

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC.,
Petitioner,

v.

RAINDANCE TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-01558
Patent 8,658,430 B2

Before MICHAEL P. TIERNEY, TINA E. HULSE, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

Patent Owner, RainDance Technologies, Inc., filed a request for rehearing (Paper 15, “Rehearing Req.”) of our Decision instituting *inter partes* review (Paper 13, “Dec.”) of claims 1–17 of U.S. Patent No. 8,658,430 B2 (Ex. 1001, “the ’430 patent”).

For the reasons that follow, we deny the request for rehearing.

ANALYSIS

When considering a request for rehearing, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

Patent Owner argues that the Board misapplied its discretion by instituting its own ground of obviousness for claims 1–7 and 12–17, that Patent Owner has had no opportunity to respond to the Board-created obviousness challenge, and that the Board’s creation of an obviousness theory is prejudicial because it is not the fixed target that a petition would provide. Rehearing Req. 1–9. We are not persuaded by Patent Owner’s arguments as they fail to point out what was misapprehended or overlooked.

The Decision was issued pursuant to the Board’s authority under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) and (c), which provide:

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.

35 U.S.C. § 314(a).

(a) When instituting *inter partes* review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.

(c) Sufficient grounds. *Inter partes* review shall not be instituted for a ground of unpatentability unless the Board decides that the petition supporting the ground would demonstrate that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.

The Board's decision will take into account a patent owner preliminary response where such a response is filed.

37 C.F.R. § 42.108(a), (c).

Under these provisions, the Board may institute *inter partes* review based on the information presented in the petition. That is, none of these provisions precludes the Board from instituting *inter partes* review of a challenged claim based on a ground of unpatentability that is implicitly, but not explicitly, raised in a petition.

Our reviewing court has held that the Board does not exceed its authority under the America Invents Act by considering whether challenged claims are unpatentable based on obviousness, where the petition asserts anticipation, but not obviousness, as to those claims. *SightSound Techs., LLC v. Apple Inc.*, ___ F.3d ___, 2015 WL 8770164, *4 (Fed. Cir. Dec. 15, 2015) (“the statute does not limit the Board’s authority at the final decision stage to grounds alleged in the CBM petitions”). Similarly, the court has held that the Board is not precluded from considering whether challenged claims are unpatentable based upon prior art that was cited in the petition, but not against the particular challenged claims. *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1273 (2015) (“the IPR statute [does not] expressly limit the Board’s authority at the final decision stage to the grounds alleged in the IPR petition”), *cert. granted sub nom. Cuozzo Speed Techs. v. Lee*, 84 U.S.L.W. 3218 (U.S. Jan. 15, 2016) (No. 15-446). These Federal Circuit decisions demonstrate that the Board does not exceed its statutory authority by instituting review of challenged claims based on a ground of unpatentability that is implicitly, but not explicitly, raised in a petition.

The Request for Rehearing incorrectly asserts that the Petition does not challenge claims 1–7 and 12–17 of the ’430 patent based on

obviousness. *See, e.g.*, Rehearing Req. 2. The pressure limitations of claim 1, Ex. 1001, 16:27–31, recite the same variable—pressure—that Petitioner asserts is results-effective for droplet size and involve the same design choice that Petitioner asserts would have been faced by a person of ordinary skill in the art, i.e., the choice between which type of channel to regulate—the carrier fluid channel or one or more of the aqueous fluid channels. Pet. 37–39; Ex. 1002 ¶¶ 108–10, 113–15. This obviousness theory was expressly raised as to claims 10 and 11, but as explained in the Decision, it applies equally to the pressure limitations of claim 1. Dec. 17. The Petition thus implicitly challenges claim 1 based on obviousness.

Patent Owner has had and will have a full and fair opportunity to respond to Petitioner’s implicitly raised obviousness challenge. The obviousness ground that is instituted as to claims 1–7 and 12–17 is based upon the same arguments and evidence that Petitioner presents with respect to anticipation of these claims and obviousness of claims 10 and 11. Dec. 17. Patent Owner addressed these arguments in its Preliminary Response, Prelim. Resp. 4, 16, 17, 21–27, 30–33, and the Board considered Patent Owner’s arguments before instituting *inter partes* review, Dec. 8–18. Patent Owner will have another full and fair opportunity to respond to these challenges in its Patent Owner Response. 35 U.S.C. § 316(a)(8).

By instituting review based on Petitioner’s implicitly raised obviousness ground, the Decision does not shift the burden of proof to Patent Owner. The burden remains with Petitioner to prove by a preponderance of the evidence that the challenged claims are unpatentable. 35 U.S.C. § 316(e).

IPR2015-01558
Patent 8,658,430 B2

We have considered Patent Owner's remaining arguments but do not find them persuasive.

CONCLUSION

Patent Owner's request for rehearing is *denied*.

IPR2015-01558
Patent 8,658,430 B2

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