

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
Patent 8,933,395 B2

Held: September 14, 2016

BEFORE: KEN B. BARRETT, KRISTEN L. DROESCH, and
TRENTON A. WARD, Administrative Patent Judges.

The above-entitled matter came on for hearing on Wednesday,
September 14, 2016, commencing at 9:30 a.m., at the U.S. Patent
and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

Case PGR2015-00017

Patent 8,933,395 B2

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P R O C E E D I N G S

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JUDGE DROESCH: Good afternoon. We are gathered here for the oral hearing for post-grant review PGR2015-00017 between petitioner, Inguran, doing business as Sexing Technologies, and patent owner, Premium Genetics Limited of the United Kingdom.

I'm Judge Droesch and with me are Judge Barrett and Judge Ward. Per our order, each party has 30 minutes to present their argument. Because Petitioner has the burden to show the claims are not patentable, Ppetitioner will proceed first followed by Patent Owner. Counsel for Petitioner may reserve a portion of its time for rebuttal.

At this time I would like counsel for Petitioner to introduce yourselves and identify who is with you in attendance, followed by introductions by counsel for Patent Owner.

MR. O'NEILL: Good morning, Your Honor. Kirt O'Neill, lead counsel for the Petitioner. With me today is Mr. Rehan Safiullah. And Mr. Safiullah will be doing most of the argument for us today.

MR. JORGENSON: Good morning, Your Honor. I'm Matt Jorgenson of Sidley Austin for the Patent Owner. With me is Jeff Kushan, lead counsel. And I will be doing the argument.

JUDGE DROESCH: Thank you, counsel. Counsel for Petitioner, you may begin your 30 minutes of arguments when you are ready.

1 MR. SAFIULLAH: Good morning, Your Honors. I
2 would like to reserve ten minutes for rebuttal time.

3 In the proceeding today we only have one claim at
4 issue. Claims 2 to 14 were disclaimed by the Patent Owner. So
5 we only have that one claim, but that claim requires two issues to
6 be resolved today. The first dispute is whether Durack discloses
7 each and every element of claim 1. There's no dispute that
8 Durack is prior art to the '395 patent. The second dispute is
9 whether claim 1 of the '395 patent has an effective filing date
10 before January 31, 2014.

11 There is no dispute that Mueth and Frontin-Rollet, two
12 of the references that Petitioner asserted, disclose each and every
13 element. But there is a dispute of whether they are prior art. I
14 will be discussing the Durack reference and Mr. O'Neill will be
15 taking the priority issue.

16 I'm going to move to slide 2. So today we are going to
17 be discussing these three elements. The first one that we are
18 going to talk about relates to the buffer input channels and
19 whether they are placed on either side of the first input channel.
20 The second one relates to whether the flow has a direction along
21 the length of the apparatus. And the third one is the at least one
22 channel which is adapted to receive the different flows after the
23 laser. And that final limitation also relates to the priority issue
24 that we'll be discussing.

25 I'm going to move to the next slide, 3. Now, Durack
26 discloses each and every limitation and therefore, anticipates. We

1 had Dr. Vacca, an expert in the field of flow cytometry and
2 sorting, analyze the prior art and take a look at the patent, and his
3 opinion was that the '395 patent was invalidated by Durack
4 because Durack disclosed each and every limitation. Dr. Vacca's
5 testimony, incidentally, was un rebutted. Patent Owner did not
6 present any counter evidence from an expert. And I just wanted
7 to reiterate that the Federal Circuit has said that mere lawyer's
8 arguments and conclusory statements unsupported by factual
9 evidence are entitled to little probative value. Where there are
10 arguments from the Patent Owner, we believe that there was
11 conclusory statements made or mere lawyer's arguments. I'll try
12 to point that out as we go through the presentation.

13 The next slide, number 4, I want to jump into Durack
14 and deal with the first disputed limitation. And again, that relates
15 to whether the buffer input channels or a plurality of buffer input
16 channels, two or more, in Durack are disposed on either side of
17 the first input channel. And Figure 5 of Durack, as we see here,
18 173 and 183, are what are called bores which have sheath fluid in
19 Durack. And these are buffer input channels, and they are
20 disposed in either side of the conduit 157. We haven't
21 highlighted it, but it's right above the number 173. The 157 is the
22 conduit that carries the particles, and that would be equivalent to
23 a first input channel.

24 The next slide, 5, and Petitioner did apply the claim
25 construction provided by the Board. And the claim construction,
26 I want to focus on the second one because it also includes the

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