

# Sequenom, Inc. v. The Board of Trustees of The Leland Stanford Junior University: Decision Denying Request for Rehearing IPR2014-00337

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*Takeaway: A provisional application, by itself, does not constitute prior art under 35 U.S.C. § 102(e). Instead, only a patent or published application claiming the benefit of an earlier filing date (including the filing date of a provisional application) may qualify as prior art under 35 U.S.C. § 102(e).*

In its [Decision](#), the Board denied Petitioner's Request for Rehearing. The Board maintained its position that a U.S. provisional application, by itself, does not constitute prior art under 35 U.S.C. § 102(e).

Petitioner had challenged certain claims of the '415 patent as being unpatentable in view of U.S. Provisional Patent Application 60/951,438 to Lo. A total of twelve grounds of unpatentability were purported to be based on Lo. For all of these challenges, Lo was alleged to be prior art under 35 U.S.C. § 102(e). The Board issued a Decision denying review of the challenged claims, in response to which Petitioner had filed a Request for Rehearing.

Petitioner's primary challenge in its Request for Rehearing was that the Board had misapprehended or overlooked the holding in *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential). The Board disagreed, emphasizing that because Lo is a provisional application, it is neither a patent nor a patent application published under 35 U.S.C. § 122(b). Accordingly, Lo, by itself, is not prior art under 35 U.S.C. § 102(e). Therefore, the Board had not erred in denying the Petition. The fact that provisional applications may later become publicly available in some cases did not impact the Board's Decision.

## **Sequenom, Inc. v. The Board of Trustees of The Leland Stanford Junior University, IPR2014-00337**

Paper 14: Decision on Petitioner's Request for Rehearing of Decision Denying Institution of Inter Partes Review

Dated: September 23, 2014

Patent: 8,195,415 B2

Before: Lora M. Green, Francisco C. Prats, and Scott E. Kamholz

Written by: Prats

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