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Paper 8 (IPR2019-00636)
Paper 8 (IPR2019-00637)
Entered: July 22, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOUNDATION MEDICINE, INC.,
Petitioner,

v.

GUARDANT HEALTH, INC.,
Patent Owner.

Case IPR2019-00636
Case IPR2019-00637
Patent 9,902,992 B2¹

Before TINA E. HULSE, JOHN E. SCHNEIDER, KRISTI L. R. SAWERT,
Administrative Patent Judges.

HULSE, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This order addresses issues that are common to both cases. We, therefore, issue a single order that has been entered in each case. Paper numbers refer to those filed in IPR2019-00636. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the caption.”

A conference call was held on July 19, 2019, among counsel for Petitioner, counsel for Patent Owner, and Judges Hulse, Schneider, and Sawert. Petitioner retained a court reporter for the call.²

On July 1, 2019, Patent Owner sent an email correspondence to the Board requesting authorization to file a corrected Preliminary Response in both proceedings. Ex. 3001. Patent Owner contends that the correction was necessary to “correct an inadvertent error [because] to the extent the POPR . . . suggests that the challenged ’992 patent is entitled priority to an application filed September 4, 2012 – that is incorrect.” *Id.* at 1. Patent Owner also attached proposed mark-ups for the correction in each proceeding, indicating it would only delete the identified content. *Id.* at 2 (IPR2019-00636), 3–4 (IPR2019-00637).

In response, Petitioner requested a conference call with the Board, indicating it opposes Patent Owner’s request.

During the call, Patent Owner stated that filing the corrected Preliminary Responses would ensure there is no confusion as to whether Patent Owner is asserting the ’992 patent is entitled to the benefit of the September 4, 2012, priority date. Patent Owner also stated that the identified priority date in the co-pending district court litigation is March 5, 2014, and that it was litigation counsel who brought this issue to Patent Owner’s attention. Patent Owner confirmed that no other changes to the arguments in the Preliminary Responses would be necessary and that it does not believe the change affects any issues or arguments in the proceedings.

² Petitioner indicated it would file a copy of the transcript as an exhibit when it is available. We summarize the call briefly in this order, as the transcript provides further details of the call.

Petitioner argued that the requested edit does not correct an inadvertent error, as the inventors have represented to the Office in application data sheets during prosecution of the '992 patent that the earliest priority date is September 4, 2012. Petitioner noted that Patent Owner had not affirmatively indicated what priority date it is asserting. Given the change, Petitioner argued that the '992 patent should not be entitled to a priority date earlier than the March 21, 2016, filing date of the '992 patent application itself. Petitioner contends that the priority date of the '992 patent affects what Petitioner needs to show to prove the Schmitt reference is prior art (i.e., whether Petitioner needs to show Schmitt is entitled to the benefit of the priority date of its provisional application). Petitioner conceded, however, that the arguments have all been made in the Petition and that its arguments in the Petition would not change if the correction is entered.

Having considered the parties' respective arguments, we find good cause exists to allow Patent Owner to file a corrected Preliminary Response in each proceeding to delete the indicated subject matter. Although Patent Owner could correct the error in the Patent Owner Response if we institute trial, we agree with Patent Owner that doing so now would create a clearer record, which would be beneficial to the public. We also note there is no prejudice to Petitioner to allow Patent Owner to clarify its assertion that it is not entitled to an earlier effective filing date.

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Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a corrected Patent Owner Preliminary Response in both proceedings is *granted*; and

FURTHER ORDERED that Patent Owner may file the corrected papers by the end of the day on July 19, 2019; and

FURTHER ORDERED that once the corrected papers are filed, the Board will expunge the originally filed Patent Owner Preliminary Responses in each proceeding.

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