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Patent Trial and Appeal Board Creates Loophole to Challenge Written Description and Enablement in Older Patent Families

Legal Update

06.15.2017

The Patent Trial and Appeal Board's May 10 decision in *Minerva Surgical, Inc. v. Hologic, Inc.* (PGR2017-00002) creates a loophole in Patent Office post-grant practice that enables challengers to bring new kinds of invalidity attacks against patents claiming priority to older applications.

The issue comes from the distinction between two types of post-grant challenge created by the Leahy-Smith America Invents Act (AIA), called *inter partes* review (IPR) and post-grant review (PGR). Since the AIA's enactment, IPRs have been the most common form of validity challenge at the Patent Office, primarily because they are available for all patents. One significant drawback to IPRs, however, is that they must be based on a limited set of statutory invalidity arguments. In contrast, PGRs do not have the subject matter restrictions of IPRs, but they are only available for patents that contain "a claim to a claimed invention that has an effective filing date on or after March 16, 2013," and they must be filed within nine months after the patent issues.

The *Minerva Surgical* case raised a key procedural question about how the Board determines whether a patent is eligible for a PGR challenge – one which opens the door for PGR attacks against new patents claiming priority to older applications. The petitioner in *Minerva Surgical* alleged that the patent's specification did not contain sufficient written description or enablement to support its claims under 35 U.S.C. § 112. Those types of challenge are available in PGRs, but not in IPRs. The challenged patent issued from a 2015 application, but it claimed priority to a string of continuation applications dating back to 1998. PGR eligibility thus hinged on whether the patentee could rely on its claim to pre-AIA priority.

The Board held that patent priority for determining PGR eligibility hinged on the substance of the parent patent application, not just the fact that a claim of priority had been made. The Board looked in detail at the disclosure of the alleged priority applications, and agreed with the petitioner that they did not support the patent claims. Notably, because the specification of the issued patent was identical to the specifications of the priority patents, the Board's finding that the challenged claims were not entitled to pre-AIA priority also led it to find that the claims were "more likely than not ... unpatentable under 35 U.S.C. § 112(a) for failure to satisfy the written

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description requirement” and for lack of enablement.

While at first blush the *Minerva Surgical* case may appear to hinge on its particular facts, those facts will appear in every written description and enablement challenge. Unless the patent applicant actually deleted parts of its invention disclosure during prosecution of the patent family, a parent application will not support anything that is missing from the final issued patent. As a result, if the Board continues to follow *Minerva Surgical*, it will evaluate each written description or enablement challenge in a PGR petition on its merits to determine the patent’s PGR eligibility. If the Board determines that the challenge is more likely than not to succeed on the merits, it will disregard any claim of priority to an earlier patent application. Of course, to be eligible for PGR, the patent must still have issued within the last nine months, and the most recent application in the chain must have been filed after March 16, 2013.