

Filed on behalf of XY, LLC.

By: Kirt O'Neill (koneill@akingump.com)
AKIN GUMP STRAUSS HAUER & FELD LLP
300 Convent Street, Suite 1600
San Antonio, TX 78205
Tel: (210) 281-7100
Fax: (210) 224-2035

Paper No. ____

Date Filed: July 15, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,
Petitioner

v.

XY, LLC,
Patent Owner

Case IPR2014-01550
Patent 7,820,425

PATENT OWNER XY, LLC'S
RESPONSE UNDER 37 CFR § 42.120

VI. THE PRIOR ART

Each of the three references relied upon by Petitioner in support of its obviousness claims were submitted to the Patent Office during the prosecution of the '425 patent. Accordingly, the examiner was made aware of Seidel, Salisbury, and Fugger before the issuance of the '425 patent.

Petitioner states that “[a]lthough Fugger 1998 was submitted to the PTO during prosecution, it appears that the PTO was incorrectly told that this reference was dated March 2003, i.e., that it post-dated the priority date of the '425 patent.” (Petition at 36.) In support, Petitioner cites to its expert’s declaration, whose allegation is based on “the face of the patent” alone. (See Ex. 1003, Pace Decl., ¶ 214.) Although the '425 patent shows the date of “Mar. 19, 2003” on its face when referencing Fugger, the actual document that was submitted to the Patent Office expressly states that the “text corresponds to the manuscript published *September 1998* in the journal Human Reproduction.” Ex. 2018, Fugger et al., Journal Publication, 1-8 (03/19/2003) (emphasis added). Upon review of the document, the Examiner would have understood that Fugger was published on September 1998, not March 2003. Petitioner’s allegation is thus baseless.

highly successful and that frozen, sex-sorted semen has revolutionized the industry.

XI. CONCLUSION

In light of the differences between the contested claims and the prior art, the fact that the references could not have been successfully combined, and the objective evidence of nonobviousness, claims 1, 2-4, 6-9, 11-13, 15, 21-28, and 31-34 of the '425 patent are patentable and not obvious. Accordingly, Petitioner has not met its burden to prove that the contested claims are unpatentable and the Board should find that the '425 patent is not obvious in view of any of the references asserted.

Date: July 15, 2015

Respectfully submitted,

By: /Kirt O'Neill/
Kirt O'Neill
Registration No. 38,257
koneill@akingump.com
Daniel L. Moffett
Registration No. 60,715
dmoffett@akingump.com
AKIN GUMP STRAUSS HAUER &
FELD LLP
300 Convent Street, Suite 1600
San Antonio, TX 78205
Tel: 210-281-7100
Fax: 210-224-2035

Counsel for XY, LLC

APPENDIX – LIST OF EXHIBITS

Exhibit No.	Description
2009	ABS SEXATION, http://www.absglobal.com/sexation (last visited June 19, 2015)
2010	John Schenk’s Bull Stud Contact Information, January-June 2003
2011	The 2 nd Bi-Annual W. E. Petersen Symposium, “Reproductive Loss in Dairy Cows: Is the Trend Reversible,” Univ. of Minnesota (April 8, 2003) (“Petersen Symposium”)
2012	<i>Sexing Claims Dismissed</i> , FARMER’S WEEKLY (July 3, 1998)
2013	E.F. Fugger et al., <i>MicroSort® Separation of X- and Y-Chromosome Bearing Sperm: Ongoing Clinical Trial Results after Intrauterine Insemination (IUI), In-Vitro Fertilization (IVF), and Intracytoplasmic Sperm Injection (ICSI)</i> , FERTILITY AND STERILITY, Vol. 76, Issue 3, Suppl. 1, at S14 (September 2001) (“Fugger 2001”)
2014	D.G. Cran et al., <i>Separation of X- and Y-Chromosome Bearing Bovine Sperm by Flow Cytometry for Use in IVF</i> , THERIOGENOLOGY, 41:183 (1994) (“Cran 1994”)
2015	Expert Declaration of Ms. Cynthia L. Ludwig
2016	Resume of Ms. Cynthia L. Ludwig
2017	Transcript of Cross-Examination of Dr. Marvin M. Pace
2018	Fugger et al., Journal Publication, 1-8 (03/19/2003) – submission to USPTO
2019	D. G. Cran & L. A. Johnson, <i>The Predetermination of Embryonic Sex Using Flow Cytometrically Separated X and Y Spermatozoa</i> , Human Reproduction Update, Vol. 2, No. 4, 355–363 (Feb. 16, 1996) (“Cran 1996”)
2020	<i>Livestock Sex Predetermination Trials in Cheshire</i> , FARMER’S WEEKLY (June 17, 1998)
2021	Deposition Transcript of John Hasler, <i>XY, LLC v. Trans Ova Genetics, L.C.</i> , No. 1:13-cv-00876-WJM (D. Colo.) (June 10, 2015) – Volume II (“Hasler Tr.”).

2022	Sarah Galdi, <i>ABS Sexation's® Strong Brand and Diverse Product Line Help ABS to Reach One Million Units</i> , BEEF MAGAZINE (Nov. 6, 2008), http://beefmagazine.com/abs-sexation-s-strong-brand-and-diverse-product-line-help-abs-reach-one-million-units (“Galdi 2008”)
2023	Seidel Speaking Points, from Hasler Tr.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing XY, LLC's Patent Owner Response (and accompanying Exhibits 2009-2023) was served on counsel of record on July 15, 2015, by filing this document through the Patent Review Processing System, as well as delivering a copy via e-mail to the counsel of record for the Petitioner at the following email addresses:

jkushan@sidley.com
peter.choi@sidley.com
mjorgenson@sidley.com
jlgordon@sidley.com

Date: July 15, 2015

By: /Kirt O'Neill/
Kirt O'Neill
Registration No. 38,257
Counsel for XY, LLC