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Paper No. 11
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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
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Statement of the Case

Sequenom, Inc. ("Petitioner") filed a corrected Petition (Paper 5, "Pet.") requesting *inter partes* review of all claims, claims 1–17, of U.S. Patent No. 8,195,415 B2 (Ex. 1001, "the '415 patent"). The Board of Trustees of the Leland Stanford Junior University ("Patent Owner") did not file a Preliminary Response. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which states:

> THRESHOLD.— The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons below, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of at least one claim of the '415 patent. Accordingly, we decline to institute an *inter partes* review. As a result, we also dismiss Petitioner's Motion to join this proceeding with IPR2013-00390 (Paper 2) as moot.

B. Related Proceedings

We instituted trial for claims 1–17 of the '415 patent in IPR2013-00390. *Sequenom, Inc. v. Stanford Univ.*, Case IPR2013-00390 (PTAB Dec. 9, 2013) (Paper 7). The '415 patent also is involved in Interference No. 105,922, declared on May 3, 2013. *Fan v. Lo*, Interference No. 105,922 (PTAB May 3, 2013) (Paper 1). The '415 patent also is asserted in a co-pending district court case, *Verinata Health, Inc. v. Sequenom, Inc.*, Case No. 3:12-cv-00865-SI (N.D. Cal.). Pet. 3–4.

II. ANALYSIS

Petitioner proposes twelve grounds of unpatentability against claims 1–17 of the '415 patent, all based on obviousness under 35 U.S.C. § 103(a). Pet. 5–6. Every proposed ground of unpatentability advanced by Petitioner relies on Lo I.[1] *Id.* Petitioner contends that Lo I "is a provisional U.S. patent application that is prior art to the '415 patent under §§ 102(e)/103(a) as of its filing date for all it discloses." *Id.* at 2 (citing *Ex parte Yamaguchi*, 88 USPQ2d 1606, 1612–1614 (BPAI 2008)).[2]

We are not persuaded. Two types of documents may be relied upon under § 102(e) to show that claims are unpatentable, "(1) an application for patent, published under section 122(b), . . . or (2) a patent granted on an application for patent." 35 U.S.C. § 102(e). As a provisional application, Lo I is not a patent.

Likewise, as a provisional application, Lo I is not "an application for patent, published under section 122(b)." To the contrary, § 122(b) states expressly that "[a]n application shall not be published if that application is . . . (iii) a provisional application filed under section 111(b) of this title." 35 U.S.C. § 122(b)(2)(iii). Accordingly, because Lo I is undisputedly a provisional application filed under § 111(b), Lo I is not "an application for patent, published under section 122(b)," and therefore, does not qualify as prior art under § 102(e).

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

[2] The application which issued as the '415 patent, serial number 12/696,509, is a divisional application of serial number 12/560,708, which was filed on September 16, 2009. Ex. 1001, 1. Accordingly, the versions of §§ 102(e) and 103(a) in effect before the Leahy-Smith America Invents Act (AIA) apply to the claims of the '415 patent. *See* AIA, Pub. L. No. 112-29, § 3(n)(1), 125 Stat. 293 (2011).

The Board's decision in *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) does not persuade us to the contrary. In that case, the Board 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. *Ex parte Yamaguchi*, 88 USPQ2d at 1612. Similarly, in *In re Giacomini*, 612 F.3d 1380, 1384–85 (Fed. Cir. 2010), the Federal Circuit held that a patent applied in a rejection under § 102(e)(2) was prior art as of the filing date of its corresponding provisional application for commonly disclosed subject matter. Thus, unlike the situation presently before us, the references at issue in *Yamaguchi* and *Giacomini* were patents, one of the two types of documents that qualify as prior art under § 102(e). In contrast, as discussed above, a provisional application does not qualify as prior art under either § 102(e)(1) or § 102(e)(2).

In sum, because Lo I is neither a patent nor an application for patent published under 35 U.S.C. § 122(b), we conclude that Lo I does not qualify under 35 U.S.C. § 102(e) as prior art to the claims of the '415 patent. Every ground of unpatentability advanced by Petitioner in the Petition under consideration herein relies on Lo I. Pet. 5-6. We are not persuaded, therefore, that Petitioner has shown a reasonable likelihood of prevailing on any of its challenges to the '415 patent under consideration herein.

III. CONCLUSION

Upon consideration of the Petition, we are not persuaded, for the reasons discussed, that there is a reasonable likelihood that Petitioner would prevail on at least one alleged ground of unpatentability advanced in the Petition with respect to the claims of the '415 patent.

IV. ORDER

It is

ORDERED that the Petition is denied and no trial is instituted;

FURTHER ORDERED that Petitioner's motion for joinder is dismissed as moot.

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