

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FOUNDATION MEDICINE, INC.,  
Petitioner

v.

CARIS MPI, INC.,  
Patent Owner

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IPR2019-00166  
Patent 9,292,660

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**PATENT OWNER'S NOTICE OF APPEAL**

Pursuant to 35 U.S.C. §§ 141(c) and 319, and 37 C.F.R. § 90.2(a), notice is hereby given that Patent Owner, Caris MPI, Inc. hereby appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision in Case No. IPR2019-00166 entered May 13, 2020 (Paper 53) (“Final Written Decision”) by the Patent Trial and Appeal Board (“the Board”), and from all underlying orders, decisions, rulings, and opinions related thereto and included therein. This appeal is timely under 35 U.S.C. § 142, 37 C.F.R. § 90.3, and Rule 15(a)(1) of the Federal Rules of Appellate Procedure.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), the expected issues on appeal include, but are not necessarily limited to:

- (1) The Board’s definition of a person of ordinary skill in the art as not requiring an oncologist and not requiring experience in treating cancer patients;
- (2) The Board’s claim construction that does not require the claimed system to test for contraindications;
- (3) The Board’s decision that claims 1-11, 13-16, 18 and 22-23 were shown unpatentable as obvious over Von Hoff, Illumina and Bibikova, including its conclusions about what the references disclose, motivation to combine, and reasonable expectation of success;

- (4) The Board's conclusions concerning objective indicia of non-obviousness, including praise; and
- (5) all other issues decided adversely to Patent Owner in any orders, decisions, ruling and opinion underlying or supporting the Final Written Decision.

Per 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a)(1), this notice is being filed with the Director of the U.S. Patent and Trademark Office, and a copy is also being filed with the Board. Per Federal Circuit Rule 15(a)(1) and 37 C.F.R. 90.2(a)(2), Patent Owner is also sending a paper copy of this Notice of Appeal to the Clerk of the U.S. Court of Appeals for the Federal Circuit, and paying the fee set forth in Federal Circuit Rule 42.

Respectfully submitted,

Date: June 2, 2020

/Michael J. Kane/  
Dorothy P. Whelan, Reg. No. 33,814  
Michael J. Kane, Reg. No. 39,722  
Martina Tyreus Hufnal, Reg. No. 58,916

*Counsel for Patent Owner*

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(4), the undersigned certifies that on June 2, 2020, a complete and entire copy of this Patent Owner's Notice of Appeal was provided via email to the Petitioner by serving the correspondence email addresses of record as follows:

David L. Cavanaugh  
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I hereby certify that, in addition to being filed electronically through the Board's E2E System, the original version of the foregoing Notice of Appeal was filed by hand on June 2, 2020, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office  
c/o Office of the General Counsel  
Madison Building East, 1 OB20  
600 Dulany Street  
Alexandria, VA 22314-5793

I hereby certify that on June 2, 2020, a true and correct copy of the foregoing Notice of Appeal, along with a copy of the Institution Decision, was filed electronically with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, at the following address:

United States Court of Appeals for the Federal Circuit  
717 Madison Place, N.W., Suite 401  
Washington, DC 20005

Respectfully submitted,

Date: June 2, 2020

/Michael J. Kane/  
Dorothy P. Whelan, Reg. No. 33,814  
Michael J. Kane, Reg. No. 39,722  
Martina Tyreus Hufnal, Reg. No. 58,916

*Counsel for Patent Owner*