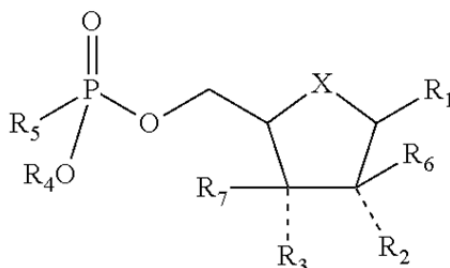


UNIV. OF MINN. v. GILEAD SCIS., INC., Appeal No. 2021-2168 (Fed. Cir. March 6, 2023).
Before Lourie, Dyk, and Stoll. Appealed from the Patent Trial and Appeal Board.

Background:

The University of Minnesota owned a patent having claims directed to a compound of the below formula, where each variable was defined by a list of possible candidate structures. The list of possible options was over a page long.



Gilead Sciences challenged the patent in an *inter partes* review as being anticipated by one of Gilead's own patent application publications. The parties stipulated that the publication disclosed every limitation of the representative challenged claim; the issue was whether the claimed subject matter was supported by the patent's priority application and thus entitled to a priority date that antedates Gilead's publication.

The PTAB held that the claim was *not* supported by its earlier priority application, and thus could not antedate Gilead's publication. Accordingly, the patent was invalidated as anticipated by the publication. The university appealed.

Issue/Holding:

Did the PTAB err in holding that the claim at issue was not supported by the priority application? No, affirmed.

Discussion:

In determining whether the claimed compound was supported by the priority application, the Federal Circuit reviewed the standard for written-description support in the context of claiming a genus of chemical compounds. In this case, the priority application described a broad genus of compounds, and the challenged patent claimed a subgenus of compounds within that broad genus. In order to find support for the subgenus in the priority application disclosure, there must be "blaze marks" in the disclosure that would guide one of ordinary skill in the art to the claimed subgenus.

There were no such "blaze marks" here. In its arguments, the university pointed to a series of dependent claims in the priority application, each one of which disclosed a list of possibilities for a single variable. The university argued that by combining a selection of these claims, one would arrive at the claimed subgenus. However, the court concluded that this "maze-like path" was not enough to "reasonably lead" one of ordinary skill in the art to the claimed subgenus. Accordingly, the claimed subgenus was not supported by the priority application's generic teachings, and thus was not entitled to its earlier filing date.