

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARIOSIA DIAGNOSTICS,

Petitioner

V.

ISIS INNOVATION LIMITED,

Patent Owner

Cases IPR2012-00022 and IPR2013-00250

Patent 6,258,540

Oral Hearing Held January 24, 2014

WITNESSES

Before LORA M. GREEN, FRANCISCO C. PRATS, and JEFFREY B.

ROBERTSON, Administrative Patent Judges.

Cases IPR2012-00022 and IPR2013-00250
Patent 6,258,540

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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Cases IPR2012-00022 and IPR2013-00250
Patent 6,258,540

1 P R O C E E D I N G S

2

3 JUDGE GREEN: Good morning and welcome. This is
4 the final oral hearing for the following cases, IPR2012-00022
5 and 2013-00250. At this time, I would like counsel to
6 introduce themselves and your colleagues, and I'll start with
7 the Petitioner.

8 MR. GARDELLA: This is Greg Gardella, from Oblon
9 Spivak, on behalf of Petitioner, Ariosa Diagnostics. I'm
10 joined by Dianna DeVore also of Ariosa Diagnostics.

11 JUDGE GREEN: Thank you. And Patent Owner?

12 MS. ELLISON: Good morning. I'm Eldora Ellison,
13 on behalf of Isis Innovation, and I'm here with Mr. Michael
14 Malecek. We have several people in the audience. I'm not
15 sure if you want me to introduce them, as well.

16 JUDGE GREEN: If they aren't going to be
17 speaking, I'm not going to worry about it.

18 MS. ELLISON: Okay. Thank you.

19 JUDGE GREEN: Thank you. And welcome to the
20 Board. Consistent with our order, each party has one hour to
21 present their arguments. Petitioner will proceed first in
22 the action charged claimed. Petitioner may reserve rebuttal
23 time for its case and time to respond to objections with
24 regard to the motion to amend. Thereafter, Patent Owner will

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1 with regards to the motion to amend claims. Patent Owner may
2 reserve rebuttal time for its case after the motion to amend
3 patent claims.

4 After that, the Petitioner will make use of the
5 rest of its time responding to Patent Owner's presentation of
6 all matters. And then if Patent Owner reserves rebuttal
7 time, Patent Owner will only address the issues raised by the
8 Petitioner regarding the motion to amend claims.

9 At this time I would like to ask counsel if they
10 have the demonstrative -- if they have copies of the
11 demonstratives for the panel, the other side and the court
12 reporter. And you can approach the bench.

13 (Whereupon, the demonstrative was distributed to
14 all parties.)

15 JUDGE GREEN: Counsel for Petitioner, you may
16 proceed when you're ready. And how much rebuttal time would
17 you like to reserve (indiscernible)?

18 MR. GARDELLA: A half hour, Your Honor.

19 JUDGE GREEN: 30 minutes? Okay, thank you.

20 MR. GARDELLA: Good morning, Judge Green, Judge
21 Prats, Judge Robertson. Thanks for having us here today. I
22 would like to start with the broadest reasonable
23 interpretation. The Board correctly noted that the Patent
24 Owner's own expert, Dr. Evans, in connection with litigation

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1 analysis, clearly indicated and reflected in the analysis in
2 which it was not necessary to distinguish maternal from fetal
3 DNA, and that's the principal debate between the parties at
4 this point.

5 One thing I'd like to bring to your attention is
6 that in the Article 3 proceedings, to my knowledge, the
7 Patent Owner, through its exclusive licensee Sequenom, has
8 never once argued for the limitation, the narrower
9 construction that it is seeking here. Never once.

10 Ariosa believed, and still believes, that the
11 proper Phillips construction is narrower, but that's not the
12 issue here. The issue here is broadest reasonable
13 interpretation, which we submit should, at the absolute
14 minimum, encompass that which has been advocated successfully
15 by the Patent Owner in Article 3 Core.

16 JUDGE GREEN: Can you tell us what the status is
17 of the co-pay litigation, then?

18 MR. GARDELLA: In the beginning in the district
19 court, the summary judgment was granted of unpatentable
20 subject matter under 101. The Court found that the claimed
21 subject matter was merely discovery, a natural phenomenon.
22 That is on appeal to the Federal Circuit currently.

23 JUDGE GREEN: And do you have any idea as to when
24 that may be heard or you're just looking for the case to be

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