Filed on behalf of Inguran, LLC d/b/a Sexing Technologies

By: Kirt S. O'Neill
Akin Gump Strauss Hauer & Feld LLP
300 Convent Street, Suite 1600
San Antonio, TX 78205-3732

Ph: 210-281-7000 Fax: 210-224-2035

Email: koneill@akingump.com

#### UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INGURAN, LLC d/b/a SEXING TECHNOLOGIES, Petitioner

V.

PREMIUM GENETICS (UK) LTD., Patent Owner

U.S. Patent 8,933,395
Appln. No. 14/169,927 filed January 31, 2014
Issued January 13, 2015
Title: MULTIPLE LAMINAR FLOW-BASED PARTICLE AND CELLULAR
IDENTIFICATION

Petition for Post-Grant Review Under 35 U.S.C. §§ 321-328 and 37 C.F.R. § 42.200 et seq.



## **Table of Contents**

I.	COMPLIANCE WITH REQUIREMENTS FOR POST-GRANT				
	REVIEW				
	A.	Certification of Petitioner's Standing to Request Post-Grant Review Under 37 C.F.R. § 42.201	1		
	B.	Time for Filing Petition for Post-Grant Review of U.S. Patent Under 37 C.F.R. § 42.202			
		Identification of Challenge Under 37 C.F.R. § 42.204(b) and			
	D.	Relief Requested Eligibility of Challenged Claims for Post-Grant Review	3		
	E.	Mandatory Notices Under 37 C.F.R. § 42.8	4		
	F.	Fee for Post-Grant Review Under 37 C.F.R. § 42.15(b)			
II.		MARY OF THE '395 PATENT DISCLOSURE AND GED INVENTIONS	5		
III.		M CONSTRUCTION UNDER 37 C.F.R. § 42.104(b)(3)			
IV.		L OF ORDINARY SKILL IN THE ART			
V.	THE CHALLENGED CLAIMS HAVE AN EFFECTIVE FILING DATE OF JANUARY 31, 2014				
	A.	The Challenged Claims Are Not Entitled to the Filing Dates of Any Related Applications That Fail to Disclose the Claimed			
		Invention	11		
	В.	The Subject Matter of Claim 1 Was Not Disclosed in Any			
	$\mathbf{C}$	Related Applications	12		
	C.	The Subject Matter of Claim 2 and Its Dependent Claims Was Not Disclosed in Any Related Applications	10		
	D.	References Patent Owner Attempted to "Incorporate by	10		
	<b>D</b> .	Reference" Do Not Give The Challenged Claims an Effective			
		Filing Date Earlier Than January 31, 2014	22		
VI.	SUMMARY OF THE PRIOR ART				
	A.	Mueth – U.S. Patent 7,355,696			
		Durack – PCT Publication No. WO 2004/088283			
	C.	Frontin-Rollet – PCT Publication No. WO 2005/075629 A1			
	D.	Wada – U.S. Patent No. 6,506,609	26		
	E.	Kachel			



VII.	IT IS MORE LIKELY THAN NOT THAT AT LEAST ONE OF THE		
	CHALLENGED CLAIMS OF THE '395 PATENT IS		
	UNPATENTABLE		28
	A.	Ground 1: Indefiniteness of Claims 1-14 of the '395 Patent	28
	B.	Ground 2: Claims 1-13 Are Anticipated Under § 102(a)(1) By	
		U.S. Patent 7,355,696 ("Mueth")	31
	C.	Ground 3: Claim 14 Is Rendered Obvious by Mueth Alone or in	
		View of Durack	43
	D.	Ground 4: Claim 1 Is Anticipated Under § 102(a)(1) By	
		Frontin-Rollet	45
	E.	Ground 5: Claim 1 Is Anticipated Under § 102(a)(1) By Durack	50
	F.	Ground 6: Claims 2-14 Are Rendered Obvious by the	
		Combination of Wada, Durack and Kachel	57
	G.	Ground 7 – Lack of Enablement of Claims 1-14 of the '395	
		Patent	73
VIII	CONCLUSION		80



## **EXHIBIT LIST**

Exhibit No.	Description
Ex. 1001	U.S. Patent Number 8,933,395 to Mueth et al. (the "'395 Patent")
Ex. 1002	Declaration of Dr. Giacomo Vacca
Ex. 1003	Curriculum Vitae of Dr. Giacomo Vacca
Ex. 1004	U.S. Patent Application No. 13/412,969, issued as Patent No.
	8,653,442
Ex. 1005	PCT Publication No. WO 2004/088283 ("Durack")
Ex. 1006	Merriam-Webster's Collegiate Dictionary, 11 <sup>th</sup> Ed. (2007)
Ex. 1007	PCT Publication No. WO 2005/075629 ("Frontin-Rollet")
Ex. 1008	U.S. Patent No. 7,355,696 ("Mueth '696")
Ex. 1009	U.S. Patent No. 6,506,609 ("Wada")
Ex. 1010	U.S. Patent No. 5,135,759 ("Johnson")
Ex. 1011	"Sex Preselection: High-Speed Flow Cytometric Sorting of X and Y
	Sperm for Maximum Efficiency," L.A. Johnson and G. R. Welch,
	Theriogenology, Vol. 52, Issue 8, 1323–1341 (1999) ("Welch")
Ex. 1012	"Uniform Lateral Orientation Caused by Flow Forces of Flat
	Particles in Flow-Through Systems," V. Kachel et al., Journal of
	Histochemistry and Cytochemistry, Vol. 25, Issue 7, pp. 774-780
F 1010	(1977) ("Kachel")
Ex. 1013	File history of '395 Patent (U.S. Patent Application No. 14/169,927)
Ex. 1014	U.S. Provisional Patent Application No. 60/399,386
Ex. 1015	U.S. Provisional Patent Application No. 60/435,541
Ex. 1016	U.S. Patent Application No. 10/630,904, issued as Patent No.
	7,241,988
Ex. 1017	U.S. Patent Application No. 10/867,328, issued as Patent No.
	7,150,834
Ex. 1018	U.S. Patent Application No. 10/934,597, issued as Patent No.
T 1010	7,118,676
Ex. 1019	U.S. Patent Application No. 11/543,773, issued as Patent No.
E 1000	7,402,131
Ex. 1020	U.S. Patent Application No. 12/213,109, issued as Patent No.
F 1001	7,699,767
Ex. 1021	U.S. Patent Application No. 12/659,277, issued as Patent No.
	8,158,927



### **TABLE OF AUTHORITIES**

	Page(s)
CASES	
AK Steel Corp. v. Sollac, 344 F.3d. 1234 (Fed. Cir. 2003)	74
Automotive Techs. Int'l, Inc. v. BMW of North Am., Inc., 501 F.3d 1274 (Fed. Cir. 2007)	74
Boston Scientific Corp. v. Johnson & Johnson, 647 F.3d 1353 (Fed. Cir. 2011)	17
Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331 (Fed. Cir. 2009)	22
Halliburton Energy Servs., Inc. v. M-I LLC, 514 F.3d 1244 (Fed. Cir. 2008)	29
Hyatt v. Boone, 146 F.3d 1348 (Fed. Cir. 1998)	12
In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991)	73, 79
In re Wands, 858 F.2d 731 (Fed. Cir. 1988)	73, 74
Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364 (Fed. Cir. 2014)	28
LizardTech, Inc. v. Earth Res. Mapping, Inc., 424 F.3d 1336 (Fed. Cir. 2005)	
Lockwood v. American Airlines, Inc., 107 F.3d 1565 (Fed. Cir. 1997)	12
MagSil Corp. v. Hitachi Global Storage Techs., Inc., 687 F.3d 1377 (Fed. Cir. 2012)	77



# DOCKET

# 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.

