

Paper No. ____

Date Filed: Jun 22, 2016

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

CASE PGR2015-00017

U.S. PATENT 8,933,395

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I. INTRODUCTION

The Petition shows that claim 1 of the '395 patent, the only remaining claim at issue now, is unpatentable in view of Durack, Mueth, and Frontin-Rollet independently. The Petition is supported by the analysis and conclusions of an expert in the field, Dr. Vacca. In response, Patent Owner argues only that claim 1 is not invalid, and has offered to disclaim claims 2 through 14 of the '395 patent.¹ Patent Owner submits no expert declaration to rebut the opinions of Dr. Vacca relating to the priority issue or to his specific invalidity analyses.

Despite Patent Owner's attempts to narrow the interpretation of the claim language, the Petition shows that Durack discloses every element of claim 1, and therefore, renders claim 1 invalid. Mueth and Frontin-Rollet individually disclose every limitation of claim 1 as well—a point which Patent Owner acknowledges; however, Patent Owner argues that claim 1 is entitled to a priority date that pre-dates the two references. Consistent with Patent Owner's own interpretation of the final limitation of claim 1 as applied to Durack, neither the earlier applications nor the specification itself provide written description support for a single output channel that receives a "first flow" and "additional flows" after the operation of a

¹ Although Patent Owner has offered to file a statutory disclaimer, it has yet to do so. Regardless, Petitioner is entitled to a judgment against Patent Owner finding claims 2–14 of the '395 patent unpatentable.

laser. Because the earliest priority date of the challenged claim fails to pre-date Mueth and Frontin-Rollet, both references individually render claim 1 invalid.

Accordingly, claim 1 of the '395 patent is invalid in view of Durack, and in the alternative, invalid in view of Mueth and Frontin-Rollet independently.

II. CLAIM 1 IS ANTICIPATED BY DURACK

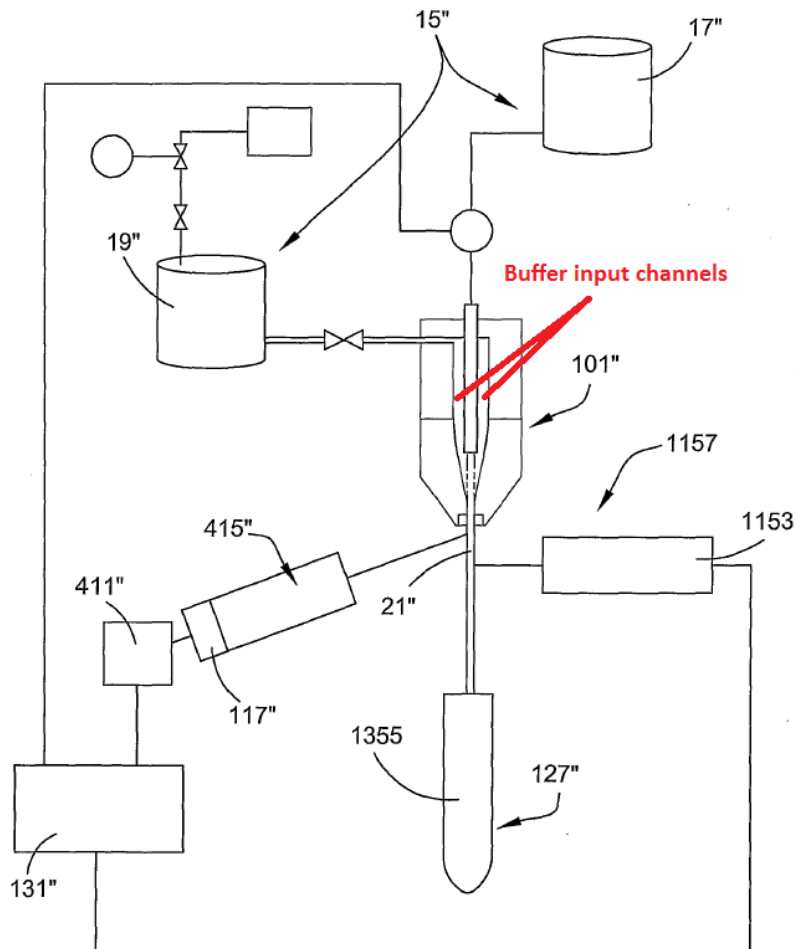
Patent Owner's contention that Durack does not anticipate claim 1 is based on a narrow reading of the claim and ignores the teachings of the prior art. As the Board noted, "Petitioner establishes sufficiently that Durack discloses each of the recited limitations of claim 1." Paper 8, Institution Decision 30 ("Decision").

A. Durack discloses a plurality of buffer input channels on either side of the first input channel

Durack discloses two or more buffer input channels on either side of a first input channel that carries the sample fluid mixture. As discussed in the Petition, Fig. 5 depicts at least two buffer input channels (radial bores 173 and 183) for delivering sheath fluid to the apparatus. Paper 1, Petition 52 ("Pet."). While Patent Owner argues that Durack's buffer input channels are orthogonal or adjacent to one another, nothing in Durack's specification limits the buffer input channels to a particular configuration. See Paper 13, Patent Owner Response 7-8 ("Resp."). Indeed, Fig. 5 does not specify a particular configuration and further, it is just one embodiment disclosed by Durack. Fig. 136 of Durack (below), which depicts a photo-damage sorting system, shows that the sheath fluid 19" enters the buffer

input channels, which are placed on either side of the first input channel carrying the carrier fluid 17":

FIG. 136



Durack, thus, discloses that the buffer solution is placed in channels on all sides of the channel carrying the fluid mixtures. Patent Owner's attempt to limit the disclosure of Durack to a single configuration in one figure should be rejected.

If the Board's construction is adopted, Durack similarly discloses two input channels surrounding a first input channel for supplying buffer similar to the '395 patent. Durack specifically discloses at least two input channels (radial bores 173

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