



Mere Possibility of Claimed Feature is Insufficient to Institute Inter Partes Review

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The challenged patent, U.S. Patent 8,206,987 (the “’987 patent”), is directed to methods for sorting delicate sperm cells to produce an enriched population of cells with a certain desired characteristic, such as an X or Y chromosome. In general, the methods disclosed in the patent involve staining a sample population of sperm cells with a fluorescent dye, flowing the stained cells in a fluid stream past an excitation laser and photodetector to detect the amount of fluorescence emitted from the cells, which varies depending on the sex chromosome of the sperm cell, and photodamaging the undesired cells to produce an enriched population of sperm cells with the desired sex characteristic. The petitioner argued that the ’987 patent was anticipated by Keij, which the board characterized as disclosing “a highspeed cell sorter . . . for ablating murine and human progenitor cells, and other rare cells, such as stem cells from bone marrow grafts.” For the ’987 claim limitations pertaining specifically to sorting delicate sperm cells, the petitioner pointed to one sentence in Keij stating that “sorting of X or Y chromosome bearing sperm cells . . . is an interesting possibility.” The board determined that this statement did not disclose “with anticipatory specificity” an example of a method of sperm sorting, “much less a method that produces an ‘enriched population of sperm.’” The board also found that this statement was insufficient to show a likelihood of prevailing at trial on the issue of obviousness. In particular, the board observed that sperm cells were known in the art as extremely delicate cells, and that the petitioner failed to set forth evidence that one skilled in the art would have expected the sperm to survive the process, compared to more robust cells. The board concluded that “Keij’s disclosure, that applying photodamage sorting to sperm cells ‘is an interesting possibility,’ is too slender a reed to support such an inference.” Accordingly, the board found that the petitioner failed to show a reasonable likelihood that it would prevail at trial on the

grounds of anticipation or obviousness and, therefore, denied the petition and declined to institute inter partes review.

ABS Global, Inc. v. Inguran, LLC, IPR20150001, Paper No. 12 (P.T.A.B. April 29, 2015).

Categories

Patent Trial & Appeal Board

Inter Partes Review

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