

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPECTRUM SOLUTIONS, L.L.C.,
Petitioner,

v.

DNA GENOTEK INC.,
Patent Owner.

IPR2022-01347
Patent 11,002,646 B2

Before DONNA M. PRAISS, CHRISTOPHER M. KAISER,
and JAMIE T. WISZ, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
Authorizing Additional Briefing
37 C.F.R. § 42.5

I. GENERAL INSTRUCTIONS

The Petition states “the claims are unpatentable as obvious regardless of whether the preamble is limiting and how it is construed.” Paper 1, 18. At the institution stage, we determined “it is not necessary for us to construe this claim term at this stage of the proceeding because neither party asserts that it is material to the asserted grounds in the Petition.” Paper 7, 10.

In its Patent Owner Response, Patent Owner states “no construction is necessary for the Board to determine patentability.” Paper 18, 6. Patent Owner also argues that “[t]he Petition does not address the ‘preventing alterations in the cellular epigenome’ requirement of its own construction” of “preserving a biological sample” recited in claim 1’s preamble. *Id.* at 89. Patent Owner further states that Petitioner “replace[s] Plante’s cap with Patterson’s annular valve, but, in doing so, eliminates the claimed ‘cap.’” *Id.* at 83 (footnote omitted).

In its Reply, Petitioner argues that “Maples ‘provides a method and composition for stabilizing biological cells and tissues,’ which includes the epigenome,” that “Maples ‘teaches stabilization and preserving the integrity of the cell’ for . . . epigenomic analysis,” and that the challenged patent “confirms that the known-in-the-art fixing agents disclosed in Maples ‘preserve the cells’ and ‘allow for a complete study of the epigenome.’” Paper 23, 24–25. Although the Petition asserts “the preamble is limiting” and that “the inventors acted as lexicographers to define the term ‘preserving cells,’” Petitioner does not provide an explicit explanation for why the preamble should require independently “preventing alterations in the cellular epigenome” in addition to preserving cells “such that the cells resist degradation.” Paper 1, 18; Paper 23, 24–25; Ex. 1001, 16:23–50. Petitioner

also disputes Patent Owner's arguments regarding Patterson's outer housing and inner tube together making up Patterson's mixing cap. Paper 23, 22.

In its Sur-reply, Patent Owner argues that the claimed "cap" is a separate element from the claimed "annular valve," and thus the Petition's identification of Patterson's annular valve as the claimed "cap" means Petitioner has not identified the claimed cap in Patterson. Paper 26, 21–22. Patent Owner also argues that claim 1's recitation of "preserving a biological sample" requires the Petitioner to show that Maples prevents alterations in the cellular epigenome by "at the very least prevent[ing] both methylation at the 5 position of cytosine in a CpG dinucleotide and acetylation of lysine residues of histones" because Petitioner avoided infringement based on this claim construction in the parallel district court litigation. *Id.* at 23 (citing *DNA Genotek v. Spectrum*, No. 21-cv-516, 2023 WL 3445207, at *20 (S.D. Cal. May 2, 2023)).

On November 14, 2023, an oral hearing was conducted for the case. In light of the parties' disputes, and based on arguments presented at the oral hearing, we determine that additional briefing may be helpful to us as to the proper claim construction for the terms "preserving a biological sample" and "cap." Specifically, we request further briefing on (1) whether claim 1's preamble is limiting, (2) whether the term "preserving a biological sample" means "stabilizing and preserving the integrity of a cell," and (3) whether the term "cap" means "a cover for the sample collection vessel that does not share a surface with the valve." We also authorize additional briefing for the parties to address what is the plain and ordinary meaning of "preserving a biological sample" and "cap" in the context of the challenged claims.

We also authorize the parties to address the effect of the construction of the aforementioned terms on the unpatentability issues before us. In the additional briefing, the parties may point to evidence already in the record, but may not introduce new evidence.

II. ORDER

Accordingly, it is

ORDERED that each party is authorized to file an opening brief, not to exceed seven pages, that addresses the above-identified issues no later than fourteen days after the date of this Order; and

FURTHER ORDERED that each party is authorized to file a responsive brief, strictly limited to addressing issues raised in the opposing party's opening brief (if submitted), not to exceed seven pages, and no later than twenty-eight days after the date of this Order.

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