



Portfolio Media, Inc. | 111 West 19th Street, 5th floor | New York, NY 10011 | www.law360.com
Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

PTAB Says Mass. Biotech's Milk Patent Ineligible For Review

By Tiffany Hu

Law360 (September 16, 2019, 8:57 PM EDT) -- Following the U.S. International Trade Commission's initial decision this month that German-based Jennewein's imports infringe a Glycosyn milk patent, the Patent Trial and Appeal Board has made public its refusal to grant Jennewein's request to review a related patent.

In a June 27 decision released Friday, the PTAB denied Jennewein Biotechnologie GmbH's petition for post-grant review of Massachusetts-based Glycosyn LLC's U.S. Patent No. 9,970,018, which covers a way to produce purified human milk oligosaccharides, or HMOs, using *E. coli* bacteria.

The board said the '018 patent was not eligible for post-grant review because it claimed priority to Glycosyn's U.S. Patent No. 9,453,230, which was filed in February 2012. Post-grant review is available only for patents filed on or after March 16, 2013.

Jennewein contended that some claims were entitled to a filing date of September 2017, when the '018 patent itself was filed, because they were "not enabled" by the teachings of the '230 patent or other applications.

The PTAB was unmoved, however, finding that Jennewein failed to sufficiently show that at least one claim in the '018 patent was entitled to the later filing date and thus qualify for post-grant review.

"Petitioner fails to carry its burden to show that at least one of the claims of the '018 patent is not entitled to an effective filing date before March 16, 2013," the board wrote. "Consequently, Petitioner failed to establish that the '018 patent is eligible for post-grant review."

The '018 and '023 patents are the center of an ongoing dispute between the biotechnology firms, beginning with Glycosyn suing Jennewein in March 2018 over its imported HMO products, which it claimed infringed the '230 patent.

In April 2018, Glycosyn had asked the ITC to investigate Jennewein's imports over similar allegations, asking the commission to ban the allegedly infringing products. The '018 patent was added to the investigation after it was issued, according to filings.

Jennewein then petitioned for post-grant review of the '018 patent in December. In its petition, it had noted its intention to eventually include the '018 patent to the district court case, which has been stayed pending the outcome of the ITC probe.

The PTAB's now-public filing follows an ITC administrative law judge's Sept. 9 decision that

Jennewein's imported HMOs infringe the '018 patent and that the German company failed to show that the disputed claims were invalid. That decision is subject to review by the commission.

The patents at issue are U.S. Patent Nos. 9,970,018 and 9,453,230.

Jennewein is represented at the PTAB by Bryan Nese, Scott McMurry and Ying-Zi Yang of Mayer Brown LLP.

Glycosyn is represented at the PTAB by Michael C. Newman, Thomas H. Wintner, Peter J. Cuomo and Daniel B. Weinger of Mintz Levin Cohn Ferris Glovsky and Popeo PC.

The PTAB case is Jennewein Biotechnologie GmbH v. Glycosyn LLC, case number PGR2019-00023, before the Patent Trial and Appeal Board.

The ITC investigation is Certain Human Milk Oligosaccharides and Methods of Producing the Same, Inv. No. 337-1120, before the U.S. International Trade Commission.

The district court case is Glycosyn LLC v. Jennewein Biotechnologie GmbH, case number 1:18-cv-10423, in the U.S. District Court for the District of Massachusetts.

--Editing by Haylee Pearl.

Correction: An earlier version of the story misstated counsel for the parties. That error has been corrected.

All Content © 2003-2019, Portfolio Media, Inc.