

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 IPR2019-00268
Patent 8,835,118 B2

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

YANG, *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.”)), seeking an *inter partes* review of claims 1–16 of U.S. Patent No. 8,835,118 B2 (“the ’118 patent,” Ex. 1401). 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

Anticipation by Kordunsky

Petitioner argues that the challenged claims are anticipated by Kordunsky. Pet. 39–49. According to Petitioner, Kordunsky qualifies as prior art because the priority application fails to provide written-description support for the limitations “heater” and “a plurality of openings,” recited in claim 1. *Id.* at 20–24. In our Decision denying the Petition, we determined Petitioner has not met its burden in showing that Kordunsky qualifies as prior art. Dec. 7–14.

In its rehearing request, Petitioner points out that in IPR2017-00054, 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.¹ *Id.* We disagree.

As we explained in the Decision, “the record here is decisively different from that of IPR2017-00054:”

Specifically, in that case, Patent Owner argued that we should limit “heater” to the lid heater as disclosed in the ’504 patent. IPR2017-00054, Paper 7, 6–9. Patent Owner’s entire argument regarding the written-description support for “heater,” and thus, the priority date of the challenged claims, hinged on that proposed claim construction. *Id.* at 13–19. Because the Board rejected Patent Owner’s construction of “heater,” the Board concluded—based on that record, and for purposes of that decision to institute—the petitioner in that case had met its burden of persuasion. IPR2017-00054, Paper 8, 6–10. In contrast, here, Patent Owner does not insist on limiting the “heater” to a lid heater. Prelim. Resp. 18. Instead, Patent Owner relies on Petitioner’s admission that “heaters” were well-known in the art in defending the claimed priority date (*id.* at 31–34), an argument we find persuasive.

Dec. 13.

Petitioner contends that the petition in IPR2017-00054 “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

¹ In its rehearing request, Petitioner does not challenge our conclusion that “Patent Owner has shown that the [priority] application provides adequate written description support for a ‘heater having a plurality of openings.’” See Dec. 14.

statement in the IPR2017-00054 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* IPR2017-00054, Paper 3, 32. Indeed, the IPR2017-00054 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 IPR2017-00054 petition for 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 the claimed apparatus, not the “heater” component at issue here. *See* Ex. 1001, claim 1 (reciting “[a] thermal cycler apparatus comprising” . . . “a heater”). We, thus, cannot equate that argument, directed to the claimed invention as a whole, with Petitioner’s admission that the “heater” is well-known here.

Because both the Petition and the Preliminary Response in this case are different from those in IPR2017-00054, 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 we erred in relying on *Boston Scientific Corp. v. Johnson &*

Johnson, 647 F.3d 1353 (Fed. Cir. 2011) and *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357 (Fed. Cir. 2018). *Id.* at 11–13.

In our Decision, we agreed with Patent Owner that “a patentee may rely on information that is ‘well-known in the art’ for purposes of meeting the written description requirement.” Dec. 10 (quoting *Boston Sci.*, 647 F.3d at 1366). We concluded that “[b]ecause Patent Owner has pointed to evidence showing that the [priority] application discloses a lid heater, a type of ‘heater,’ and that—as Petitioner admits—the broader genus of heaters were well-known at the relevant time,” “Petitioner has not sufficiently persuaded us that Kordunsky qualifies as prior art because of the lack of written-description support for ‘heater.’” *Id.* at 12 (citing *Hologic*, 884 F.3d at 1361–62).

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.

We do not read *Boston Scientific* so narrowly; apparently, nor does the Federal Circuit. Indeed, as recent 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 recites “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. Even though it was out of the context Petitioner asserts *Boston Scientific* should be limited to, 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).

Petitioner also attempts to distinguish *Hologic*. Reh’g Req. 13. In *Hologic*, the Federal Circuit held that there is sufficient written-description support for a “light guide” because (1) the disclosure of the priority application describes a “fibre optics bundle,” a type of “light guide,” and (2) various types of light guides were well-known in the art. *Hologic*, 884 F.3d at 1361–62. Petitioner contends that “in *Hologic*, it was undisputed that another type of ‘light guide’ could perform the function of the ‘fibre optic bundle.’” Reh’g Req. 13. Here, however, Petitioner continues, “a generic ‘heater’ does not satisfy the remaining claim elements, nor . . . would it be capable of performing the function of the disclosed ‘lid heater,’ such as preventing condensation on the lids.” *Id.* We are not persuaded.

First, the challenged claims do not recite a heater to “prevent[] condensation on the lids.” Second, Petitioner does not explain what other

“remaining claim elements” a generic heater does not satisfy. Thus, we are not persuaded by Petitioner’s attempt to distinguish *Hologic*.

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

Obviousness Grounds

Petitioner also argues that the challenged claims would have been obvious over various combinations of prior art teachings. Pet. 49–72. In our Decision denying the Petition, we found “Petitioner merely offer[ed] general statements regarding the reason to combine the teachings of the prior art,” and those “‘generic motivations with no specificity’ fall short of the articulated rationale required.” Dec. 19 (quoting Prelim. Resp. 41). 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. 2–3. 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 5 (quoting Pet. 51). 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. 4 (quoting Pet. 51). We

rejected similar arguments in our Decision denying the Petition. Dec. 18–19. 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”).

In addition, although Petitioner argues that “advantages and benefits of prior art combinations support motivation to combine” (Reh’g Req. 8), the cases Petitioner relies on do not support the arguments in the Petition. Indeed, the Petition contends that Li discloses every limitation of claim 1 without explaining “which limitation is lacking in Li’s teaching, and why and how the teachings of the other references would supply the missing link.” Dec. 18. Thus, we are also not persuaded by Petitioner’s argument that we overlooked and misapprehended the Federal Circuit case law.

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

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,

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we conclude that Petitioner has not demonstrated that we abused our discretion in denying institution of the challenged claims.

ORDER

Accordingly, it is

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

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