

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIO-RAD LABORATORIES, INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

IPR2024-01178
Patent 10,770,170 B2

Before GRACE KARAFFA OBERMANN, TAWEN CHANG, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Petitioner Bio-Rad Laboratories, Inc. requests rehearing of our Decision denying institution of *inter partes* review (Paper 10). Paper 11 (“Request” or “Req.”).

In the Decision, we determined that Petitioner had not shown that all of the portions of Saxonov that Petitioner relied on in its unpatentability arguments qualify as prior art to the challenged claims. *See* Dec. 17–24. On this basis, we found that Petitioner failed to demonstrate a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’170 patent.

Petitioner requests rehearing of the Decision, arguing that “the Board effectively overlooked entire grounds, specifically Grounds 6-10.” Req. 4. According to Petitioner, “the Board assumed—without any analysis—that because institution could be denied for Ground 1 because certain portions of Saxonov were not prior art, institution could be denied for Grounds 6-10 for the same reason.” *Id.* at 1. Petitioner contends that Grounds 6–10 are materially different from Ground 1 because they are “based on the **combination** of Saxonov with another reference—Larson,” and “the invalidity analysis for the key claim elements relies upon **Larson**, not Saxonov.” *Id.* at 1–2. Petitioner asserts that “Grounds 6-10 are fully supported by prior art disclosure that the Board did not consider,” and the Board should “correct this error and grant rehearing.”¹ *Id.* at 2.

For the reasons explained below, we *deny* Petitioner’s Request.

¹ Petitioner does not seek rehearing of our analysis of grounds that do not include Larson (i.e., Grounds 1–5), or our finding that at least certain portions of Saxonov do not qualify as prior art. *See generally* Req.

II. STANDARD OF REVIEW

A party requesting rehearing of a Board decision has the burden to show that the decision should be modified. Pursuant to 37 C.F.R.

§ 42.71(d), a rehearing request must identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed. When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if: (1) a decision is based on an erroneous interpretation of law, (2) a factual finding is not supported by substantial evidence, or (3) an unreasonable judgment is made in weighing relevant factors. *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

III. ANALYSIS

Petitioner argues that the Board erred in denying institution of Grounds 6–10 based on our determination that portions of Saxonov are not prior art. *See* Req. 1. More specifically, Petitioner argues that the Board erred by (i) not analyzing those portions of Saxonov cited in Grounds 6–10 that qualify as prior art (*see, e.g.*, Req. 5); and (ii) not appreciating that the Petition’s citations to the non-prior art portions of Saxonov are unnecessary because Grounds 6–10 are fully supported by citations to prior art material (i.e., Larson and/or the non-disputed portions of Saxonov) (*see, e.g.*, Req. 11, 12–13).

Petitioner’s Request is unavailing. As an initial matter, Petitioner does not persuade us that the presence of Larson in Grounds 6–10 renders our analysis in the Decision inapplicable to Grounds 6–10. Larson notwithstanding, Ground 6 expressly builds on Ground 1. *See, e.g.*, Pet. 58 (asserting that Ground 6 “is identical to Ground I in all respects except that the teachings of Larson are used for three claim elements”), 60 (arguing that

a person of ordinary skill in the art “would have been motivated to rely on the related teachings of Larson, *if necessary, to modify Saxonov*”) (emphasis added), 63–64 (cross-referencing Pet. Ground 1 at Sections X.A.2 and X.A.4). Indeed, Petitioner admits in its Request that for several limitations, Ground 6 expressly “relies upon the evidence set forth in Ground 1.” Req. 6; *see also id.* at 10 (“Ground 6 relies on the same disclosure as in Ground 1.”), 12 (same), 13 (same). Importantly, Petitioner also admits that Ground 6 expressly cites portions of the non-prior art material in Saxonov (either directly or via cross-reference to Ground 1). *See id.* at 9, 10, 11, 12–14.

Ground 6, like Ground 1, also relies on citations to the non-prior art material in Saxonov. The Petition nowhere disavows any part of Ground 1 for purposes of Ground 6. *See generally* Pet. Accordingly, even if our Decision identified deficiencies only in Grounds 1–5 as Petitioner asserts (Req. 1–2), those same deficiencies permeate Grounds 6–10. This alone provides sufficient basis for applying our findings in the Decision regarding Ground 1 to the remaining grounds. *See* Dec. 24.

Petitioner attempts to minimize Ground 6’s citation of non-prior art material in Saxonov in two ways. First, it asserts that, “[t]o the extent Grounds 6-10 cited Saxonov, the Board did not recognize that Grounds 6-10 were more than sufficiently supported by material from Saxonov that is indisputably carried forward from the ’013 provisional and is thus prior art to the ’170 patent.” Req. 4. This argument is unavailing, because as indicated in the Decision, we found that Petitioner has not adequately shown that subject matter in Saxonov cited and relied upon in the Petition is found in or supported by the ’013 provisional. Dec. 20–21. Petitioner does not dispute that finding in the Request. And to the extent Petitioner argues that

Patent Owner does not dispute that the Saxonov material cited in Ground 6 qualifies as prior art (*see, e.g.*, Req. 6–7, 14), this is an improper attempt to shift Petitioner’s burden to Patent Owner.² As discussed in the Decision, Petitioner carries the burden of production of showing that the material it cites is prior art. *See* Dec. 18 (citing *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1377, 1381–82 (Fed. Cir. 2015); MPEP §§ 2136 (I), 2136.03 (III), 2136 (Examples 2, 4, 7); *Google LLC v. Ikorongo Tech, LLC*, IPR 2021-00058, Paper 14, 10–12 (PTAB May 10, 2021)).

Second, Petitioner argues that notwithstanding the Petition’s reliance on non-prior art portions of Saxonov, the Board should analyze its other citations to determine whether Ground 6 is “fully supported by prior art disclosure” from Larson and/or Saxonov. Req. 2; *see also id.* at 5 (“[T]he Board conducted no meaningful . . . inquiry into what material from Saxonov relied upon in Grounds 6-10 of the Petition is prior art.”). Petitioner is essentially arguing that once the Board identified portions of Saxonov that do not qualify as prior art, it should have gone back through the Petition, taken on the task of excising the citations to the non-prior art

² In any event, this argument is not factually correct. Petitioner did not rely on Larson in discussing claim element 1(f), pointing instead to the analysis of that claim element in Ground 1. *See* Pet. 59–65 (addressing only claim elements 1(a) and the wherein clauses of claim elements 1(b) and 1(e) in Ground 6 because it is otherwise “identical to Ground I in all respects”); *see also* Req. 14 (citing Pet. 42–44). The Petition’s discussion of claim element 1(f) in Ground 1, however, explicitly referred back to the analysis in the preceding sections, which cited to, e.g., Figures 9 and 10 and paragraphs 17, 18, and 76–79 of Saxonov. Pet. 41–43. Patent Owner disputed the prior art status of these portions of Saxonov in its Preliminary Response. Prelim. Resp. 41.

portions of Saxonov, and determined whether the remaining allegations were sufficient for Petitioner to meet the institution burden.

Such an approach is inconsistent with the Supreme Court’s statements that in an *inter partes* review, “the petitioner is master of its complaint,” and “the petition [is] the centerpiece of the proceeding.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 363, 369 (2020). “It is of the utmost importance that petitioners in IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). In contravention of these principles, Petitioner’s approach improperly shifts the onus to Patent Owner or the Board to identify and parse out erroneous, and purportedly non-essential, citations to Saxonov and piece together an argument based on the remaining citations. As we stated in the Decision, we decline to assume this task. *See* Dec. 20.

Finally, in the Request, Petitioner attempts to “show[] how Ground 6 is fully supported by undisputed prior art material.” Req. 6. This attempt is improper. Petitioner cannot use the Request as a means to supplement the Petition to identify purportedly essential citations and disavow erroneous or non-essential citations.

IV. CONCLUSION

Upon review, we see no error in our findings of fact or conclusions of law, nor any unreasonable judgment in our denial of institution of *inter partes* review.

For the reasons stated, Petitioner has not demonstrated an abuse of discretion in the Decision to institute *inter partes* review.

V. ORDER

Accordingly, it is hereby

ORDERED that Petitioner's Request for Rehearing is *denied*.

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