

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALERE INC.,
Petitioner,

v.

REMBRANDT DIAGNOSTICS, LP,
Patent Owner.

IPR2016-01502
Patent 6,548,019 B1

Before CHRISTOPHER L. CRUMBLEY, JON B. TORNQUIST, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding and Remand Scheduling Order
37 C.F.R. § 42.5

This case was remanded from the Court of Appeals for the Federal Circuit for us to consider grounds of unpatentability asserted in the Petition but not addressed in our Final Written Decision (Paper 39, “FWD” or “Final Written Decision”).

We instituted review of claims 1–5, 9, and 11–15 of US Patent No. 6,548,019 (“the ’019 patent”) on seven of thirteen grounds asserted in the Petition. Paper 13, 6, 36–37 (“Institution Decision” or “Inst. Dec.”). We did not institute a trial with respect to whether: (1) claims 2–6 are anticipated by Lee-Own; (2) claims 2–6 would have been obvious over Lee-Own and Tydings; (3) claim 10 would have been obvious over MacKay and Charm or May; (4) claims 2–6 would have been obvious over DE ’825 or DE ’825 and Cipkowski; and (5) claims 2–6 and 10 would have been obvious over Tydings and MacKay or Lee-Own. Inst. Dec. 6, 36.

Patent Owner subsequently disclaimed claims 1, 9, and 11–15 of the ’019 patent (Ex. 2016, 1), thus leaving only two grounds challenging (1) claim 2 as anticipated by McKay and (2) claims 3–5 as having been obvious over the combination of MacKay and Cipkowski remaining for resolution in the proceeding.

In our Final Written Decision, issued February 9, 2018, we construed the term “device” and the first “wherein” clause of claim 1. FWD 7–17. Applying these constructions to the remaining two grounds at issue, we found that Petitioner had demonstrated that claim 2 is anticipated by MacKay but that Petitioner had failed to demonstrate that the subject matter of claims 3–5 would have been obvious over the combined disclosures of MacKay and Cipkowski. *Id.* at 17–25.

On April 12, 2018, Petitioner filed a Notice of Appeal with the Court of Appeals for the Federal Circuit.¹ Paper 40. On April 24, 2018, while the appeal was pending, the Supreme Court held in *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018) that the Board must decide the patentability of all the claims challenged in the petition in an instituted trial.

On October 29, 2019, the Federal Circuit issued a decision affirming our construction of the first “wherein” clause of claim 1. Ex. 3001, 2, 9. In view of the intervening Supreme Court decision in *SAS*, however, the Federal Circuit vacated the remainder of the Final Written Decision and remanded the case for the Board to review “all claims and grounds included in the petition and issue a complete and final written decision” addressing the non-instituted claims and grounds. *Id.* at 10. The Federal Circuit’s mandate issued on December 9, 2019. Ex. 3002, 1.

On January 15, 2020, a telephone conference was conducted with counsel for the parties and Judges Tornquist, Crumbley, and McGraw. On the call, the parties agreed that additional briefing is required in this case and that any such briefing should be limited to addressing the non-instituted grounds. The parties also ultimately agreed that the Board’s standard filing procedure should be used (i.e., a Patent Owner Response, a Reply, and a Sur-reply) and that an abbreviated filing timeline would be acceptable.

Upon consideration of the parties’ arguments, we find good cause exists to permit briefing with respect to all non-instituted grounds set forth in the Petition. Patent Owner’s Response shall be limited to 9,000 words; Petitioner’s Reply shall be limited to 5,600 words; and Patent Owner’s Sur-

¹ On April 27, 2018, Patent Owner filed a Notice of Cross-Appeal. Paper 41. This cross-appeal was voluntarily dismissed.

reply shall be limited to 5,600 words. The guidelines set forth in the Board's Consolidated Trial Practice Guide and the following Remand Schedule will apply to this remanded proceeding. The due dates for the parties' submissions are set forth in the table below:

Action	Due Date
Patent Owner's Response (9,000 words)	On or before March 15, 2020.
Petitioner's Reply (5,600 words)	One month after the filing of Patent Owner's Response.
Patent Owner's Sur-reply (5,600 words)	Two weeks after the filing of Petitioner's Reply.
Motions to exclude evidence; requests for oral argument	Two weeks after the filing of Patent Owner's Sur-reply.
Oppositions to motions to exclude evidence	One week after the filing of the corresponding motions to exclude evidence.
Replies to motions to exclude evidence	One week after the filing of the corresponding oppositions to the motions to exclude evidence.
Oral Argument	To be determined, but generally within one month of the requests for oral argument, if granted.

In consideration of the foregoing, it is:

ORDERED that trial is instituted as to all grounds set forth in the Petition;

FURTHER ORDERED that the parties' briefing on remand shall be limited to addressing the non-instituted grounds and the challenged claims remaining in the '019 patent; and

FURTHER ORDERED that briefing shall proceed as outlined herein.

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