

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOUNDATION MEDICINE, INC.,
Petitioner

v.

CARIS MPI, INC.,
Patent Owner

Case IPR2019-00170
Patent No. 9,372,193

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. IPR2019-00170 entered May 28, 2020 (Paper 56) (“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 requiring no M.D. and no experience in treating cancer patients;
- (2) The Board’s claim construction that does not require the claimed system to be cancer-lineage independent;
- (3) The Board’s decision that claims 1-14 were shown unpatentable as obvious over Lu and Illumina, including its conclusions about what the references disclose, motivation to combine, and reasonable expectation of success;
- (4) The Board’s decision that claims 2-3 were shown unpatentable as obvious over Lu, Illumina and Muraca, including its conclusions about

what the references disclose, motivation to combine, and reasonable expectation of success;

(5) The Board's decision that claims 7 and 11 were shown unpatentable as obvious over Lu, Illumina and McDoniels-Silvers, including its conclusions about what the references disclose, motivation to combine, and reasonable expectation of success;

(6) The Board's conclusions concerning objective indicia of non-obviousness, including nexus, long-felt need, skepticism, surprise, and praise; and

(7) 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:

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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
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