Published on *The National Law Review* https://natlawreview.com

Did PTAB Dose AIA Poison Pill Incorrectly Against Premium Genetics?

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In ***Inguran, LLC v. Premium Genetics (UK) Ltd.***, the ***USPTO Patent Trial and Appeal Board (PTAB)*** instituted Post Grant Review (PGR) proceedings in a patent granted from an AIA transition application based on its finding that at least one of the claims was not entitled to an effective filing date before March 16, 2013. While that aspect of the institution decision makes it interesting enough, I am not confident that the PTAB correctly applied 35 USC §§ 100 (i), 100 (j), and 102(A)(1) in its grounds for institution against claim 1.

The Institution Decision

The patent at issue is Premium Genetic's U.S. Patent 8,933,395, which was granted January 13, 2015, from an application filed January 31, 2014. The USPTO's Patent Application Information Retrieval website gives the following priority information for the '395 patent:

The patent was granted with 14 claims, with claims 1 and 2 being independent claims.

Inguran argued that none of the claims were adequately supported by the ‘969 application filed March 6, 2012, such that the effective filing date of all claims was January 31, 2014, making the ‘395 patent subject to PGR.

The PTAB was “***not*** persuaded that claim 1 is ***not*** disclosed in the ‘969 Application in the manner required by 35 U.S.C. § 112(a),” and was “***not*** persuaded that claim 1 is ***not*** entitled to an effective filing date before March 16, 2013? (emphasis added). However, the PTAB agreed for the purposes of its institution decision that “claim 2 is not disclosed in the ‘969 Application in the manner required by 35 U.S.C. § 112(a),” such that “the ‘395 Patent is available for post-grant review.”

The PTAB considered Inguran’s written description, enablement, and prior art challenges to the claims, and instituted PGR on the following prior art grounds (only):

- Claims 1-13 under 35 U.S.C. § 102(a)(1) as anticipated by Mueth
- Claim 14 under 35 U.S.C. § 103 as unpatentable over Mueth, or Mueth and Durack
- Claim 1 under 35 U.S.C. § 102(a)(1) as anticipated by Frontin-Rollet
- Claim 1 under 35 U.S.C. § 102(a)(1) as anticipated by Durack
- Claims 2-13 under 35 U.S.C. § 103 as unpatentable over Wada, Durack, and Kachel

The AIA Poison Pill Was Correctly Prescribed

Under section 3(n)(1) of the America Invents Act (AIA), presenting a single claim with an effective filing date of March 16, 2013 or later acts as a “poison pill” that brings that application/patent, and any application/patent claiming priority to it, under the first-inventor-to-file provisions of the AIA, including the provisions that make a patent subject to post grant review:

> (n) EFFECTIVE DATE.—
> (1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and ***shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time***—
> (A) ***a claim to a claimed invention that has an effective filing date*** as defined in section 100(i) of title 35, United States Code, that is ***on or after the effective date*** described in this paragraph; or
> (B) ***a specific reference*** under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

Thus, having found that claim 2 of the ‘395 patent was not adequately supported by the earlier ‘969 Application, I think the PTAB correctly found that the ‘395 Patent as a whole is subject to PGR.

Claim 1 Was Deprived Of Its Effective Filing Date Antidote

Even if one claim acts like an AIA poison pill that subjects all claims to the first-inventor-to-file provisions of the AIA, I believe the AIA still requires each claim to be analyzed independently based on its own effective filing date when applying prior art.

35 USC § 102(a)(1) of the AIA provides:

> (a) Novelty; Prior Art.— A person shall be entitled to a patent unless—
> (1) ***the claimed invention*** was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public ***before the effective filing date of the claimed invention***; or
> (2) ***the claimed invention*** was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122 (b), in which the patent or application, as the case may be, names another inventor and was effectively filed ***before the effective filing date of the claimed invention***.

The term “claimed invention” is defined in 35 USC § 100(j) of the AIA:

The term “claimed invention” means the subject matter ***defined by a claim*** in a patent or an application for a patent.

The term “effective filing date” of a “claimed invention” is defined in 35 USC § 100(i) of the AIA:

> (1) The term “effective filing date” for a claimed invention in a patent or application for patent means—
> (A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or
> (B) ***the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority*** under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

As I understand them, 35 USC §§ 100 (i), 100 (j), and 102(A)(1) together mean that different claims in a first-inventor-to-file patent can have different effective filing dates, and thus be subject to different prior art. So, why didn’t the PTAB consider the earlier effective filing date of claim 1 when deciding the grounds for institution?

As shown above, the priority claim of the ‘395 Patent traces back to September 3, 2004 through a series of continuation and divisional applications. Since the PTAB was not persuaded that claim 1 was not entitled to the March 6, 2012 filing date of the ‘969 Application, if it had considered this issue it may have found that claim 1 is entitled to the September 3, 2004 filing date of the ‘597 Application, since that application appears to have the same specification. In that case, only items published or effectively filed before September 3, 2004 would qualify as prior art to claim 1 under 35 USC §

102(a)(1) of the AIA. However, it appears that each of Mueth, Durack and Frontin-Rollet were published or effectively filed ***after*** September 3, 2004.

If my understanding is correct, there still should be time to save claim 1 from an untimely death, since trial just was instituted on December 22, 2015.

Am I missing something?

National Law Review, Volume VI, Number 4

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