

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANCESTRY.COM DNA, LLC,
Petitioner,

v.

DNA GENOTEK INC.,
Patent Owner.

Case IPR2016-01152
Patent 8,221,381 B2

Before WILLIAM V. SAINDON, HYUN J. JUNG, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Ancestry.com DNA, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 3, 6, 9, 10, 13, 14, 18, 19, 39, 40, 43, and 45–47 of U.S. Patent No. 8,221,381 B2 (Ex. 1001, “the ’381 patent”). DNA Genotek Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we deny institution of an *inter partes* review.

I. BACKGROUND

A. *Related Proceedings*

The parties identify three cases involving the ’381 patent: (1) *DNA Genotek, Inc. v. Ancestry.com DNA LLC*, Case No. 15-00355-SLR (D. Del.); (2) *DNA Genotek, Inc. v. Spectrum DNA*, Case No. 15-cv-00661-SLR (D. Del.); and (3) *DNA Genotek, Inc. v. Spectrum DNA*, Case No. 16-cv-1544-MMA-NLS (S.D. Cal.). Pet. 2; Paper 5, 2.

The parties also identify the following petition for *inter partes* review involving the ’381 patent: IPR2016-00060. Pet. 2; Paper 5, 3.

B. *The ’381 Patent*

The ’381 patent is titled “Container System for Releasably Storing a Substance.” According to the ’381 patent, there is often a need to store a substance in a container before mixing the substance with another substance. Ex. 1001, 1:19–21. For example, there is a need in certain applications to

store or ship diagnostic compositions before combining them with biological samples. *Id.* at 1:30–32. The '381 patent addresses this need, describing a container system that releasably and reliably stores a substance. *Id.* at 2:5–6, 15–16.

The container system of the '381 patent comprises a vial and a lid that may be screwed onto the vial. *Id.* at 4:6–7, 5:7–10. The lid defines a reservoir for holding a substance, such as a nucleic acid preservative. *Id.* at 4:27–31, 5:17–18. A pierceable membrane that attaches to the lid serves as a physical barrier to releasably store the substance within the reservoir. *Id.* at 4:34–36.

The vial comprises a chamber for receiving a sample, such as saliva. *Id.* at 5:53–55. The vial also comprises at least one piercing member, which extends from a base surface within the vial. *Id.* at 6:14–23. Figure 3, which is reproduced below, illustrates a piercing member.

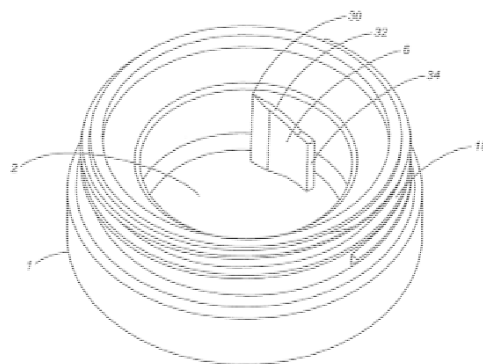


FIG. 3

Figure 3 is a perspective view of the interior of the vial. *Id.* at 3:3–4. As shown in the figure, piercing member 6 is shaped like a trapezoid. In particular, piercing member 6 includes cutting edge 32 with first pointed end

30 at a first corner of the trapezoid and a second end at a second corner of the trapezoid where cutting edge 32 intersects side wall 34. *Id.* at 6:33–37.

When a user begins to screw (or twist) the lid onto the vial, the lid and vial are moved to a piercing position. *Id.* at 7:12–13. At the piercing position, the first pointed end of the piercing member pierces the pierceable membrane. *Id.* at 7:18–20. As the user continues to twist the lid, the cutting edge of the piercing member moves through the pierceable membrane, creating an opening in the membrane that allows for the substance stored in the lid to enter the vial and mix with the sample stored in the vial. *Id.* at 7:21–24, 11:37–39. With the lid on, the vial is sealed against leakage of its contents. *Id.* at 7:1–9.

C. Illustrative Claim

Petitioner challenges claims 3, 6, 9, 10, 13, 14, 18, 19, 39, 40, 43, and 45–47, each of which depends from independent claim 1. We resolve issues raised by Petitioner’s challenges based on claim 1, as we will explain in our discussion section below. Claim 1 recites:

1. A container system for releasably storing a substance, comprising:
 - a) a vial comprising a first open end for receiving a sample, a second end comprising a sample storage chamber and a piercing member, wherein said piercing member comprises a side wall, a first cutting edge extending from a first pointed corner to a second corner that defines the intersection between said cutting edge and said side wall; and
 - b) a lid configured to removably engage said vial, said lid comprising a reservoir for holding the substance, and a pierceable membrane sealing the substance within said reservoir,

wherein, when said system is closed by removable engagement of said vial with said lid, said vial and said lid are movable to a piercing position in which the piercing member disrupts the pierceable membrane to allow fluid communication between said reservoir and said chamber, wherein the chamber is sealed against leakage to the outside of the container system in the piercing position.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 3, 6, 9, 10, 13, 14, 18, 19, 39, 40, 43, and 45–47 of the '381 patent on the following grounds. Pet. 26–72.

References	Basis	Claims Challenged
Birnboim ¹ and O'Donovan ²	§ 103	3, 6, 9, 10, 39, 40, 43, and 45–47
Birnboim, O'Donovan, Chelles ³	§ 103	18 and 19
Birnboim, O'Donovan, and Clarkson ⁴	§ 103	13 and 14

In support of its arguments, Petitioner proffers the Declaration of Dr. Terry N. Layton, Ph.D. (Ex. 1003). *See id.*

E. Claim Construction

We construe claims in an unexpired patent by applying the broadest reasonable interpretation in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*,

¹ Birnboim, Int'l Publ'n No. WO 03/104251 A2, published Dec. 18, 2003 (Ex. 1008).

² O'Donovan, U.S. Patent No. 7,645,424 B2, issued Jan. 12, 2010 (Ex. 1007).

³ Chelles, U.S. Publ'n No. US 2003/0089627 A1, published May 15, 2003 (Ex. 1020).

⁴ Clarkson, Int'l Publ'n No. WO 2005/023667 A1, published Mar. 17, 2005 (Ex. 1021).

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