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To: [Precedential Opinion Panel Request](#)
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Subject: IPR2021-00100
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Attachments: [2021.06.14 - IPR2021-00100 - Request for Rehearing.pdf](#)

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Your Honors,

I write on behalf of Petitioner Dropworks, Inc. regarding a matter of precedential importance in IPR2021-00100. Dropworks filed the attached request for rehearing on June 14, 2021, and requests that a Precedential Opinion Panel convene to review the decision under Standard Operating Procedure 2.

Review by the Precedential Opinion Panel is necessary to clarify that there is no *per se* rule precluding review even if a prior art reference previously considered by the Office is viewed as a “primary” reference in a different combination with newly submitted art not previously considered. The panel decision (Paper 9) denied institution under 35 U.S.C. §325(d) because it termed one reference previously considered by the Office to be a so-called “primary” reference in the present Petition. *See, e.g.*, Paper 9 at 19 (“All of these proceedings focused heavily on Quake, the primary prior art reference cited in the instant Petition. In these circumstances, Petitioner’s arguments are insufficient to show material error by the Office, and we are unwilling to subject the ’193 patent, and Patent Owner, to yet another proceeding before the Office.”). The present Petition, however, does not contend that the Board previously erred regarding the content of Quake *per se*, but that the Office was previously presented with a materially incomplete record—deficiencies that are cured by the different references newly submitted here. The new art and argument should have been considered.

Based on my professional judgment, I believe the Decision is contrary to statute, Board precedent, Board rule, and other Board decisions, including the following:

- 35 U.S.C. §325(d)
- *Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15, at 19-20 (Oct. 16, 2019) (precedential) (second prong of *Advanced Bionics* test satisfied by presentation of new reference that is material to patentability even if a “majority of referenced cited in the Petition were analyzed during prosecution”)
- *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (prec. §III.C.5, ¶1) (requiring consideration of material differences in *newly presented art*)
- *NuVasive, Inc. v. Acantha LLC*, IPR2020-00706, Paper 11, at 27 (Aug. 25, 2020) (“*Advanced Bionics* does not draw any distinction of primary or secondary references” but does require considering the arguments made).
- Nov. 2019 Consolidated Trial Practice Guide at 62 (Board must balance the petitioner’s desire to be heard against patent owner interest in avoiding *actually* duplicative challenges)

Respectfully submitted,

/s/ Michael T Rosato

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