

Filed: November 1, 2021

Filed on behalf of:

Patent Owner Rembrandt Diagnostics, LP  
By: Joseph F. Jennings (Reg. No. 40,664)  
Jared C. Bunker (Reg. No. 58,474)  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
2040 Main Street, Fourteenth Floor  
Irvine, CA 92614  
Tel.: (949) 760-0404  
Fax: (949) 760-9502  
Email: BoxREMPIL.001LP@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

ALERE, INC.

Petitioner,

v.

REMBRANDT DIAGNOSTICS, LP

Patent Owner

---

Case No. IPR2016-01502  
U.S. Patent 6,548,019

---

**PATENT OWNER'S REQUEST FOR REVIEW BY THE DIRECTOR**

## TABLE OF CONTENTS

	Page No.
I. INTRODUCTION .....	1
II. BACKGROUND .....	2
A. Procedural History.....	2
B. Technical Background.....	5
III. ARGUMENT.....	6
A. Alere’s New Declaration And Reply Went Beyond The Proper Scope And Should Have Been Excluded In Their Entirety—The Board’s Failure To Do So Justifies Reversal.....	6
B. The Board’s Reliance On Alere’s New Declaration And Reply Also Justifies Reversal.....	7
C. The Board Also Erred In Finding That Charm And May Each Discloses A Device With Multiple Test Strips In A Single Channel .....	9
D. The Board Also Erred In Finding That One Of Ordinary Skill Would Have Been Motivated And Reasonably Expected To Successfully Reverse Tydings’s Design.....	12
IV. CONCLUSION.....	15

## TABLE OF AUTHORITIES

Page No(s).

<i>Alere, Inc. v. Rembrandt Diagnostics, LP</i> , 791 Fed. Appx. 173 (Fed. Cir. 2019).....	3, 4
<i>Intel. Bioystems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016) .....	6
<i>In re Stepan</i> , 868 F.3d 1342 (Fed. Cir. 2017) .....	12
<i>TQ Delta v. Cisco Sysys.</i> , 942 F.3d 1352 (Fed. Cir 2019) .....	10, 13

### OTHER AUTHORITIES

35 U.S.C. § 312 .....	6, 9
37 C.F.R. § 42.23 .....	6, 9
77 Fed. Reg. 48,756 (Aug. 14, 2012).....	6

## I. INTRODUCTION

The Board originally determined that Alere had failed to show even a likelihood of proving the unpatentability of claims 3-6 and 10 based on certain grounds. In doing so, the Board identified several gaps and inconsistencies in Alere's petition. Following remand from the Federal Circuit based on *SAS Institute*, Alere used the Board's institution decision as a roadmap in an attempt to fill in those gaps and correct the inconsistencies. It did so by submitting and relying on new expert testimony and arguments.

Rembrandt informed the Board of these procedural irregularities. In spite of Rembrandt's objections, the Board, in the Final Written Decision on Remand ("FWD on Remand"), relied on portions of that new testimony and arguments to find those claims unpatentable based on the same grounds it had originally rejected as deficient.

Alere's new testimony and arguments should have been excluded because they went beyond responding to Rembrandt's arguments on remand. The Board compounded this error by relying on the new testimony and arguments to find claims 3-6 and 10 unpatentable. The additional testimony and arguments, moreover, are conclusory, conflict with the record, and lack substantial evidentiary support. The Board's decision should be reversed.

## II. BACKGROUND

### A. Procedural History

In 2016, Alere filed an IPR petition challenging claims 1-6 and 9-15 of the '019 patent. Paper 2, 5. In its petition, Alere asserted thirteen grounds of unpatentability based on eight prior art references. *Id.* at i-ii. Alere relied on a declaration from Dr. Robert Bohannon. Ex. 1003.

In response to Alere's petition, the Board agreed to institute review of claims 1-5, 9, and 11-15 on certain grounds, but it declined to institute review as to those same claims on other grounds. Paper 13, 36-37. The Board also denied institution on any grounds challenging claims 6 and 10. *Id.* In declining to review claim 10 based on Alere's Ground IV, the Board found that Alere and Dr. Bohannon failed to show a likelihood of establishing claim 10 unpatentable based on MacKay in view of Charm or May:

Petitioner and Dr. Bohannon do not explain sufficiently *how* the single channel device of MacKay would be modified to accept multiple test strips within a single flow control channel. Nor do Petitioner and Dr. Bohannon explain sufficiently *why* a person of ordinary skill in the art would have concluded from the use of a single test strip within a single flow control channel in Charm and May that any additional test strips would be placed in the same flow control channel, as opposed to each being placed in their own individual flow channels.

*Id.* at 31. The Board noted that Dr. Bohannon's testimony on this point was conclusory and failed to address conflicting statements in the prior art. *Id.* at 31-32.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.