NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In re: VERINATA HEALTH, INC., ILLUMINA, INC.,
Petitioners

2017-109

On Petition for Writ of Mandamus to the United States District Court for the Northern District of California in No. 3:12-cv-05501-SI, Judge Susan Y. Illston.

ON PETITION

Before PROST, *Chief Judge*, NEWMAN and HUGHES, *Circuit Judges*.

PER CURIAM.

O R D E R

Illumina, Inc. and Verinata Health, Inc. (collectively "Petitioners") seek a writ of mandamus directing the United States District Court for the Northern District of California to strike portions of the invalidity contentions of Ariosa Diagnostics, Inc. and its parent company Roche Molecular Systems, Inc. (collectively "Respondents").

Section 315(e)(2) of title 35 provides, in relevant part, that "[t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert . . . in a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review."

The § 315(e)(2) dispute in this case arises out of consolidated district court actions brought by Petitioners alleging that Respondents' prenatal testing product infringes U.S. Patent Nos. 8,318,430 ("the '430 patent") and 7,955,794 ("the '794 patent"). Respondents sought inter partes review ("IPR") of each of the asserted patents based on numerous grounds. For each patent, the Patent Trial and Appeal Board instituted review on only one of the grounds raised in the petitions.

Following the Board's final written decisions holding the challenged claims of the '430 and '794 patents not unpatentable on the instituted grounds, Petitioners moved to strike substantial portions of Respondents' district court invalidity contentions based on § 315(e)(2). In their opposition, Respondents argued that under this court's decision in *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), § 315(e)(2) does not apply to grounds that were included in a petition for IPR but not instituted. Petitioners, in contrast, argued that *Shaw* established a limited exception to § 315(e)(2) where the Board had declined to review on redundancy grounds without performing any substantive analysis of the references.

After reviewing the parties' arguments, the district court declined to adopt Petitioners' narrow understanding of *Shaw* and held that Respondents were barred from raising obviousness and anticipation grounds that the

Board had instituted and addressed in its final written decisions, as well as a ground that it considered to be a subset of those grounds. The district court otherwise denied Petitioners' motion to strike as to the disputed issues before it. Petitioners then filed this request for mandamus relief.

A writ of mandamus is a "drastic and extraordinary remedy" that can only be used in "exceptional circumstances." *Cheney v. U.S. Dist. Court for the Dist. of Columbia.*, 542 U.S. 367, 380 (2004) (internal quotation marks and citations omitted). A writ requires that petitioners have no other adequate means to obtain the desired relief and have a "clear and indisputable" right to the writ. *Id.* at 380–81 (internal quotation marks and citations omitted). And even when those two requirements are met, the issuing court, in the exercise of its discretion, must still be satisfied that the writ is appropriate under the circumstances. *Id.* at 381.

We conclude on the record presented that Petitioners' right to relief is not clear and indisputable. The current state of the binding precedent does not compel a finding that the district court clearly abused its discretion or usurped judicial power. *See id.* at 380. Moreover, Petitioners fail to satisfy the requirement that they have no other adequate remedy available to them to obtain the relief sought. Petitioners have failed to show why they cannot raise their arguments regarding § 315(e)(2) with an appeal from the district court's final judgment or why that alternative would be inadequate in this case. The petition is therefore denied without prejudice to these issues being raised on appeal after final judgment.

Accordingly,

IT IS ORDERED THAT:

The petition is denied.

FOR THE COURT

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

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