

Patentee May Cancel but May Not Substitute Claims when Proposed Amended Claims Are Not Shown To Be Unobvious

Article By:

Shane G. Smith, Ph.D.

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.

Addressing the burden of establishing the patentability of claim amendments in inter partes review (IPR), the U.S. Patent and Trademark Office Patent Trial and Appeal Board (PTAB or Board) denied a patent owner's motion to amend claims based upon its finding that the proffered amended claims would have been obvious to one of ordinary skill in the art. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, Case No. IPR 2013-00266 (PTAB, Oct. 28, 2014) (Crumbley, APJ.)

Petitioner Intelligent Bio-Systems petitioned for IPR of Illumina's patent on grounds that certain claims were anticipated by any of three prior art references. The PTAB instituted IPR on those grounds. Illumina elected not to file a response to that decision and instead submitted a motion to amend the patent claims under review.

The patent relates to methods of sequencing DNA by the stepwise addition of a detectable label and blocking group so that the sequence of the target DNA may be determined one nucleotide at a time. The PTAB noted that such a sequence-by-synthesis technique was nothing new. Amendments offered by Illumina thus sought to narrow the claims to the use of cleavable labels bound to target DNA by a disulfide linkage. The PTAB, applying the broadest reasonable interpretation standard, construed the claims under review as further limited to uses of blocking groups that can be cleaved under the same conditions as a disulfide bond but without requiring a specific structure.

Intelligent Bio-Systems demonstrated that multiple prior art references gave a skilled worker reason to use a disulfide linker in a stepwise synthesis reaction. Such a linkage would, for example, ensure that attachment of the detectable label to the target nucleotide would not interfere with the action of a polymerase enzyme during the synthesis reaction. Counter-arguments by Illumina's expert that one of skill could not modify prior art teachings to arrive at the patent methods failed to persuade the PTAB.

Considering this evidence as a whole, the PTAB concluded that Illumina failed to carry its burden of proving by a preponderance of evidence that the proposed substitute claims were patentable over the prior art considered in the opinion. The PTAB thus denied Illumina's motion to enter substitute claims. However, the PTAB granted Illumina's motion to the extent it cancelled the remaining patent

claims under review.

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