

Filed on behalf of Ancestry.com DNA, LLC

By: Daniel M. Becker, Reg. No. 38,376
Jennifer R. Bush, Reg. No. 50,784
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel: (650) 988-8500
Fax: (650) 938-5200

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANCESTRY.COM DNA, LLC,
Petitioner

v.

DNA GENOTEK INC.,
Patent Owner.

Inter Partes Review No. IPR2016-00060
Patent 8,221,381 B2

**RESUBMITTED PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT 8,221,381
(assigned filing date October 20, 2015)**

TABLE OF CONTENTS

| | Page |
|--|------|
| I. INTRODUCTION | 1 |
| II. MANDATORY NOTICES (37 CFR § 42.8(A)(1))..... | 1 |
| A. Real Party-In-Interest (37 CFR § 42.8(b)(1)) | 1 |
| B. Notice of Related Matters (37 CFR § 42.8(b)(2))..... | 2 |
| C. Designation of Lead and Backup Counsel (37 CFR § 42.8(b)(3)) | 2 |
| D. Service of Information (37 CFR § 42.8(b)(4))..... | 2 |
| III. GROUNDS FOR STANDING (37 CFR § 42.104(A))..... | 3 |
| IV. THRESHOLD FOR REVIEW | 3 |
| V. IDENTIFICATION OF CHALLENGE (37 CFR § 42.104(B)) | 3 |
| A. Effective filing date of the challenged claims..... | 3 |
| B. Technical background | 4 |
| C. Claim Construction (37 CFR § 42.104(b)(3))..... | 5 |
| D. Ground 1: Claims 1, 2, 4, 5, 8, 15-17, 20, 41, 44, and 49 are anticipated under 35 USC § 102(e)(2) by U.S. Patent 7,645,424..... | 18 |
| E. Ground 2: Claims 1, 7, and 14 are unpatentable under 35 USC § 103(a) over U.S. Patent No. 7,645,424 in view of WO 98/03265.. | 29 |
| F. Ground 3: Claims 1, 2, 4, 5, 11-13, and 15-19 are unpatentable under 35 USC § 103(a) as obvious over U.S. Pat. No. 6,152,296 in view of WO 98/03265. | 37 |
| G. Ground 4: Claims 3, 6, 8-10, 20, 39-41, 43-47, and 49 are unpatentable under 35 USC § 103(a) over Shih in view of WO 2003/104251 (“Birnboim”). | 50 |
| VI. THE ASSERTED GROUNDS ARE NON-CUMULATIVE AND NON-REDUNDANT | 58 |

| | |
|----------------------|----|
| VII. CONCLUSION..... | 60 |
|----------------------|----|

TABLE OF AUTHORITIES

| | Page(s) |
|---|------------------------|
| CASES | |
| <i>In re Cuozzo Speed Techs., LLC,</i> 778 F.3d 1271 (Fed. Cir. 2015) | 5 |
| <i>In re Trans Texas Holdings Corp.,</i> 498 F.3d 1290 (Fed. Cir. 2007) | 5 |
| <i>KSR Int'l Co. v. Teleflex Inc.,</i> 550 U.S. 398 (2007)..... | 33, 40, 41 |
| <i>NuVasive v. Warsaw Orthopedic,</i> IPR2013-00395 | 59 |
| <i>Phillips v. AWH Corp.,</i> 415 F.3d 1303 (Fed. Cir. 2005) | 5, 6 |
| <i>SAP America Inc. v. Versata Dev. Group Inc.,</i> CBM2012-00001 | 5 |
| <i>Titanium Metals Corp.v. Banner,</i> 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) | 29 |
| STATUTES | |
| 35 USC § 102(b) | 30, 37, 38, 50, 59, 60 |
| 35 USC § 102(e) | 59 |
| 35 USC § 102(e)(2)..... | 18, 19, 21, 30 |
| 35 USC § 103(a) | 3, 29, 30, 37, 50 |
| 35 USC § 111 | 18 |
| 35 USC § 112(6) | 15 |
| 35 USC § 120 | 18 |

TABLE OF AUTHORITIES
(continued)

| | |
|-------------------------|----|
| 35 USC § 154..... | 19 |
| 35 USC § 301 | 6 |
| 35 USC § 301(a)(2)..... | 6 |
| 35 USC § 311 | 60 |
| 35 USC §§ 311-319..... | 1 |
| 35 USC § 314(a) | 3 |
| 35 USC § 365(c) | 18 |
| 35 USC § 371 | 4 |

OTHER AUTHORITIES

| | |
|--|----------|
| 37 CFR §§ 42.1-42.80 & 42.100-42.123 | 1 |
| 37 CFR § 42.8(a)(1)..... | 1 |
| 37 CFR § 42.8(b)(1)..... | 1 |
| 37 CFR § 42.8(b)(2)..... | 2 |
| 37 CFR § 42.8(b)(3)..... | 2 |
| 37 CFR § 42.8(b)(4)..... | 2 |
| 37 CFR § 42.63(e)..... | vii-viii |
| 37 CFR § 42.100(b) | 5 |
| 37 CFR § 42.101 | 60 |
| 37 CFR § 42.104(a)..... | 3 |
| 37 CFR § 42.104(B)..... | 3 |
| 37 CFR § 42.104(b)(3)..... | 5 |

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.