

## PGR denied for failing to establish lack of written description and enablement

OCTOBER 19, 2020

*BASF Corp. v. Ingevity South Carolina, LLC*, PGR2020-00035, Paper 11 (September 10, 2020)

Before: Crumbley, Kaiser, and Heaney

The PTAB denied institution of a PGR petition brought by BASF Corporation because BASF failed to show that it was more likely than not that it would prevail in establishing unpatentability of the challenged claims for lack of written description and enablement.

BASF filed a petition seeking post-grant review of certain claims of a patent related to canister systems employing activated carbon to adsorb fuel vapor emitted from motor vehicle fuel systems and to reduce hydrocarbon air pollution. BASF asserted four grounds of unpatentability based on lack of written description and enablement.

In Ground 1, BASF alleged that the limitations requiring “a subsequent adsorbent volume having . . . an effective butane working capacity (BWC) of less than 3 g/dL, and a g-total BWC of  $\leq 6$  grams” were not enabled. In particular, BASF argued that the specification only included examples of canister systems having a g-total BWC of between 2g and 6g that were able to meet the claimed emissions requirements. BASF further argued that certain examples taught away from the claimed invention by showing that when the g-total BWC was less than 2g, the inventors were unable to meet the requisite emissions performance.

The PTAB disagreed, and found that BASF had not sufficiently shown that the claims lack enablement under Ground 1. The PTAB first noted that BASF’s arguments were improperly based on the inventor’s state of mind, and failed to consider the knowledge of a POSA. Turning to the specification, the PTAB was not persuaded by BASF’s arguments because: (i) there was no explicit teaching that a g-total BWC outside the window of 2-6g would fail to achieve the claimed emissions requirements; and (ii) BASF’s interpretation of the examples unduly attributed emissions levels to the g-total BWC, without taking into account other parameters of a canister system that could have been adjusted to reduce emissions, such as purge volume.

As for Ground 2, BASF argued that the claim limitations requiring a two- or three-volume canister system were not enabled because the specification only disclosed one configuration of adsorbent volumes—a canister system consisting of four total volumes—that was capable of meeting the claimed emissions performance. The PTAB stated that BASF’s reliance on a prior art reference disclosing a canister system having two adsorbent volumes to show obviousness, in a related PGR proceeding involving the same patent-at-issue, contradicted BASF’s assertion that

undue experimentation would be required to arrive at a canister with two or three volumes. The PTAB also reiterated its finding above that BASF unduly attributed the emissions levels in the examples to the number of adsorbent volumes, without considering other parameters.

In Ground 3 and 4, BASF argued lack of written description and enablement of certain claims for the same reasons as in Grounds 1 and 2, which the PTAB rejected on the same bases.

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