

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DAVID O. B. A. ADEBIMPE,
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,
Patent Owner.

Case PGR2016-00020
Patent 9,108,890 B2

Before MICHAEL P. TIERNEY, CHRISTOPHER M. KAISER, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
37 C.F.R. § 42.208

INTRODUCTION

David O. B. A. Adebimpe (“Petitioner”) filed a Petition requesting post-grant review of claims 1–18 of U.S. Patent No. 9,108,890 B2 (Ex. 1008, “the ’890 patent”). Paper 1. The Johns Hopkins University (“Patent Owner”) has not yet filed a Preliminary Response, but Patent Owner requested that the parties be permitted to file briefs on the issue of whether the ’890 patent is eligible for post-grant review. Following a conference call attended by counsel for both parties, we authorized this briefing. Paper 9. On July 5, 2016, Patent Owner filed its brief on post-grant review eligibility, and Petitioner filed a responsive brief on July 19, 2016. Paper 11; Paper 13.

We have considered the Petition, the evidence currently of record, and the briefing submitted by both parties, and we conclude that the ’890 patent is not eligible for post-grant review. Accordingly, we deny the Petition.

BACKGROUND

The ’890 patent relates to a “method for manufacturing training aid materials for detecting homemade explosives.” Ex. 1008, at [57]. Specifically, the ’890 patent describes manufacturing training aids that allow explosives detection dogs to be trained to detect homemade explosives in various environments. *Id.* at 1:23–2:2, 2:26–9:39. The ’890 patent issued from an application whose actual filing date was February 25, 2013. Ex. 1008, at [22]. The ’890 patent also asserts a claim of priority to an earlier provisional application, which was filed October 4, 2012. *Id.* at [60], 1:8–11.

ANALYSIS

Post-grant reviews are available only for patents “described in section 3(n)(1)” of the Leahy-Smith America Invents Act (“AIA”), Pub L. No. 112-

29, 125 Stat. 284 (2011). AIA § 6(f)(2)(A). These patents are those that issue from applications “that contain[] or contained at any time . . . a claim to a claimed invention that has an effective filing date in section 100(i) of title 35, United States Code, that is on or after” “the expiration of the 18-month period beginning on the date of the enactment of” the AIA.

Id. § 3(n)(1). Because the AIA was enacted on September 16, 2011, post-grant reviews are available only for patents that issue from applications that at one point contained at least one claim with an effective filing date on or after March 16, 2013, with “effective filing date” having the definition given to it by 35 U.S.C. § 100(i). Our rules require that each petitioner for post-grant review certify that the challenged patent has an effective filing date that renders the patent available for post-grant review. 37 C.F.R.

§ 42.204(a) (“The petitioner must certify that the patent for which review is sought is available for post-grant review . . .”).

The effective filing date of an application for a patent on an invention is “the filing date of the earliest application for which the . . . 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).” 35 U.S.C. § 100(i)(1)(B). In the event that the application is not entitled to any earlier filing date or right of priority, the effective filing date is “the actual filing date of the . . . application for the patent containing a claim to the invention.”

Id. § 100(i)(1)(A). Section 100(i)(1) does not make any provision for the effective filing date to be later than the actual filing date of the application in question, even when the application is amended later, and even when the

later amendment introduces claims that lack written-description support in the original specification.

Because the eligibility of a patent for post-grant review is controlled by the definition of “effective filing date” in § 100(i)(1), we are not persuaded by Petitioner’s argument, Paper 13, 2–3, that the effective filing date of the amended claims of the ’890 patent was March 17, 2015. Here, the ’890 patent issued from an application whose actual filing date was February 25, 2013. Ex. 1008, at [22]. The ’890 patent also asserts a claim of priority to an earlier provisional application, which was filed October 4, 2012. *Id.* at [60], 1:8–11. Under § 100(i)(1), each claim of the ’890 patent must have as its effective filing date one of these two dates. Regardless of which date is properly the effective filing date,¹ both dates are earlier than March 16, 2013. Thus, the ’890 patent is not among those patents that § 6(f)(2)(A) of the AIA makes eligible for post-grant review.

CONCLUSION

Because claims 1–18 of the ’890 patent are not entitled to an effective filing date on or after March 16, 2013, the ’890 patent is not subject to the first-inventor-to-file provisions of the AIA and, thus, not eligible for post-grant review. Accordingly, we cannot institute a post-grant review of any of the challenged claims.

ORDER

It is hereby

ORDERED that the Petition is denied, and no trial is instituted.

¹ We need not, and accordingly do not, decide whether the claim of priority to the earlier provisional application is valid.

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