

International Flavors & Fragrances Inc. v. United States, Final Written Decision (Granting Motion to Amend) IPR2013-00124

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[Takeaway: For the first time ever, the Board granted \(in-part\) a Patent Owner's Motion to Amend.](#)

For the first time, in its [Final Written Decision](#), the Board granted-in-part **Patent Owner's Motion to Amend**. Rather than filing a Patent Owner Response to argue the patentability of the challenged claims, Patent Owner filed a Motion to Amend cancelling the challenged claims and proposing a set of substitute claims. Petitioner did not file an Opposition to the Motion to Amend.

The '016 patent is drawn to the use of a particular chemical, isolongifolenone, to repel arthropods, such as ticks and mosquitoes. The Board had instituted trial on the following grounds: claims 1, 4, 5, 7, 8, 14, 19-21, and 23 as being anticipated by Behan; claims 1, 4, 5, 7, 8, 14-21, and 23 as obvious over Behan and Grieco; and claims 1, 4, 5, 7, 8, 14, and 19-26 as obvious over Behan and Carroll.

The Board generally described the disclosures of each of the relied upon prior art references. In particular, the Board explained that Behan disclosed the use of perfume ingredients as insect repellents and particularly as being effective against mosquitoes and cockroaches. Behan lists several ingredients that may be used as repellents, including isolongifolanone, an analog of isolongifolenone. However, the Board stated that Behan "does not include an example, nor present any data, demonstrating the ability of isolongifolanone to repel arthropods, such as mosquitoes or cockroaches."

With respect to Grieco, the Board stated that the reference "does not disclose the use of isolongifolenone derivatives, such as isolongifolanone." Similarly, the Board found that "[l]ike Grieco, Carroll does not disclose the use of isolongifolenone derivatives, such as isolongifolanone."

The Board noted that Patent Owner, as the moving party, bears the burden of proof to establish entitlement to the relief requested. Patent Owner must demonstrate by a preponderance of the evidence that the proposed claims are patentable.

First, the Board noted that substitute claims may not enlarge the scope of the original claims. The Board held that the proposed substitute claims do not impermissibly broaden the scope of the challenged claims. In this regard, the substitute independent claim 27 corresponds to challenged claim 1 and further limits the analogs of isolongifolenone used in the method to specific modified

isolongifolanone compounds. Proposed independent claim 45 corresponds to claim 1 and adds the limitation that the method is limited to repelling ticks or mites, without the further limitation to the type of compound found in claim 27.

Next, the Board discussed the written description support for the substitute claims. The Board agreed that the portions of the specification cited by Patent Owner provided the required written description support for each of the proposed substitute claims.

The Board then discussed patentability of the substitute claims over the prior art. The Board noted that Patent Owner has the “the burden of proof to demonstrate patentability of the proposed claims over the prior art in general, and thus entitlement to the proposed claims.” In particular, a “patent owner should discuss, as well as present evidence, if appropriate, as to the level of ordinary skill in the art, and what was known regarding the features being relied upon to demonstrate patentability of the proposed claims.”

With respect to establishing patentability of prior art in general, the Board first noted that Patent Owner only characterized Behan as the “apparent closest prior art.” However, the Board held that Patent Owner had provided sufficient evidence to demonstrate “what would have been understood by the ordinary artisan as to those features being relied upon to demonstrate patentability of the proposed claim.” In particular, Patent Owner cited several publications and provided an expert declaration that “the ordinary artisan would not expect that minor structural changes to a known insect, tick, or mite repellent would result in a modified compound having the same repellency as the parent compound.” Thus, Patent Owner argued, “such activity cannot be predicted based on structure alone, but must be determined by experiment.”

In light of the finding that Behan did not disclose the use of the claimed analog as a repellent, the Board discussed the patentability of the substitute claims under the law of obviousness. In particular, the Board noted that “the prior art must provide a reason to make the claimed compound, and there must also be ‘adequate support in the prior art’ for the change in structure.” In addition, for chemical cases, “it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound,” and there must be “a finite number of identified solutions” in the field.

The Board credited Patent Owner’s evidence that small changes in structure can change the activity of an insect repellent. The Board found that the prior art did not disclose the use of the particular compound used in claim 27, but only disclosed the use of its analogs. The prior art also failed to “provide a reason to modify isolongifolanone to arrive at the modified isolongifolanone compounds of proposed claim 27” and to “provide a reasonable expectation that such modifications would result in a compound having the desired insect repellent activity.” Thus, claim 27 and its dependent claims 28-44 were found patentable over the prior art, and the Board granted the Motion with respect to those claims.

With respect to claim 45, Patent Owner argued that it would not have been obvious to apply the claimed repellent to ticks or mites based on the known use of the compound to repel mosquitoes. The Board noted that the claim was drawn to a method where the “isolongifolenone analog may be isolongifolanone,” which Behan disclosed could be used to repel insects, including mosquitoes and cockroaches. The Board found that Patent Owner had not presented sufficient evidence to establish that it would not have been obvious to use the compound disclosed in Behan to repel ticks or mites. Thus, the Board denied the Motion with respect to claim 45.

International Flavors & Fragrances Inc. v. United States, as represented by the Secretary of Agriculture, IPR2013-00124

Final Written Decision

Dated: May 20, 2014

Patent 7,579,016 B2

Before: Lora M. Green, Francisco C. Prats, and Michael J. Fitzpatrick

Written by: Green

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