

Case IPR2016-00822
U.S. Patent No. 7,064,197

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOLOGIC, INC.,
Petitioner

v.

ENZO LIFE SCIENCES, INC.,
Patent Owner

Case IPR2016-00822

U.S. Patent No. 7,064,197
TITLE: SYSTEM, ARRAY AND NON-POROUS SOLID SUPPORT
COMPRISING FIXED OR IMMOBILIZED NUCLEIC ACIDS
Issue Date: June 20, 2006

ENZO'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71(d)
AND SUGGESTION FOR REHEARING BY EXPANDED PANEL

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION AND RELIEF REQUESTED	1
II. GOVERNING LAWS, RULES, AND PRECEDENT	2
III. THE BOARD SHOULD GRANT ENZO’S REQUEST FOR REHEARING AND REVERSE THE INSTITUTION DECISION BECAUSE PETITIONER FAILED TO ESTABLISH THE PUBLIC ACCESSIBILITY OF ITS NON-PATENT REFERENCES.....	3
A. Enzo Showed In Its Preliminary Response That Petitioner Did Not Establish That Its Non-Patent References Were “Printed Publications” Because Petitioner Failed To Adduce Admissible Evidence Of Public Accessibility.....	4
B. The Institution Decision Was An Abuse Of Discretion Because The Federal Rules Of Evidence Were Not Applied.....	5
C. The Panel Abused Its Discretion By Failing To Hold Petitioner To Its Burden Of Establishing The Public Accessibility Of Its Non-Patent References And By Adopting Positions That Petitioner Did Not Raise.	7
IV. ENZO RESPECTFULLY SUGGESTS REHEARING BY AN EXPANDED PANEL THAT INCLUDES THE CHIEF JUDGE.....	10
A. Consideration By An Expanded Panel Is Warranted To Bring Uniformity To The Board’s Conflicting Decisions Concerning The Standard For Establishing That A Non-Patent Reference Is A Publicly Accessible “Printed Publication.”	11
B. The Evidentiary Standard For Establishing That A Non-Patent Reference Is A Publicly Accessible “Printed Publication” Is An Issue Of Exceptional Importance, And The Board’s Decision In This Proceeding Conflicts With Federal Circuit Precedent.	13
V. CONCLUSION.....	14

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>Cases</u>	
<i>Apple, Inc. v. DSS Tech. Mgm't</i> , Case IPR2015-00369, Paper 9 (PTAB June 25, 2015).....	4, 6, 8, 12
<i>Cisco Sys., Inc. v. Constellation Techs. LLC</i> , Case IPR2014-00914, Paper 11 (PTAB Jan. 2, 2015).....	4, 9
<i>Coalition for Affordable Drugs IV LLC v. Pharmacyclics LLC</i> , Case IPR2015-01076, Paper 33 (PTAB Oct. 19, 2015).....	4
<i>Daicel Corp. v. Celanese Int'l. Corp.</i> , Case IPR2015-00173, Paper 15 (PTAB June 26, 2015).....	3, 10
<i>emnos USA Corp. v. Dunnhumby, Ltd.</i> , Case CBM2015-00162, Paper 7 (PTAB Dec. 30, 2015).....	12
<i>Hewlett-Packard Co. v. U.S. Philips Corp.</i> , Case IPR2015-01505, Paper 15 (PTAB Dec. 16, 2015).....	4, 14
<i>In re: Magnum Oil Tools Int'l, Ltd.</i> , No. 2015-1300, 2016 WL 3974202 (Fed. Cir. July 25, 2016).....	8, 9, 13
<i>Indoor Skydiving Germany GmbH v. IFLY Holdings LLC</i> , Case IPR2015-01272, Paper 14 (PTAB Jan. 5, 2016).....	8
<i>Service v. Dulles</i> , 354 U.S. 363 (1957).....	6
<i>ServiceNow, Inc. v. Hewlett-Packard Co.</i> , Case IPR2015-00707, Paper 12 (PTAB Aug. 26, 2015)	12
<i>Standard Innovation Corp. v. Lelo, Inc.</i> , Case IPR2014-00148, Paper 41 (PTAB Apr. 23, 2015)	5
<i>TRW Automotive US LLC v. Magna Elecs. Inc.</i> , Case IPR2015-00960, Paper 9 (PTAB Oct. 5, 2015).....	4, 7, 9
<i>Wagner v. United States</i> , 365 F.3d 1358 (Fed. Cir. 2004)	5

Statutes

35 U.S.C. § 311 4, 7, 9

Regulations

37 C.F.R. § 42.108(c).....9
37 C.F.R. § 42.26
37 C.F.R. § 42.62(a).....4, 6
37 C.F.R. § 42.71(c).....3
37 C.F.R. § 42.71(d)2, 4

Rules

FED. R. EVID. 8014
FED. R. EVID. 8024, 6

Other Authorities

Anish Desai, Christopher Marando, & Amanda Do Couto, *PTAB Approaches To Accessibility Of Printed Publication*, LAW360 (Oct. 3, 2016), <http://www.law360.com/articles/845934/print?section=ip>11
Michael R. Weiner, *APJs Dispute Requirements for a Reference to Qualify as a Printed Publication*, PTABWATCH (Oct. 15, 2015), <http://www.ptabwatch.com/2015/10/apjs-dispute-requirements-for-a-reference-to-qualify-as-a-printed-publication>.....11
Patent Trial and Appeal Board Standard Operating Procedure 1, Rev. 1411

All emphases are added unless otherwise noted.

PATENT OWNER'S EXHIBIT LIST

Enzo Exhibit No.	DESCRIPTION
2101	Declaration of Gregory Buck, Ph.D.
2102	Declaration of Dollie M.W. Kirtikar, Ph.D., submitted in U.S. Patent App. No. 08/486,070 (Oct. 28, 2003).
2103	Robberson, D. L. and Davidson, N., <i>Biochemistry</i> 11, 533 (1972).
2104	Schott, Herbert, "Special Methods for the Immobilization of RNA and Polyribonucleotides," in <i>Affinity Chromatography, Chromatographic Science Series, Vol. 27</i> (allegedly 1984).
2105	Petitioner's Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,064,197 in Case IPR2016-00820.
2106	Anish Desai, Christopher Marando, & Amanda Do Couto, <i>PTAB Approaches To Accessibility Of Printed Publication</i> , LAW360 (Oct. 3, 2016), http://www.law360.com/articles/845934/print?section=ip .
2107	Michael R. Weiner, <i>APJs Dispute Requirements for a Reference to Qualify as a Printed Publication</i> , PTABWATCH (Oct. 15, 2015), http://www.ptabwatch.com/2015/10/apjs-dispute-requirements-for-a-reference-to-qualify-as-a-printed-publication .

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.