

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

Record of Oral Hearing
Held: June 22, 2020

Before CHRISTOPHER J. CRUMBLEY, JON B. TORNQUIST, and
KIMBERLY MCGRAW, *Administrative Patent Judges*.

IPR2016-01502
Patent 6,548,019 B1

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Monday, June 22, 2020, commencing at 1:00 p.m., EDT, by video/by telephone.

PROCEEDINGS

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3 JUDGE TORNQUIST: Good afternoon. This is a video hearing for
4 IPR 2016-1502, Alere Inc. v. Rembrandt Diagnostics. Who do we have
5 from Petitioner today?

6 MS. HOLLIS: Good afternoon. You have Amanda Hollis from
7 Kirkland and Ellis. I'm joined on the phone by my colleague, Kourtney
8 Baltzer and Daniel Gross also from Kirkland and Ellis; and we also have
9 Jennifer Embry, Senior Counsel at Abbot Laboratories which now also
10 (inaudible).

11 JUDGE TORNQUIST: Okay, welcome; and Patent Owner?

12 MR. BUNKER: Good afternoon, Your Honors. Jared Bunker, for the
13 Patent Owner, backup attorney. With me in the room is Joseph Jennings,
14 lead attorney. We're trying to be socially distant. So, he's off the camera.

15 JUDGE TORNQUIST: Okay, perfect. Per our hearing order, each
16 side will have one hour of total argument time today. Petitioner, bearing the
17 burden of proof, you'll go first and reserve time for rebuttal. And we'll hear
18 from Patent Owner. You can also reserve a short period of time for sur-
19 rebuttal. As we're on video here today, there's going to be a short lag
20 between the Judges' questions coming on line, so if you hear us coming on
21 line just pause a second, listen to the question, and make sure that it's
22 finished before you answer.

23 If you have any difficulty seeing, but especially hearing, please let us
24 know and we'll get with the technical staff and make sure everyone can hear
25 the hearing going forward. All right, with that, Petitioner, when you're
26 ready.

1 MS. HOLLIS: Thank you, Your Honor. One question -- I do not see
2 the Judges any more on the screen. They were present when the -- there we
3 go, okay.

4 JUDGE TORNQUIST: Okay.

5 MS. HOLLIS: Okay; thank you.

6 JUDGE TORNQUIST: And do you want to reserve any rebuttal
7 time?

8 MS. HOLLIS: Yes, Your Honor. I'm going to reserve approximately
9 10 minutes, if that's okay. Will I get a notice or should I keep my own
10 clock?

11 JUDGE TORNQUIST: I'll give you a notice about 1 minute before
12 your 10 minutes is about to hit.

13 MS. HOLLIS: Okay; thank you, Your Honor. So, before I get into
14 the merits of our challenges, I'd like to address one procedural question, and
15 that question is whether the Board should be revisiting its decision that
16 claims 3 through 5 were not obvious over our ground 2 challenge, the
17 challenge based on Cipkowski and McKay, now that we're here back on
18 remand. And the answer to that question, I submit, yeah, there should be a
19 revisiting of that. And it is because of the following: First, we are on a
20 remand from the Federal Circuit. As I show in my slide 2, the instruction
21 here from the Federal Circuit is that they vacated the remainder of the
22 Board's final written decision. So, everything except for the claim
23 construction, the (inaudible) is now vacated. That, of course, would include
24 the final written official decision, its conclusion on that ground; and remand
25 for the Board to review all claims and grounds included in the Petition; and
26 to issue a complete final written decision.

1 Also, the record has changed. It never (inaudible) on the Rembrandt
2 side since that 2018 final written decision. Remember, that final written
3 decision in 2018 cited an expert declaration from Rembrandt. That expert
4 declaration did conclude, or opine, that the challenge was not enough to
5 render the claims not obvious. But he made a few preliminary findings that
6 have since been rejected, and now Rembrandt has no expert standing by it
7 when it's arguing to you that despite all this happen, those claims are still
8 somehow not obvious.

9 And one of those preliminary findings by that expert was, for
10 example, he believed all of the elements of claim 1 were not present in the
11 McKay reference. Well, that was rejected. He also opined that the claim
12 required things like a single-step device and a single, unitary structure. And
13 those are very important to his opinion because, remember, when he
14 discusses the advantages of the patent claims over the prior art combination,
15 that's what he's relying on, the single-step and the single-unitary structure.

16 Now that those theories and arguments like Rembrandt's have been
17 rejected, there is no expert standing by Rembrandt's side and, so, for that
18 reason alone, we do think that the Board should be taking another look at
19 that ground.

20 JUDGE TORNQUIST: Okay. Let me ask you a question on that
21 then. This is Judge Tornquist. Would you agree though that the Petitioner
22 had a full and fair opportunity to address, in that first trial, the question of
23 whether claims 3 through 5 were obvious over Cipkowski and McKay?

24 MS. HOLLIS: Well, we did have a trial; we had the briefing; we had
25 the argument. What we didn't emphasize or focus on as much back then
26 because Rembrandt would have argued it wouldn't matter, was how the

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