

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARIOSA DIAGNOSTICS

Petitioner,

v.

ISIS INNOVATION LIMITED

Patent Owner.

IPR2013-00250

Patent 6,258,540

**PETITIONER'S
MOTION FOR JOINDER
UNDER 37 C.F.R. § 42.122(B)**

RELIEF REQUESTED

Petitioner Ariosa Diagnostics, Inc. hereby moves for joinder of the petition for *inter partes* review of claims 3, 8, 12, 13, 15 and 18 of U.S. Patent No. 6,258,540 filed on even date herewith with the instituted *inter partes* review styled *Ariosa Diagnostics v. Isis Innovation Limited* Case No. IPR2012-00022 (MPT).

STATEMENT OF MATERIAL FACTS

1. On September 28, 2012, Ariosa filed a Petition for *Inter Partes* Review requesting review of claims 1, 2, 4, 5, 8, 19-22, 24, and 25 of the '540 Patent.
2. On March 19, 2013 the Board issued a decision instituting trial on claims 1, 2, 4, 5, 8, 19-22, 24, and 25 in IPR2012-00022.
3. On even date herewith, Petitioner filed a petition for *inter partes* review which challenges additional claims which depend directly or indirectly from claim 1, namely, claims 3, 12, 13, 15 and 18. The grounds of invalidity presented in the second petition are premised upon the same the grounds adopted by in the Decision and add only references necessary to meet the additional recitations of claims 3, 12, 13, 15 and 18.
4. More particularly, the second petition argues that each of i) Bianchi (Exhibit 1043), ii) Mutter (1048) and the iii) combination of Lo 1990 (Ex. 1044)

and Lo 1989 (Ex. 1045) render claims 3, 12, 13, 15 and 18 obvious when viewed in in light of the references (or combinations of references) found by the Board to establish a *prima facie* case of unpatentability of claim 1.

5. The only other new issue raised in the petition is a discussion of supplemental evidence which addresses the Board's finding in connection with claim 8 that "it is unclear what was amplified by the B1 and C2 primers described in the Kazakov reference." (*Decision at 26*). That same supplemental evidence is presented in a motion for entry of supplemental information under §42.123(a) in IPR2012-00022, filed on even date herewith.

6. As explained in the declaration of Ms. Dianna DeVore, Petitioner launched a new product in March 2013 and Patent Owner may assert claims 3, 12, 13, 15 and 18 against that new product in the litigation captioned *Ariosa Diagnostics v. Sequenom et al.*, N.D.Cal, Case No. 3:11-cv-06391. (*See Exhibit 1049*)

7. For this reason Petitioner considered the filing of the second petition necessary and appropriate. (*See Exhibit 1049*)

GOVERNING RULE(S)

§ 42.122 Multiple proceedings and Joinder.

(b) *Request for Joinder.* Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

DISCUSSION

This motion is made within one month of the date the trial was instituted as required by Rule 42.122(b). Trial was instituted on March 19, 2013 and the instant motion has been filed on or before April 19, 2013.

The second petition raises a limited number of new issues in that the grounds of invalidity presented in the second petition are premised upon the same the grounds adopted by in the Decision and add only references necessary to meet the additional recitations of claims 3, 12, 13, 15 and 18.

The new proposed ground of invalidity based on Kazakov raised in the second petition (i.e. anticipation of claim 8 by Kazakov) is not included in IPR2012-00022. However, in that trial Kazakov is applied as a ground of

invalidity as to claim 8 in combination with Simpson (Ex. 1025 -X) and Schallhammer (Ex. 1022 - V). (*Decision, pp. 30-32, and 37*) Accordingly, the extent to which Kazakov meets the recitation of claim 8 is at issue in IPR2012-00022.

Petitioner is willing to forfeit a reasonable portion of its response period to the extent that is deemed necessary to provide Patent Owner sufficient time to address the additional issues raised in the second petition. Petitioner will also accommodate any reasonable logistical or scheduling request of Patent Owner in order to accommodate joinder of the proceedings.

In view of the foregoing joinder of the second petition to IPR2012-00022 would not cause any undue prejudice or hardship to Patent Owner. The second petition accordingly should be joined to IPR2012-00022 under under Rule 42.122(b).

To the extent that the Board believes that anticipation of claim 8 based on Kazakov should not be joined to IPR2012-00022 because doing so presents a new issue or would prejudice Patent Owner, Petitioner requests in the alternative that the remainder of the grounds raised in the second petition be joined with IPR2012-00022 under Rule 42.122(b).

The Patent Office is authorized to charge Deposit Account 15-0030 any fee appurtenant to this filing.

Respectfully submitted,

OBLON SPIVAK

Dated: April 19, 2013

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