

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOUNDATION MEDICINE, INC.,
Petitioner,

v.

GUARDANT HEALTH, INC.,
Patent Owner.

Case No. IPR2019-00636

Case No. IPR2019-00637

U.S. Patent No. 9,902,992

**PETITIONER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(d)**

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I. INTRODUCTION

Petitioner respectfully requests rehearing of the Patent Trial and Appeal Board's ("the Board") decision denying institution of trial on *inter partes* review petitions IPR2019-00636, challenging claims 1-11, 13, and 15-26 of U.S. Patent No. 9,902,992 ("the '992 patent"), and IPR2019-00637, challenging claims 11, 12, 14, and 27-33 of the '992 patent. *See* Paper 10 ("Decision").¹ The Board's decision was premised on the conclusion that Petitioner did not sufficiently demonstrate that the prior art "inherently" taught the claim limitation of tagging "at least 20% of the cfDNA molecules by ligation." Decision at 15. But Petitioner never made an inherency argument. Instead, the Board was led to error by Patent Owner's mischaracterization of Petitioner's obviousness argument. This error prevented the Board from applying the correct legal standard and fairly considering the argument and evidence actually provided by Petitioner.

As a result, the Board committed several errors in the Decision. First, the Board acted contrary to multiple Board decisions declining to apply an inherency standard where a Patent Owner mischaracterizes an obviousness argument as relying on an inherency theory. Here, the Board misapprehended Petitioner's obviousness argument and improperly required Petitioner to demonstrate that Schmitt inherently

¹ Unless stated otherwise, paper and exhibit numbers refer to those filed in IPR2019-00636.

disclosed tagging “at least 20%” of cfDNA molecules by ligation. Second, the Board erred by overlooking Petitioner’s express arguments regarding motivation to improve ligation efficiency. Petitioner’s explanation, ignored by the Preliminary Response and the Decision, provides the requisite motivation to modify the method of Schmitt to improve ligation efficiency.

Petitioner respectfully requests rehearing and institution of each ground in its petitions. Additionally, Petitioner is filing a request for a Precedential Opinion Panel (POP) along with this Request for Rehearing.

II. LEGAL STANDARD

A party requesting rehearing must show that a decision should be modified by identifying “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). The Board reviews requests for rehearing under an abuse of discretion standard. *Id.* at § 42.71(c). “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.” *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

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