior art to the claims of the '415 patent." *Paper 11 at 4.*

The Board abused its discretion by overlooking controlling case law in *Ex parte Yamaguchi*, 88 U.S.P.Q. 2d 1606 (B.P.A.I. 2008). In that case, the Board held that even though provisional patent applications are not published under 35 U.S.C. § 122(b), they become public when corresponding utility applications are published, and thus qualify as prior art under 35 U.S.C. § 102(e) "like a regular utility application" and "constitute[] prior art for all that [they] teach[]." *Yamaguchi*, 88 U.S.P.Q. 2d at 1611-12. Other panels of this Board have followed the precedential decision in *Yamaguchi* and found that a provisional application to which an application published under 35 U.S.C. § 122(b) claims priority qualifies as § 102(e) prior art. *Ex Parte Argasinski*, Appeal 2008-3200, Decision on Appeal at 3 n.2, 2009 WL 460669, at \*4 n.2 (B.P.A.I. Feb. 24, 2009) ("We note that the Ferreira 60/182,282 reference is the provisional application for the Ferreira utility patent application publication, US 2001/0034661 A1. We consider Ferreira's 60/182,282 provisional application available as prior art in accordance with *Ex parte Yamaguchi*[.]"); *Ex Parte Green*, Appeal 2010-002449, Decision on Appeal

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.