

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISTOLOGICS, LLC,
Petitioner,

v.

CDX DIAGNOSTICS, INC. and
SHARED MEDICAL RESOURCES, LLC,
Patent Owners.

Case IPR2014-00779
Patent 6,258,044 B1

Before PHILIP J. KAUFFMAN, SCOTT E. KAMHOLZ, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Histologics, LLC filed a Request for Rehearing (Paper 7, “Req.”) of our Decision (Paper 6, “Dec.”) to deny institution of an *inter partes* review. Histologics contends that 35 U.S.C. § 315(b) does not bar this *inter partes* review. We have considered the Request for Rehearing but decline to modify the Decision.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). *See also* 37 C.F.R. § 42.71(d). In its request for rehearing, the dissatisfied party must identify the place where in the record it previously addressed each matter it submits for review. 37 C.F.R. § 42.71(d).

III. DISCUSSION

A. Background

Shared Medical Resources, LLC (“SMR”), co-owner of U.S. Patent No. 6,258,044, filed and served a complaint against Histologics in a civil action for infringement of the ’044 patent in the U.S. District Court for the Central District of California (“the ’612 action”). Dec. 2. The other co-owner, CDx Diagnostics, Inc., did not join the ’612 action because it was in bankruptcy proceedings at the time. *Id.* The Court dismissed the ’612 action, without prejudice, for failure to join CDx but stayed the ’612 action

pending resolution of the bankruptcy proceeding. *Id.* at 3. CDx eventually emerged from bankruptcy, and the Court lifted the stay. *Id.* Meanwhile, SMR and CDx had jointly brought a second action against Histologics for infringement of the '044 patent in another court, and that action was transferred to the U.S. District Court for the Central District of California. *Id.* at 3-4. The '612 action was consolidated into the transferred action and dismissed in favor of the transferred action. *Id.* at 4.

B. Analysis

Histologics argues that we committed legal error in determining that service of the complaint in the '612 action triggered the one-year deadline under 35 U.S.C. § 315(b). Req. 1. In particular, Histologics argues that (a) the complaint in the '612 action was a nullity, because SMR lacked standing to bring the complaint alone and without co-owner CDx; (b) SMR's complaint was dismissed without prejudice, and it was only the underlying civil action that was stayed; and (c) the subsequent lifting of the stay did not revive the dismissed complaint. *Id.*

We gave Histologics's arguments and evidence complete consideration and addressed them fully in the Decision. As we explained, the issue in this case was whether service of SMR's complaint was nullified by the Court's dismissal of the '612 action. Dec. 5. We explained that service was not nullified, because Histologics remained answerable to the Court for the allegations made in the original '612 action complaint, and that the parties were not left in the same legal position as if the '612 action had never been filed. *Id.* Histologics does not address this determination or

explain how it was in error, other than by advancing alternative legal theories.

A Request for Rehearing is not an opportunity to re-argue old arguments or to present new evidence or arguments. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Yet Histologics does all of these, by repeating its Petition arguments, amplifying them, and filing eleven new evidentiary exhibits, nos. 1028-1038, without showing good cause why the evidence should be considered. *See id.* As to the old arguments, we addressed them fully in the Decision. As to the new, we cannot have misapprehended or overlooked arguments and evidence not presented in the Petition.

We gave Histologics's Petition full consideration and explained the reasoning underlying our determinations. A request for rehearing is not a second chance for a party to present its case. We are not persuaded of an abuse of discretion.

IV. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is *denied*.

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For Petitioner:

Rudolph Telscher
Bryan Wheelock
Greg Meyer
HARNESS, DICKEY & PIERCE, PLC
rtelscher@hdp.com
bwheelock@hdp.com
gmeyer@hdp.com

For Patent Owner:

Peter Berger
LEVISOHN BERGER LLP
pberger@llbl.com