

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILENT TECHNOLOGIES, INC.,
Petitioner,

v.

BIO-RAD LABORATORIES, INC.,
Patent Owner.

Case IPR2019-00266
Patent 8,236,504 B2

Before MICHELLE N. ANKENBRAND, *Acting Vice Chief Administrative Patent Judge*, SHERIDAN K. SNEDDEN, and ZHENYU YANG, *Administrative Patent Judges*.

ANKENBRAND, *Acting Vice Chief Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

Agilent Technologies, Inc. (“Petitioner”) filed a Petition (Paper 1 (“Pet.”)), requesting an *inter partes* review of claims 1–22 of U.S. Patent No. 8,236,504 B2 (“the ’504 patent,” Ex. 1201). We denied the Petition. Paper 8 (“Dec.”). Petitioner filed a request for rehearing of the Decision. Paper 9 (“Reh’g Req.”).

For the following reasons, we deny Petitioner’s request.

STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). A rehearing request “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d).

DISCUSSION

Kordunsky Grounds

Petitioner asserted in the Petition that Kordunsky anticipates claims 1–20 and 22 and that Kordunsky would have rendered obvious claim 21. Pet. 39–54. According to Petitioner, Kordunsky qualifies as prior art because the priority applications fail to provide written description support for the limitations “heating element”/“heater” recited in claims 1 and 13; a heating element with “a plurality of openings extending through” it, as recited in claim 1; and “a heater having a plurality of transparent portions to

permit optical communication” with each well, as recited in claim 13. *Id.* at 19–24. In our Decision denying the Petition, we determined that Petitioner failed to rebut Patent Owner’s showing that the priority applications provide adequate written description support for the above-noted claim limitations. Dec. 13–17.

In its rehearing request, Petitioner points out that in IPR2017-00054 (“the 54 IPR”), we found “Kordunsky qualified as prior art and instituted trial.” Reh’g Req. 9–10. Petitioner argues that we erred when we declined to do so here. *Id.* at 10–11. According to Petitioner, we misapprehended or overlooked that the record in IPR2017-00054 is “substantively the same” as the one here. *Id.* We disagree. As we explained in the Decision, and Petitioner acknowledges in the rehearing request, “our determination in the 54 IPR . . . was based on a different record and different arguments.” Dec. 16 n.10.

Petitioner contends that the 54 IPR petition “also included argument and evidence that the use of heaters, including heated lids, was ‘well-known.’” Reh’g Req. 10. As support, Petitioner refers to the statement in the 54 IPR petition that “[t]he skill level and knowledge of an artisan was exceptionally deep and rich.” *Id.* (quoting IPR2017-00054, Paper 3, 32). Petitioner, however, ignores that the assessment of the skill level there was specifically “with respect to the use of optics heads and scanning assemblies in real-time cyclers,” not the heater, the disputed component here. *See* 54 IPR, Paper 3, 32. Indeed, the 54 IPR petition argued, “it was a well-known and even typical practice to mount a movable shuttle on a support to provide a convenient attachment site for an optics head for scanning sample wells in a thermal cycler.” *Id.* at 33. It did not address the “heater.”

Petitioner also relies on the 54 IPR petition in arguing that “[t]hermal cyclers were not merely a matter of academic interest, but part of everyday life to artisans.” Reh’g Req. 10 (quoting IPR2017-00054, Paper 3, 32). A thermal cycler, however, is not the “heater” component at issue here. See, e.g., Ex. 1201, 15:2-15 (claim 1) (reciting “[a] fluorescence detection apparatus . . . comprising . . . a heating element”). We, thus, cannot equate that argument, directed to a thermal cycler, with Petitioner’s admission here that the “heater” is well-known.

Because both the Petition and the Preliminary Response in this case are different from those in the 54 IPR, we are not persuaded that we “misapprehended or overlooked that the records [in the two proceedings] were substantively the same.” Reh’g Req. 10–11.

Petitioner further argues that we “Misapprehended The Applicability Of Patent Owner’s Cited Cases.” Reh’g Req. 11. Specifically, Petitioner contends that “Patent Owner erroneously led the Board with its argument that there is a ‘well-known in the art’ exception to the written description requirement, relying on *Boston Scientific Corp. v. Johnson & Johnson*, 647 F.3d 1353 (Fed. Cir. 2011) and *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357 (Fed. Cir. 2006).” *Id.*

In our Decision, we agreed with Patent Owner that “a patent applicant need not describe information that is ‘well-known in the art’ in order to satisfy the written description requirement.” Dec. 14 (citing Prelim. Resp. 31 (quoting *Boston Sci.*, 647 F.3d at 1366)). We further explained that the Federal Circuit had set forth a number of factors for evaluating the adequacy of the disclosure for generic claims, including “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the

science or technology, [and] the predictability of the aspect at issue.” *Id.* at 14 (quoting *Ariad Pharm. Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). And we noted that Petitioner did not address the factors, whereas Patent Owner directed us to evidence in the record “indicating that the broader category of heaters was well-known before 2003, given the existing knowledge in the field, the extent and content of the prior art, and the maturity of the technology.” *Id.* at 15. Based on that evidence, we concluded, “the disclosure in the priority applications of a lid heater reasonably conveys to those of ordinary skill in the art that the inventor was in possession of the broader genus of a ‘heating element’/‘heater.’” *Id.* at 16.

Petitioner does not challenge our finding that it failed to address the relevant factors in its analysis.

Instead, Petitioner argues that

Boston Scientific addressed the sufficiency of a claimed “functional description” of genetic material and is directed to whether there was a “known . . . correlation” between the disclosed function and a known structure sufficient to support the patentee’s functional claiming. *See Boston Sci.*, 647 F.3d at 1366. It is in this limited context that the Court noted that “in some circumstances, a patentee may rely on information that is ‘well-known in the art’ for purposes of meeting the written description requirement.” *Id.*

Reh’g Req. 12 (emphasis in original removed).

We do not read *Boston Scientific* so narrowly; apparently, nor does the Federal Circuit. Indeed, as recently as this past August, the Federal Circuit cited the case for the same proposition that we relied on in our Decision. *Ajinomoto Co. v. Int’l Trade Comm’n*, 932 F.3d 1342, 1359 (Fed. Cir. 2019) (citing *Boston Sci.*, 647 F.3d at 1366). In *Ajinomoto*, the claim-at-issue

recited “replacing the native promoter . . . with a more potent promoter.” *Id.* at 1347. The patent challenger argued that the claim lacked an adequate written description of a “more potent promoter.” *Id.* at 1358. The Federal Circuit disagreed. *Id.* The court explained that because the challenged patent discloses four examples of “potent promoters,” and “the genus of more potent promoters was already well explored in the relevant art,” the claim is not invalid for lack of an adequate written description. *Id.* at 1359. In so doing, the court reiterated that “a patentee may rely on information that is ‘well-known in the art’ for purposes of meeting the written description requirement,” because “the specification is viewed from the perspective of one of skill” in the relevant art. *Id.* (quoting *Boston Sci.*, 647 F.3d at 1366).

In sum, Petitioner has not shown that we abused our discretion in rejecting the anticipation challenge.

Obviousness Grounds

Petitioner also asserted in the petition that the challenged claims would have been obvious over various combinations of prior art teachings. Pet. 56–80. In our Decision denying the Petition, we found Petitioner merely provided “generic rationales” that “fail to explain adequately why a skilled artisan would have been led to combine the elements from the references in the precise fashion that is specified in the claims.” Dec. 23 (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)). In its rehearing request, Petitioner argues that we overlooked and misapprehended the strong evidence of motivation to combine presented in the Petition. Reh’g Req. 3. We are not persuaded.

As one example, Petitioner points to its argument in the Petition that “[t]his field was a competitive one in which a POSITA would be motivated

to improve similar and related devices.” *Id.* at 4 (quoting Pet. 57). But a generalized desire to improve existing devices is different from a specific reasoning to combine the prior art asserted in this proceeding. *See Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 381 F.3d 1371, 1377 (Fed. Cir. 2004) (“Recognition of a need does not render obvious the achievement that meets that need.”).

As another example, Petitioner also points to its argument in the Petition that “[a] POSITA would also have recognized the compatibility of these references and the ability to combine salient features of each with reasonable expectation of success.” Reh’g Req. 5 (quoting Pet. 58–59). We rejected similar arguments in our Decision denying the Petition. Dec. 24. We reiterate that “obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk–Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015); *see also Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993–94 (Fed. Cir. 2017) (explaining the fact that the references could be combined “does not imply a motivation to pick out those . . . references and combine them to arrive at the claimed invention”).

Petitioner argues that “advantages and benefits of prior art combinations support motivation to combine.” Reh’g Req. 8. In that regard, Petitioner merely asserted that an ordinarily skilled artisan “would have recognized the advantages . . . and the ability to combine them.” Pet. 58. Petitioner, however, failed to explain adequately what teachings or elements of each reference one of ordinary skill in the art would have combined to arrive at the claimed subject matter. For example, the Petition asserts that Li

discloses each of the elements that the challenged claims require. *Id.* at 56. Thus, the Petition does not explain adequately which limitation or limitations Li does not teach, and why and how the other asserted references supply the missing limitation.

Accordingly, in view of the foregoing, Petitioner does not persuade us that we overlooked and misapprehended the Federal Circuit case law, or that we abused our discretion in rejecting Petitioner's obviousness challenges.

CONCLUSION

In sum, we determine that, in its Petition, Petitioner did not establish a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claims. On rehearing, Petitioner does not persuade us that our decision was based on an erroneous conclusion of law or clearly erroneous factual findings. Accordingly, we conclude that Petitioner has not demonstrated that we abused our discretion in denying institution of the challenged claims.

ORDER

It is

ORDERED that Petitioner's request for rehearing is *denied*.

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