

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.

Patent No. 11,536,632

Inter Partes Review No. IPR2023-01424

PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY BRIEF

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The Board authorized Patent Owner, DNA Genotek Inc., to provide this Preliminary Sur-Reply Brief in its January 17, 2024 email.

I. ARGUMENT

A. The Board Should Reject Petitioner’s Cap Construction Because It Is Not Faithful to the Claim Language

Petitioner’s Reply (Paper 7) cannot save the fundamentally deficient grounds in the Petition. Petitioner ignores that the Board—not Patent Owner—proposed a construction of “cap” as meaning “a cover for the sample collection vessel that does not share a surface with the valve” for the related ’646 Patent. (Paper 6 at 11 n.24.) Petitioner does not dispute that the meaning of “cap” includes a “‘cover’ for the sample collection vessel.” (Paper 7 at 1.) Thus, the only claim construction question is whether the claimed cap is co-extensive—or shares surfaces—with the claimed valve according to the language in the challenged claims. The answer of course is “No.”

Look at Claim 1:

1. A biological sample collection system, the system comprising:
 a sample collection vessel comprising
 a sample collection reservoir,
 a first connection member, and
 a first aperture for receiving a biological sample;
 a cap comprising
 a second aperture,
 a reagent chamber storing a reagent therein, and
 a second connection member complementary to the first connection member; and
 a moveable annular valve in the second aperture, the moveable annular valve comprising
 a vent,
 a first cylinder comprising a third aperture,
 a second cylinder comprising the vent, the second cylinder positioned in the third aperture,
 a closed configuration, and
 an open configuration, wherein
 in the annular valve’s closed configuration, the first and second cylinders create a fluid-tight seal with the cap and the first cylinder obstructs the vent to retain the reagent in the reagent chamber,
 the first cylinder and second cylinder are relatively moveable to thereby change the annular valve from the closed configuration to the open configuration, and
 in the annular valve’s open configuration, the first cylinder does not obstruct the vent to thereby allow flow of the reagent from the reagent chamber, through the vent, and into the sample collection reservoir.

The cap comprises a “second aperture.” (Ex. 1001 at 22:28.) The “valve” is “*in the second aperture*” of the “cap.” (*Id.* at 22:32 (emphasis added).) The valve cannot be in an opening of the cap if the valve is co-extensive with the cap. (*Id.* at 22:27-37.) Petitioner’s argument that the “valve is *part of the cap*” thus misreads the text of the claims. (Paper 7 at 3.) This is reading comprehension, not metaphysics. *Becton, Dickinson & Co. v. Tyco Healthcare Grp.*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (“Where a claim lists elements separately, ‘the clear implication of the claim language’ is that those elements are ‘distinct component[s]’ of the patented invention.” (citations omitted)). Petitioner’s argument also does not make sense in view of the structure of the claims with respect to separately recited elements. The cap and valve are listed as separate elements that interact with one another (e.g., the fluid-tight seal between the valve components and the cap).

Petitioner’s flawed analysis continues with Figure 3A. (Paper 7 at 3-4.) Contrary to Petitioner’s suggestion, the location of the reagent chamber as discussed in the specification does not impact the construction of “cap.” (*Id.*) Figure 3A depicts a cap **12**. Whether an “interior space **20**” can be partially defined by “wall **18**” or alternatively by the cap’s “wall **24**” proves nothing. Elsewhere, the specification explains that “**16**” is “an example interior chamber.” (Ex. 1001 at 12:10-13.) More to the point, the ’632 Patent claims a cap comprising an aperture with a “reagent chamber storing a reagent therein.” (*Id.* at 22:29.) The valve (with

its first and second cylinders) is within the aperture of the cap, but Claim 1 does not require that the reagent chamber be within or outside the valve itself. (*Id.*) Indeed, Petitioner does not dispute in its Reply that “[w]hether or not the cap may form part of a cavity that holds reagents, the cap is not the valve.” (Paper 6 at 13.) The location of the reagent compartment does not change whether the valve and cap are co-extensive.

Petitioner’s assertion of a “[m]anufactured [c]onstruction” rings hollow given that Patent Owner’s natural reading of the claim language is consistent with the claims, specification, and prosecution history. (Paper 7 at 2.) “[W]ords of a claim are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history.” *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Of course, a POSA would not think that “cap” can mean “valve” in the ’632 Patent because Claim 1 says that the valve goes inside the cap. Petitioner raises a distracting strawman-argument by asserting that there was no disavowal or lexicography. Patent Owner is not “redefining” the ordinary meaning of cap, *id.*, by pointing out that (1) the plain and ordinary meaning of “cap” does not mean “valve” and (2) the claims are structured such that the cap and valve are not co-extensive. In fact, Petitioner never disputes that the cap “is listed as a distinct structure from the valve” in the text of the claims. (Paper 6 at 12.) Petitioner cannot point to anything

in the intrinsic record to show that the cap and valve can be co-extensive. Thus, by waiving its hands at lexicography and disavowal, the entirety of Petitioner's Reply misses the mark.

Petitioner's own analysis supports that a POSA would not understand the cap to be co-extensive with the valve. Petitioner does not dispute that:

- “[C]ap” has its “ordinary sense as an object to cover and close the tube.” (Paper 7 at 2.)
- The “cap mates with the sample collection vessel (i.e., tube) to cover and close it.” (*Id.*)
- “[W]hen the cap's connection member engages the connection member of the vessel, the cap covers and closes the vessel.” (*Id.*)

None of those statements suggests a cap that is co-extensive with the valve.

B. Petitioner's Last-Ditch Construction Does Not Save the Petition

Even under Spectrum's newly proposed claim construction analysis, each ground fails.

1. Plante, Cho, and Patterson Combinations Fail Despite Spectrum's New Construction Arguments (Grounds 1, 2, and 4)

Whichever construction is adopted, Petitioner does not contend that its construction of cap salvages its failure to show a motivation to combine Plante, Cho, and Patterson under the Needlestick Safety and Prevention Act. (Paper 6 at 14-18.) Similarly, injection molding difficulties do not provide a motivation to combine under any construction. (*Id.* at 18-19.) Petitioner's construction also does not

address whether Cho’s valve defeats Plante’s objectives or creates an unacceptable risk of contamination. (*Id.* at 20-24.) Petitioner’s construction does nothing to refute that simple substitution is not a motivation to combine or that Patterson and Cho are not analogous art. (*Id.* at 24-34.)

2. Petitioner’s New Construction Does Not Fix the Flawed Ueda, Patterson, and Williams Grounds (Grounds 3, 4, and 5)

The Ueda, Patterson, and Williams grounds all fail under Petitioner’s construction of “cap” as “‘a lid or cover’ for the sample collection vessel.” (Paper 7 at 1.) Assuming *arguendo* that Ueda’s plug member 9 is a cap—it is not—Petitioner’s Reply does not dispute that Claim 1 requires “a sample collection vessel comprising . . . a first connection member” and “a cap comprising . . . a second connection member complementary to the first connection member.” (Paper 6 at 37.) Petitioner also does not dispute—under either construction—that the plug member 9 is Ueda’s alleged cap and that the plug member’s connection member is not complementary to the vessel’s connection member. Nothing in Petitioner’s proposed construction cures this defect.

II. CONCLUSION

Patent Owner requests that the Board deny the Petition.

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CERTIFICATE OF SERVICE

I hereby certify that the attached PATENT OWNER'S PRELIMINARY
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