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Paper No. 14
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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 IPR2014-00337
Patent 8,195,415 B2

Before LORA M. GREEN, FRANCISCO C. PRATS, and SCOTT E. KAMHOLZ, *Administrative Patent Judges.*

PRATS, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
of Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71

I. INTRODUCTION

Sequenom, Inc. ("Petitioner") has filed a Request for Rehearing (Paper 12, "Req. Reh'g") of our Decision (Paper 11, "Dec.") denying review of the claims of U.S. Patent No. 8,195,415 B2 (Ex. 1001, "the '415 patent"), as to all grounds advanced in the corrected Petition (Paper 5, "Pet."). For the reasons that follow, we deny Petitioner's request to rehear the decision not to institute *inter partes* review of the '415 patent.

II. STANDARD OF REVIEW

When rehearing a decision on a petition to institute an *inter partes* review, the Board "will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). The party requesting rehearing has the burden of showing the decision should be modified, and "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." 37 C.F.R. § 42.71(d).

"An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors." *Lacavera v. Dudas*, 441 F.3d 1380, 1383 (Fed. Cir. 2006), citing *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

III. ANALYSIS

Petitioner presented twelve grounds of unpatentability, all of which relied on the Lo I[1] reference. Pet. 5–6. Petitioner contended that Lo I, a provisional

[1] Lo et al., U.S. Provisional Patent Application 60/951,438 (filed July 23, 2007) (Ex. 1003).

U.S. patent application, constitutes prior art under § 102(e) as of its filing date for all it discloses, under *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential). Pet. 2.

We declined to institute trial because Lo I is neither a patent nor an application for patent published under 35 U.S.C. § 122(b), and, therefore, is not one of the two types of documents that may be relied upon under 35 U.S.C. § 102(e) to show that claims are unpatentable. Dec. 3. We also explained that we were not persuaded that *Ex parte Yamaguchi* stands for the proposition that a ground of unpatentability under § 102(e) may be predicated on a provisional application, without reference to a corresponding patent or application for patent published under § 122(b). *Id.* at 4. Specifically, we noted that, like the decision in *In re Giacomini*, 612 F.3d 1380, 1384–85 (Fed. Cir. 2010), *Ex parte Yamaguchi* held that, "under § 102(e)(2), *a patent* that claimed the benefit of an earlier filed provisional application qualified as prior art, as of the filing date of the provisional application, for all commonly disclosed subject matter." Dec. 4.

In its Request for Rehearing, Petitioner contends that our statement of the holding in *Yamaguchi* overlooks language in that decision stating that a provisional application constitutes prior art under § 102(e) "for all that it teaches." Req. Reh'g 6 (citing *Yamaguchi*, 88 USPQ2d at 1612). Petitioner, thus, argues that our Decision overlooked the full breadth of the holding in *Yamaguchi*. *Id.* at 7–8. Moreover, Petitioner contends, contrary to our conclusion that a provisional application is not an application for patent published under § 122(b) as required by § 102(e)(1), *Yamaguchi* explains that provisional applications, in general, become publicly available when the corresponding utility application is published. *Id.* at 8–9 (citing *Yamaguchi*, 88 USPQ2d at 1611–12).

We are not persuaded that our Decision misapprehended or overlooked the breadth of the holding in *Yamaguchi*. In particular, we are not persuaded that *Yamaguchi* held that, because provisional applications generally become publicly available, the proponent of the patent-defeating provisional application is discharged from the requirement of showing, in a ground based on § 102(e), that the critical disclosures relied upon in the provisional application are also present in a corresponding patent, or application published under § 122(b). To the contrary, the *Yamaguchi* decision noted expressly that the examiner had made the fact-finding that the relevant disclosures of the patent and its corresponding provisional application were the same. *Yamaguchi*, 88 USPQ2d at 1613. Then, in determining whether the appellant had shown error in that finding, the decision used a table to compare directly the disclosures of the patent upon which unpatentability was asserted, and the corresponding disclosures in the related provisional application. *Id.*

Thus, rather than analyzing the provisional application in isolation, the *Yamaguchi* decision ensured that the patent-defeating disclosures were present in both the patent which formed the basis of unpatentability under § 102(e), as well as the corresponding provisional application. The decision in *Yamaguchi* recognized, therefore, that in a ground of unpatentability under § 102(e), the patent-defeating disclosures in a provisional application must also be found in a document applicable as prior art under § 102(e), that is, either a patent or application for patent published under § 122(b). Accordingly, we are not persuaded that *Yamaguchi* held that a ground of unpatentability under § 102(e) may be predicated on a provisional application, without reference to a corresponding patent or application for patent published under § 122(b).

Petitioner also directs us to the decisions in *Ex parte Argasinski*, 2009 WL 460669 (BPAI 2009), *Ex parte Green*, 2011 WL 5116559 (BPAI 2011), *Ex Parte Gilde*, 2014 WL 1154004 (PTAB 2014), and *Focal Therapeutics, Inc. v. Senorx, Inc.*, IPR2014-00116 (Paper 8), 2014 WL 1651257 (PTAB 2014). Req. Reh'g 1–2, 7, 9–10. Those decisions are not precedential, however. We, therefore, are not bound by them, and decline to consider them.

In sum, for the reasons discussed, we are not persuaded that our Decision not to institute trial misapprehended or overlooked the holding in *Ex parte Yamaguchi*. We are also not persuaded that Petitioner has been precluded, in a prejudicial fashion, from presenting to the Board its case regarding Lo I and the other references cited in its corrected Petition. *See* Req. Reh'g 11–13. Petitioner did, in fact, present its grounds of unpatentability based on Lo I. *See* Pet., *generally*. Although Petitioner disagrees with our assessment of the merits of the grounds advanced in the corrected Petition, that disagreement does not demonstrate that Petitioner was not afforded the opportunity to present the grounds of unpatentability it desired, or that we misapprehended or overlooked the grounds of unpatentability that were advanced, to an extent that would be considered an abuse of discretion.

IV. CONCLUSION

Having considered Petitioner's request for rehearing, we are not persuaded, for the reasons discussed, that Petitioner has shown that our Decision misapprehended or overlooked any point of law or fact advanced in the corrected Petition, such that the Decision can be considered an abuse of discretion.

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