

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ALERE INC.,  
Petitioner,

v.

REMBRANDT DIAGNOSTICS, LP,  
Patent Owner.

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IPR2016-01502  
Patent 6,548,019 B1

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Record of Oral Hearing  
Held: June 22, 2020

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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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ALSO APPEARING:

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Senior Counsel Abbott Laboratories

ON BEHALF OF THE PATENT OWNER:

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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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