

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH
ORGANISATION,

Petitioner,

v.

BASF PLANT SCIENCE GMBH,
Patent Owner.

PGR2022-00026
Patent 11,180,769 B2

Before ULRIKE W. JENKS, JO-ANNE M. KOKOSKI, and
TINAE. HULSE, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

DECISION
Granting Institution of Post Grant Review
35 U.S.C. § 324

I. INTRODUCTION

Commonwealth Scientific and Industrial Research Organisation (“Petitioner”) filed a Petition for a post-grant review of claims 1–3 (“the challenged claims”) of U.S. Patent No. 11,180,769 B2 (Ex. 1001, “the ’769 patent”). Paper 1 (“Pet.”). BASF Plant Science GmbH (“Patent Owner”) did not file a Preliminary Response.

Institution of a post-grant review is authorized by statute when “the information presented in the petition filed under [35 U.S.C. §] 321 . . . demonstrates that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a). For the reasons set forth below, we determine that Petitioner has demonstrated that it is more likely than not that claims 1–3 are unpatentable, and we institute a post-grant review of claims 1–3 based on the grounds set forth in the Petition.

A. Real Parties-in-Interest

Each party identifies itself as the real party-in-interest. Pet. 6; Paper 4, 1.

B. Related Matters

The parties identify as a related matter pending U.S. Patent Application No. 17/532,634, which is a continuation of the application that issued as the ’769 patent.

C. The ’769 Patent (Ex. 1001)

The ’769 patent is titled “Method for the Production of Multiple-Unsaturated Fatty Acids in Transgenic Organisms.” Ex. 1001, code (54). The ’769 patent was filed as Application No. 16/509,247 (“the ’247 application”) on July 11, 2019, which is a continuation of Application No. 15/237,901, filed August 16, 2016, which is a division of Application

No. 10/566,944 (“the ’944 application”), filed on July 16, 2004. *Id.*, codes (21), (22), (60).

The ’769 patent discloses a process for producing polyunsaturated fatty acids (“PUFAs”) in a transgenic plant. *Id.* at 1:35–62. The process includes genetically engineering the plant by introducing nucleic acids that encode polypeptides providing desaturase and elongase activity. *Id.* Desaturase and elongase are used in biological pathways to synthesize PUFAs including eicosapentaenoic acid (EPA) and docosahexaenoic acid (DHA), which are long-chain polyunsaturated fatty acids (“LCPUFAs”). *See id.* at 4:25–45, Fig. 1. The Specification explains that “higher plants” produce PUFAs, such as linoleic acid, but do not produce large amounts of LCPUFAs, such as EPA and DHA. *See id.* at 5:59–65. The ’769 patent discloses that producing LCPUFAs in higher plants, including oil crops, would economically provide large amounts of high-quality LCPUFAs for the food industry, animal nutrition, and pharmaceuticals. *Id.* at 5:65–6:3. Specifically, the Specification describes a process for creating transgenic plants capable of producing EPA and DHA by introducing into oil-crop plants genes encoding $\Delta 6$ -desaturases, $\Delta 6$ -elongases, $\Delta 5$ -desaturases, and $\Delta 4$ -desaturases. *See id.* at 6:3–15.

D. Illustrative Claim

Independent claim 1 of the ’769 patent is illustrative and reproduced below.

1. A process for the production of a transgenic plant that produces docosahexaenoic acid (DHA) and/or eicosapentaenoic acid (EPA), said process comprising:
 - a) introducing, into the plant, at least one nucleic acid sequence which encodes a polypeptide with $\Delta 6$ -desaturase activity, and

- b) introducing, into the plant, at least one nucleic acid sequence which encodes a polypeptide with $\Delta 6$ -elongase activity, and
 - c) introducing, into the plant, at least one nucleic acid sequence which encodes a polypeptide with $\Delta 5$ -desaturase activity, and
 - d) introducing, into the plant, at least one nucleic acid sequence which encodes a polypeptide with $\Delta 5$ -elongase activity, and
 - e) introducing, into the plant, at least one nucleic acid sequence which encodes a polypeptide with $\Delta 4$ -desaturase activity, and wherein the $\Delta 6$ -desaturase uses CoA fatty acid esters as a substrate,
- wherein the at least one nucleic acid encoding a polypeptide with $\Delta 6$ -desaturase activity comprises:
- i) the nucleotide sequence of SEQ ID NO: 89;
 - ii) a nucleotide sequence encoding the amino acid sequence of SEQ ID NO: 90; or
 - iii) a nucleotide sequence encoding a polypeptide having at least 65% sequence identity to the amino acid sequence of SEQ ID NO: 90.

Id. at 451:1–452:8.

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–3 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. ¹ §	Reference(s)/Basis
1–3	112(a)	Written Description
1–3	112(a)	Enablement
1–3	102(a)	Zank ²
1–3	102(a)	Napier ³

¹ Although the Petition identifies eleven (11) grounds, there are only four distinct bases with multiple written description and enablement grounds.

² Zank et al., WO 2005/012316 A2, published Feb. 10, 2005 (Ex. 1003).
Petitioner cites to the English language publication, US 2008/0155705 A1, published Jun. 26, 2008 (Ex. 1018).

³ Napier et al., WO 2013/0153404 A1, published Oct. 17, 2013 (Ex. 1019).

Petitioner also relies on the Declarations of Dr. Narendra Yadav (Ex. 1002) and Dr. Robert Charles de Feyter (Ex. 1015) to support its assertions.

II. ANALYSIS

A. Person of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art “would have had at least a Ph.D. in plant sciences, lipid biochemistry, lipid metabolism, bioinformatics or a related field and at least 3–5 years of research work experience (excluding Ph.D. thesis studies) in the structure-function relationship of fatty acid enzymes.” Pet. 45 (citing Ex. 1002 ¶ 16). Patent Owner does not provide a separate definition with respect to the ordinarily skilled artisan.

Petitioner’s unopposed proposed definition is consistent with the cited prior art and the disclosure of the ’769 patent, and we adopt it for purposes of this Decision. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)). Patent Owner is invited to brief the issue further during trial if it disagrees with that definition.

B. Claim Construction

In this post-grant review, we construe the claims of the ’769 patent “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b).” 37 C.F.R. § 42.200(b) (2019). Under that standard, the words of a claim are generally given their “ordinary and customary meaning,” which is the meaning the term would

have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Petitioner proposes the ordinary and customary meaning for “docosahexaenoic acid (DHA) *and/or* eicosapentaenoic acid (EPA).” *See* Pet. 44 (emphasis added). Specifically, Petitioner contends that the use of “and/or” “encompasses a plant that produces EPA without producing DHA and encompasses a plant that produces DHA without producing EPA,” in addition to a plant that produces both DHA and EPA. *Id.* at 44–45 (citing Ex. 1002 ¶ 94). For purposes of this Decision, and based on the record before us, we determine that none of the claim terms requires an explicit construction to determine whether to institute post-grant review.

C. Post-Grant Review Eligibility

As a threshold issue, we must determine whether the ’769 patent is eligible for post-grant review.⁴ There are two requirements that must be met for post-grant review to be available. First, post-grant review is only available if the petition is filed within nine months of the issuance of the challenged patent. 35 U.S.C. § 321(c). Here, the Petition was filed on February 28, 2022, which is within nine months of the ’769 patent’s November 23, 2021, issue date. Paper 3, 1; Ex. 1001, code (45).

Second, as noted above, post-grant review is available only for patents that issue from applications that at one point contained at least one claim with an effective filing date of March 16, 2013, or later. *See* Leahy-Smith

⁴ The ’769 patent is a transitional patent. A “transitional” patent is a patent that issued after the effective date of the AIA, but was filed as a continuation application that claims priority to an application that was filed prior to the effective date of the AIA.

America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) §§ 3(n)(1), 6(f)(2)(A). The “effective filing date” for a claim is either the application’s actual filing date or the filing date of the earliest application that supports the claim. 35 U.S.C. § 100(i) (2018). A patent claiming the benefit of priority of an application filed before March 16, 2013, must have written description support for the claimed invention in the earlier-filed application in order to avoid PGR-eligibility. *Id.*

Petitioner has the burden of establishing eligibility for post-grant review. *See Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.*, PGR2016-00010, Paper 9 at 10 (PTAB Aug. 15, 2016). To show that the ’769 patent is eligible for post-grant review, Petitioner bears the burden of proving that the challenged claims lack the priority benefit of the filing date of an earlier application. In particular, Petitioner must show that at least one of the challenged claims, or a claim pending during examination of the ’247 application, “was not disclosed in compliance with the written description and enablement requirements of § 112(a) in the earlier application for which the benefit of an earlier filing date prior to March 16, 2013 was sought.” *Inguran, LLC v. Premium Genetics (UK) Ltd.*, PGR2015-00017, Paper 8 at 11 (PTAB Dec. 22, 2015).

Petitioner contends that the ’769 patent is eligible for post-grant review because none of the challenged claims are entitled to an effective filing date earlier than the July 11, 2019 filing date of the ’247 application, let alone in an application filed prior to March 16, 2013. Pet. 45–48. Notably, the ’769 patent claims priority to a pre-AIA application, the ’944 application filed on July 16, 2004. Ex. 1001, code (60). Accordingly, Petitioner bears the burden of showing that at least one of the challenged claims are not supported by ’944 application, which has the same disclosure

as the '769 patent. Petitioner contends that “specification of the ['769] Patent provides neither written description nor enablement for the scope of patent protection it seeks to cover by its claims 1–3.” Pet. 3.

1. Written Description

To satisfy the written description requirement under 35 U.S.C. § 112(a), the specification must “reasonably convey[] to those skilled in the art that the inventor had possession” of the claimed invention as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). An adequate description does not require any particular form of disclosure or that the specification recite the claimed invention *in haec verba*, but must do more than render the claimed invention obvious. *Id.* at 1352. In evaluating the adequacy of the disclosure, a court may consider “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.” *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005) (cited with approval in *Ariad*, 598 F.3d at 1352); *see also Boston Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011) (holding that because the assessment for written description is made from the perspective of a person of ordinary skill in the art, in some instances, a patentee can rely on information that is “well-known in the art” to satisfy written description).

- a) Grounds 1 and 2: “wherein the at least one nucleic acid encoding a polypeptide with $\Delta 6$ -desaturase activity comprises: . . . iii) a nucleotide sequence encoding a polypeptide having at least 65% sequence identity to the amino acid sequence of SEQ ID NO: 90”*

Claim 1 requires the step of introducing into a plant at least one nucleotide sequence which encodes a polypeptide with $\Delta 6$ -desaturase

activity. Ex. 1001, 451:5–7. Claim 1 further limits the nucleotide sequence associated with $\Delta 6$ -desaturase activity to one of three alternatives (i–iii). *See id.* at 452:1–8. Claims 2 and 3 directly depend from claim 1, and also include this limitation. *Id.* at 452:9–21.

For convenience, our discussion refers to the '769 patent specification (“Specification”), rather than the '944 application. “The grandparent of the '769 Patent (U.S. Application No. 10/566,944) was filed as a § 371 national stage entry of this PCT Application and thus the specification of the WO 2005/012316 is the same as the specification of the '769 Patent.” Pet. 83.

Petitioner first contends that the '769 patent “does not mention, much less properly describe, a nucleotide sequence encoding a polypeptide having at least ‘65%’ sequence identity to the amino acid sequence of SEQ ID NO:90.” Pet. 52–53 (citing Ex. 1002 ¶ 103). Specifically, Petitioner contends that the Specification describes 65% as the level of homology for isolating nucleic acids by hybridization, but does not describe the number “65%” in the context of amino acid sequence identity. *See id.* at 52 (citing Ex. 1002 ¶ 104); *see* Ex. 1001, 68:1–29.

Second, Petitioner contends that the '769 patent does not provide written description support for a nucleic acid encoding a polypeptide with $\Delta 6$ -desaturase activity, having at least 65% sequence identity to the amino acid sequence of SEQ ID NO: 90. Pet. 53–60. Petitioner contends that for inventions in an unpredictable art “the disclosure must adequately reflect the structural diversity of the claimed genus, either through the disclosure of sufficient species that are ‘representative of the full variety or scope of the genus,’ or by the establishment of ‘a reasonable structure-function correlation.’” *Id.* at 49 (citing *AbbVie Deutschland GmbH & Co., KG v.*

Janssen Biotech, Inc., 759 F.3d 1285, 1300–01, (Fed. Cir. 2014). Petitioner contends that the '769 patent Specification does not meet either of these two requirements.

As to a representative number of species, Petitioner contends that the '769 patent Specification “describes only a *single* species—SEQ ID NO:90 itself—that is within the scope of the claimed genus encompassing polypeptides with as little as 65% identity to SEQ ID NO:90.” *Id.* at 54. For example, Petitioner contends that the '769 patent describes eight other $\Delta 6$ -desaturases, each having amino acid sequences “with only between 21.91% to 24.01% identity to the amino acid sequence set forth in SEQ ID NO:90.” *Id.* (citing Ex. 1002 ¶ 107). Accordingly, Petitioner contends that the Specification does not describe a representative number of species within the claimed genus of $\Delta 6$ -desaturases. *See id.* at 54.

Because the Specification discloses only a single species within the claimed genus, Petitioner contends that the Specification must describe “the relationship between the structure of SEQ ID NO:90 and its function as (1) a $\Delta 6$ -desaturase that (2) acts on a CoA substrate.” *Id.* at 51. Petitioner sets forth several arguments as to why the '769 patent does not establish this structure-function correlation. *See id.* at 55–60.

First, Petitioner contends that “[t]he sole disclosure in the [']769 Patent which relates to the structure of SEQ ID NO:90 is in Example 28 of the [']769 Patent, which outlines how five sequences containing conserved His-box motifs common to *all* membrane-bound desaturase enzymes were identified in the *Ostreococcus tauri* genome.” *Id.* at 55; *see* Ex. 1001, 93:48–94:27. However, Petitioner contends that the '769 patent Specification “is completely devoid of any disclosure regarding the structure(s) of the polypeptide set forth in SEQ ID NO:90, which confer its regioselectivity, i.e.

its ability to act as a $\Delta 6$ -desaturase by adding a carbon-carbon double bond to the sixth carbon of a fatty acid in contrast to [other desaturases].” *Id.* at 55–56 (citing Ex. 1002 ¶ 110).

Second, Petitioner contends that post-filing publications indicate that the $\Delta 6$ -desaturase structure-function activity had not been clearly identified at the time the ’944 application was filed. Pet. 56–57 (citing Ex. 1002 ¶¶ 111–112). For example, Petitioner contends that the claimed $\Delta 6$ -desaturase was unrelated to any other $\Delta 6$ -desaturase that had been functionally characterized at the time, and was “the *first* acyl-CoA desaturase from a member of the plant kingdom.” *Id.* at 37–39, 56–57 (citing Ex. 1002 ¶¶ 71–75, 86, 113).

Third, Petitioner contends that experimental evidence shows that “changes in as little as 1.1% of the amino acids of SEQ ID NO:90 . . . can eliminate $\Delta 6$ -desaturase activity.” *Id.* at 58–59. Specifically, Petitioner contends that Dr. de Feyter’s Declaration “describes experiments which were designed to test whether variants of SEQ ID NO:90, designed based on information provided in the [’]769 Patent and knowledge in the art, retain $\Delta 6$ -desaturase activity.” *Id.* at 58 (citing Ex. 1015 ¶¶ 2–9; Ex. 1002 ¶ 115). Dr. de Feyter produced and tested “ten variants of SEQ ID NO:90” including “deletions or substitutions of between 1.1% and 13.2% of the amino acids of SEQ ID NO:90, well within the scope of the claimed 65% identity.” *Id.* at 58–59 (citing Ex. 1015 ¶¶ 10–29; Ex. 1002 ¶ 116). Petitioner contends that, “[d]espite avoiding changes to the conserved His-boxes and HPGG amino acid motif of the cytochrome *b₅* domain, seven of the ten variants completely lacked $\Delta 6$ -desaturase activity, while two of the variants retained slight activity of <1% on LA as substrate but lacked activity on ALA as substrate.” *Id.* at 59 (citing Ex. 1015 ¶¶ 30–40; Ex. 1002 ¶ 117).

Based on our review of the current record, we find that the disclosures in the Specification are insufficient to show that the inventors were in possession of the full scope of the claims including nucleotide sequence encoding a $\Delta 6$ -desaturase polypeptide having as little as 65% identity to SEQ ID NO:90 at the time the '944 application was filed. We therefore determine, based on the current record, that the disclosures in the Specification (and the '944 application) are insufficient to provide sufficient written description support for independent claim 1, and claims 2–3 that depend directly therefrom.

b) Grounds 3–6

Petitioner presents additional arguments that the '769 patent does not provide written description support for the recited claims. *See* Pet. 60–68 (Grounds 3–6). In Grounds 3 and 4, Petitioner contends that there is no written description support for a $\Delta 6$ -desaturase of SEQ ID NO:90, which uses CoA fatty acid esters as a substrate (Ground 3), or a transgenic plant using SEQ ID NO:90 to produce EPA and/or DHA (Ground 4). *See id.* at 60–66. In Grounds 5 and 6, Petitioner contends that the Specification does not provide written description support for plants that produce DHA *or* EPA (Ground 5) and the claims are broader in scope than the minimum amount of DHA and EPA described by the Specification (Ground 6). *See id.* at 66–68. Having already determined that Petitioner has sufficiently established that all of the challenged claims lack written description support in the Specification, we need not address whether the claims lack written description support based on these additional grounds as well.

2. Enablement

Petitioner also contends that the Specification does not enable the challenged claims. Pet. 68–80. Having determined that Petitioner sufficiently

demonstrates that the challenged claims lack written description support in the Specification, we need not reach the merits of Petitioner's enablement argument for the purposes of deciding whether the '769 patent is eligible for post-grant review.

3. Conclusion: PGR Eligibility

For the foregoing reasons, and on the current record, we are persuaded that Petitioner has satisfied its burden to prove that the Specification (and the '944 application) fails to provide written description support for the challenged claims. Therefore, we determine that the '769 patent is not entitled to the benefit of the filing date of the '944 application (July 16, 2004), and, thus, the '769 patent is eligible for post-grant review.

D. Grounds 1–6: Lack of Written Description Support

Petitioner contends that the challenged claims are unpatentable for lack of written description support for the same reasons it contends the '769 patent is eligible for post-grant review. Pet. 81. As set forth above (*see* § II.C.1), we determined that the disclosures in the Specification are insufficient to provide written description support for the challenged claims. For the same reasons, we also determine that Petitioner has demonstrated that it is more likely than not that the challenged claims are unpatentable for lack of written description support. Thus, we exercise our discretion and institute post-grant review of claims 1–3 as challenged under Grounds 1–6.

E. Grounds 7–9: Lack of Enablement

Petitioner contends that the challenged claims are unpatentable for failing to satisfy the enablement requirement. Pet. 68–80, 82–83.

Under 35 U.S.C. § 112(a), enablement is separate and distinct from the written description requirement. *Ariad*, 598 F.3d at 1344. “The test of enablement is whether one reasonably skilled in the art could make or use

the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). “[A] patent specification complies with the statute even if a ‘reasonable’ amount of routine experimentation is required in order to practice a claimed invention.” *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1371 (Fed. Cir. 1999). “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). These factors, referred to as the *Wands* factors, include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id.

1. *Ground 7: “at least one nucleic acid sequence which encodes a polypeptide with $\Delta 6$ -desaturase activity,” “wherein the $\Delta 6$ -desaturase uses CoA fatty acid esters as a substrate,” “wherein the at least one nucleic acid encoding a polypeptide with $\Delta 6$ -desaturase activity comprises . . . a nucleotide sequence encoding a polypeptide having at least 65% sequence identity to the amino acid sequence of SEQ ID NO: 90”*

Claim 1 requires a nucleic acid sequence that encodes a polypeptide having at least 65% sequence identity to SEQ ID NO:90 and having $\Delta 6$ -desaturase activity when using CoA fatty acid esters as a substrate.

Ex. 1001, 451:1–452:8. Claims 2–3 directly depend from claim 1 and also include this limitation. *Id.* at 452:8–21. Petitioner contends that “the claims recite a broad genus of $\Delta 6$ -desaturases, which can differ in amino acid

sequence by up to 35% relative to SEQ ID NO:90,” which “is the only polypeptide sequence disclosed in the entire application within the scope of the claimed genus.” Pet. 70; *see also id.* at 71, 74. Petitioner further contends that there is no guidance or working examples “regarding modifications to the amino acid sequence of SEQ ID NO:90—that might allow a POSITA to make other polypeptides that (1) act on an acyl-CoA substrate, (2) have $\Delta 6$ -desaturase activity, or (3) have any desaturase activity at all.” *Id.*; *see also id.* at 71–72, 74–80. Accordingly, Petitioner contends that due to the breadth of the claims and the limited guidance and working examples, “the disclosure does not teach the POSITA how to make and use the full claimed scope, without undue experimentation.” *Id.* at 70 (citing Ex. 1002 ¶ 138).

Based on the evidence of record, we find that Petitioner has adequately established, for purposes of this Decision, that the claim language relating to a nucleotide sequence encoding a peptide having 65% sequence identity to SEQ ID NO:90 *and* $\Delta 6$ -desaturase activity using CoA fatty acid esters as a substrate is not enabled. The Specification does not provide guidance to one skilled in the art how to vary the amino acid sequence of SEQ ID NO:90 up to 35% while maintaining the claimed $\Delta 6$ -desaturase activity. As set forth above, the Specification provides only one example of a sequence that falls within the claimed 65% sequence identity to SEQ ID NO:90, although the claims cover a wide range of amino acid sequences. *See* Pet. 71. Petitioner contends that

Because little was known about the structures of SEQ ID NO:90 that confer its functionality, a comprehensive mutagenesis study, amounting to significant trial and error experimentation, would be required for a POSITA to determine how to vary SEQ ID

NO:90 by up to 35% while maintaining its ability to use CoA fatty acid esters as a substrate.

Id. at 73 (citing Ex. 1002 ¶ 145).

Because there is only one example of a nucleic acid that meets the broad claim limitation and the Specification does not provide adequate guidance or direction in an unpredictable art, we find that Petitioner adequately demonstrates, for purposes of this Decision, that independent claim 1, and claims 2–3 that directly dependent therefrom, are not enabled. Accordingly, we institute a post-grant review of claims 1–3 under Ground 7.

2. Grounds 8 and 9

In Grounds 8 and 9, Petitioner contends that certain limitations are not enabled by the Specification. Pet. 74–80. Having determined that Petitioner has established it is more likely than not that at least one of the challenged claims is unpatentable under alternate grounds as discussed above (*see above*, § II.D), we institute a post-grant review based on Grounds 8 and 9 as well. *See Guidance of the Impact of SAS on AIA Trial Proceedings* (April 26, 2018) (explaining that “the PTAB will institute as to all claims or none” and “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition”).

F. Grounds 10 and 11

Petitioner contends that claims 1–3 are anticipated by Zank (Ground 10) or Napier (Ground 11). Pet. 83–90. Having determined that Petitioner has established it is more likely than not that at least one of the challenged claims is unpatentable under alternate grounds as discussed above (*see above*, § II.D), we institute a post-grant review based on Grounds 10 and 11 as well. *See Guidance of the Impact of SAS on AIA Trial Proceedings* (April 26, 2018) (explaining that “the PTAB will institute as to

all claims or none” and “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition”).

III. CONCLUSION

Based on the arguments in the Petition, and the evidence of record, we determine that Petitioner has sufficiently demonstrated that claims 1–3 of the ’769 patent lack written description support in the ’944 application, and that the ’769 patent is eligible for post-grant review. Additionally, we determine that Petitioner has demonstrated, on the current record, that it is more likely than not that at least one claim of the ’769 patent is unpatentable. Thus, we institute a post-grant review of all challenged claims on all the grounds presented.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the ’769 patent is instituted with respect to the grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

PGR2022-00026
Patent 11,180,769 B2

PETITIONER:

Gary J. Gershik
Brian A. Comack
AMSTER ROTHSTEIN & EBENSTEIN LLP
ggershik@arelaw.com
bcomack@arelaw.com

PATENT OWNER:

Sandip H. Patel
Mark H. Izraelewicz
MARSHALL, GERSTEIN & BORUN LLP
spatel@marshallip.com
mizraelewicz@marshallip.com