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Paper 5
Entered: March 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLUIDIGM, CORP.,
Petitioner,

v.

THE BOARD OF TRUSTEES OF
THE LELAND STANFORD JUNIOR UNIVERSITY,
Patent Owner.

Case IPR2017-00014
Patent 7,695,926 B2

Before ERICA A. FRANKLIN, GEORGIANNA W. BRADEN, and ZHENYU YANG, *Administrative Patent Judges.*

FRANKLIN, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Fluidigm Corporation ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–9 and 11–12 of U.S. Patent No. 7,695,926 B2 (Ex. 1001, "the '926 patent"). Paper 1 ("Pet."). The Board of Trustees of the Leland Stanford Junior University ("Patent Owner") did not file a Preliminary Response to the Petition.[1]

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Upon considering the Petition, we determine that Petitioner has shown a reasonable likelihood that it would prevail in showing the unpatentability of claims 1–9 and 11–12. Accordingly, we institute an *inter partes* review of those claims.

A. Related Proceedings

Petitioner and Patent Owner affirm that they are not aware of any judicial proceeding involving the '926 patent. Pet 3, Paper 4, 1.

B. The '926 Patent

The claims of the'926 patent are directed to a kit comprising first and second activation state-specific antibody, wherein each of those antibodies binds to an activation form of respective first and second proteins within one

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[1] Although Patent Owner did not file a Preliminary Response, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

of the recited signaling pathways, i.e., MAPK, AKT, NFkB, STAT, or WNT. Ex. 1001, 51:20–33. Additionally, the kit comprises instructions for using those antibodies. *Id*. at 51:21–22. In some embodiments, claims 6–9, the antibodies are uniquely labeled. *Id*. at 52:44–55. In other embodiments, claims 11–12, the antibodies are immobilized in a solid surface. *Id*. at 52:58–63.

C. Illustrative Claim

Claim 1 of the ’926 patent is the only independent claim and it is reproduced below:

> 1. A kit comprising a first activation-state specific antibody and a second activation-state specific antibody and instructions for use of the antibodies, wherein at least one of the antibodies is specific for a phosphorylation site, wherein said first activation state-specific antibody binds to an activation form of a first protein within the MAPK (mitogen activated protein kinase), AKT (homolog of V-akt murine thymoma viral oncogene), NFkB (nuclear factor kappa B), PKC (protein kinase C), STAT (signal transducers and activators of transcription) or WNT (Win gless/Int) signaling pathways, and said second activation state-specific antibody binds to an activation form of a second protein within the MAPK, AKT, NFkB, PKC, STAT or WNT signaling pathways, and wherein said first and second proteins are different proteins.

Ex. 1001, 51:20–33.

D. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–9 and 11–12 of the ’926 patent on the following grounds:

Claims	Basis	References
1–5 and 11–12	§ 102[2]	Shen[3]
1–9	§ 103(a)	Fleisher[4]
1–9	§ 103(a)	Darzynkiewicz[5] and Yen[6]

Petitioner also relies upon the Declaration of Tom Huxford, Ph.D. (Ex. 1002).

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016) (affirming applicability of broadest reasonable construction standard to *inter*

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[2] Petitioner asserts that Shen is prior art under pre-AIA 35 U.S.C. § 102(a) or § 102(b). Pet. 18.
[3] Patent Application Publication No. WO 01/27624 A2 by Li Shen et al., published Apr. 19, 2001 (Ex. 1016) ("Shen").
[4] Thomas A. Fleisher et al., *Detection of Intracellular Phosphorylated STAT-1 by Flow Cytometry*, 90 CLINICAL IMMUNOLOGY 425–430 (1999) (Ex. 1004) ("Fleisher").
[5] Patent Application Publication No. WO 99/44067 A1 by Zbigniew Darzynkiewicz et al., published Sep. 2, 1999 (Ex. 1005) ("Darzynkiewicz").
[6] Andrew Yen et al., *Retinoic Acid Induced Mitogen-activated Protein (MAP)/Extracellular Signal-regulated Kinase (ERK) Kinase-dependent MAP Kinase Activation Needed to Elicit HL-60 Cell Differentiation and Growth Arrest*, 58 CANCER RESEARCH 3163–3172 (1998) (Ex. 1006) ("Yen").

partes review proceedings). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

The Specification explains, "the term 'activation state-specific antibody' or 'activation state antibody' or grammatical equivalents thereof, refer to an antibody that specifically binds to a corresponding and specific antigen." Ex. 1001, 26:55–58. Petitioner recognizes that definition as the broadest reasonable construction of the claim term. Pet. 6–7. Petitioner also asserts, however, that definition encompasses "virtually any antibody, as all antibodies bind to a specific antigen." *Id*. at 7. Based on that reasoning, Petitioner proposes to construe the term more narrowly to mean "an antibody that specifically binds to a corresponding and specific isoform of an activatable protein." *Id*. (citing Ex. 1002 ¶¶ 54–55).

Petitioner makes the point that, based on the disclosure of the Specification, a person of ordinary skill in the art at the time of the invention would consider an "activation state-specific antibody" as referring to an "antibody that specifically binds to a corresponding and specific isoform of an activatable protein." *Id*. We decline, however, to substitute that construction for the definition expressly provided by the Specification, as it is set forth with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d at 1480. Moreover, independent claim 1 further describes an "activation state-specific antibody" in a manner that identifies such

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