

Filed on behalf of ANCESTRY.COM DNA, LLC

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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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ANCESTRY.COM DNA, LLC,  
Petitioner

v.

DNA GENOTEK INC.,  
Patent Owner.

Inter Partes Review No. IPR2016-01152  
Patent 8,221,381 B2

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**PETITIONER ANCESTRY.COM DNA, LLC'S  
REQUEST FOR REHEARING AND RECONSIDERATION  
UNDER 37 C.F.R. § 42.71(d)**

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**OTHER AUTHORITIES**

Office Patent Trial Guide,  
Fed. Reg. Vol. 77 at 48757 (August 14, 2012).....1

Office Patent Trial Guide,  
Fed. Reg. Vol. 77 at 48765 (August 14, 2012).....3

Office Patent Trial Practice Guide (August 14, 2012) .....2

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## I. INTRODUCTION

On November 23, 2016, the Board issued its Decision Denying Institution of *Inter Partes* Review in IPR2016-01152 (Paper 11) (“Decision”). This request respectfully seeks rehearing of the Decision for factual and legal errors discussed in detail below. This request is authorized under 37 C.F.R. § 42.71(d), and prior authorization by the Board is not required for filing such a request. This paper is timely filed within the 30-day period set forth in 37 C.F.R. § 42.71(d)(2).

## II. LEGAL STANDARDS

### A. The Standard of Review for Rehearing

“A party dissatisfied with the Board’s determination to institute trial may request a hearing as to points believed to have been overlooked or misapprehended.” Office Patent Trial Guide, Fed. Reg. Vol. 77 at 48757 (August 14, 2012); *see also* 37 C.F.R. §42.71(c) and (d). Under 37 C.F.R. §42.71(d), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion “occurs when a court misunderstands or misapplies the relevant law” or makes erroneous factual findings. *Renda Marine, Inc. v. U.S.*, 509 F.3d 1372, 1379 (Fed. Cir. 2007). “A decision based on an erroneous view of the law ... invariably constitutes an abuse of discretion.” *Atl. Research Mktg. Sys. v. Troy*, 659 F.3d 1345, 1359 (Fed. Cir. 2011), citing *United*

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