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*Edited by Gregory J. Battersby
and Charles W. Grimes*

IP *Litigator*



US Patent and Trademark Office Practice

Y. Jenny Chen

Opting for PGR over IPR: A Cautionary Tale

With respect to patent trial proceedings before the Patent Trial and Appeal Board (PTAB), it is tempting to view post-grant review (PGR) as potentially more powerful than *inter partes* review (IPR), as PGR allows challenges to any requirement of patentability, while IPR is limited to claim validity in view of patents and printed publications. Accordingly, PGR, if available, may in some cases be a better option for petitioners. However, as one recent case before the PTAB demonstrates, there are drawbacks to the procedure. While PGR may seem like the better option, the petitioner must be certain to persuade the examiner that the patent at issue is qualified for PGR.

PGR is available only for patents filed after March 15, 2013. A patent issued from an application filed after March 15, 2013 may be shielded from PGR if all of its claims, and all claims that ever existed in that application or any application to which it claims priority, are entitled to priority to an application filed before March 16, 2013. For patents filed after March 15, 2013 but claiming priority to applications filed before March 16, 2013, whether to challenge such a patent under PGR or IPR can be a tricky question for a

petitioner, because patents eligible for PGR may not be challenged in an IPR until at least nine months after they issue.

In *Mylan Pharmaceuticals Inc. v. Yeda Research & Development Co. Ltd.* [PGR2016-00010], Mylan filed a petition requesting post-grant review of Yeda's patent, which issued from an application filed after March 15, 2013 and which claims priority, *via* a chain of intermediate applications, to a provisional application filed in 2009. Mylan asserted that certain claims of Yeda's patent lack written description in both the instant specification and in the 2009 provisional application, and as such, the patent is subject to PGR. If Mylan had prevailed in the priority challenge, the benefit of taking the PGR route would be obvious: Yeda's patent would face both anticipation/obviousness attacks based on intervening prior art and non-prior art-based invalidity grounds as alleged by Mylan in the PGR petition.

However, the PTAB decided not to institute Mylan's petition on the ground that Mylan failed to meet its burden to show that Yeda's patent includes at least one claim having an effective filing date on or after March 16, 2013. First, the PTAB agreed with Yeda that whether the involved patent is an America Invents Act (AIA) case was addressed during prosecution by the examiner, who stated in a notice that the application was being examined under the pre-AIA

provisions. The PTAB apparently gave a lot of deference to the examiner's decision on this issue.

Second, the PTAB concluded that Mylan, as the petitioner, failed to meet its burden of persuasion on at least two grounds by failing to address all possible sources of support, including: (1) any original claims of the prior applications, which could have been used to satisfy the written description requirement, and (2) all pre-March 16, 2013 ancestor applications in the chain of priority claim, so as to show a break in the priority claim.

Takeaways for Practitioners

For some recently granted patents, PGR may be a preferable vehicle for a challenge, either because of the breadth of issues that can be raised or possibility of immediate action. The petitioner should make sure that the petition meets the requirements, and, where there is a claim of priority to an application filed before March 16, 2013, the petitioner should be mindful that it bears the burden of persuasion to show that the patent to be challenged indeed qualifies for PGR. For example, the petition should take into consideration all prior applications in the priority chain and all original claims in each prior application.

Y. Jenny Chen PhD is a shareholder in the Biotechnology and Post-Grant Proceedings Groups at intellectual property law firm Wolf Greenfield in Boston, MA. She focuses her practice on US and foreign patent prosecution and portfolio strategy, opinion work, due diligence, and post-grant matters such as interference, inter partes review, and reexamination. She can be reached at jchen@wolfgreenfield.com.