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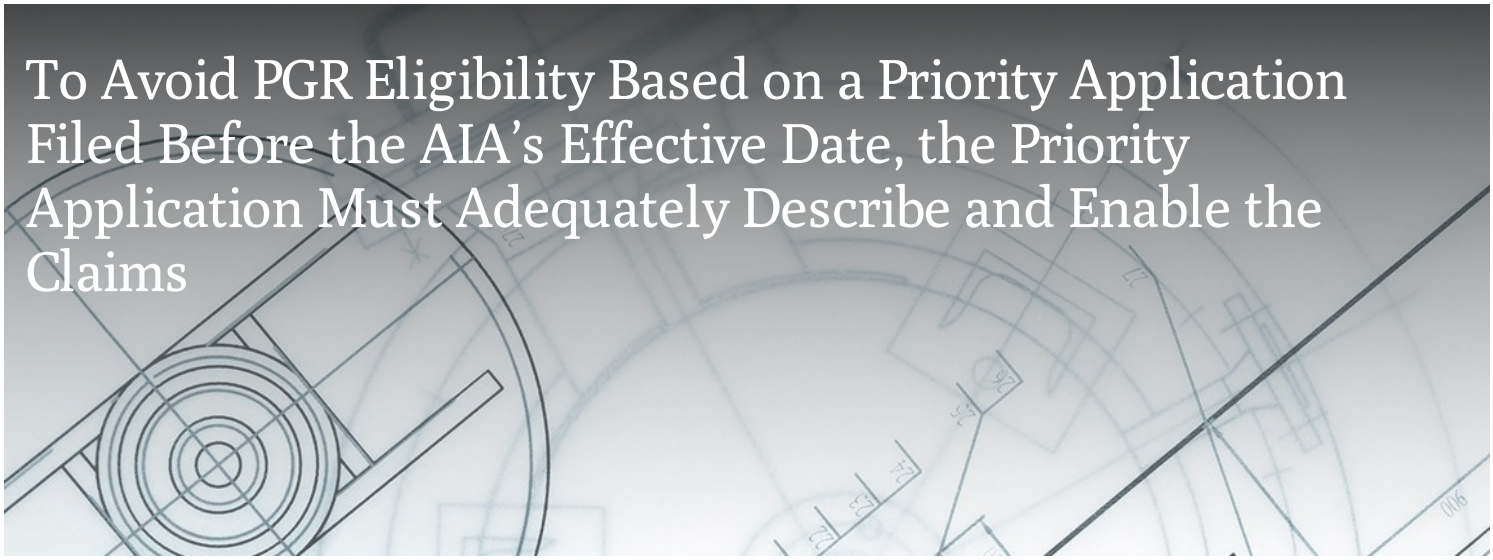
BLOG

To Avoid PGR Eligibility Based on a Priority Application Filed Before the AIA's Effective Date, the Priority Application Must Adequately Describe and Enable the Claims



FEBRUARY 12, 2021

Commonwealth Scientific and Industrial Research Organisation v BASF Plant Science GMBH, PGR2020-00033, Paper 11 (P.T.A.B. September 10, 2020).
Before: Jenks, Kokoski, and Abraham

The PTAB instituted a PGR petition brought by CSIRO because CSIRO had demonstrated that the challenged claims were eligible for post-grant review, and because it was more likely than not that at least one claim was unpatentable for lack of written description and enablement.

CSIRO filed a petition seeking post-grant review of a patent related to a process for the production of oils, lipids, and/or fatty acids in transgenic plants, on anticipation and obviousness grounds, as well as for lack of written description and enablement. As a threshold matter, the PTAB had to determine whether the challenged patent was eligible for post-grant review. The Board noted that "[t]here are two requirements that must be met for post-grant review to be available." First, the petition must be filed within nine months of the issuance of the challenged patent. Second, "post-grant review is only available for patents that issue from applications that at one point contained at least one claim with an effective fling date of March 16, 2013, or later." The Petitioner "bears the burden of proving that the challenged claims lack the benefit of the filing date of the earliest application that supports the claims."

Here, CSIRO took the position that the challenged patent was eligible for post-grant review because it was not entitled to "an effective filing date earlier than September 6, 2016, which is the actual filing date of the application" for the patent. More specifically, CSIRO argued that the challenged claims lacked sufficient written description and enablement in the priority applications. The PTAB agreed, and rejected BASF's arguments that a "pre-AIA designation made during prosecution [is] dispositive of the issue of whether the [] patent is eligible for post-grant review." In addition, the mere fact that the patent is a continuation of, and claims priority to, a pre-AIA application "does not relieve [the Board] of [its] obligation to determine whether the [challenged] patent is eligible for post-grant review by confirming that the claims have sufficient written description and are enabled in the priority application."

On the merits, the PTAB found that the challenged claims were not adequately supported by the priority application. The Board also declined to exercise its discretion under 35 U.S.C. § 324(a) to deny CSIRO's petition. In particular, the Board disagreed with BASF's assertions that CSIRO took contrary positions in a prior district court litigation between the parties. The arguments made in the prior litigation were directed to an unrelated patent, and the PTAB noted that

even if the issues were similar, “Petitioner is not bound by the arguments it made with respect to a different patent on a different record.” There was no evidence that CSIRO was trying to “game the system” or “harass patent owners” when it had not previously challenged the patent-at-issue before the Board or in district court.

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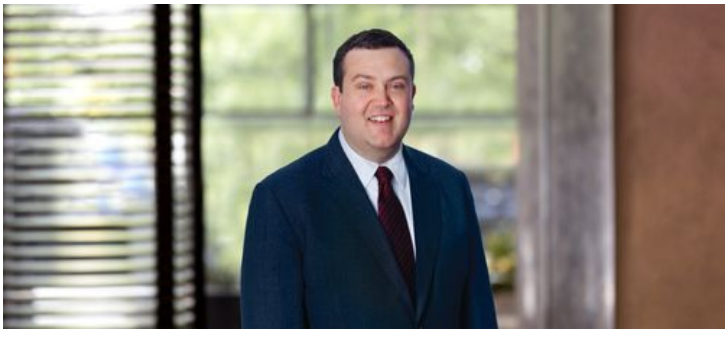

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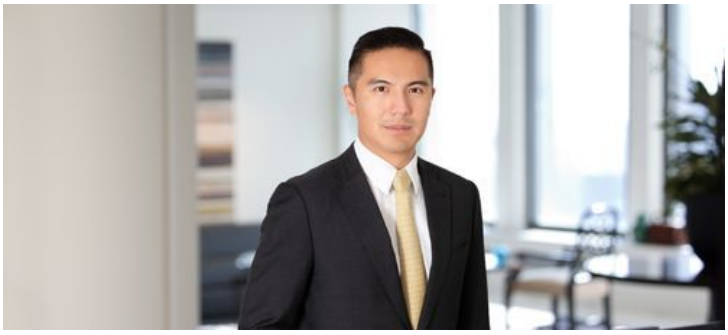

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