

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEUMODX MOLECULAR, INC.,
Petitioner,

v.

HANDYLAB, INC.,
Patent Owner.

IPR2020-01133
Patent 8,415,103 B2

Before SHERIDAN K. SNEDDEN, JO-ANNE M. KOKOSKI, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

NeuMoDx Molecular, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–15 (the “challenged claims”) of U.S. Patent No. 8,415,103 B2 (“the ’103 patent,” Ex. 1200). Paper 2 (“Pet.”). HandyLab, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 20 (“Prelim. Resp.”).

In our Decision (Paper 21, “Decision” or “Dec.”) denying institution of *inter partes* review, we exercised our discretion to deny institution of the challenged claims on the following grounds:

Claims Challenged	35 U.S.C.	References/Basis
1–15	§ 102(e)	Handique-Publ’941, ¹ Handique-Prov’284 ²
1–15	§ 102(b)	Ganesan-Publ’424 ³
1–15	§ 103	Ganesan-Publ’424, Jensen, ⁴ Kellogg, ⁵ Yoon ⁶
1–15	§ 102(e)	Handique-Publ’941, Handique-Prov’007 ⁷

Specifically, we determined that Petitioner established a reasonable likelihood of establishing that the challenged claims are anticipated by

¹ U.S. Patent App. Pub. No. 2007/0292941 A1, published Dec. 20, 2007 (Ex. 1205).

² U.S. Provisional App. No. 60/859,284, filed Nov. 14, 2006 (Ex. 1206).

³ U.S. Patent App. Pub. No. 2005/0084424 A1, published Apr. 21, 2005 (Ex. 1109).

⁴ U.S. Patent App. Pub. No. 2006/0246493 A1, published Nov. 2, 2006 (Ex. 1115).

⁵ WO 00/078455 A1, published Dec. 28, 2000 (Ex. 1055).

⁶ U.S. Patent App. Pub. No. 2005/0112754 A1, published May 26, 2005 (Ex. 1118).

⁷ U.S. Provisional App. No. 60/786,007, filed March 24, 2006 (Ex. 1207).

Handique-Prov’284, which is incorporated by reference in Handique-Publ’941, but did not establish a reasonable likelihood of prevailing on the other asserted grounds. Dec. 18–19, 21. We concluded that “instituting a trial with respect to all four grounds based on evidence and arguments directed to one ground based on a reference that Patent Owner may try to antedate is not an efficient use of the Board’s time and resources,” and “that, in the interests of efficient administration of the Office and integrity of the patent system, the entire Petition should be denied.” *Id.* at 23–24. Accordingly, we declined to institute trial on the challenged claims of the ’103 patent.

Petitioner filed a request for rehearing (Paper 22, “Rehearing Request” or “Reh’g Req.”) of our Decision. In the Rehearing Request, Petitioner contends that we erred in our Decision in that we failed to view the evidence in the light most favorable to Petitioner. Reh’g Req. 5–7. Petitioner also contends that we unreasonably exercised our discretion to deny institution of review. *Id.* at 7–8. Finally, Petitioner contends that we misapprehended the law relative to incorporation by reference with respect to Petitioner’s challenges based on Ganesan-Publ’424. *Id.* at 8–15.

We have considered the arguments presented by Petitioner in the Rehearing Request and conclude that we misapprehended the law of incorporation by reference when evaluating the grounds based on Ganesan-Publ’424, and that the Petition sets forth sufficient grounds and evidence to justify institution of trial.⁸ We, therefore, grant Petitioner’s Rehearing

⁸ Because our determination that we misapprehended the law of incorporation by reference is dispositive, we need not address Petitioner’s other arguments in the Rehearing Request.

Request and institute an *inter partes* review of claims 1–15 of the ’103 patent on all the grounds asserted in the Petition.

II. ANALYSIS

A. Standard of Review

A request for rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

37 C.F.R. § 42.71(d). Petitioner, as the party challenging the Decision, has the burden of showing that the Decisions should be modified. *Id.* When rehearing a decision on a petition, the Board reviews the decision for an abuse of discretion. *Id.* § 42.71(c). “An abuse of discretion occurs if the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 442 (Fed. Cir. 2015).

B. Anticipation by Ganesan-Publ’424

Petitioner contends that Ganesan-Publ’424 anticipates claims 1–15 of the ’103 patent. Pet. 31–52. In the Decision, we determined that Petitioner did not show a reasonable likelihood of establishing that Ganesan-Publ’424 discloses “placing the microfluidic cartridge in thermal communication with an array of independent heaters” as recited in claim 1. Dec. 18–19. In particular, we disagreed with Petitioner that Ganesan-Prov’284,⁹ which is

⁹ U.S. Provisional App. No. 60/491,264, filed July 31, 2003 (Ex. 1208).

incorporated by reference into Ganesan-Publ'424, necessarily forms a part of Ganesan-Publ'424 for purposes of anticipation. *Id.* at 17–18. As a result, the Decision did not address Petitioner's contentions with regard to Ganesan-Prov'284 in determining whether Petitioner established a reasonable likelihood of showing that Ganesan-Publ'424 anticipates the challenged claims. *Id.* at 18.

Petitioner argues that our finding that “Ganesan-Publ'424 only ‘generally incorporates’ Ganesan-Prov'264, and did not ‘identif[y] with particularity’ any specific subject matter from Ganesan-Prov'264 . . . misapprehended the law of incorporation by reference in a way that is contrary to both Federal Circuit precedent and other Board decisions.” Req. Reh'g 10 (citing Dec. 18; *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000)). In particular, Petitioner argues that *Advanced Display*'s statement that “[t]o incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents” (212 F.3d at 1282)

does ***not*** mean that the host document must identify some specific subject matter or subpart of the incorporated document (such as by page/line). Rather, the quoted statement simply means that the host document must clearly identify what is being incorporated and where it can be found—even when the incorporation applies to the entire document.

Req. Reh'g 10. According to Petitioner, “Ganesan-Publ'424 identifies with particularity both what is incorporated” and where it can be found. *Id.* at 12 (citing Ex. 1109, ¶ 1).

In relevant part, Ganesan-Publ'424 states: “The present application also claims the benefit of U.S. provisional application No. 60/491,264, filed

Jul. 31, 2003 [Ganesan-Prov’264], 60/491,539, filed Aug. 1, 2003, 60/491,269, filed Jul. 31, 2003 60/551,785, filed Mar. 11, 2004, and 60/553,553, filed Mar. 17, 2004. *All of the foregoing applications are incorporated herein by reference.*” Ex. 1109 ¶ 1 (emphasis added). The second sentence of this passage identifies the material subject to incorporation (the entirety of the identified applications, not just particular portions thereof), and where it can be found (in the identified applications). Our reviewing court has held that this type of language “is plainly sufficient to incorporate” the identified applications in their entirety. *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 907 (Fed. Cir. 2018) (citing *Harari v. Lee*, 656 F.3d 1331, 1335–36 (Fed. Cir. 2011)). In particular, in *Paice* the court found that similar language indicating that another patent “is incorporated herein by this reference” was broad and unambiguous, and plainly sufficient to incorporate the referenced patent in its entirety. *Id.* Applying that standard here, we determine that Ganesan-Publ’424 sufficiently identifies Ganesan-Prov’264 such that the disclosures in Ganesan-Prov’264 are part of Ganesan-Publ’424 for purposes of anticipation, and that we erred in finding otherwise in the Decision.

We turn now to Petitioner’s contentions with regard to Ganesan-Prov’284 to determine whether Petitioner establishes a reasonable likelihood of showing that Ganesan-Publ’424 anticipates the challenged claims.

1. “placing the microfluidic cartridge in thermal communication with an array of independent heaters”

In the Decision, we were not persuaded by Petitioner’s argument that Ganesan-Publ’424 disclosed “placing the microfluidic cartridge in thermal communication with an array of independent heaters” as required by the

challenged claims. Dec. 14–19. In particular, we determined that Petitioner did not establish that the heaters depicted in Ganesan-Publ’424’s Figures 3 and 11 meet this limitation. *Id.* at 15–18. We do not modify that determination here.

Petitioner also contends that Ganesan-Prov’264, which is incorporated by reference into Ganesan-Publ’424, discloses heaters/sensors that are formed separately from the microfluidic device, including an embodiment where “one or more heater/sensors may be formed as part of a device configured to operatively receive a microfluidic device.” Pet. 42 (citing Ex. 1208, 12:20–25). According to Petitioner, a person of ordinary skill in the art “recognizes that the heater array of Ganesan-Publ’424 may be formed integrally with the network-containing microfluidic substrate, or may be formed separately in a testing device into which the microfluidic substrate is placed or another part of the system.” *Id.* at 43 (citing Ex. 1109 ¶ 79; Ex. 1208, 12:20–25; Ex. 1101, ¶¶ 344–345).

Patent Owner responds that the portion of Ganesan-Prov’264 on which Petitioner relies “provides only a general discussion of positioning heater/sensors without any reference to any specific structure or embodiment of Ganesan-Prov’264.” Prelim. Resp. 30 (citing Ex. 2016 ¶ 87). Patent Owner also faults Petitioner for not providing an “explanation of how or why a [person of ordinary skill] would combine this general disclosure with any particular embodiment of Ganesan-Publ’424, or what specific arrangement a [person of ordinary skill] would ‘at once envisage’ in view of the section of Ganesan-Prov’264’s cited by Petitioner.” *Id.* at 30–31 (citing Ex. 2016 ¶ 88). Patent Owner argues that Petitioner does not “articulate any rationale for how, or why, these different embodiments could be combined

to support anticipation—*e.g.*, how or why the arrangement of features between different microfluidic devices (for example, the different microfluidic layouts and number of PCR reactions chambers in Ganesan-Publ’424 Fig. 3 and Fig. 11) are combinable.” *Id.* at 31 (citing Pet. 39, 41, 44, 52; Ex. 1001 ¶¶ 341, 347, 367–369; Ex. 2016 ¶ 89).

As explained above, Ganesan-Publ’424 describes Ganesan-Prov’264 with sufficient particularity such that the entirety of Ganesan-Prov’264 is incorporated therein, and Ganesan-Prov’264 forms a part of Ganesan-Publ’424 for purposes of anticipation. Ganesan-Prov’264 “relates generally to techniques for thermal control of microfluidic devices.” Ex. 1208, 2:29–30. Ganesan-Prov’264 teaches that “heater/sensors in accordance with the invention may be integral with a microfluidic device *or separate from a microfluidic device*,” and “*may be formed separately* from the microfluidic device.” *Id.* at 12:16–21 (emphases added). Ganesan-Prov’264 further teaches that “one or more heater/sensors may be formed as part of a device configured to operatively receive a microfluidic device,” and “[t]he device may include one or more heater sensors positioned to be in thermal contact with portions of the operatively received microfluidic device.” *Id.* at 12:21–26. Based on these teachings, Petitioner’s declarant, Dr. Mark Burns, testifies that “the heater array of Ganesan-Publ’424 may be formed integrally with the network-containing microfluidic substrate, or may be formed separately in a testing device into which the microfluidic substrate is placed or another part of the system.” Ex. 1101 ¶ 345 (citing Ex. 1109 ¶ 79; Ex. 1208, 12:20–25).

Because Ganesan-Prov’264 teaches that heater/sensors can be formed in the device configured to receive the microfluidic device such that the

heater/sensors are in thermal contact with portions the microfluidic device, we are persuaded that Petitioner sufficiently shows that Ganesan-Publ'424 (which incorporates the disclosures of Ganesan-Prov'264) discloses “placing the microfluidic cartridge in thermal communication with an array of independent heaters” as recited in independent claims 1 and 15. Petitioner is not improperly “conflat[ing] the disclosure of unrelated embodiments within and between” Ganesan-Publ'424 and Ganesan-Prov'264 as Patent Owner argues, because Petitioner’s argument is based on what Ganesan-Publ'424 expressly teaches (by way of its incorporation of Ganesan-Prov'264), and not on a combination of different embodiments. Prelim. Resp. 25.

2. Conclusion

We reviewed all of Petitioner’s assertions regarding the elements of independent claims 1 and 15, as well as the supporting evidence, and we determine, on this record, that Petitioner demonstrates a reasonable likelihood of establishing that they are anticipated by Ganesan-Publ'424. Pet. 37–44, 51–52. We also considered the arguments and evidence with respect to dependent claims 2–14, and determine that Petitioner demonstrates a reasonable likelihood that it would prevail as to those claims as well. Pet. 45–51.

C. Discretionary Denial Under 35 U.S.C. § 314(a)

Under 35 U.S.C. § 314(a), the Director has discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question *whether* to institute review.”); *Harmonic v. Avid*

Tech., Inc., 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

In determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a), the Board considers an early trial date in related litigation as part of an assessment of all relevant circumstances of the case, including the merits, in an effort to balance considerations such as system efficiency, fairness, and patent quality. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”); *see also NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, 19–20 (PTAB Sept. 12, 2018) (precedential) (denying institution relying, in part, on § 314(a) because the parallel district court proceeding was scheduled to finish before the Board reached a final decision).

When considering an early trial date in related litigation, the Board evaluates the following factors (“*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv Order 5–6. In evaluating these factors, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny institution due to the common issues being litigated in parallel district court cases. Prelim. Resp. 40–50.¹⁰ We have considered the circumstances and facts before us in view of the *Fintiv* factors and determine that the circumstances presented here weigh against exercising discretion under § 314(a) to deny institution of *inter partes* review.

1. Likelihood of a Stay

Petitioner and Patent Owner are concurrently engaged in a parallel district court proceeding involving the '103 patent. *See Becton, Dickinson and Co., et al. v. NeuMoDx Molecular, Inc.*, No. 1:19-cv-1126 (D. Del.). The District Court has not granted a stay, Petitioner has not requested a stay, and there is no evidence suggesting that a stay might be requested or granted if an *inter partes* review were initiated. Prelim. Resp. 44–45. Furthermore, a judge determines whether to grant a stay based on the facts of each specific case as presented in the briefs by the parties. We decline to infer, based on actions taken in different cases with different facts, how the district court would rule should a stay be requested by the parties in the parallel case here. Thus, we find this factor to be neutral.

¹⁰ Our Rules provide Petitioner with the opportunity to seek leave to file a reply brief addressing Patent Owner's arguments on discretionary denial under 35 U.S.C. § 314(a). *See* 37 C.F.R. § 42.108(c) ("A petitioner may seek leave to file a reply to the preliminary response . . ."). However, Petitioner did not do so.

*2. Proximity of Trial Date to the
Board's Projected Statutory Deadline*

According to Patent Owner, trial for the parallel litigation is scheduled to begin on April 11, 2022. Prelim. Resp. 45. We note, however, that the parties recently filed a Stipulation and Proposed Order to Extend Case Schedule, pushing the trial to December 2022, which the district court granted. Ex. 3001. Given the statutory deadlines, our latest possible date for issuance of a final written decision in this proceeding is in July, 2022, one year after we issue this decision instituting an *inter partes* review. 35 U.S.C. §§ 314(c), 316(a)(11); *see also* 37 C.F.R. § 42.100(c). Thus, our final written decision would issue at least four months before trial.

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv* Order 9. We find that this factor weighs strongly against exercising discretion to deny institution.

3. Investment in Proceedings

Patent Owner argues that because the parties and the court have invested substantial resources in the parallel litigation, institution “would only create duplicative costs, [and] this factor weighs against institution.” Prelim. Resp. 47–48. Specifically, Patent Owner contends that

Defendants served invalidity contentions on October 2, 2020 and the parties are nearing the end of the *Markman* process—briefing will conclude on February 1, 2021 and the *Markman* hearing is scheduled for February 23, 2021. The invalidity contentions assert the same prior art references that are at issue in the current Petition. The parties and court will shortly make additional investments in the parallel litigation, including: substantially completing document production by January 29, 2021; completing fact discovery on April 28, 2021; completing

expert discovery on September 3, 2021; and filing dispositive motions on October 15, 2021. In short, by the time a final written decision is expected in April 2022, trial will be imminent or will have just been completed.

Prelim. Resp. 47–48.

We have considered Patent Owner’s position but note that, although there has been some investment in the parallel litigation, it appears that considerable effort remains to be completed. In particular, under the extended schedule, fact discovery is still ongoing and important deadlines, such as the filing of final invalidity contentions, have not yet occurred. Expert discovery will not close until June 2022. On balance, given this level of investment by the parties and the court, we find that this factor weighs against exercising discretion to deny institution.

4. Overlap of Issues

Based on the facts provided in the record, we are unable to ascertain independently the level of overlap between the claims and issues raised in the Petition and the parallel proceeding. We acknowledge, however, Patent Owner’s contention that “Petitioner has presented the same art to challenge the same claims in the parallel proceeding.” Prelim. Resp. 49. Based on the record before us and the representations made by Patent Owner, we determine that this factor on balance weighs in favor of exercising discretion to deny.

5. Whether the Petitioner and the Defendant in the Parallel Proceeding are the Same Party

The parties in this proceeding are identical to the parties in the parallel litigation. Because the final written decision in this case will issue before

trial in the parallel litigation, this factor weighs against exercising discretion to deny institution.

6. Other Circumstances, Including the Merits

The factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the merits. *Fintiv* Order 14. For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution. *Id.* at 14–15. By contrast, if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present. *Id.* at 15.

Patent Owner contends that its Preliminary Response “demonstrates why the petition fails on the merits, or at the very least that Petitioner’s case is ‘a close call’ that ‘weigh[s] in favor of discretionary denial.’” Prelim. Resp. 50 (citing *Fintiv* Order 15–16).

We have considered Patent Owner’s Preliminary Response in its entirety, but are nevertheless persuaded that the merits of Petitioner’s challenges have a reasonable likelihood of success, as discussed herein and in the Decision. *See* Dec. 21–22. Accordingly, the sixth *Fintiv* factor is neutral.

7. Conclusion

Considering all the factors together as a whole, we determine under the particular circumstances of this case, the interests of efficiency and integrity of the patent system do not sufficiently tilt toward invoking our discretionary authority under § 314(a) to deny institution of the Petition.

D. Discretionary Denial Pursuant to 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 325(d) to deny institution because “[a]rt analogous to the art relied upon by Petitioner . . . was already considered and distinguished during prosecution of the ’103 patent.” Prelim. Resp. 37.

1. Legal Framework

Section 325(d) provides that, in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” The Board uses a two-part framework for evaluating arguments under § 325(d):

(1) determining whether the same or substantially the same art previously was presented to the Office, or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). In applying this framework, we consider the *Becton, Dickinson*¹¹ factors that address discretion to deny when a petition present the same or substantially the same prior art or arguments previously presented to the Office, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated

¹¹ *Becton, Dickinson & Co. v. B. Braun Mesungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, Paper 8 at 17–18. If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relates to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the claims. *Advanced Bionics*, Paper 6 at 10.

2. Analysis

As to the first part of the relevant framework, Patent Owner contends that Petitioner relies “on a configuration in Ganesan-Publ’424 with heaters integrated in the cartridge unit, which is analogous to that which was already considered and distinguished during prosecution of the ’103 patent.” Prelim. Resp. 40. In particular, Patent Owner contends that the “placing the microfluidic cartridge in thermal communication with an array of independent heaters” limitation of claims 1 and 15 was added to overcome the Examiner’s rejections based on U.S. Patent No. 6,334,980 (“Hayes”), which “teaches a ‘compact unitary reaction and analysis chamber’ wherein ‘the heaters and reaction chambers used in Hayes are part of the same cassette.’” *Id.* at 39–40 (citing Ex. 1201, 2–8; Ex. 1202, 3–7; quoting Ex. 1202, 7). Therefore, according to Patent Owner, arguments similar to Petitioner’s argument that Ganesan-Publ’424 anticipates claims 1–15 of the

'103 patent were already considered by the Examiner during prosecution.
Id. at 37.

In the Decision, we evaluated the Examiner's rejection based on Hayes, and the applicant's response thereto, and agreed with Patent Owner that the "placing the microfluidic cartridge in thermal communication with an array of independent heaters" limitation of claims 1 and 15 does not include heaters that are integrated in the microfluidic device. Dec. 8–11. We then determined that Ganesan-Publ'424's Figures 3 and 11, which integrate an array of independent heaters in a microfluidic device like that disclosed in Hayes, do not meet the "placing the microfluidic cartridge in thermal communication with an array of independent heaters" limitation of the claims. *Id.* at 15–17. Accordingly, we agree with Patent Owner that Petitioner's arguments regarding Ganesan-Publ'424's configuration with heaters integrated in the cartridge unit (shown in Ganesan-Publ'424's Figures 3 and 11) are cumulative to arguments made by the applicant during prosecution regarding Hayes.

However, there is not complete overlap between the arguments made during examination and the manner in which Petitioner relies on Ganesan-Publ'424 here. Petitioner also argues that Ganesan-Prov'264, which is incorporated by reference into Ganesan-Publ'424, discloses "placing the microfluidic cartridge in thermal communication with an array of independent heaters." *See* Pet. 42–43; *supra* Section II.B.1. Patent Owner does not contend that Petitioner's arguments regarding Ganesan-Prov'264's disclosures were previously considered by the Office.

Accordingly, Petitioner's contention that Ganesan-Publ'424 anticipates the claims of the '103 patent includes some cumulative

arguments, but also includes arguments that are not cumulative of those previously presented to Office. We also determined that Petitioner establishes a reasonable likelihood of prevailing with respect to at least one other ground presented in the Petition that does not include cumulative arguments. *See* Dec. 21–22. Thus, overall, we find that substantially the same arguments were not previously presented. When considering the Petition as a whole, we find that it does not sufficiently implicate the concerns addressed by § 325(d) to warrant discretionary denial. Because the first part of the framework of *Advanced Bionics* is not met, we need not reach “whether the Petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics*, Paper 6 at 8–9.

III. CONCLUSION

For the reasons expressed above and in the Decision (Dec. 11–21), we determine that Petitioner has demonstrated a reasonable likelihood of showing that the challenged claims are unpatentable under two of the four ground asserted by Petitioner. In accordance with the Court’s decision in *SAS* (138 S.Ct. at 1359–60) and Office policy, we institute an *inter partes* review of all challenged claims of the ’103 patent on all grounds in the Petition. *See* Guidance on the Impact of SAS on AIA Trial Proceedings (Apr. 26, 2018), <https://www.uspto.gov/patents/ptab/trials/guidance-impact-sas-aia-trial> (“If the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”).

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is

instituted. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner's burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”) (quoting 35 U.S.C. § 314(a) and comparing *id.* § 316(e)). Our final decision will be based on the record as fully developed during trial. Thus, our view with regard to any conclusion reached in the foregoing could change upon consideration of Patent Owner’s merits response and upon completion of the current record.

IV. ORDER

In view of the foregoing, it is:

ORDERED that Petitioner’s Request for Rehearing is *granted*;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–15 of the ’103 patent is instituted as to all grounds set forth in the Petition; and

FURTHER ORDERED, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of a trial, which commences on the entry date of this Order.

IPR2020-01133
Patent 8,415,103 B2

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